

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INNOSCIENCE AMERICA, INC.,
Petitioner,

v.

INFINEON TECHNOLOGIES AMERICAS CORP.,¹
Patent Owner.

IPR2025-00010
Patent 9,070,755 B2

Before JO-ANNE M. KOKOSKI, CHRISTOPHER M. KAISER, and
MICHELLE N. WORMMEESTER, *Administrative Patent Judges*.

WORMMEESTER, *Administrative Patent Judge*.

DECISION
Denying Institution of *Inter Partes* Review
35 U.S.C. § 314

¹ The caption of Paper 6 lists Infineon Technologies Austria AG as the patent owner. Paper 6 (Patent Owner's Preliminary Response). Papers 3, 4, and 7, however, identify Infineon Technologies Americas Corp. as the patent owner. Paper 3, 1 (Patent Owner's Mandatory Notices); Paper 4 (Power of Attorney); Paper 7 (Patent Owner's Authorized Supplemental Preliminary Response (*see caption*)). Accordingly, we treat Infineon Technologies Americas Corp. as the patent owner in this proceeding.

I. INTRODUCTION

Innoscence America, Inc. (“Petitioner”) filed a Petition (Paper 1, “Pet.”) requesting *inter partes* review of claims 1–14 of U.S. Patent No. 9,070,755 B2 (Ex. 1001, “the ’755 patent”). Infineon Technologies Austria AG filed a Preliminary Response (Paper 6, “Prelim. Resp.”). With our authorization, Infineon Technologies Americas Corp. (“Patent Owner”)² filed a supplemental preliminary response (Paper 7, “Supp. Prelim. Resp.”), and Petitioner filed a preliminary reply (Paper 8, “Prelim. Reply”) to the supplemental preliminary response. *See* Ex. 2011 (e-mail authorization).

We have authority under 35 U.S.C. § 314 and 37 C.F.R. § 42.4(a) to institute *inter partes* review or to deny institution. *See Cuozzo Speed Techs. v. Commerce for Intellectual Property*, 579 U.S. 261, 273 (2016) (“[T]he agency’s decision to deny a petition is a matter committed to the Patent Office’s discretion.”). For the reasons that follow, we exercise our discretion to deny institution of *inter partes* review of the challenged claims.

II. BACKGROUND

A. Real Parties in Interest

Petitioner identifies itself as well as Innoscience (Zhuhai) Technology Company, Ltd. and Innoscience (Suzhou) Technology Holding Company, Ltd. as the real parties in interest. Pet. 94. Patent Owner identifies itself as the real party in interest. Paper 3, 1.

² As noted above, although Infineon Technologies Austria AG filed the Preliminary Response, we treat Infineon Technologies Americas Corp. as the patent owner. *See supra* n.1.

B. Related Proceedings

The parties identify various related matters. Pet. 94–95; Paper 3, 1. Two related matters include: (1) *Infineon Technologies Austria AG v. Innoscience (Suzhou) Technology Company, Ltd.*, No. 4:24-cv-01553 (N.D. Cal.) (hereinafter, “District Court Litigation”); and (2) *In re Certain Semiconductor Devices and Products Containing the Same*, Inv. No. 337-TA-1414 (USITC) (hereinafter, “ITC Investigation”). Pet. 94–95; Paper 3, 1. ITC stands for U.S. International Trade Commission.

C. The ’755 Patent

The ’755 patent is titled “Transistor Having Elevated Drain Finger Termination.” Ex. 1001, code (54). The abstract describes the subject matter as follows:

According to an exemplary implementation, a transistor includes drain finger electrodes interdigitated with source finger electrodes. The transistor also includes a current conduction path in a semiconductor substrate between the drain finger electrodes and the source finger electrodes. At least one of the drain finger electrodes has a drain finger electrode end and a drain finger electrode main body, where the drain finger electrode main body is non-coplanar with at least a portion of the drain finger electrode end. The transistor may also include a dielectric material situated between at least a portion of the drain finger electrode end and the semiconductor substrate. The dielectric material can be an increasing thickness dielectric material. The dielectric material can thus elevate the drain finger electrode end over the semiconductor substrate. Further, the drain finger electrode end can have an increased radius of curvature.

Id. at code (57).

D. Challenged Claims

Petitioner challenges claims 1–14 of the ’755 patent. Claims 1 and 10 are independent. Claim 1, reproduced below, is illustrative.

1. A transistor comprising:
 - drain finger electrodes interdigitated with source finger electrodes;
 - current conduction paths in a semiconductor substrate between said drain finger electrodes and said source finger electrodes;
 - at least one of said drain finger electrodes having a drain finger electrode main body and a drain finger electrode end, wherein at least a portion of said drain finger end is non-coplanar with said drain finger electrode main body.

Ex. 1001, 11:18–27.

E. Asserted Challenges to Unpatentability

Petitioner asserts seven challenges against various subsets of claims 1–14 of the ’755 patent as follows. Pet. 3, 14–93.

Claims Challenged	35 U.S.C. §³	References/Basis
1–5, 8–14	102	Fujishima ⁴
1–14	103(a)	Fujishima
6, 7	103(a)	Fujishima, Ludikhuize ⁵

³ The Leahy-Smith America Invents Act (“AIA”), Pub. L. No. 112-29, 125 Stat. 284 (2011), amended 35 U.S.C. §§ 102 and 103, effective March 16, 2013. Because the application from which the ’755 patent issued claims priority to an application filed before this date, we apply the pre-AIA versions of §§ 102 and 103.

⁴ U.S. Patent No. 5,523,599, issued June 4, 1996 (Ex. 1005).

⁵ U.S. Patent No. 5,910,670, issued June 8, 1999 (Ex. 1006).

Claims Challenged	35 U.S.C. § ³	References/Basis
8, 9, 14	103(a)	Fujishima, Sriram ⁶
13	103(a)	Fujishima, Beach ⁷
1–4, 8, 9	102	Asano ⁸
1–4, 8, 9	103(a)	Asano

In support of its challenges, Petitioner relies on a Declaration of Yuji Zhao, Ph.D. (Ex. 1003).

III. DISCRETIONARY DENIAL UNDER 35 U.S.C. § 314(a)

As noted above, the '755 patent is the subject of the related District Court Litigation and ITC Investigation. Pet. 94–95; Paper 3, 1. Patent Owner argues that we should exercise discretion to deny institution under 35 U.S.C. § 314(a) because the factors identified in *Apple, Inc. v. Fintiv, Inc.* IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (precedential), weigh in favor of denying institution in view of the ITC Investigation. Supp. Prelim. Resp. 1–10. Petitioner argues that we should not discretionarily deny institution. Prelim. Reply 1–10. For the reasons explained below, we exercise our discretion to deny institution under 35 U.S.C. § 314(a).

A. Fintiv Analysis

We consider the following six factors to assess “whether efficiency, fairness, and the merits support the exercise of authority to deny institution in view of an earlier trial date in the parallel proceeding”:

⁶ U.S. Publ’n No. 2006/0091498 A1, published May 4, 2006 (Ex. 1007).

⁷ U.S. Patent No. 7,417,257 B2, issued Aug. 26, 2008 (Ex. 1008).

⁸ U.S. Publ’n No. 2006/0255403 A1, published Nov. 16, 2006 (Ex. 1009).

1. whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted;
2. proximity of the court's trial date to the Board's projected statutory deadline for a final written decision;
3. investment in the parallel proceeding by the court and the parties;
4. overlap between issues raised in the petition and in the parallel proceeding;
5. whether the petitioner and the defendant in the parallel proceeding are the same party; and
6. other circumstances that impact the Board's exercise of discretion, including the merits.

Fintiv, Paper 11 at 5–6. In considering these factors, we apply the guidance set forth in a Memorandum regarding “Guidance on USPTO’s recission of ‘Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation,’” issued by the Chief Administrative Patent Judge of the Patent Trial and Appeal Board on March 24, 2025 (hereinafter, “Guidance Memo”).⁹

We address each of the *Fintiv* factors in turn.

1. Factor 1: Likelihood of Stay

A stay of parallel litigation pending resolution of an *inter partes* review allays concerns about inefficiency and duplication of efforts, and strongly weighs against exercising our authority to deny institution. *Fintiv*, Paper 11 at 6; Guidance Memo 2 (“[T]he Board will apply the *Fintiv* factors

⁹ Available at https://www.uspto.gov/sites/default/files/documents/guidance_memo_on_interim_procedure_recission_20250324.pdf.

when there is a parallel proceeding at the International Trade Commission.”).

The ’755 patent is involved in two parallel proceedings—the District Court Litigation and the ITC Investigation. Patent Owner argues Petitioner’s failure to request a stay in the ITC Investigation “strongly favors denial.” Supp. Prelim. Resp. 5. According to Patent Owner, the ITC Investigation is the relevant parallel proceeding for evaluating the *Fintiv* factors, given the District Court Litigation has been stayed pending the ITC Investigation. *Id.* (citing *Intel Corp. v. Koninklijke Philips N.V.*, IPR2021-00328, Paper 9 at 9 (PTAB July 16, 2021)). Patent Owner adds that “[s]tays in ITC investigations are rarely granted, and a stay based on an instituted [*inter partes* review] is especially unlikely here because the due date for the Board’s Institution Decision is May 20—**after** the ITC’s five-day evidentiary hearing is scheduled to begin (May 19).” *Id.*

Petitioner responds that “[t]his factor is neutral” because neither party has requested a stay of the ITC Investigation. Prelim. Reply 3. As to the District Court Litigation, Petitioner argues this factor “favors institution” because the District Court Litigation has been stayed. *Id.*

As noted above, the Guidance Memo says “the Board will apply the *Fintiv* factors when there is a parallel proceeding at the International Trade Commission.” Guidance Memo 2. Because the District Court Litigation has been stayed pending resolution of the ITC Investigation, we agree with Patent Owner that the ITC Investigation is the relevant parallel proceeding for evaluating the *Fintiv* factors. *See* Ex. 2007 (district court stay order); *see also Intel*, Paper 9 at 9 (“[T]hose [district court] proceedings were stayed

because of the ITC investigation [T]he ITC investigation is now the relevant parallel proceeding we must evaluate under the *Fintiv* factors.”).

Patent Owner is likely correct that the ITC would not be inclined to grant a stay, if one were even requested at this late date, given the ITC evidentiary hearing is scheduled to begin within days of entry of our institution decision in this case, not to mention the substantial investment by the ITC and the parties to date in the parallel ITC Investigation (as discussed below in connection with factor 3). Nevertheless, acknowledging the speculative nature of this assumption, we weigh this factor as neutral. *See Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 15 at 12 (PTAB May 13, 2020) (informative) (cautioning against speculating whether another tribunal would grant a stay if one were requested).

2. Factor 2: ITC Final Determination Date

Fintiv provides that an ITC trial date that is earlier than the Board’s projected statutory deadline for a final written decision may favor discretionary denial if the ITC is going to decide the same or substantially similar issues to those presented in the petition. *Fintiv*, Paper 11 at 8. The Guidance Memo further provides that “the Board is more likely to deny institution where the ITC’s projected final determination date is earlier than the Board’s deadline to issue a final written decision.” Guidance Memo 2.

Here, the ITC has set the target date for its final determination to March 2, 2026. Ex. 2010, 3 (ITC Order Amending the Procedural Schedule). Our final written decision would be due almost three months later, in late May 2026, should we institute *inter partes* review.

Patent Owner argues this factor “strongly favors denial.” Supp. Prelim. Resp. 6. Patent Owner asserts “[t]he nearly 3-month gap between the **conclusion** of the parallel proceeding (here, the ITC investigation) and the Board’s projected [final written decision] date is larger than in *Fintiv*, where this factor was found to weigh in favor of denial.” *Id.* (citing *Fintiv*, Paper 15 at 13).

Petitioner responds that this factor “is neutral or, at worst, slightly disfavors institution given the uncertainty of the target date for the [ITC]’s final determination and the short gap between the current ITC target date and the estimated [final written decision] deadline.” Prelim. Reply 3–4. Relying on other ITC investigations, Petitioner asserts the target date for complex cases “can be extended” and “delay is possible.” *Id.* at 4–5 (citing Ex. 1053, 2; Ex. 1054, 2; Ex. 1055, 1; Ex. 1056, 1; Ex. 1057, 2). According to Petitioner, “[t]he uncertainty of the target date and potential for delay support[] institution.” *Id.* at 5; *see also id.* at 9–10 (“Institution is particularly warranted here because there is a reasonable possibility the ITC target date is delayed, creating a situation where [the Board’s final decision] issues before the final ITC determination.”). Petitioner also argues “[t]his factor strongly favors institution for the district court case.” *Id.* at 3–4.

Considering the arguments and evidence presented by the parties, we find this factor weighs in favor of exercising discretion to deny institution. As noted above, the relevant parallel proceeding is the ITC Investigation. The ITC’s projected final determination date is March 2, 2026, almost three months before the final decision in this proceeding would be due in late May 2026. Although Petitioner raises a concern about the potential for delay at the ITC, nothing in the record indicates the ITC’s final determination date—

which Petitioner itself requested—will be postponed. *See* Ex. 2008 (ITC order setting an 18-month target date for the final determination where Petitioner proposed an 18-month target date). Because the ITC will address issues relating to the validity of the ’755 patent in an investigation where the final determination is set to occur months before we would issue a final decision, we weigh the second *Fintiv* factor as favoring discretionary denial.

3. *Factor 3: Investment in the Related ITC Investigation*

We consider now the amount and type of work that the ITC and the parties will have completed in the parallel investigation by the time of our institution decision. *See Fintiv*, Paper 11 at 9.

Patent Owner argues “this factor favors denial because of the ‘extensive’ investment in the ITC proceeding.” Supp. Prelim. Resp. 6–7. Patent Owner asserts “[t]he parties have already completed *Markman* briefing before the ITC.” *Id.* at 6. Patent Owner also asserts,

By the time the Board issues an institution decision (due May 20), the parties will have exchanged contentions and expert reports on validity, filed summary determination motions and pre-hearing briefs (including on validity), conducted the final pre-hearing conference before the [Administrative Law Judge], prepared and exchanged witness statements, prepared witnesses for the evidentiary hearing, and ***started*** the ITC’s five-day evidentiary hearing on May 19.

Id. In addition, Patent Owner notes that Petitioner filed its Petition two months after the ITC Investigation was instituted. *Id.* at 7.

Petitioner responds that “[t]his factor favors institution for both the district court . . . and ITC.” Prelim. Reply 5. For the ITC Investigation in particular, Petitioner acknowledges a claim construction order has issued but

notes the ITC determination will be due nearly ten months from the time we enter our institution decision. *See* Prelim. Reply 5; Ex. 1059 (ITC claim construction order filed by Petitioner). As to the timing of its Petition, Petitioner asserts that “[a]ny fact and expert discovery that occurred in the ITC Investigation ‘is not a result of Petitioner’s delay’ in filing its Petition.” Prelim. Reply 5 (citing *SharkNinja Operating LLC v. iRobot Corp.*, IPR2021-00545, Paper 11 at 7–8 (PTAB Sept. 8, 2021) (finding completion of substantial fact discovery and some expert discovery was not a result of the petitioner’s delay, where the petition was filed one day after the ITC initiated its investigation)).

Again, the relevant parallel proceeding is the ITC Investigation. We agree with Patent Owner’s assessment that work by the ITC and the parties is at an advanced stage. The ITC Investigation has been pending since August 27, 2024 (*see* Ex. 2007), and the evidentiary hearing is scheduled to begin within days of issuance of our institution decision (*see* Ex. 2010, 3). Claim construction and discovery are complete, and the parties are engaging in final preparations for the hearing. *See* Ex. 1059; Ex. 2009, 2–4 (ITC Order Setting the Procedural Schedule); Ex. 2010, 1–3. Petitioner’s timing argument, that any discovery having occurred in the ITC Investigation “is not a result of Petitioner’s delay,” is insufficient to overcome the substantial work completed in the ITC Investigation in preparation for a hearing to begin just days from now.

Under these circumstances, we find this factor strongly favors exercising our discretion to deny institution. *See Fintiv*, Paper 11 at 10 (“[C]laim construction orders may indicate that the court and parties have invested sufficient time in the parallel proceeding to favor denial.”); *id.* at 11

(“[I]t may impose unfair costs to a patent owner if the petitioner . . . waits until the district court trial has progressed significantly before filing a petition [H]owever, . . . it is often reasonable for a petitioner to wait to file its petition until it learns which claims are being asserted against it in the parallel proceeding. Thus, the parties should explain facts relevant to timing.”); *see also Motorola Sols., Inc. v. Stellar, LLC*, IPR2024-01205, Paper 19, 3 (PTAB Mar. 28, 2025) (Order Granting Director Review, Vacating the Decision Granting Institution, and Denying Institution of *Inter Partes* Review) (finding “factor 3 strongly favors discretionary denial” where “the parties had served extensive infringement and invalidity contentions, served opening and rebuttal expert reports, filed claim construction briefs, and conducted several depositions,” and “[t]he court also had held a claim construction hearing and construed the disputed claim terms”).

4. Factor 4: Overlap of Issues

This factor evaluates “concerns of inefficiency and the possibility of conflicting decisions” when substantially the same claims, challenges, arguments, and evidence are submitted in both the *inter partes* review proceeding and the parallel proceeding. *Fintiv*, Paper 11 at 12.

As an initial matter, we note the Petition in this proceeding challenges claims 1–14. Claims 1–4, 8, and 9 also are asserted in the ITC Investigation, whereas claims 5–7 and 10–14 are not. *See* Supp. Prelim. Resp. 7; Prelim. Reply 5–6.

Patent Owner argues this factor “weigh[s] in favor of discretionary denial” because “[t]here is significant overlap in the validity issues raised in

the Petition and in the parallel ITC investigation.” Supp. Prelim. Resp. 7. Patent Owner asserts that the Petition challenges independent claims 1 and 10 based on Fujishima and Asano, and that “[t]he *same* prior art . . . and arguments are *also* advanced in Petitioner’s ITC invalidity contentions against all the claims (claims 1–4 and 8–9) asserted in the ITC investigation.” *Id.* According to Patent Owner, “[t]he disputed issues in this proceeding are whether Petitioner established that Fujishima discloses a transistor with interdigitated electrodes and a drain finger electrode with a non-coplanar end . . . , and whether Petitioner established that Asano’s transistor meets the non-coplanar limitation under Petitioner’s own construction.” *Id.* at 7–8. Patent Owner contends “[t]hose claim limitations are in *every* claim at issue in the ITC proceeding.” *Id.* at 8.

Petitioner counters that this factor “heavily favors institution” because “[m]any issues here will not be considered in the ITC Investigation.” Prelim. Reply 6. Petitioner contends the claims asserted at the ITC relate to “elevating a drain finger electrode end.” *Id.* As for the claims not asserted at the ITC, Petitioner contends they relate to either “different geometric configurations, such as a curved drain finger electrode end and the relative length of drain finger electrode ends,” or a device with “a dielectric material of increasing thickness to elevate the drain finger electrode end.” *Id.* According to Petitioner, “[t]hese significantly different claims are also invalid over different grounds and references.” *Id.* Petitioner adds that the ITC “may not decide invalidity for *any* claims,” and that any “patent validity determinations are only for the purposes of resolving the alleged unfair trade practices and ‘do not have claim or issue preclusive effect even if affirmed [on appeal].’” *Id.* at 7; *see also id.* at 1 (citing Ex. 1049, 1–2 (notice of ITC

decision indicating the Commission adopted the Administrative Law Judge’s finding of invalidity for indefiniteness but took no position on other invalidity findings)). Lastly, Petitioner contends that “understanding the validity of the unasserted claims will inform Petitioner [of] the proper bounds of the claim scope,” which will guide Petitioner in its efforts to “create innovative new products” and “prevent future assertion by Patent Owner in potential serial litigation.” *Id.* at 6–7.

It is undisputed that there is overlap between the issues in this proceeding and the issues in the ITC Investigation as to claims 1–4, 8, and 9, and that the disputed limitations in this proceeding appear in every claim asserted in the ITC Investigation. And, “although an ITC final invalidity determination does not have preclusive effect, it is difficult as a practical matter to assert patent claims that the ITC has determined are invalid.” Guidance Memo 2. Because claims 5–7 and 10–14 are not asserted in the ITC Investigation, however, the ITC Investigation will not directly resolve the dispute as to the patentability of those claims, which are challenged in the Petition. Our review indicates the unasserted claims recite further limitations that need not be addressed in the ITC Investigation. *See, e.g.*, Ex. 1001, claim 5 (dependent claim requiring that “said drain finger electrode end has an increased radius of curvature”), claim 10 (independent claim requiring that “an increasing thickness dielectric material is situated between at least said portion of said drain finger electrode end and said semiconductor substrate”).

On balance, we find this factor weighs slightly against exercising our discretion to deny institution.

5. Factor 5: Identity of Parties

For this factor, we consider “whether the petitioner and the defendant in the parallel proceeding are the same party.” *Fintiv*, Paper 11 at 13 (emphasis omitted).

Both Petitioner and Patent Owner acknowledge that the parties in this proceeding and the ITC Investigation are the same. Supp. Prelim. Resp. 9; Prelim. Reply 8. Patent Owner asserts this factor “strongly favors denial,” whereas Petitioner views this factor as “neutral.” Supp. Prelim. Resp. 9; Prelim. Reply 8.

Applying Board precedent, we determine this factor weighs in favor of discretionary denial. *See Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12, 19 (PTAB Dec. 1, 2020) (precedential) (determining “this factor supports denying institution” where “the parties are the same in the *inter partes* proceeding and in the parallel proceeding”) (citing *Fintiv*, Paper 15 at 15; *Sand Revolution II, LLC v. Cont’l Intermodal Grp. – Trucking LLC*, IPR2019-01393, Paper 24, 12–13 (PTAB June 16, 2020)).

6. Factor 6: Other Circumstances, Including the Merits

The final *Fintiv* factor takes into account other circumstances that may bear on the decision to exercise discretion to deny, such as the merits of the patentability challenges. *Fintiv*, Paper 11 at 14–16.

For this factor, Petitioner makes various arguments. Petitioner argues “fairness considerations strongly support institution” where “[t]he potential remedy at the ITC may prohibit [Petitioner] from importing all accused products.” Prelim. Reply 9. According to Petitioner, “the ITC has shown

willingness” to suspend remedial orders pending resolution of an *inter partes* review. *Id.* Petitioner asserts that suspending remedial orders “serves the [America Invents Act]’s objective of establishing [*inter partes* review] as ‘a quick, inexpensive, and reliable alternative to district court litigation to resolve questions of patent validity.’” *Id.*

Petitioner’s argument is unpersuasive. There is no indication in the record that the ITC would suspend any remedial order, if one were to issue in the ITC Investigation, pending resolution of *inter partes* review in this proceeding should we institute review. Moreover, it is not clear why suspending a remedial order, as opposed to staying the ITC Investigation itself, would help establish *inter partes* review as an *alternative* to the ITC Investigation.

Petitioner further argues that institution “would achieve the goals of the [*inter partes* review] statute and perpetuate Congress’s intent to have the USPTO—and not the ITC—serve as the leading and specialized agency for adjudicating patentability issues.” Prelim. Reply 9. Petitioner adds that “[i]nstitution would also avoid unnecessary agency conflict and reduce duplicative and inefficient agency proceedings.” *Id.* at 10.

This argument also is unpersuasive. The Guidance Memo explains, [A]lthough an ITC final invalidity determination does not have preclusive effect, it is difficult as a practical matter to assert patent claims that the ITC has determined are invalid. *See Fintiv*, Paper 11 at 8–9. Additionally, instituting an [*inter partes* review] . . . where the ITC has set a target date for completing its investigation (i.e., the full Commission’s final determination) to occur earlier than the Board’s deadline to issue a final written decision in a challenge involving the same patent claims means that multiple tribunals may be adjudicating validity at the same

time, which may increase duplication and expenses for the parties and the tribunals.

Guidance Memo 2. As discussed above, the target date for completing the ITC Investigation is set to occur months before we would issue a final decision should we institute *inter partes* review in this proceeding. The invalidity of the '755 patent will have been litigated in the ITC Investigation, which is well underway with a hearing scheduled to begin within days of issuance of our institution decision. There is no indication that the ITC would grant a stay if one were to be requested. Contrary to Petitioner's position, institution here would not avoid unnecessary agency conflict or reduce duplicative agency proceedings.

As a separate matter, each party argues that the merits tip the balance in its favor. Supp. Prelim. Resp. 9–10; Prelim. Reply 8–9. Patent Owner argues “the Petition is fundamentally flawed.” Supp. Prelim. Resp. 9. Regarding the Fujishima challenges, Patent Owner asserts “Petitioner conflated different embodiments and failed to establish that Fujishima discloses any transistor meeting both interdigitated electrodes *and* a drain finger electrode with a non-coplanar end.” *Id.* As for the Asano challenges, Patent Owner asserts “Petitioner *ignored* disclosures in Asano demonstrating that Asano's transistor does not meet the non-coplanar limitation under Petitioner's own construction.” *Id.* at 9–10.

Petitioner counters that “the USPTO finally rejected claims substantially similar to those of the '755 patent during prosecution of a continuation application,” and that Patent Owner “fail[s] to dispute the USPTO's findings or that these findings show the strong merits of the Fujishima grounds.” Prelim. Reply 8. Petitioner also asserts “denying

institution would be improper because it is inconsistent with the USPTO's earlier determination." *Id.* at 8–9. According to Petitioner, "the strength of the merits alone outweighs any potential inefficiencies." *Id.* at 8.

Although we may consider the merits for this factor, a full analysis of the merits is not necessary; rather, the parties may point out particular strengths or weaknesses to aid us in deciding whether the merits tip the balance one way or another. *Fintiv*, Paper 11 at 14–16. We have considered the parties' arguments and evidence regarding the asserted challenges. *See* Pet. 14–92; Prelim. Resp. 2–65; Supp. Prelim. Resp. 9–10; Prelim. Reply 8–9. On this record, we find that the merits of Petitioner's asserted challenges do not outweigh the other *Fintiv* factors.

Petitioner's argument regarding the Office's rejection of the claims of a related continuation application does not alter our analysis. Petitioner cross-references its discussion in the Petition regarding the prosecution history of the continuation application. Prelim. Reply 8 (citing Pet. 10–13). In that discussion, Petitioner asserts that claim 10 of the '755 patent and rejected claim 10 of the continuation application are "substantially similar." Pet. 11. Referring to rejected claim 10 of the continuation application, Petitioner adds that the "applicant amended the independent claim to recite an additional limitation that the 'drain finger electrodes extend[] beyond said source finger electrodes so as to be situated closer to said source pad than said source finger electrodes'—a limitation not present in any of the '755 patent claims." *Id.* at 13 (citing Ex. 1022, 77 (prosecution history for the continuation application)). Petitioner asserts that the applicant "not[ed] that Fujishima failed to disclose the additional limitation," and that "[t]he

examiner issued an allowance relying upon the prior art's failure to disclose this additional limitation.” *Id.*

Although the additional limitation in claim 10 of the continuation application may not be recited in claim 10 of the '755 patent, we note that claim 10 of the '755 patent recites “an *increasing thickness* dielectric material is situated between at least said portion of said drain finger electrode end and said semiconductor substrate.” Ex. 1001, 12:24–26 (emphasis added). Claim 10 of the continuation application does not include the same limitation. Petitioner appears to acknowledge this difference in the claim language through its color coding of the limitations. *See* Pet. 11 (chart comparing claim 10 of the '755 patent and rejected claim 10 of the continuation application). Accordingly, we are not persuaded that denying institution here would be inconsistent with the Office's rejection of claim 10 of the continuation application, as Petitioner contends.

In view of the foregoing, we determine this factor is neutral.

B. Fintiv Determination

We have considered the circumstances and facts before us in view of the *Fintiv* factors. As discussed above, factors 1 and 6 are neutral, factors 2, 3, and 5 weigh in favor of discretionary denial of institution, with factor 3 strongly favoring discretionary denial, and factor 4 weighs slightly against discretionary denial. We conclude that, on balance, the evidence of record favors exercising our discretion to deny institution of *inter partes* review.

IV. CONCLUSION

For the reasons given above, we exercise our discretion under § 314(a) to deny institution of *inter partes* review.

V. ORDER

Accordingly, it is

ORDERED that the Petition is *denied* and no trial is instituted.

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