

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INNOSCIENCE AMERICA, INC.,
Petitioner,

v.

INFINEON TECHNOLOGIES AMERICAS CORP.,
Patent Owner.

Case No. IPR2025-00175
Patent No. 8,686,562

PATENT OWNER'S SUPPLEMENTAL BRIEF

TABLE OF AUTHORITIES¹

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¹ All emphasis added unless otherwise indicated.

I. ARGUMENT THAT ONE YU EMBODIMENT MEETS [1C] IS NEW

Petitioner's brief (Paper 28, "Br.") cites *Guardant* for the proposition that no motivation is required to modify a reference that discloses all elements of the claim in a single embodiment. That is not new law. *Guardant* is a ***non-precedential*** decision noting that the Court's *Realtime Data* decision from **2019** found this. *Guardant*, 2026 WL 184334, at *4-*5. If Petitioner wanted to argue that a single Yu embodiment meets the claims, it could (and should) have argued that in the Petition. Petitioner raised *Guardant* only as a pretext to support an improper new argument.

The Petition never argued that "Yu alone discloses the disputed limitation, in a single embodiment, unmodified." Br., 1. Indeed, Petitioner conceded that Yu does not disclose this. Petition, 38 ("Yu expressly discloses every element of claims 1 and 13 ***except*** a refractory metal nitride capping layer having a thickness greater than that of a bottommost layer (claim element [1c])."); Reply, 27 ("While Yu does ***not*** expressly disclose the claimed thickness of [1.C], it renders it obvious."). The Petition also never argued that "Yu includes a 600Å thick TiN and TaN capping layer." Br., 3. Instead, the Petition conceded: "While Yu discloses the capping layer is preferably 600Å... ***this disclosure is made with respect to the capping layer being polysilicon...*** which is ***not*** a refractory metal nitride..." Petition, 38.

Ground 5 is based on ***obviousness*** – not anticipation by Yu. Petition, 3, 33. Petitioner ***admitted*** Yu does not meet [1c] and made two obviousness arguments.

The Petition’s Yu-alone obviousness argument mixed teachings from different Yu embodiments. Petition, 38 (“A POSITA would have been motivated to replace Yu’s polysilicon” capping layer with a refractory metal nitride “using the same disclosed thicknesses.”). The Board recognized this. DI (Paper 10), 18. The assertion that Petitioner “preserved” an argument that Yu has a “single-embodiment disclosure” meeting [1c] by arguing that “Yu at least suggests” [1c] (Br. 1) fails for two reasons.

First, the Petition’s “Yu at least suggests [1c]” argument mixed disclosures from different embodiments. Petition, 43. The Petition cited a thickness teaching – “about 200-1,000Å, preferably about 600Å” (Petition, 43) – for Yu’s “present embodiment” where the capping layer “comprises polysilicon” (Yu, [0036]), and mixed it with teachings for what Yu says are different “embodiments” where “the capping layer may include metal” (*id.*). The “Yu at least suggests [1c]” argument (Petition, 43) was thus not based on “single-embodiment disclosure” in Yu (Br., 1).

Second, an IPR petition is not a notice pleading that “preserves” arguments. The ***Petition*** is where Petitioner needs to make its arguments “with particularity.” 35 U.S.C. § 312(a)(3). A later filing cannot advance an argument the Petition never presented. *Intelligent Bio-Sys. v. Illumina Cambridge*, 821 F.3d 1359, 1369 (Fed. Cir. 2016); *Luminex v. Signify Holdings*, IPR2024-00101, Paper 57, at 2, 5-6 (Feb. 5, 2026) (reversing FWD where panel adopted “new arguments” not in the petition). Petitioner’s “single-embodiment” theory was “absent from the petition” and should

be rejected. *Wasica v. Cont'l Auto.*, 853 F.3d 1272, 1286-87 (Fed. Cir. 2017).

II. ***GUARDANT DOES NOT APPLY***

Petitioner alleged a POSA would have used a 600Å TiN or TaN capping layer. Petition, 38; Reply, 28 (600Å was an “obvious” “suitable choice”). The assertion (Br., 3) that Yu ***discloses*** an embodiment with a TiN or TaN capping layer of 600Å fails. *In re Baird*, 16 F.3d 380, 382-383 (Fed. Cir. 1994) (disclosure of a genus with a vast number of possibilities is not disclosure of every species within that genus).

Motivation to combine is not required if the claim is “***disclosed in a single embodiment.***” *Guardant*, at *4. The assertion that “Yu ¶[0036] is that embodiment” (Br., 1) fails. Yu, [0036] discloses ***many*** embodiments, including “the ***present embodiment***” (600Å polysilicon capping layer) and “***embodiments***” using different materials and thicknesses. Yu says the capping layer can be “metal” – a massive genus with only some examples identified – and gives a huge range of possible thicknesses. *Id.* There is an almost limitless number of combinations of metals and thicknesses from 50Å-1000Å. *Guardant* distinguished “single embodiment” disclosure from a “combination of ***multiple embodiments...*** or ***selection from a large list of elements.***” *Guardant*, at *6. Because Yu, [0036] discloses multiple embodiments and Petitioner selects “from a large list,” *Guardant* does not apply. Petitioner needed to show motivation to select 600Å for a TiN or TaN capping layer.

Date: June 2, 2026

/Richard Giunta /

Richard F. Giunta, Reg. No. 36,149

CERTIFICATE OF SERVICE UNDER 37 C.F.R. § 42.6 (E)(4)

I certify that on June 2, 2026, a copy of the foregoing document, including any exhibits filed therewith, is being served via electronic mail, as previously consented to by Petitioner, upon the following:

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