

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LAM RESEARCH CORP.,
Petitioner

v.

INPRIA CORP.,
Patent Owner

Case IPR2025-00256
Patent No. 11,537,048

PATENT OWNER'S DISCRETIONARY DENIAL BRIEF

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<u>Exhibit No.</u>	<u>Description</u>
2001	Case Docket for <i>Inpria Corp. v. Lam Research Corp.</i> , C.A. No. 22-01359-CJB (D. Del.)
2002	Order, <i>Inpria Corp. v. Lam Research Corp.</i> , C.A. No. 22-01359-CJB, D.I. 116 (D. Del. May 3, 2024)
2003	Lam's Initial Invalidity Contentions, <i>Inpria Corp. v. Lam Research Corp.</i> , C.A. No. 22-01359-CJB (D. Del.) (May 13, 2024)
2004	Lam's Final Invalidity Contentions, Ex. 048-G, <i>Inpria Corp. v. Lam Research Corp.</i> , C.A. No. 22-01359-CJB (D. Del) (Feb. 20, 2025)
2005	Lam's Final Invalidity Contentions, Ex. 048-H, <i>Inpria Corp. v. Lam Research Corp.</i> , C.A. No. 22-01359-CJB (D. Del) (Feb. 20, 2025)
2006-2009	<i>Reserved</i>
2010	Lam's Final Invalidity Contentions, Ex. 048-B, <i>Inpria Corp. v. Lam Research Corp.</i> , C.A. No. 22-01359-CJB (D. Del) (Feb. 20, 2025)
2011	Lam's Initial Invalidity Contentions, Ex. 5, <i>Inpria Corp. v. Lam Research Corp.</i> , C.A. No. 22-01359-CJB (D. Del.) (Sept. 24. 2024)
2012	[Ex. 1024 from IPR2025-00309] - Declaration of Stephen Gillen
2013	Email from Stephen Gillen (Dec. 14, 2024, 12:40 AM ET)
2014	Email from Stephen Gillen (Dec. 14, 2024, 12:29 AM ET)
2015	USPS Packing Slip - EJ680364635US and EJ680364621US
2016	USPS.com® - USPS Tracking® Results - EJ680364621US
2017	USPS.com® - USPS Tracking® Results - EJ680364635US
2018	April 15, 2025 letter from Lam Counsel to Inpria counsel, <i>Inpria Corporation v. Lam Research Corp.</i> , Case No. 22-1359-CJB (D. Del.) and IPR2025-00256, regarding Sotera-type stipulation
2019-2028	<i>Reserved</i>
2029	Amended Complaint, <i>Inpria Corp. v. Lam Research Corp.</i> , C.A. No. 22-01359-CJB (D. Del.), D.I. 43 (Dec. 13, 2023)
2030-2038	<i>Reserved</i>

I. INTRODUCTION

Lam Research Corp.’s Petition is one of three recent IPRs (IPR2025-00256, -00267, and -00309) challenging a subset of patents at issue in *Inpria Corp. v. Lam Research Corp.*, 1:22-cv-01359 (D. Del.) (“the Delaware litigation”). The Petition should be discretionarily denied for at least two reasons. First, the Petition should be denied under *Fintiv* because it is duplicative of the parallel Delaware litigation, in which the validity of U.S. Patent No. 11,537,048 (“the ’048 patent”) will be decided on the same issues at a trial scheduled to occur four months *before* any Final Written Decision would issue here. In fact, the prosecution amendments that underpin the priority argument that is central to all of the grounds in the Petition are currently being considered by the district court in the context of claim construction and invalidity. Second, the Petition should be denied under *Advanced Bionics* because these prosecution amendments were also already considered extensively by the Examiner, and Lam fails to establish that the Examiner’s carefully considered decision was erroneous. Accordingly, the Petition should be denied because Lam is seeking a baseless do-over of both the prosecution and the parallel district court litigation.

II. BACKGROUND

A. District of Delaware Litigation

The '048 patent is currently being litigated in the District of Delaware. The Delaware litigation began on October 14, 2022, Ex. 2001 at 12 (D.I. 1),¹ and Inpria first asserted the '048 patent in an Amended Complaint served on December 13, 2023, *id.* at 17 (D.I. 43-44). *See also* Ex. 2029. Trial is scheduled for April 20, 2026. *Id.* at 62 (D.I. 443).

The district court has shown reluctance to stay the case or move the trial date. On May 3, 2024, the court considered and rejected a motion to stay the Delaware litigation pending resolution of an inventorship dispute in the Northern District of New York. *Id.* at 24 (D.I. 116). In denying the request for a stay, the court explained that “there is good evidence before the Court that Plaintiff and Defendant are competitors, and that granting the Motion could later harm Plaintiff in ways that might be difficult to remedy with money damages.” Ex. 2002 at ¶ 6.

On February 19, 2025, despite granting a one-month extension of deadlines for fact discovery and expert reports, the court held the trial date the same. Ex. 2001

¹ For the Board’s convenience, Inpria has included a printout of the district court docket sheet as Exhibit 2001 to reference certain filings, events, and orders from the parallel district court proceeding.

at 44. In an order considering a request to revise the case schedule around one month later, on March 28, 2025, the court again kept the December 2025 trial date in mind, advising the parties that further changes to the case schedule need to “still permit the case to be tried in or reasonably close to December 2025.” *Id.* at 56 (D.I. 383).

Even though the court eventually ended up postponing the trial until April 2026, the court did so only after finding good cause and noting this was still “reasonably close” to the originally scheduled date. *Id.* at 62 (D.I. 443). The court determined “[i]n light of the unexpected entry of a resource-intensive preliminary injunction process at an already-busy point in the current case schedule, there is good cause ... [for the] new schedule [that] seems to the Court a measured, responsible proposal as to how to do that and still go to trial ‘reasonably close’ to the current December 2025 trial date.” *Id.*

Patent validity issues have been moving forward in district court. On May 14, 2024, Lam served its Initial Invalidity Contentions. *Id.* at 8 (D.I. 117); Ex. 2003 at 14-15 (relying on the same Weidman and Molloy references as in this Petition). On October 18, 2024, the parties filed a Joint Claim Construction Brief, *id.* at 34 (D.I. 199), which Lam cites throughout its Petition and uses to frame its arguments (and those of Patent Owner) on the construction of claim terms and the priority date of the ’048 patent. Pet. at 5-13 (citing Ex. 1010).

On February 20, 2025, Lam served Final Invalidity Contentions. Ex. 2001 at 45 (D.I. 288). Lam is advancing arguments based not only on the references at issue in this Petition and other patents and printed publications, but also based on the same priority argument, system art (including in combination with art at issue in the IPR), and Section 112.

B. The '048 Patent Prosecution

Inpria's '048 patent underwent a thorough review during prosecution. There were three non-final office actions and two final office actions. Ex. 1002 at 70-85, 144-158, 206-222, 282-293, 478-490. During this extensive back-and-forth, the Petition's argument about amendments associated with Figure 16 was considered by the Office. In particular, in the first Office Action, the Examiner objected to the drawings and the claims, and rejected the claims. *Id.* at 479-481. In the response to the first Office Action, Inpria amended the application to incorporate Figure 16 and related text. *Id.* at 456-458, 472. Inpria explained how the amendment contained no new matter because it was based on the specification as filed, including, for example, *Maeng et al., Atomic Layer Deposition of Ta-Based Thin Films: Reactions of Alkylamide Precursor with Various Reactants*, J. VACUUM SCI. & TECHNOL. B 24:2276 (2006) ("Maeng"), which was incorporated by reference, and that explanation was accepted by the Patent Office. *See, e.g., id.* at 9-19, 16, 269, 456. Lam now attempts to parallel track its priority argument from the Delaware litigation

as well as relitigate the Patent Office's acceptance of the Figure 16 amendments during prosecution.

III. ARGUMENT

There are several reasons to discretionarily deny the Petition. Taking all the issues collectively, this is a compelling case for discretionary denial. *See NHK Spring Co., Ltd. v. Intri-Plex Techs., Inc.*, IPR2018-00752, Paper 8 (Sept. 12, 2018) (precedential) (considering both 325(d) and 314(a) and denying institution because the prior art was previously considered and because the parallel district court proceeding was nearing completion).

First and foremost, the Petition presents references and priority arguments that are redundant with validity issues in the Delaware litigation, in which trial is scheduled for April 2026, whereas a Final Written Decision in this case would not issue until August 2026. Lam submitted a *Sotera*² stipulation, but Lam presents the same priority argument, system art, written description arguments, and other invalidity arguments in the Delaware litigation that are not covered by the stipulation and thus Lam's stipulation does not materially reduce overlap between the proceedings.

² *Sotera Wireless, Inc. v. Masimo Corporation*, IPR2020-01019, Paper 12 (Dec. 1, 2020) (precedential).

Second, Lam's Petition should be denied as redundant because it relies on arguments that were already before the Office during a thorough and lengthy examination. The Examiner did not simply rubber-stamp these claims. Instead, they underwent significant examination for over two years which included consideration of the same arguments Lam applies here. This is not a petitioner seeking the answer to a different invalidity question, it is Lam seeking a different answer to the same invalidity question the Examiner already answered.

A. The *Fintiv*³ Factors Favor Discretionary Denial

1. Factor 1 – Whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted

Factor 1 favors denial because the district court has not granted a stay and it is extremely unlikely the court would grant a stay, given only some of the asserted patents have been challenged in IPRs, the advanced stage of the litigation (discussed below in Factor 3), and the pending Motion for Preliminary Injunction. Overall, the four petitions filed by Lam and Entegris, collectively, only challenge three of the

³ *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (March 20, 2020) (precedential).

eight asserted patents in the Delaware Litigation.⁴ This makes it extremely unlikely the district court would grant a stay due to the IPRs themselves. Lam appeared to recognize this reality because it never moved for a stay pending IPR2024-00033 regarding U.S. Patent No. 9,823,564 that is also at issue in the Delaware Litigation, even after that IPR was instituted.

The district court has also shown reluctance to stay the case for any other reasons. On May 3, 2024, the court denied a motion for a stay pending resolution of a separate district court case about an inventorship dispute between Inpria and another party, State University of New York (SUNY), in the Northern District of New York, involving all of the patents asserted in the district court (including the '048 patent). Ex. 2001 at 24 (D.I. 116); Ex. 2002. In denying the stay, the court explained that “there is good evidence before the Court that Plaintiff and Defendant are competitors, and that granting the Motion could later harm Plaintiff in ways that might be difficult to remedy with money damages.” Ex. 2002 at ¶ 6. The same analysis would apply if a stay were sought now. Additionally, Inpria has filed a Motion for Preliminary Injunction that has been briefed and argued to the district

⁴ 10,732,505; 9,823,564 (IPR2024-00033); 9,310,684; 10,642,153; 11,537,048 (IPR2025-00256 and IPR2024-00309); 11,673,903 (IPR2025-00267); 11,693,312; 11,809,081. Ex. 2001 at 13 (D.I. 3), 17 (D.I. 44).

court, who is currently considering the motion, making a stay even less likely. Ex. 2001 at 50 (D.I. 315), 67 (Minute Entry for Hearing on Plaintiff's Motion for Preliminary Injunction held on April 25, 2025).

Thus, the district court has not granted a stay, has denied a request for a stay, and has indicated why it would be unlikely to grant a stay. The IPRs challenge only some of the asserted patents in the litigation, which is in its advanced stages, and a preliminary injunction motion is currently pending. The low likelihood for a stay weighs in favor of discretionary denial.

2. Factor 2 – Proximity of the court's trial date to the Board's projected statutory deadline for a final written decision

Factor 2 strongly favors denial because the district court's trial date is scheduled four months *before* the Board's projected statutory deadline for a final written decision. Duplicative litigation such as this weighs heavily in favor of discretionary denial.

The Board has consistently denied institution on discretionary grounds where a co-pending district court trial was scheduled for a date before the Board's Final Written Decision deadline. *See Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 15, at 17 (May 13, 2020) (informative) (trial scheduled two months before the final written decision favored denial); *NHK*, Paper 8, at 20 (trial scheduled six months before the final written decision favored denial); *see also Motorola Solutions, Inc. v. Stellar, LLC*, IPR2024-01205, -01206, -01207 & -01208, Paper 19, at 3-4 (Mar.

28, 2025) (Director Review decision *sua sponte* vacating institution where trial was scheduled eleven months before the final written decision); *Nokia of Am. Corp. v. Godo Kaisha IP Bridge*, IPR2022-00755, Paper 9, at 10 (Nov. 2, 2022) (trial scheduled eleven months before the final written decision favored denial).

The Delaware litigation is scheduled for trial on April 20, 2026. Ex. 2001 at 62 (D.I. 443). This date is unlikely to move, as the District Court has already extended the date once (to allow for third-party discovery) and the court has indicated a reluctance to reschedule the trial. For instance, on February 19, 2025, despite granting a one-month extension of deadlines relating to fact discovery and expert reports, the court did not reschedule the trial date. *Id.* at 44. Next, on March 28, 2025, the court indicated its sensitivity to moving the trial date, noting that further changes to the case schedule need to “still permit the case to be tried in or reasonably close to December 2025.” *Id.* at 56 (D.I. 383). Although the court recently postponed the trial until April 2026, the court did so only after finding good cause: “[i]n light of the unexpected entry of a resource-intensive preliminary injunction process at an already-busy point in the current case schedule, there is good cause ... [for the] new schedule [that] seems to the Court a measured, responsible proposal as to how to do that and still go to trial ‘reasonably close’ to the current December 2025 trial date.” *Id.* at 62 (D.I. 443). Thus, even when the date was

extended, the court kept in mind the originally scheduled December 2025 date and required the new date to be “reasonably close” to that.

Meanwhile, the Board’s institution decision of this Petition is due in August 2025, and if this Petition were instituted, the Board’s final written decision would be due in August 2026. Because the court’s reluctance to postpone the trial date suggests that the trial date will occur well before the Board’s projected statutory deadline for a final written decision, the Board should deny the Petition to prevent further burdening of the parties with simultaneous litigation in two forums and prevent the possibility of inconsistent outcomes. This factor weighs strongly in favor of discretionary denial.

3. Factor 3 – Investment in the parallel proceeding by the court and the parties

Factor 3 favors denial because Lam could have challenged the ’048 patent earlier, but instead chose to wait and see the district court and the parties make (and continue to make) significant investments in the parallel district court proceeding.⁵

The Delaware litigation started on October 14, 2022. Ex. 2001 at 12 (D.I. 1). Lam was accused of infringing the ’048 patent on December 13, 2023. *Id.* at 17 (D.I.

⁵ Factor 3 additionally favors denial when “the evidence shows that the petitioner did not file the petition expeditiously.” *Fintiv*, Paper 11, at 11-12.

43). Instead of filing this Petition shortly thereafter, Lam made the parties first make the following significant investments in the Delaware litigation:

- Initial Invalidity Contentions: Lam showed no interest in the efficiencies of resolving patentability before the Board because instead of filing this Petition, Lam served Initial Invalidity Contentions on May 14, 2024. *Id.* at 24 (D.I. 117). Lam could have filed this Petition much earlier because the Initial Invalidity Contentions relied on the Weidman and Molloy references that Lam ultimately used in this Petition. Ex. 2003 at 14-15. Furthermore, Lam knew of its other two references, Meyers⁶ and Berney⁷, for a long time prior.
- Claim construction: On October 18, 2024, the parties filed a Joint Claim Construction Brief, including on terms appearing in the '048 patent, Ex. 2001 at 34 (D.I. 199); the court conducted a *Markman* hearing on November 6, 2024, *id.* at 36; and the court issued a partial *Markman*

⁶ On December 13, 2023, Lam was accused of infringing the '048 patent, for which Meyers is the parent. Ex. 1001 at code 63 ("15/291,738"); Ex. 1006 at code 21 ("15/291,738").

⁷ On June 27, 2019, Lam filed Berney. Ex. 1020, code 30 ("27 June 2019"), code 71 ("Lam Research Corporation").

order on December 11, 2024, *id.* at 38-40, with the parties awaiting additional orders.

- Final Invalidity Contentions: On February 20, 2025, Lam served its Final Invalidity Contentions that rely on the same references and arguments as those in this Petition in addition to other references, as well as the same priority argument, system art (including in combination with art at issue in the IPR), and Section 112. *Id.* at 45 (D.I. 288); Ex. 2004; Ex. 2005.⁸
- Preliminary Injunction: On March 10, 2025, Inpria filed a Motion for Preliminary Injunction, Ex. 2001 at 50 (D.I. 315), and both parties filed responsive briefs in advance of the court's preliminary injunction hearing, which was held on April 25, 2025, *id.* at 67. Both parties filed post-hearing supplemental briefs on May 7, 2025. *Id.* at 71 (D.I. 525, 526).
- Fact Discovery: The parties are at the very end of Fact Discovery, which will be completed by July 18, 2025. *Id.* at 68 (D.I. 508).

⁸ Inpria can only file public portions of Lam's Final Invalidity Contentions with this paper because Lam designated other portions as Attorney Eyes Only under the district court Protective Order.

- Expert Reports: The parties are quickly approaching expert discovery.

By August 2025, the parties will have exchanged opening and rebuttal expert reports. *Id.*⁹

While the parties made significant investments into the Delaware litigation, dealing with some of the very issues Lam argues in the Petition, Lam chose to strategically try to wait until the last second to initiate this IPR. Lam should not be rewarded for delaying its Petition in order to narrow the binding effect of the proceeding and to throw a wrench in the parallel litigation that is gearing up for trial. Accordingly, Factor 3 very strongly weighs in favor of denial.

4. Factor 4 – Overlap between issues raised in the petition and in the parallel proceeding

Factor 4 strongly favors denial notwithstanding the *Sotera* stipulation submitted by Lam. *See* Ex. 2018. First, Lam’s *Sotera* stipulation does not prevent Lam’s priority date challenge from remaining duplicative with its claim construction and invalidity arguments. Lam’s Petition challenges the priority date of the ’048 patent by challenging whether the claims are “supported by the original specification.” Pet. at 9-13. Lam’s arguments center around whether “Figure 16

⁹ In considering Factor 3, the “Board also has considered the amount and type of work already completed in the parallel litigation by the court and the parties *at the time of the institution decision.*” *Fintiv*, Paper 11, at 9-10 (emphasis added).

and related text—which Inpria argued provided support for multiple limitations in the independent claim—are new matter introduced after the original specification’s filing.” *Id.* at 13. This issue must be resolved to determine whether Meyers and Berney, at least one of which is present in each of the Petition’s grounds, are prior art to the ’048 patent. *Id.* at 3, 13-14. Although deciding this issue requires a written description inquiry, Lam wants to litigate this issue twice by expressly stating that its *Sotera* stipulation does not apply to “written-description issues.” Ex. 2018 at 2.

Lam made the same arguments based on Figure 16 in its claim construction briefing and Final Invalidity Contentions. In claim construction briefing, Lam’s arguments are so similar that many are the same verbatim. *See* Ex. 1010 at 44-48, 51-53; *compare id.* at 35-36 *with* Pet. at 10-11. The court already conducted a *Markman* hearing on November 6, 2024 (*id.* at 36); and the court issued a partial *Markman* order on December 11, 2024 (*id.* at 38-40), with the parties awaiting additional orders. In the Final Invalidity Contentions, Lam asserts the same priority arguments and written description arguments.¹⁰ Lam’s *Sotera* stipulation is not

¹⁰ In addition to its argument that the ’048 patent’s incorporation by reference from Maeng was improper, Lam also presents arguments that the claims are obvious in view of Maeng. *See* Ex. 2010; Ex. 2011.

meaningful: it cannot prevent the court from considering the same Figure 16 arguments to construe the claims or determine their validity.

Second, Lam’s *Sotera* stipulation also does not prevent Lam from raising the references in this Petition in combination with system art, as it is doing in its invalidity contentions.¹¹ By asserting system art in combination with the references in this Petition, both the Board and the district court would analyze the references presented in this Petition. Moreover, as explained in relation to Factors 1 and 2, the district court would do so before the Board’s FWD. *See Motorola*, Paper 19, at 4 (when “invalidity arguments in the district court are more expansive and include combinations of the prior art asserted in these proceedings with unpublished system prior art ... the stipulation does not outweigh the substantial investment in the district court proceeding or *Fintiv* factors 1, 2, and 5”).¹² The *Sotera* stipulation is not

¹¹ Nor will statutory estoppel apply. *See Ingenico Inc. v. Ioengine, LLC*, No. 2023-1367, 2025 U.S. App. LEXIS 10956, at *19 (Fed. Cir. May 7, 2025).

¹² Before former Director Vidal’s 2022 memorandum, which is now rescinded, the Board also denied institution when the trial date was scheduled before the FWD despite a *Sotera* stipulation. *See Cisco Systems Inc v. Estech Systems Inc*, IPR2021-00333, Paper 12, at 11-13 (Jul. 7, 2021).

meaningful when it cannot prevent Lam from presenting the same references to both the Board and the district court.

For all these reasons, Factor 4 weighs in favor of denial.

5. Factor 5 – Whether the petitioner and the defendant in the parallel proceeding are the same party

Lam is both the Petitioner and the defendant in the Delaware litigation. Accordingly, Factor 5 weighs in favor of denial.

6. Factor 6 – The merits are weak because the priority date challenge is legally improper and incorrect on the merits

Factor 6 favors denial because Lam erroneously argues that the '048 patent could have a priority date as of the date of an amendment during prosecution. This argument contravenes the fundamentals of patent law, which defines that the effective filing date of an application is its filing date. *See* 35 U.S.C. § 100(i). Such glaring weakness in the merits favors denial.

Lam's Petition relies on a theory of breaking the priority chain between the '048 patent and the instant specification filed on August 6, 2020, as well as any earlier-filed non-provisional or provisional application to which the '048 patent claims priority. *See* Pet. at 9-13. Based on this theory, Lam alleges that “the earliest priority date (or effective filing date) for the Challenged Claims is January 20, 2021—the date that the first version of Figure 16 and related text were added.” *Id.* at 13.

Lam’s priority date theory is legally defective. The effective filing date of the ’048 patent can only be its August 6, 2020 actual filing date or the filing date of a priority application—such as a parent or grandparent application—and not the filing date of a later-filed amendment. This is shown by the applicable statutory text:

35 U.S.C. § 100 - Definitions

...

(i)

(1) The term “effective filing date” for a claimed invention in a patent or application for patent means—

(A) if subparagraph (B) does not apply, the actual filing date of the patent or the application for the patent containing a claim to the invention; or

(B) the filing date of the earliest application for which the patent or application is entitled, as to such invention, to a right of priority under section 119, 365(a), 365(b), 386(a), or 386(b) or to the benefit of an earlier filing date under section 120, 121, 365(c), or 386(c).

The Board has repeatedly found that the priority date of an application is either its filing date or the filing date of its parent application, but not the date of any amendments during prosecution. *See David O. B. A. Adebimpe v. The Johns Hopkins University*, PGR2016-00020, Paper 14, at 3-4, (Jul. 25, 2016) (“Section 100(i)(1) does not make any provision for the effective filing date to be later than the actual filing date of the application in question, even when the application is amended later, and even when the later amendment introduces claims that lack written-description support in the original specification.”); *Front Row Technologies, LLC v. MLB Advanced Media, L.P.*, PGR2015-00023, Paper 8, at 3, (Feb. 22, 2016) (“[n]owhere does the statute contemplate that the effective filing date might depend on the date of a *later-filed* amendment”); *MPL Brands NV, Inc. v. BuzzBallz, LLC*, IPR2024-01098, Paper 8, at 17-26 (Jan. 27, 2025) (finding that if a patent claimed priority to a grandparent but the intervening parent added unsupported figures during prosecution, the patent could have an effective filing date of the intervening parent rather than the date the figures were added). Lam’s priority theory is also inconsistent with precedent rejecting a “late claiming” doctrine for determining the effective filing date of an application. *See Westphal v. Fawzi*, 555 F.2d 575, 577 (C.C.P.A. 1981) (holding that “[a]n amendment of a claim or a later filed claim does not change the ‘date of the application’ as the reference date for applicability of the time bars in § 102(b)”).

Lam cites no case to the contrary. Lam’s citation to *Muncie Gear Works v. Outboard, Marine & Mfg. Co.*, 315 U.S. 759, 768 (1942) from over eighty years ago, Pet. at 10, is inapposite for at least the reason that it does not interpret the relevant statutory authority which defines “effective filing date.” 35 U.S.C. § 100(i)(1). Lam’s citation to *Enzo Biochem, Inc. v. Gen-Probe Inc.*, 323 F.3d 956, 987 (Fed. Cir. 2002) states the general proposition that added material must find support in the original specification. See Pet. at 10. This does not support Lam’s theory that the effective filing date of a patent—even to the extent that added matter is not supported—is controlled by the filing date of the added matter.

On the merits, the ’048 patent claims are entitled to an effective filing date of at least October 12, 2016. See Ex. 1001 at code 65 (claiming priority to, *inter alia*, “application No. 15/291,738, filed on Oct. 12, 2016”). Lam attempts to disrupt this priority claim by arguing Inpria’s addition of Figure 16 during prosecution constituted new matter, and thus, according to Lam, the ’048 patent claims are only entitled to an effective filing date of the day the final form of Figure 16 was added. Pet. at 9-13. The second part of Lam’s argument is legally incorrect for the reasons above, but the predicate is faulty as well. Inpria’s amendments adding Figure 16 were supported by the original specification, including both express disclosures and incorporation by reference of Maeng, and therefore did not constitute new matter. Because the claims are entitled to at least an October 12, 2016 priority date (if not

earlier), Ground 1 fails for relying on Meyers's April 13, 2017 publication date and Grounds 2 and 3 fail for relying on Berney's December 30, 2020 publication date. Pet. at 13.

Thus, as explained more fully in the concurrently filed preliminary response, the merits of Lam's underlying priority argument, which was already considered during prosecution and is currently being considered in District Court, are weak. Moreover, as also explained in the Preliminary Response, the Petition was served late and is barred under 35 U.S.C. § 315(b).

Accordingly, Factor 6 weighs in favor of denial.

B. Institution Should Be Denied Because the Office Did Not Err While Considering Lam's Priority Challenge Argument During Prosecution

The Director should reject the Petition because the Office already considered Lam's arguments and Lam fails to show that the Office erred in considering those arguments.

**1. Lam’s Argument was Already Considered by the Office
(*Advanced Bionics*¹³ Step 1 (*Becton, Dickinson*¹⁴ Factors (a),
(b), and (d))**

To challenge the priority date of the ’048 patent, Lam raises the same exact argument previously considered by the Office: whether “Figure 16 and related text—which Inpria argued provided support for multiple limitations in the independent claim—are new matter introduced after the original specification’s filing.” Pet. at 13. Lam argues that Inpria’s amendments were “new” or “improperly added during prosecution” from the Maeng reference. *Id.* at 9-13. As explained below, the Examiner considered the same argument and allowed the application after Inpria explained that its amendments were based on the application as filed, including, for example, the Maeng reference, which Inpria’s original specification had incorporated by reference.¹⁵

¹³ *Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6 (Feb. 13, 2020) (precedential).

¹⁴ *Becton, Dickinson & Co. v. B. Braun Melsungen AG*, IPR2017-01586, Paper 8 (Dec. 15, 2017) (precedential).

¹⁵ The Examiner also thoroughly considered Maeng by applying it in obviousness rejections in four office actions. Ex. 1002, 70-85, 144-158, 206-222, 282-293, 478-

Lam argues that “[specification] does not describe structures configured to deliver flow of an organotin compound or a second precursor vapor,” Pet. at 12-13, which is the same argument made by the Examiner in the first Office Action:

6. Claim limitation “structure configured to deliver flow from a supply of an organotin compound” invokes 35 U.S.C. 112(f) or pre-AIA 35 U.S.C. 112, sixth paragraph.

[...]

8. Claim limitation “structure to deliver a second precursor vapor” invokes 35 U.S.C. 112(f) or pre-AIA 35 U.S.C. 112, sixth paragraph.

Ex. 1002 at 481.

14. However, the written description fails to disclose the corresponding structure, material, or acts for performing the entire claimed functions and to clearly link the structure, material, or acts to the functions.

Id. at 482. In the response to the first Office Action, Inpria amended the application to incorporate Figure 16 and related text. *Id.* at 456-458, 472. Inpria stated that the amendment contained no new matter because it was based on the specification of the application as filed, including a figure and related text in Maeng, which was incorporated by reference. *Id.* at 456. The Examiner withdrew this argument in the second Office Action. *Id.* at 292.

490. In the Delaware litigation, Lam also presents arguments that the claims are obvious in view of Maeng. *See* Ex. 2016; Ex. 2017.

In the second Office Action, the Examiner raised a new argument that was nonetheless similar to Lam's current argument:

8. No clear **structure** is found in the drawings or specification which delivers a flow of from a supply of an inert gas, **deliver a first precursor vapor** deliver, **a second precursor vapor**, deliver a third precursor vapor, deliver flow comprises one or more vapor inputting structures, deliver a first flow, deliver a second flow or deliver a third flow. No clear structure is found in the drawings or specification for selection of the pressure and/or the temperature in the deposition chamber.

Id. at 285-286. In the response to the second Office Action, Inpria amended Figure 16 and related text. *Id.* at 265, 269-270. Inpria again stated that the amendment contained no new matter because it was supported by the specification, including, for example the same figure and related text in Maeng. *Id.* at 269.

In the third Office Action, the Examiner accepted Inpria's amendments and withdrew the associated objections and rejection. *Id.* at 208 ("The drawings were received on April 13, 2021. These drawings are acceptable."), 208-211 (interpreting, but not rejecting, the claims under 112(f)). Over the course of two more Office Actions and an Advisory Action, Inpria and the Examiner engaged in additional back-and-forth about the prior art and 112(f) interpretations. *Id.* at 38-60 (Appeal Brief to the Board), 70-85 (Fifth Office Action), 100-112 (Response to fourth Office Action and Advisory Action), 123-127 (Advisory Action), 131-141 (After Final Response to fourth Office Action), 144-158 (fourth Office Action), 198-204

(Response to third Office Action). The Examiner ultimately allowed the application while considering Inpria's amendments associated with Figure 16. *Id.* at 9-19, 16 (considering Inpria's amendments associated with Figure 16 to interpret the claims).

* * *

As shown above, the Office already carefully considered Lam's arguments about Inpria's amendments, and determined that Inpria's amendments do not contain new matter.

2. Lam Fails to Establish That the Office Erred in its Consideration of Inpria's Amendments (*Advanced Bionics* Step 2 (*Becton, Dickinson* Factors (c), (e), and (f)))

Despite asking the Office for a reconsideration of the carefully examined '048 patent, Lam does not even allege that the Office erred. *See* Pet. at 77. Lam attempts to sidestep its requirement to show error by instead presenting arguments about Inpria's amendments while describing the '048 patent. *See id.* at 9-13. To the extent Lam's priority chain arguments allege Office error, Lam is wrong: the Office did not err in issuing the claims.

When a patent applicant incorporates a document by reference, the "information incorporated is as much a part of the application as filed as if the text was repeated in the application." MPEP § 2163.07(b). However, if the applicant's claims rely on material in an incorporated reference for § 112 support, and that incorporated reference is not a U.S. patent or U.S. patent application publication, the

applicant must “submit[] an amendment ... to include the material incorporated by reference.” MPEP § 608.01(p)(I)(A); *see also id.* at Examples 1 and 2; 37 C.F.R. § 1.57(d), (g).¹⁶ In other words, the applicant must expressly incorporate the relied-upon material that was previously incorporated only by reference.

Such an amendment expressly incorporating previously incorporated-by-reference material is allowed under the rules and precedent. *See* 37 C.F.R. § 1.57(g); *In re Hawkins*, 486 F.2d 569, 574-75 (C.C.P.A. 1973); *see also* MPEP § 608.01(p). But in making the amendment, the applicant must confirm that the amendment does not include “new matter.” *See* 37 C.F.R. § 1.57(g). Inpria complied with those requirements in adding Figure 16 by referring to the original specification, including, for example, the “incorporation by reference of Maeng et al.” and by confirming that “[n]o new matter is introduced.” Ex. 1002 at 456-457.¹⁷

¹⁶ The reason being that, under 37 C.F.R. § 1.57(d), “essential matter” (matter upon which the claims rely for § 112 support) may only be incorporated by reference for a U.S. patent or U.S. patent application publication. Because Inpria amended its specification, Lam’s hypothetical situation where Maeng’s figure would be relied on only by bare incorporation by reference, Pet. at 11 n.2, is irrelevant.

¹⁷ Lam’s weak attempt to twist an admission out of Inpria’s description of Figure 16 as “new” when it was added to the specification, Pet. at 10, should be rejected out of

Under 35 U.S.C. § 132, the Office reviews the added matter in the specification amendments to determine whether to object to the added matter as new matter and reject any affected claim limitations under 35 U.S.C. § 112. *See* MPEP §§ 608.04, 2163.06, 2181(III). In reviewing such amendments, the Office explains that “rephrasing” and “[a]mendments ... which are supported in the original description are NOT new matter.” MPEP § 2163.07. Furthermore, information contained in the drawings can be added to the specification (or vice versa) “without introducing new matter.” MPEP § 2163.06. The Examiner here reviewed the amendments and did not issue a new matter rejection. *See* Ex. 1002 at 456 (adding Fig. 16), 284 (Examiner acknowledging addition of Fig. 16 without including new matter rejection, but requiring corrected drawings), 269 (amending Fig. 16 as specified by Examiner), 16 (Notice of Allowance relying on structure from Fig. 16). Collectively, this means that Inpria’s amendments adding Figure 16 did not constitute new matter, as the Examiner correctly found, because the amendments were supported by the specification as filed, including, for example, Maeng’s Figure 1 that was previously incorporated by reference. *See* Ex. 1010 at 31-33, 40-41 (citing Ex. 1001 at 19:64-20:10).

hand. The question is not whether the figure was “new,” but rather whether it was “new matter,” which it was not for the reasons described in this section.

Lam contends here—just as it does in the Delaware litigation—that Figure 16 and the corresponding text are new matter because that figure is an “altered” version of Figure 1 in Maeng. Pet. at 11. But Lam fails to rebut the specification support that Inpria identified, instead only giving a deficient facial description of the passage—which Lam’s expert then parrots (even copying the same emphasis), Ex. 1003 at ¶ 31—without describing how its cursory description of the specification connects to the supposedly different aspects between the figures. Pet. at 12-13 (citing Ex. 1003 at ¶¶ 30-33). And even though Inpria included thorough expert testimony describing how “the alterations are supported by the originally filed specification,” Ex. 1010 at 41, Lam fails to rebut this showing in its Petition.

Lam also recycles its argument from the Delaware Litigation attempting to manufacture an inconsistency between the patentee’s position that Figure 16 is supported through the incorporation by reference of Maeng and Inpria’s arguments during prosecution to overcome Maeng. Pet. at 12. But contrary to Lam’s argument, Inpria did not argue that Maeng’s “apparatus” was “unable to perform the claimed function of delivering an organotin compound.” *Id.* Instead, Inpria argued that Maeng’s “process conditions,” such as “high heating,” were not suitable for forming and preserving an organotin layer. Ex. 1010 at 41; Ex. 1002 at 53-54, 202-203.

As Inpria has already demonstrated—and Lam has given no reason to second guess here—Inpria’s amendment adding Figure 16 was proper and did not add new matter. Lam’s contrary arguments are without merit.

* * *

For these reasons, Lam’s arguments in this Petition were presented to the Examiner, but Lam has not demonstrated that the Examiner erred when determining that Inpria’s amendments did not contain new matter. Accordingly, Lam’s Petition should be denied.

IV. CONCLUSION

For these reasons, Inpria respectfully requests that the Board deny the Petition for *inter partes* review of the ’048 patent.

Respectfully submitted,

Dated: May 12, 2025

By: /Naveen Modi/
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Counsel for Patent Owner

CERTIFICATE OF COMPLIANCE

Pursuant to 37 C.F.R. § 42.24(d), the undersigned certifies that the foregoing Patent Owner's Discretionary Denial Brief contains, as measured by the word-processing system used to prepare this paper, 5,900 words. This word count does not include the items excluded by 37 C.F.R. § 42.24.

Respectfully submitted,

Dated: May 12, 2025

By: /Naveen Modi/
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CERTIFICATE OF SERVICE

I hereby certify that on May 12, 2025, I caused a true and correct copy of the foregoing Patent Owner's Discretionary Denial Brief to be served via email on Petitioner at the following addresses:

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