

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

**PETITIONER'S RESPONSE TO PATENT OWNER'S DISCRETIONARY
DENIAL BRIEF**

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1004	<i>Curriculum Vitae</i> of Seán Barry, Ph.D.
1005	U.S. Patent No. 8,536,068 (“Weidman”)
1006	U.S. Patent Application No. 2017/0102612 (“Meyers”)
1007	U.S. Patent No. 9,328,416 (“Dhas”)
1008	B. Cardineau, et al., <i>Photolithographic properties of tin-oxo clusters using extreme ultraviolet light (13.5 nm)</i> , Microelectronic Engineering 127 (2014) 44-50 (“Cardineau”)
1009	K. Molloy, <i>Precursors for the formation of tin(IV) oxide and related materials</i> , J. Chem. Research (Oct. 2008) 549-554 (“Molloy”)
1010	<i>Inpria Corp. v. Lam Research Corp.</i> , No. 1-22-cv-01359, Dkt. No. 199, Joint Claim Construction Brief (D. Del. Oct. 18, 2024)
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1020	PCT published Application WO 2020263750 (“Berney”)
1021	<i>Inpria Corp. v. Lam Research Corp.</i> , No. 1-22-cv-01359, Dkt. No. 59, Scheduling Order (D. Del. Jan. 1, 2024)
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1027	<i>Inpria Corp. v. Lam Research Corp.</i> , No. 1-22-cv-01359, Dkt. No. 426, MOTION for Leave to File Amicus Curiae Brief - filed by The Research Foundation for The State University of New York (D. Del. Apr. 9, 2025)
1028	<i>Inpria Corp. v. Lam Research Corp.</i> , No. 1-22-cv-01359, Dkt. No. 426-1, Exhibit 1 - filed by The Research Foundation for The State University of New York (D. Del. Apr. 9, 2025)
1029	<i>Inpria Corp. v. Lam Research Corp.</i> , No. 1-22-cv-01359, Dkt. No. 499, Opening Brief in Support of [315] MOTION for Preliminary Injunction Redacted

I. INTRODUCTION

Lam Research Corp. (“Petitioner”) hereby responds to Patent Owner’s Discretionary Denial brief dated May 12, 2025. Discretionary denial is not appropriate for the reasons set forth in the Petition (at 77-79) and elaborated below. *Sotera* remains precedential, and Petitioner’s full *Sotera* stipulation “weigh[s] strongly in favor of not exercising discretion to deny institution under 35 U.S.C. § 314(a).” *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 at 19 (PTAB Dec. 1, 2020) (precedential as to § II.A). Petitioner’s timely, well-supported Petition and binding *Sotera* stipulation weigh strongly against discretionary denial in this case.

Moreover, Patent Owner’s (“PO”) description of the parallel litigation is incomplete. Recent events, including (1) a companion case in the Northern District of New York, (2) multiple pending motions and briefs seeking to transfer the parallel litigation to New York, or to stay the parallel litigation, (3) and a history of trial rescheduling and major open motions, demonstrate that the parallel district court litigation is in flux. While a trial is *currently* set in the district court case for April 2026, the history of the case and present proceedings make that trial date uncertain—weighing against PO’s main argument for discretionary denial. Moreover, given the district court’s order to drastically narrow the asserted claims, many (if not all) of the claims challenged in the Petition are unlikely to be decided

in the district court. Overall, an analysis of the *Fintiv* factors shows that multiple factors weigh against discretionary denial and support institution.

Moreover, the Petition weighs clear issues of priority entitlement and new matter—issues that are central to patentability. These complex technical issues specific to patent law are best decided by the PTAB, not a district court or jury that may be less familiar with patent issues. Moreover, PO’s argument that these priority and new matter arguments were previously considered during prosecution is incorrect. During prosecution, the examiner considered only whether the specification disclosed sufficient structure to support the claimed function, whereas the Petition raises the issue of whether new matter was introduced during an amendment such that the patent is not entitled to an earlier priority date. Given the new and well-supported challenges raised in the Petition, discretionary denial is not warranted under *Advanced Bionics* or *Becton Dickinson*.

II. THE *FINTIV* FACTORS WEIGH AGAINST DENIAL¹

¹ Petitioner agrees that the parties involved in the noted litigation and present IPR are the same for Factor 5, rendering Factor five either neutral or marginally in favor of denial.

A. Factor 4: Petitioner’s *Sotera* Stipulation Strongly Counsels Against Discretionary Denial.²

PO has argued that “Factor 4 strongly favors denial notwithstanding the *Sotera* stipulation submitted by Lam.” Paper 8 at 13. PO is wrong. Factor 4 considers overlap between issues raised in the petition and in the parallel proceeding. To avoid duplicative effort, the Petitioners have stipulated that if IPR is instituted, the Petitioners will “(i) not pursue the grounds [presented in the IPR Petition] in the District Court Case, and (ii) not pursue any other ground that reasonably could have been raised during the IPR (should it be instituted) in the District Court Case.” EX2018. This stipulation matches the petitioner’s language in *Sotera*. Such a stipulation “mitigates any concerns of duplicative efforts between the district court and the Board, as well as concerns of potentially conflicting decisions.” *Sotera*, Paper 12 at 19.

Although the June 2022 Interim Procedure For Discretionary Denials In AIA

² *Sotera* remains a precedential decision that indicates that Factor 4 stipulation “***weighs strongly*** in favor of not exercising discretion to deny institution under 35 U.S.C. § 314(a).” *Sotera*, Paper 12 at 19 (emphasis added). Factor 4 is addressed first here based on that strong weight. The remaining factors are then addressed in order (except for Factor 5 as noted in f.n. 1).

Post-Grant Proceedings With Parallel District Court Litigation (“Guidance”) has been rescinded, the PTAB continues to give considerable weight to *Sotera* stipulations in granting institution. *See, e.g., Adobe Inc. v. Jonathan E. Jaffe*, IPR2024-01352, Paper 8 at 12, n. 4 (PTAB March 5, 2025) (recognizing that even after rescission of the Guidance, a *Sotera* stipulation “weighs strongly in favor of not exercising discretion to deny institution”); *Samsung Electronics Co. Ltd., v. Headwater Research LLC*, IPR2024-01407, Paper 9 at 8 (PTAB March 20, 2025) (weighing Factor 4 “strongly against exercising ... discretion to deny institution” because “[b]ased on Petitioner’s [*Sotera*] stipulation, ... there would be no overlap between issues raised in the Petition and in the parallel proceeding”); *Deltran USA LLC v. The NOCO Company*, IPR2024-01219, Paper 8 at 17-18 (PTAB March 19, 2025) (weighing Factor 4 “strongly against exercising ... authority to deny institution” because of petitioner’s *Sotera* stipulation). Even after withdrawal of the Guidance, the stipulation in the present matter means that Factor 4 “weighs strongly in favor of not exercising discretion to deny institution under 35 U.S.C. § 314(a).” *Sotera*, Paper 12 at 19.

PO also argues that Petitioner is raising references in this Petition in combination with system art in the district court, leading to overlap between the Petition and the parallel proceeding. But Lam’s “overlap” analysis is legally incorrect. Instead, the overlap analysis focuses on whether the Petitioner is

pursuing the same grounds in the district court proceeding. *Sand Revolution II, LLC v. Continental Intermodal Group*, IPR2019-01393, Paper 24 (June 16, 2020) (“Although the patentability issues presented in the Petition were a subset of the issues in the district court case, Sand Revolution stipulated that if institution were granted it would not pursue the same **grounds** in the district court litigation.... Sand Revolution’s stipulation mitigated the Board’s concerns of duplicative efforts and potentially conflicting decisions.” (emphasis added)). Here, Petitioner’s *Sotera* stipulation prevents any such overlap.

Moreover, PO’s argument that Petitioner is raising references in this Petition in combination with system art is without any support. Indeed, the primary prior art references raised in the grounds of the Petition are Meyers and Berney. *See* Pet. at 3 (listing these references as the first named reference for each ground). Yet, Petitioner’s district court system art combinations do not rely on either of these primary prior art references. The *Sotera* stipulation will meaningfully prevent Lam from presenting the same grounds and references in the district court, greatly limiting the overlap between issues raised in the petition and in the parallel proceeding.

Finally, PO ignores the significant difference in the number of claims challenged in the Petition as compared to the claims at issue in the district court litigation. PO is presently asserting claims 1-10 and 14-20 of the ’048 Patent in the

district court proceeding—as part of a total of 139 claims across 8 Asserted Patents. Petitioner has challenged all claims of the '048 Patent in its Petition. Moreover, PO is required to narrow its Asserted Claims to only 20 total claims across all patents by June 23, 2025. EX2001 at D.I. 426. And PO will be required to “further narrow the number of asserted claims . . . prior to trial.” *Id.* After this narrowing, it is quite possible that none of the claims of the '048 Patent will be presented at trial.

Accordingly, Factor 4 weighs strongly against discretionary denial.

B. Factor 1: PO Presents An Incomplete Picture Of The Parallel Proceedings And The Likelihood Of A Stay

While PO correctly notes that the district court case is not presently stayed and that the district court has previously denied a motion to stay, the PO fails to identify key recent facts that demonstrate that a stay may be forthcoming.

First, PO references an inventorship and ownership dispute between Inpria and the State University of New York (SUNY) that is ongoing in the Northern District of New York. This companion litigation, which challenges PO's ownership of the '048 Patent, is on a delayed schedule, with no trial date set and expert discovery not scheduled to close until October 27, 2026—months after the projected Final Written Decision here. EX1026 at D.I. 134. Following requested discovery of SUNY in the parallel district court proceeding, SUNY filed a motion

(1) opposing such discovery, and (2) seeking leave to file an *Amicus* brief requesting that the district court case be dismissed, transferred, or stayed given SUNY's ownership of the Asserted Patents, including the '048 Patent. EX2001 at D.I. 426; EX1027; EX1028. SUNY's Motion for leave to file its *Amicus* brief has since been granted. EX2001 at D.I. 508. Following SUNY's Motion, Petitioner filed a motion to dismiss or in the alternative, to sever, transfer and stay proceedings due to the failure of PO to join SUNY, an alleged owner of the Asserted Patents. EX2001 at D.I. 452. Moreover, the Court further extended deadlines in the district court case, in part due to ongoing disputes with SUNY regarding the appropriate scope of discovery—and moved the trial date about four months to April 20, 2026. *See* EX2001 at D.I. 508.

Given the ongoing disputes with SUNY—and SUNY's own request to stay or transfer the district court case, there is a reasonable likelihood that the district court litigation will be transferred to the Northern District of New York (on a much different schedule) or stayed. Accordingly, Factor 1 is neutral.

C. Factor 2: The Current Trial Date Does Not Weigh In Favor Of Denial And Is Likely To Be Delayed

PO correctly points out that the parallel district court proceeding is currently scheduled for trial on April 20, 2026, about four months before the projected date of the Final Written Decision, should the Petition be instituted. EX2001 at D.I.

508. Even if this trial date were to hold, it does not weigh in favor of discretionary denial. *Protect Animals with Satellites v. OnPoint Systems*, IPR2021-01483, Paper 11 (Mar. 4, 2022) (finding “this factor neutral” when a trial date was scheduled two months prior to the FWD). In fact, the PTAB has found that a trial date that was five months prior to the proposed FWD “weighs marginally in favor of not exercising discretion to deny institution” in circumstances where, like here, the district court has pushed back the trial date such that the scheduled trial date is not certain. *Sand Revolution II, LLC v. Continental Intermodal Group*, IPR2019-01393, Paper 24 at 8-9 (June 16, 2020).

And it is clear that there is a likelihood that the current trial date will be delayed or stayed. As discussed above in Section A, recent events in the district court include two separate motions to transfer or stay, as well as ongoing discovery disputes with SUNY that have recently caused a four-month trial delay. EX2001 at D.I. 508. Moreover, as PO noted, the district court recently held a hearing regarding a preliminary injunction motion (a motion that did not involve the ’048 Patent). EX2001 at 4/25/2025 Minute Entry. The district court specifically noted that this preliminary injunction process was an “unexpected entry of a resource-intensive . . . process at an already-busy point in the current case schedule” that required an extension to the case schedule. EX2001 at D.I. 443. The ongoing discovery disputes with SUNY, motions to transfer or stay, and continued

preliminary injunction proceedings are likely to further strain the court's resources, such that additional delays to the trial date are likely.

Accordingly, Factor 2 is neutral or weighs marginally against discretionary denial.

D. Factor 3: There Has Been Limited Investment In The Parallel Proceeding With Respect To The '048 Patent

PO's arguments with respect to Factor 3 discuss the district court's claim construction, preliminary injunction briefing, and expert reports. The investment related to each of these issues in the district court shows that there has been limited investment in the '048 patent. First, while the parties have briefed claim construction, including certain terms of the '048 patent, the Court *has yet to rule on any of the claim terms related to the '048 patent*. See EX2001 at D.I. 244 and 245 (providing claim construction opinions with respect to only two terms, neither of which relate to the '048 patent). Similarly, while PO has filed a preliminary injunction and the parties have spent substantial resources in litigating the preliminary injunction, the '048 patent was *not at issue in the preliminary injunction*. EX1029 at 6 (identifying the Asserted Patents as the '505 patent, the '081 patent, and the '312 patent—not the '048 patent). Finally, while opening expert reports are currently scheduled to be exchanged in August 2025, (i) the claims are scheduled to be drastically narrowed by June 23, 2025 (EX2001 at D.I.

426), meaning that the Parties are unlikely to have invested in the '048 patent until the specific claims are identified—which may not include any claims of the '048 patent, and (ii) the expert report deadline was recently postponed by four months, and given the ongoing disputes with SUNY, motions to transfer or stay, and continued preliminary injunction proceedings, that date may be further postponed (*see* Section C, *supra*).

Accordingly, Factor 3 is neutral.

E. Factor 6: The Petition is Strong, Favoring Institution

Factor 6 considers other circumstances that impact the Board's exercise of discretion, including the merits. The Petition presents a strong case for unpatentability, demonstrating that the challenged claims are invalid in view of the cited prior art. The prior art renders the claimed invention invalid, fully describing all the claim limitations with clear motivations to combine presented. The Petition's unpatentability assertions are backed by expert testimony. Thus, Factor 6 also favors institution.

Moreover, the complicated new matter and priority questions presented in the Petition make the PTAB the proper forum to resolve the issues raised in the Petition. Specifically, the Board regularly determines whether claims are entitled to an asserted priority date when evaluating prior art status. *Arthrex, Inc. v. Smith & Nephew, Inc.*, 35 F.4th 1328, 1340 (Fed. Cir. 2022) (“Arthrex challenges the Board's

finding that prior art anticipated claims 1, 4, 8, 10–12, 16, 18, and 25–28 of the '907 patent. It also contends the Board lacked statutory authority to determine the validity of Arthrex's priority claim during IPR. Because substantial evidence supports its anticipation finding, and because it has the authority to resolve priority issues during IPR, we affirm the Board's decision."); *In re NTP, Inc.*, 654 F.3d 1268, 1279 (Fed. Cir. 2011) (holding that "priority can be considered and determined during reexamination proceedings," which are governed by similar statutory language).

Indeed, the Board's technical expertise and the focused record for this proceeding will make this forum ideal for resolving any dispute regarding the priority date and applicability of prior art under Sections 102 and 103. *See, e.g., Synopsys, Inc. v. Mentor Graphics Corp.*, 814 F.3d 1309, 1328 (Fed. Cir. 2016), *overruled on other grounds by Aqua Prods., Inc. v. Matal*, 872 F.3d 1290 (Fed. Cir. 2017) (Newman, J., dissenting) ("The [AIA] vests the PTAB with authority to adjudicate post-grant validity under sections 102 (anticipation) and 103 (obviousness).... These grounds are well suited to resolution by the PTAB whose adjudicators are experienced in technology, for the determination is required to be made from the viewpoint of 'a person having ordinary skill in the art to which said subject matter pertains,' the words of section 103."); *Gechter v. Davidson*, 116 F.3d 1454, 1459 (Fed. Cir. 1997) ("Many Board members, now known as 'Administrative Patent Judges,' are experienced former senior examiners. Due to

their technical expertise as well as their opinion writing experience as administrative judges, they are more than capable of providing the adequate fact finding required by our cases reviewing the PTO Board, and also called for regarding other tribunals in Rule 52(a) and administrative law decisions.”).

Accordingly, Factor 6 favors institution.

III. THE PETITION SHOULD NOT BE DISCRETIONARILY DENIED UNDER 35 U.S.C. § 325(D).

A. The Same Or Substantially The Same Prior Art Or Arguments Were Not Previously Presented To The Office

PO does not dispute that the Petition presents new prior art, grounds, and arguments not presented to the Office. *See* Pet. at 77. Nor does it dispute that none of the art at issue in the Petition was cited or relied upon during prosecution. *Id.*

Instead, PO suggests that discretionary denial is warranted under *Advanced Bionics* and *Becton Dickinson* because “Lam raises the 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.’” Paper 8 at 21 (citing Pet. at 13).

PO misses the mark entirely. The only arguments during prosecution to which PO points concerned whether the specification disclosed sufficient structure to support the claimed function. In contrast, the argument in the Petition is whether Figure 16 constituted the introduction of new matter such that the claims are not

entitled to a priority date any earlier than the date that Figure 16 was added. At no point did the examiner evaluate the priority date to which the eventually issued claims were entitled, or address the prior art in play should the as-issued claims be entitled to a later effective filing date—the specific grounds that are the subject of the Petition.

For example, although PO points to an “argument made by the Examiner in the first Office Action,” Paper 8 at 22, PO conflates the Examiner’s rejection based on lack of sufficiently disclosed structure with Petitioner’s argument regarding priority date in light of the newly added Figure 16.

In that “first Office Action” dated **October 8, 2020**, the Examiner determined that (i) certain claim limitations, including those that recited a “structure configured to deliver flow from a supply of an organotin compound” and “structure to deliver a second precursor vapor,” invoked 35 U.S.C. 112(f) or pre-AIA 35 U.S.C. 112, ¶6, and (ii) the written description failed 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. Ex. 1002 at 481-82.

But the **October 8, 2020** Office Action cannot constitute “the same argument” (see Paper 8 at 22) as the argument in the Petition, because Petitioner’s priority date argument is based on PO’s addition of Figure 19 on **January 20, 2021**. Specifically, on **January 20, 2021**, in response to the October 8, 2020 Office Action, Inpria

amended the specification “to refer to new Fig. 16,” which it told the Examiner “discloses the structures in items 6-8 and 10 on page 4 of the Office Action,” and also amended then-pending claims 9 and 19-20 to address “[i]tems 9 and 13 on page 4 of the Office Action.” *Id.* at 459; *see also id.* at 454-55, 472.

Moreover, in connection with the **October 8, 2020** Office Action, the Examiner never assessed whether Figure 16 constituted new matter, evaluated the priority date to which the eventually as-issued claims were entitled, or addressed prior art in play should the as-issued claims be entitled to a later effective filing date.

PO also points to “the second Office Action” (dated February 5, 2021) wherein the Examiner allegedly “raised a new argument that was nonetheless similar to Lam’s current argument.” Paper 8 at 23. But, as shown by PO’s own highlighted excerpt from that Office Action, the Examiner merely determined that “[n]o clear structure is found in the drawings or specification which delivers a flow of from [sic] a supply of an inert gas, deliver a first precursor vapor deliver, [sic] 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.” *Id.* (citing Ex. 1002 at 285-86). Again, the Examiner did not consider, let alone analyze, whether Figure 16 constituted new matter or how that affected the priority date to which the later issued claims would be entitled.

Although Inpria may have “stated that the amendment contained no new

matter,” Paper 8 at 23 (citing Ex. 1002 at 269), this is not evidence that the Examiner actually evaluated whether Figure 16 constituted new matter for purposes of a priority date determination, and it certainly was not the basis for a rejection. *See Becton, Dickson*, Paper 8 at 17-18, 22-23. Indeed, “the USPTO does not make determinations of priority as a matter of course during prosecution.” *Hulu, LLC v. SITO Mobile R&D IP, LLC*, No. IPR2021-00304, 2022 WL 1614391, at *23 (P.T.A.B. May 17, 2022); *see also PowerOasis, Inc. v. T-Mobile USA, Inc.*, 522 F.3d 1299, 1305 (Fed. Cir. 2008) (“When neither the PTO nor the Board has previously considered priority, there is simply no reason to presume that claims in a CIP application are entitled to the effective filing date of an earlier filed application.”). Nor does any “additional back-and-forth about the prior art and 112(f) interpretations” (Paper 8 at 23) demonstrate that the Examiner considered the same or substantially similar arguments as Petitioner makes now regarding the priority date.

B. The New Priority Date Argument is Critical

As explained in the Petition (at 10), if Figure 16 constitutes new matter but the '048 Patent is *not invalid* based on improperly adding this new matter, then the earliest priority date for the Challenged Claims is January 20, 2021—the date when the first version of Figure 16 and related text were added. However, if Figure 16 did not constitute new matter, then the Challenged Claims would be entitled to the filing

date of August 6, 2020. *See Enzo Biochem v. Gen-Probe*, 323 F.3d 956 (Fed. Cir. 2002) (“Matter disclosed for the first time in a CIP is not entitled to the earlier filing date.”).

In this proceeding, if the effective filing date is January 20, 2021, all three Grounds are valid and warrant institution because the references on which the Grounds are based constitute prior art. In contrast, if the effective filing date is August 6, 2020, then institution is still proper as to Ground 1 based on the Meyers reference (published on April 13, 2017) in view of Weidman (published on April 12, 2012). Pet. at 13-36. Under either scenario, institution is proper, and discretionary denial is not appropriate.

IV. CONCLUSION

The Board should institute review of this Petition. The balance of the *Fintiv* factors strongly favors institution, with Factors 4 and 6 weighing heavily in Petitioner’s favors, and Factors 1-3 either neutral or marginally favoring institution. Moreover, the PTAB is the proper forum to resolve the complex priority and validity concerns and issue in the Petition, and the Patent Owner’s own arguments confirm that at least Ground 1 should be instituted. Institution should be granted.

Dated: June 12, 2025

Respectfully Submitted,

/ Dion M. Bregman /
Dion M. Bregman (Reg. No. 45,645)

CERTIFICATE OF COMPLIANCE

The undersigned certifies that the foregoing **PETITIONER’S
RESPONSE TO PATENT OWNER’S DISCRETIONARY DENIAL BRIEF**
contains 3,659 words, exclusive of the parts exempted as provided in 37 C.F.R. §
42.24(a), and therefore complies with the type-volume limitations of 37 C.F.R. §
42.24(a).

Dated: June 12, 2025

Respectfully Submitted,

/ Dion M. Bregman /
Dion M. Bregman (Reg. No. 45,645)

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e)(4), it is hereby certified that on June 12, 2025 an electronic copy of this PETITIONER'S RESPONSE TO PATENT OWNER'S DISCRETIONARY DENIAL BRIEF was served via email on Patent Owner's counsel of record in this proceeding:

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Dated: June 12, 2025

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