

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ENTEGRIS, INC.,
Petitioner

v.

INPRIA CORP.,
Patent Owner

Case IPR2025-00267
Patent No. 11,673,903

PATENT OWNER'S DISCRETIONARY DENIAL BRIEF

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LIST OF EXHIBITS

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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. Del.), D.I. 116 (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)
2004-2027	<i>Reserved</i>
2028	Lam-Entegris Strategic Collaboration Announcement, <i>available at</i> https://www.entegris.com/en/home/about-us/news/lam-research-entegris-gelest-team-team-up-to-advance-euv-dry-resist-technology-ecosystem-july-2022.html (last visited May 12, 2025), and https://www.prnewswire.com/news-releases/lam-research-entegris-gelest-team-up-to-advance-euv-dry-resist-technology-ecosystem-301584404.html (last visited May 12, 2025)
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	Lam's Answer, <i>Inpria Corp. v. Lam Research Corp.</i> , C.A. No. 22-01359-CJB (D. Del.), D.I. 52 (Jan. 12, 2024)
2031	Lam's Initial Invalidity Contentions, Ex. 13, <i>Inpria Corp. v. Lam Research Corp.</i> , C.A. No. 22-01359-CJB (D. Del.) (May 13, 2024)
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2033	Lam's Final Invalidity Contentions, Ex. 903-B, <i>Inpria Corp. v. Lam Research Corp.</i> , C.A. No. 22-01359-CJB (D. Del.) (Feb. 20, 2025)
2034	Lam's Final Invalidity Contentions, Ex. 903-C, <i>Inpria Corp. v. Lam Research Corp.</i> , C.A. No. 22-01359-CJB (D. Del.) (Feb. 20, 2025)
2035	Lam's Final Invalidity Contentions, Ex. 903-D, <i>Inpria Corp. v. Lam Research Corp.</i> , C.A. No. 22-01359-CJB (D. Del.) (Feb. 20, 2025)
2036	Lam's Final Invalidity Contentions, Ex. 903-E, <i>Inpria Corp. v. Lam Research Corp.</i> , C.A. No. 22-01359-CJB (D. Del.) (Feb. 20, 2025)

2037	Lam's Final Invalidity Contentions, Ex. 903-F, <i>Inpria Corp. v. Lam Research Corp.</i> , C.A. No. 22-01359-CJB (D. Del.) (Feb. 20, 2025)
2038	U.S. Patent No. 8,198,352
2039	May 9, 2025 email correspondence between counsel for Entegris and counsel for Inpria regarding Lam Common Interest

I. INTRODUCTION

Entegris Inc.’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. 11,673,903 (“the ’903 patent”) will be decided on the same issues at a trial scheduled to occur four months *before* any Final Written Decision would issue here. Although Entegris is not a named defendant, Entegris has been collaborating, and shares a common interest, with the defendant in the Delaware litigation, Lam Research Corporation (“Lam”). And Lam’s invalidity contentions expressly incorporate the “arguments, evidence, and statements” in this IPR. Thus, the validity issues here are entirely redundant with (and a subset of) those that will be decided at trial before any final written decision would issue here.

Second, the Petition should be denied under *Advanced Bionics* as it repeats the same prior art that Patent Owner Inpria Corporation dealt with extensively during original prosecution. Because the Examiner already considered all of the prior art at issue, and because the Petition fails to establish that the Examiner’s carefully considered decision was erroneous, discretionary denial is appropriate for this reason as well.

II. BACKGROUND

A. District of Delaware Litigation

The '903 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 '903 patent in an Amended Complaint filed on December 13, 2023, *id.* at 17 (D.I. 43-44); 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.*

Although Entegris is not a named defendant in the Delaware litigation, Entegris has been involved. On December 13, 2023, Inpria’s amended complaint identified a July 12, 2022 Entegris-published press release announcing Entegris’s collaboration with Lam:



SEMICON WEST 2022, SAN FRANCISCO, July 12, 2022 – Lam Research Corp. (NASDAQ: LRCX), Entegris, Inc. (NASDAQ: ENTG), and Gelest, Inc., a Mitsubishi Chemical Group company, today announced a strategic collaboration that will provide semiconductor manufacturers worldwide with reliable access to precursor chemicals for **Lam's breakthrough dry photoresist technology for extreme ultraviolet (EUV) lithography**, an innovative approach used in the production of next-generation semiconductors. The parties will work together on EUV dry resist technology research and development (R&D) for future device generations of logic and DRAM products that will help enable everything from machine learning and artificial intelligence to mobile devices.

Ex. 2028; *see also* Ex. 2029 at ¶ 36; Ex. 2030 at ¶ 36 (Lam admitting that this press release was published). Inpria alleged that such “strategic collaboration” is evidence of Lam’s intent to induce infringement. Ex. 2029 at ¶ 36. Entegris has also participated in the discovery process in the Delaware litigation, responding to subpoenas for production of documents and deposition testimony served by both Inpria and Lam. Ex. 2001 at 30 (D.I. 164), 31 (D.I. 168), 44 (D.I. 281), 46 (D.I. 299).

Patent validity issues have been moving forward in district court. For example, on May 14, 2024, Lam served Initial Invalidity Contentions that relied on the same Hänssgen and Meyers references used in Entegris’s Petition, among other invalidity defenses and prior art references. Ex. 2001 at 24 (D.I. 117); Ex. 2003 at 37-38. As one example, the initial invalidity contentions included a claim chart that applied Meyers to claims 1-4 and 6-9. *See generally* Ex. 2031; Pet. at 7, 40-56 (Entegris’s Grounds 2A and 2B similarly mapping to Meyers).

On February 20, 2025, Lam served Final Invalidity Contentions, Ex. 2001 at 45 (D.I. 288), expressly incorporating the grounds set forth in this IPR petition in at least six of its exhibits:

This claim chart is meant to illustrate one example of how the asserted claims are invalid for obviousness. In addition to the citations set forth in the charts below, Defendant further incorporates by reference, as if fully set forth in, the arguments, evidence, and statements set forth in IPR2025-00267. By not discussing portions of a reference in the claim chart below, Defendant does not waive

Ex. 2032 at 3 (highlighting added).

Hanssgen anticipates asserted claims 1-4, and 6-9 of the '903 patent under 35 U.S.C. § 102, at least for the reasons explained in Defendant's final Invalidity Contentions and as set forth in this chart. In addition to the citations set forth in the charts below, Defendant further incorporates by reference, as if fully set forth in, the arguments, evidence, and statements set forth in IPR2025-00267.

Ex. 2033 at 2 (highlighting added).

Hanssgen renders asserted claims 1-4, and 6-9 of the '903 patent obvious alone, and/or in combination with the general knowledge of a person of ordinary skill in the art at least for the reasons explained in Defendant's final Invalidity Contentions and as set forth in this chart. In addition to the citations set forth in the charts below, Defendant further incorporates by reference, as if fully set forth in, the arguments, evidence, and statements set forth in IPR2025-00267.

Ex. 2034 at 2 (highlighting added).

Odedra '797 renders Asserted Claims 1-4, 6-9 of the '903 patent obvious alone, in combination with the general knowledge of a person of ordinary skill in the art, and/or in combination with Hanssgen as set forth in this chart. In addition to the citations set forth in the charts below, Defendant further incorporates by reference, as if fully set forth in, the arguments, evidence, and statements set forth in IPR2025-00267.

Ex. 2035 at 2 (highlighting added).

Deelman '268 renders Asserted Claims 1-4, 6-9 of the '903 patent obvious alone, in combination with the general knowledge of a person of ordinary skill in the art, and/or in combination with Jones-I as set forth in this chart. In addition to the citations set forth in the charts below, Defendant further incorporates by reference, as if fully set forth in, the arguments, evidence, and statements set forth in IPR2025-00267.

Ex. 2036 at 2 (highlighting added).

Meyers '839 renders Asserted Claims 1-4, 6-9 of the '903 patent obvious alone, in combination with the general knowledge of a person of ordinary skill in the art, and/or in combination with the other references identified in Defendant's Invalidity Contentions, including as set forth in this chart. In addition to the citations set forth in the charts below, Defendant further incorporates by reference, as if fully set forth in, the arguments, evidence, and statements set forth in IPR2025-00267.

Ex. 2037 at 2 (highlighting added).

B. '903 Patent Prosecution

The '903 patent underwent a thorough review during the original prosecution. There were three non-final Office actions and two final Office actions. Ex. 1004 at 465-473, 597-603, 628-638, 908-916, 1135-1143.

During this back-and-forth, all of the Petition's references were put in front of the Examiner. Hänssgen was incorporated by reference in the specification of the

'903 patent (*id.* at 1220), as well as cited in an Information Disclosure Statement (IDS) (*id.* at 1148-1149), and thus was considered by the Examiner during original prosecution. Moreover, in 2021, Inpria submitted a declaration to the Examiner to explain that Hänssgen could not satisfy the claims ("2021 Hänssgen declaration"). *Id.* at 896-898.

For Deelman and Meyers, the Examiner applied those references in the last two Office actions. *Id.* at 465-473, 597-603. In 2022, in response to the second to last Office action, Inpria submitted a declaration to the Examiner to explain that Deelman did not teach or suggest the claims. *Id.* at 551-553 ("2022 Deelman declaration"). And again in 2023, in response to the last Office action, Inpria submitted another declaration to further explain that Deelman did not teach or suggest the claims. *Id.* at 447-450 ("2023 Deelman declaration"). In light of Inpria's responses and declarations, the Notice of Allowance indicated that the applicant had overcome Deelman and Meyers. *Id.* at 361.

For Jones, Inpria presented that reference to the Examiner in an IDS, which was considered by the Examiner. *Id.* at 1149.

III. ARGUMENT

There are several reasons to discretionarily deny Entegris's Petition, including some that should be sufficient on their own. Taking all the issues collectively, this is a compelling case for discretionary denial. *See NHK Spring Co., Ltd. v. Intrix-Plex*

Techs., Inc., IPR2018-00752, Paper 8, at 11-21 (Sept. 12, 2018) (precedential) (considering both 325(d) and 314(a) and denying institution because the prior art was previously considered and because the co-pending district court proceeding was nearing completion).

First and foremost, this Petition is redundant with litigation involving the '903 patent that is in advanced stages 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. The validity arguments in Entegris's Petition are entirely redundant with those in the Delaware litigation because Lam expressly incorporated into the district court proceeding "the arguments, evidence, and statements set forth in IPR2025-00267" (this IPR proceeding). *See* Exs. 2032-2037. And this is setting aside the other invalidity arguments Lam is presenting. Entegris argues discretionary denial based on parallel litigation is unwarranted because it is "not a party" in that litigation. Pet. at 23. But as explained below, Entegris's entanglement with Lam and the Delaware litigation is clear. Regardless, even if Entegris had been a completely unrelated party (which they are not), judicial efficiency is not served by the Board addressing the same issues that currently are being argued in parallel litigation and will be decided in Delaware before the Board's FWD.

Second, Entegris's Petition should be denied as redundant because it relies exclusively on references 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 five years which included submission of several inventor declarations to overcome rejections based on the same prior art Entegris applies here. This is not a petitioner seeking the answer to a different invalidity question, it is Entegris seeking a different answer to the same invalidity question the Examiner already answered.

A. The *Fintiv* 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 eight asserted patents in the Delaware Litigation. 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 '903 patent). Ex. 2001 at 24 (D.I. 116); Ex. 2002 at ¶ 6. 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 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 44-45 (D.I. 287). 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 Entegris’s 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 the district court and the parties have already made (and will continue to make) significant investments in the parallel district court proceeding. The Delaware litigation started on October 14, 2022. Ex. 2001 at 12 (D.I. 1). Lam was accused of infringing the '903 patent on December 13, 2023. *Id.* at 17 (D.I. 43-44). As such, the District Court for the District of Delaware and Inpria have made the following significant investments in the Delaware litigation:

- Initial Invalidity Contentions: On May 14, 2024, Lam served initial invalidity contentions that relied on the same Hänssgen and Meyers references used in Entegris's Petition, among other invalidity defenses and prior art references. *Id.* at 24 (D.I. 117); Ex. 2003 at 36-38; Ex. 2031.
- Claim construction: On October 18, 2024, the parties filed a Joint Claim Construction Brief, including on terms appearing in the '903 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* 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 as those

in Entegris's Petition and broadly incorporate Entegris's IPR filings. Ex. 2001 at 45 (D.I. 288); Exs. 2032-2037.

- 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).
- Expert Reports: The parties are quickly approaching expert discovery. By August 2025, the parties will have exchanged opening and rebuttal expert reports. *Id.*²

Entegris has also invested in the Delaware litigation. Over the past year, Inpria and Lam have served multiple subpoenas to Entegris for production of documents and deposition of witnesses in the Delaware litigation. *Id.* at 30 (D.I.

² 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).

164), 31 (D.I. 168), 44 (D.I. 281), 46 (D.I. 299). And the evidence suggests Entegris is also investing resources behind the scenes, with Lam asserting common interest privilege to shield discovery of communications involving both Lam and Entegris. Entegris similarly claimed common interest privilege in responding to Inpria's subpoenas. *See* Ex. 2039.

Accordingly, Factor 3 strongly weighs in favor of denial because the district court and the parties have made, and will continue to make, significant investments into the Delaware litigation.

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

Factor 4 strongly favors denial because all issues in this Petition (and more) are at issue in the parallel district court proceeding. Specifically, Lam expressly incorporated by reference “the arguments, evidence, and statements set forth in IPR2025-00267” in its Final Invalidity Contentions for the '903 patent. *See* Exs. 2032-2037. Unless the Petition is denied, the parties will undoubtedly be required to argue overlapping validity issues in two forums.

In addition to the express incorporation by reference (which alone is sufficient), the invalidity grounds and rationales presented in the district court overlap on the merits. Ground 1A is duplicative with the Final Invalidity Contentions:

1A	1–4, 6-10	102	<i>Hänssgen</i>
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Pet. at 7.

Hänssgen anticipates asserted claims 1-4, and 6-9 of the '903 patent under 35 U.S.C. § 102, at least for the reasons explained in Defendant's final Invalidity Contentions and as set forth in this chart. In addition to the citations set forth in the charts below, Defendant further incorporates by reference, as if fully set forth in, the arguments, evidence, and statements set forth in IPR2025-00267.

Ex. 2033 at 2. Specifically, both Ground 1A and the Final Invalidity Contentions challenge claims 1-4 and 6-9 under 35 U.S.C. § 102 in view of Hänssgen.

Ground 1B is duplicative with the Final Invalidity Contentions:

1B	1–4, 6–10	103	<i>Hänssgen in view of the knowledge of a person of ordinary skill in the art ("POSITA")</i>
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Pet. at 7.

Hänssgen renders asserted claims 1-4, and 6-9 of the '903 patent obvious alone, and/or in combination with the general knowledge of a person of ordinary skill in the art at least for the reasons explained in Defendant's final Invalidity Contentions and as set forth in this chart. In addition to the citations set forth in the charts below, Defendant further incorporates by reference, as if fully set forth in, the arguments, evidence, and statements set forth in IPR2025-00267.

Ex. 2034 at 2. Specifically, both Ground 1B and the Final Invalidity Contentions challenge claims 1-4 and 6-9 under 35 U.S.C. § 103 in view of Hänssgen.

Ground 2A is duplicative with the Final Invalidity Contentions:

2A	1–4, 6	103	<i>Meyers in view of Deelman</i>
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Pet. at 7.

Meyers '839 renders Asserted Claims 1-4, 6-9 of the '903 patent obvious alone, in combination with the general knowledge of a person of ordinary skill in the art, and/or in combination with Deelman '268 and Hänssgen as set forth in this chart.

Ex. 2032 at 2. Specifically, both Ground 2A and the Final Invalidity Contentions challenge claims 1-4 and 6 under 35 U.S.C. § 103 in view of Meyers in view of Deelman.

Ground 2B is duplicative with the Final Invalidity Contentions:

2B	1-4, 6-10	103	<i>Meyers in view of Deelman and Hänssgen</i>
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Pet. at 7.

Meyers '839 renders Asserted Claims 1-4, 6-9 of the '903 patent obvious alone, in combination with the general knowledge of a person of ordinary skill in the art, and/or in combination with Deelman '268 and Hänssgen as set forth in this chart.

Ex. 2032 at 2. Specifically, both Ground 2B and the Final Invalidity Contentions challenge Claims 1-4 and 6-9 under 35 U.S.C. § 103 in view of Meyers in view of Deelman and Hänssgen.

Grounds 3A and 3B are duplicative with the Final Invalidity Contentions:

3A	1–4, 6	103	<i>Deelman in view of Jones</i>
3B	1–4, 6-10	103	<i>Deelman in view of Jones and Hänssgen</i>

Pet. at 7.

U.S. Patent Publication No. 2011/0166268 (“**Deelman** ’268”) published on **July 7, 2011**, before the ’903 patent’s earliest priority date of **April 11, 2018**. Meyers ’839 is therefore prior art to the ’903 patent under AIA 35 U.S.C. 102(a)(1).

K. **Jones** and M.F. Lappert, “Amino-derivatives of Metals and Metalloids. Part I. Preparation of Aminostannanes, Stannylamines, and Stannazanes,” *Journal of Chemical Society*, pp. 1944-1951 (“**Jones-I**”) published in **1965**. Jones- I is therefore prior art to the ’903 patent under AIA 35 U.S.C. 102(a)(1).

Hänssgen, D., et al. “Synthesis of the First Mono-t-Butyltin Element Compounds,” *J. Organometallic Chemistry* 293 (1985): 191-195 (“**Hänssgen**”) published on **September 24, 1985**. Hänssgen is prior art under post-AIA 35 U.S.C. §102(a)(1) because it published on **September 24, 1985**, which is before the ’903 patent’s earliest possible priority date of **April 11, 2018**.

Deelman ’268 renders Asserted **Claims 1-4, 6-9** of the ’903 patent obvious alone, in combination with the general knowledge of a person of ordinary skill in the art, and/or in combination with **Jones-I** as set forth in this chart. In addition to the citations set forth in the charts below, Defendant further incorporates by reference, as if fully set forth in, the arguments, evidence, and statements set forth in IPR2025-00267.

Ex. 2036 at 2; *see also id.* at 4-13 (claim chart mapping to Deelman, Jones, and Hänssgen). First, both Ground 3A and the Final Invalidity Contentions challenge claims 1-4 and 6 under 35 U.S.C. § 103 in view of Deelman in view of Jones. Second, both Ground 3B and the Final Invalidity Contentions additionally challenge claims 1-4 and 6-9 under 35 U.S.C. § 103 in view of Deelman in view of Jones and Hänssgen.

As shown above, even putting aside the express incorporation by reference, and the other invalidity arguments presented by Lam, the claim charts in the Final Invalidity Contentions assert invalidity of nearly every challenged claim in the

Petition on the exact same grounds (and include many other invalidity arguments).³

As such, Factor 4 strongly favors denial.

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

Factor 5 slightly favors denial because, although Petitioner Entegris is not a named defendant in the Delaware litigation and Defendant Lam is not expressly named as an RPI on this Petition, Entegris is in “strategic collaboration” with Lam regarding the photoresist materials accused of infringement in the district court and because Lam is a clear beneficiary of these proceedings.

As Inpria identified in its complaint in the Delaware litigation, Entegris published a press release to announce their collaboration with Lam and Gelest on July 12, 2022:



SEMICON WEST 2022, SAN FRANCISCO, July 12, 2022 – Lam Research Corp. (NASDAQ: LRCX), Entegris, Inc. (NASDAQ: ENTG), and Gelest, Inc, a Mitsubishi Chemical Group company, today announced a strategic collaboration that will provide semiconductor manufacturers worldwide with reliable access to precursor chemicals for **Lam's breakthrough dry photoresist technology for extreme ultraviolet (EUV) lithography**, an innovative approach used in the production of next-generation semiconductors. The parties will work together on EUV dry resist technology research and development (R&D) for future device generations of logic and DRAM products that will help enable everything from machine learning and artificial intelligence to mobile devices.

³ The exceptions being claim 9 in Ground 3B and claim 10 in Grounds 1A, 1B, 2B, and 3B. But such minor differences are immaterial when both claims are dependent claims, claim 9 is challenged by other grounds in the Petition, and claim 10 is not asserted in the Delaware litigation. *See also Fintiv*, Paper 11, at 13 n.25.

Ex. 2028; *see also* Ex. 2001 at 31 (D.I. 172, 176); Ex. 2029 at ¶ 36; Ex. 2030 at ¶ 36 (Lam admitting this press release was published). Inpria alleged that such collaboration is an example of Lam’s intent to induce infringement (*i.e.*, by causing direct infringement by parties like Entegris). Ex. 2029 at ¶ 36. The subject matter of the ’903 patent involving monoalkyltin compounds (which Entegris makes) and Inpria’s induced infringement allegations against Lam (who Entegris supplies with such photoresist materials) clearly implicates Entegris’s involvement.

During the Delaware litigation, Inpria and Lam have served multiple subpoenas to Entegris for production of documents and deposition of witnesses. Ex. 2001 at 30 (D.I. 164), 31 (D.I. 168), 44 (D.I. 281), 46 (D.I. 299). In responding to these subpoenas, Entegris has asserted common interest privilege between itself and Lam. *See* Ex. 2039. Lam similarly is relying on common interest privilege with Entegris in the district court case. Lam is thus a “clear beneficiary that has a preexisting, established relationship” with Entegris. *See RPX Corp. v. Applications in Internet Time, LLC*, IPR2015-01750, Paper 128, at 2 (Oct. 2, 2020) (precedential).⁴

⁴ Inpria reserves all rights to request additional discovery if Entegris fails to add Lam as a real party-in-interest, which further weighs in favor of denying the Petition because such discovery would increase the workload of the Board.

Furthermore, both Lam's and Entegris's actions demonstrate their coordination. First, Lam expressly incorporated Entegris's Petition arguments, evidence, and statements into its Final Invalidity Contentions (as well as including claim charts mapping nearly identical grounds for all claims in the Petition). Exs. 2032-2037. Second, Entegris recognized its interrelation with Lam by filing its Petition on the eve of *Lam's* bar date. Ex. 2001 at 17 (D.I. 43) (December 13, 2023 Amended Complaint asserting the '903 patent); Pet. at 75 (listing December 12, 2024 date for Petition); *see* 35 U.S.C. § 315(b). Third, in what appears to be a coordinated move, Lam filed its own petitions, IPR2025-00256 and IPR2025-00309, over the next few days challenging a different asserted patent. It is likely here that Lam is at least a privy to these proceedings, if not an unnamed RPI. Entegris's cursory "not a party" argument does not consider the realities of the parties' relationships and thus should not prevent denial here.

Accordingly, Factor 5 weighs slightly in favor of denial because, even though Entegris is not a named party in the Delaware litigation, Entegris is certainly entangled with defendant Lam. And, as the Board noted in *Fintiv* itself, even when "a petitioner is unrelated to a defendant" discretionary denial might still be appropriate where "the issues are the same as, or substantially similar to, those already or about to be litigated, or other circumstances weigh against redoing the

work of another tribunal,” as they are here. *Fintiv*, Paper 11, at 13-14; *see supra* Section III.A.4.

6. Factor 6 – Other circumstances that impact the Board’s exercise of discretion, including the merits

Factor 6 favors denial because Entegris’s extensive reliance on experimental testing is better suited for district court litigation and because the merits of its unpatentability challenges are weak. *See FAQs for Interim Processes for PTAB Workload Management*, n. 21.⁵ In particular for the experiments, Entegris’s Petition provides testimony from two experts, Dr. Parkin (Ex. 1002) and Dr. Hood (Ex. 1003),⁶ where “Dr. Gerard Parkin, supervised Dr. Drew Hood in conducting the synthesis methods under the proper conductions [*sic*].” Pet. at 17; *see also* Ex. 1002 at ¶¶ 103-112. Entegris’s experts present four experiments:

⁵ Available at: <https://www.uspto.gov/patents/ptab/faqs/interim-processes-workload-management>

⁶ Dr. Hood is employed by Entegris. Ex. 1003, ¶ 2. Inpria reserves all rights to seek discovery into whether Entegris has withheld any of the test results. *See Spectrum Solutions LLC v. Longhorn Vaccines & Diagnostics, LLC*, IPR2021-00847, IPR2021-00850, IPR2021-00854, IPR2021-00857, IPR2021-00860, Paper 107 (May 3, 2023) (Board and Director sanctioning party for withholding test results).

1. First Hänssgen experiment purportedly synthesizing Hänssgen's reaction (2a). *See* Ex. 1002 at ¶¶ 113-118 (Dr. Parkin's overview); Ex. 1020 (Dr. Parkin's "Procedure 1" instructions for Dr. Hood); Ex. 1003 at ¶¶ 11-18 (Dr. Hood's procedure and results).
2. Second Hänssgen experiment that modifies the First Hänssgen experiment by increasing the t-BuLi to 1.2eq. *See* Ex. 1002 at ¶¶ 113-118 (Dr. Parkin's overview); Ex. 1020 (Dr. Parkin's "Procedure 2" instructions for Dr. Hood); Ex. 1003 at ¶¶ 19-25 (Dr. Hood's procedure and results).
3. First Meyers experiment purportedly synthesizing Example 7 of Meyers. *See* Ex. 1002 at ¶¶ 119-122 (Dr. Parkin's overview); Ex. 1019 (Dr. Parkin's instructions for Dr. Hood); Ex. 1003 at ¶¶ 27-38 (Dr. Hood's procedure and results).
4. Second Meyers experiment that modified the First Meyers experiment "with tetrahydrofuran ('THF')." *See* Ex. 1002 at ¶¶ 119-122 (Dr. Parkin's overview); Ex. 1003 at ¶¶ 39-47 (Dr. Hood's procedure and results).

Entegris's grounds each rely on the above experiments:

1. Ground 1A relies on the First Hänssgen experiment for limitation [1b]. *See* Pet. at 29 (citing Ex. 1003 at ¶¶ 17-18).

2. Ground 1B relies on Ground 1A. *See* Pet. at 37-39.
3. Ground 2A relies on the Second Meyers experiment for limitation [1b].
See Pet. at 43, 46, 49 (citing Ex. 1003 at ¶¶ 46-47).
4. Ground 2B incorporates the analysis from Ground 2A for claim 1. *See* Pet. at 52.
5. Ground 3A relies on the Second Meyers experiment for limitation [1b].
See Pet. at 60, 64 (citing Ex. 1003 at ¶¶ 46-47).
6. Ground 3B incorporates the analysis from Ground 3A for claim 1. *See* Pet. at 70.

Additionally, Entegris's Petition (and its experts) questions Inpria's experiments of Hänssgen and Deelman presented during prosecution. Pet. at 14-17.

All of Entegris's grounds involve disputes that would require analysis of experimental testing. Such analysis would involve reviewing the deposition testimony of both Dr. Parkin and Dr. Hood, along with handling requests for additional discovery on how those experts conducted the experiments, such as requests for withheld lab notebooks and NMR data for Dr. Hood's experiments. If trial is instituted, this discovery-intensive work may further be doubled if Inpria elects to conduct its own experiments.

Factor 6 also favors denial because the merits of Entegris's patentability challenges are weak for the reasons explained in Inpria's Preliminary Response, filed

simultaneously with this paper. First, Entegris and its experts fail to provide underlying bases and data for their experiments sufficient to prove the results of the experiments would be the necessary and inherent results a POSA would have achieved at the relevant time following the prior art. Entegris provides no characterization of its starting materials (or for the Meyers experiment even an indication of the source of their materials), includes no laboratory notebooks from Dr. Hood, and withheld the underlying NMR data which was the ultimate test of whether the results met the claimed purity limitations, instead only providing screenshots of the NMR spectra. This lack of basic evidence renders unreliable Entegris's experiments attempting to meet the heavy burden of inherency.

Second, Entegris silently modified both experiments to wrap the reaction vessels in tin foil to avoid light exposure. Ex. 1019; Ex. 1020; Ex. 1003 at ¶¶ 11, 28. Entegris and its experts gave no rationale for this addition, let alone a rationale supported by the prior art. This unexplained modification means Entegris's results are insufficient to prove the "natural result" of practicing the prior art procedure.

Third, Entegris's experiments based on Meyers, which are relied upon for four of Entegris's six grounds, impermissibly rely on a modification inspired by hindsight after Entegris's first test failed. Ex. 1002 at ¶¶ 120-121. And the modification itself lacks rationale—Entegris and its expert simply pluck THF from a list of solvents disclosed in Deelman and then add it in a specific way (to dilute one of the starting

materials) in a specific amount in Meyers. Ex. 1002 at ¶ 121; Ex. 1003 at ¶ 40. But Entegris and its expert provide absolutely no justification for the chosen manner in which the THF was added and make no ties between this change and the purported purity “optimiz[ation]” motivation that Entegris’s expert came up with after the first experiment failed. Ex. 1002 at ¶¶ 120-121.

For all of these reasons, Factor 6 weighs in favor of denial.

* * *

Accordingly, Entegris’s Petition should be denied because each of the *Fintiv* Factors weighs in favor of denying institution.

B. Institution Should Be Denied Because the Office did not Err While Considering All of the References in the Petition During Prosecution

The Director should reject the Petition because every piece of prior art used in the Petition previously was presented to the Office during prosecution and Entegris fails to show that the Examiner erred in considering the references.

1. All References Were Already Considered by the Office (*Advanced Bionics*⁷ Step 1 (*Becton, Dickinson*⁸ Factors (a), (b), and (d)))

Entegris admits that all of the Petition’s references were before the Office. Pet. at 23-24 (admitting the prior art “was reviewed and, in certain cases relied upon by the Office”). Despite this, Entegris requests repetitive “reconsideration of these references.” *Id.*

a) Hänssgen was previously presented to the Office

Hänssgen was presented to, and considered by, the Office in three ways. First, the ’903 patent specification cites Hänssgen and expressly incorporates it by reference. Ex. 1001 at 3:32-36; Ex. 1004 at 1220; *see Universal Imaging Indus. LLC, v. Lexmark Int’l, Inc.*, IPR2019-01387, Paper 7, at 17-18 (Feb. 27, 2020) (denying institution under § 325(d) where the challenged patent discussed the prior art in its background section because, *inter alia*, “[i]t is reasonable to assume that the Examiner read the Specification and understood these statements as part of examining the [challenged] patent” (citing MPEP §§ 608.01(c), 2129)). Second,

⁷ *Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6 (Feb. 13, 2020) (precedential).

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

Inpria included Hänssgen in an IDS that was considered by the Examiner. Ex. 1004 at 1148; *see also* Ex. 1001 at code 56 (“Other Publications”). Third, Inpria submitted a declaration to the Examiner to explain why Hänssgen did not disclose or suggest the claim limitations. *Id.* at 896-898. Accordingly, Hänssgen was previously presented to and considered by the Office.

b) Meyers was previously presented to the Office

Meyers was also presented to the Office in three ways. First, like Hänssgen, the '903 patent cites Meyers in the specification and expressly incorporates it by reference. Ex. 1001 at 4:8-16; Ex. 1004 at 1221. Second, Meyers was presented to the Office by Inpria in an IDS that was considered by the Examiner. Ex. 1004 at 1148; *see also* Ex. 1001 at code 56 (“2016/0116839”). Third, Meyers was actually applied by the Examiner in multiple Office action rejections. Ex. 1004 at 465-473, 599-603. In particular, the Examiner considered whether Meyers in combination with Deelman disclosed the claims (*id.*), which is the same prior art Entegris presents in Grounds 2A and 2B of the Petition. Pet. at 7. Inpria overcame the Examiner’s rejections based on Meyers. Ex. 1004 at 361. Accordingly, Meyers was previously presented to and considered by the Office.

c) Deelman was previously presented to the Office

Deelman was presented to the Office in four ways. First, like Hänssgen and Meyers, the specification of the '903 patent cites and expressly incorporates by

reference the patent that issued from the Deelman application that was published as Entegris's Exhibit 1007—U.S. Patent No. 8,198,352. Ex. 1001 at 3:55-62; Ex. 1004 at 1220 (“8,198,352”); Ex. 1007, code 10 (“2011/0166268”); Ex. 2038 at code 10 (“8,198,352”), code 65 (“2011/0166268”). Second, Deelman was presented to the Office by Inpria in an IDS considered by the Examiner. Ex. 1004 at 1147-1149; *see also* Ex. 1001 at code 56 (“2011/0166268” and “8,198,352”). Third, Deelman was applied by the Examiner in multiple Office action rejections. Ex. 1004 at 465-473, 599-603. As described above, the Examiner considered whether Deelman in combination with Meyers disclosed the claims (*id.*), the same prior art Entegris presents in Grounds 2A and 2B, as well as considering substantially similar arguments in Grounds 3A and 3B that rely on Deelman in combination with other references used the same way as Meyers. Pet. at 7. Fourth, Deelman was presented to the Office when Inpria submitted two declarations to the Examiner to explain why Deelman did not disclose or suggest the claim limitations. Ex. 1004 at 447-450, 551-553. Inpria overcame the Examiner's rejections based on Deelman. *Id.* at 361. Accordingly, Deelman was previously presented to and considered by the Office.

d) Jones was previously presented to the Office

Jones was presented to the Office by Inpria in an IDS that was considered by the Examiner. Ex. 1004 at 1149; *see also* Ex. 1001 at code 56 (“Other

Publications”). Accordingly, Jones was previously presented to and considered by the Office.

* * *

For these reasons, every piece of prior art in this Petition was presented to the Examiner.

2. Entegris Fails to Establish That the Office Erred in its Consideration of the References (*Advanced Bionics* Step 2 (*Becton, Dickinson* Factors (c), (e), and (f)))

Entegris fails to show that the Office erred when it considered each of the references that Entegris recycles with its Petition. For Hänssgen, Entegris alleges Inpria’s inventor’s declaration submitted during prosecution “lacked sufficient detail to allow a POSITA to assess the appropriateness” of the experiments. Pet. at 14-15. Yet, in arguing the Office erred, Entegris argues Inpria “failed to properly follow the experiment procedures (in the case of Hänssgen).” Pet. at 26. But Entegris has no basis to simultaneously allege faulty procedures and insufficient description to evaluate the procedures. Furthermore, Entegris’s experiments fail to show error because Entegris and its expert silently applied modifications rooted in hindsight, rather than faithfully following the prior art procedures to prove inherency and, ironically, provide insufficient information to analyze their single reported experiment for each procedure. Ex. 1003 at ¶ 11 (wrapping the reaction vessels in tin foil), 28; *see also supra* Section III.A.6 (explaining Entegris’s modifications).

Entegris's analysis of Meyers and Deelman is even shakier, failing to show the Office erred in its analysis of those references that were heavily analyzed during prosecution. Meyers does not disclose the purity of its isopropyl tin compounds, and when Entegris tested Meyers, it failed to come even close to the claims, with 6.16% dialkyl impurity. Ex. 1003 at ¶ 37. So Entegris then created a modified synthetic procedure that is described nowhere in the prior art, relying on a stray teaching in Deelman regarding a different solvent, THF. Ex. 1002 at ¶¶ 120-121; *see also supra* Section III.A.6 (explaining Entegris's lack of rationale). But Entegris's characterization of Deelman's experimental procedures as "simply irrelevant" because they "describe[] an entirely different category of compound," Pet. at 16 (faulting Inpria for applying the synthetic method disclosed in Deelman), undermines Entegris's own modification to Meyers based on Deelman.⁹ And Entegris shows no error in the Board's evaluation of Deelman itself, with Entegris performing no tests of its own and failing to undermine the fact that Inpria's tests showed Deelman's procedures were ineffective to meet the claims.

Finally, Entegris presents no argument at all that the Office erred in its evaluation of Jones. Because Entegris fails to show the Office erred in its

⁹ This also undermines Entegris's baseless accusation that Inpria's declarations "misled the Examiner." Pet. at 26.

consideration of any of the references (each of which were already considered during prosecution), Entegris's Petition should be discretionarily denied.

a) Entegris Fails to Establish That the Office Erred in its Consideration of Hänssgen

In arguing that the Examiner erred in considering Inpria's 2021 Hänssgen declaration, Entegris only provides two stray sentences: "a POSITA would not have had sufficient information to assess the appropriateness of the experiment" (Pet. at 15) and that the inventor "failed to properly follow the experiment procedures" (*id.* at 26). Because Entegris entirely fails to explain what information was missing or what procedures were not followed, Entegris fails to show that the Office erred in its analysis of Hänssgen. And Entegris's allegation that the inventor "failed to properly follow the experiment procedures" is baseless, given their allegation that they did not have "sufficient information to assess the appropriateness of the experiment." *Id.* at 15, 26.

Entegris's argument is principally based on its own testing of Hänssgen. But Entegris's tests include unexplained discrepancies in procedure and insufficient indications of reliability. Entegris alleges that its "expert synthesized two monoalkyltin triamide products, $\text{tBuSn}(\text{NEt}_2)_3$ (following the Hänssgen procedure)." Pet. at 17; *see also id.* at 27. Entegris's expert, Dr. Parkin, testifies that he "closely follow[ed] the detailed experimental conditions disclosed in Hänssgen, including using the same amounts of reagents. *Compare* EX1020 *with* EX1005." Ex. 1002 at

¶ 115. However, comparing Hänssgen (Ex. 1005) with the procedures from Dr. Parkin (Ex. 1020) shows that Dr. Parkin silently added—without providing *any* basis in the prior art or a POSA’s knowledge—that “the reactants and the products ... should also be protected from ambient light to prevent any possible decomposition from prolonged exposure.” Ex. 1020. Dr. Hood appears to have complied with this unexplained directive from Dr. Parkin by ensuring that the “flask containing $\text{Sn}(\text{NEt}_2)_4$ was then wrapped in aluminum foil to prevent light exposure.” Ex. 1003 at ¶¶ 11, 19. Dr. Parkin also includes an entirely new “Procedure 2,” which “[i]nstead of employing 10 mmol of t-BuLi, use[s] an excess amount of t-BuLi (e.g., by 20%) in Step 2.” Ex. 1020. Dr. Hood appears to have complied with this unexplained directive from Dr. Parkin by increasing the t-BuLi to 1.2eq. *See* Ex. 1003 at ¶¶ 19-25. Entegris’s modifications mean that it fails to show the Office erred in its consideration of Hänssgen.

b) Entegris Fails to Establish That the Office Erred in its Consideration of Deelman

For Deelman, Entegris fails to show error in the Examiner’s conclusion that Deelman’s procedures fail to result in the claimed purity of the claimed monoalkyl tin triamide compounds. Although Entegris conducted several experiments for this Petition, it never attempted to test Deelman’s procedures (or any modified versions of Deelman’s procedures) to contradict the experiments Inpria conducted and described to the Examiner during prosecution.

Instead, Entegris's argues that Inpria's experiments during prosecution were "designed to fail" (Pet. at 15) and "adopted an irrelevant synthesis method" (*id.* at 26-27) without *any* proof that Inpria deviated from the teachings of Deelman. In other words, during prosecution, Inpria argued that Deelman did not satisfy the claims and provided experiments of Deelman to support that argument. Ex. 1004 at 444-445, 546-550. Entegris criticizes those experiments but provides no rationale for how a POSA would have synthesized monoalkyltin triamide products using Deelman's synthetic processes any differently. By failing to show that Deelman suggested different procedures and by arguing that the Deelman procedures were "designed to fail," Entegris fails to show the Examiner erred in its conclusion that Deelman's procedure does not result in the claims.

Moreover, Entegris's argument that Deelman is "simply irrelevant" because it relates to "an entirely different category of compound," Pet. at 16, completely undermines its simultaneous use of Deelman in the Petition as a basis for modifying Meyers in four out of its six grounds, *id.* at 40-74 (Grounds 2A, 2B, 3A, 3B). Either Entegris fails to show error in the Examiner's consideration of the experiments following Deelman's examples dictating an aqueous solution, or Deelman is indeed irrelevant (in which case Entegris's Grounds 2A, 2B, 3A, and 3B should be ignored entirely).

c) Entegris Fails to Establish That the Office Erred in its Consideration of Meyers

Entegris’s only argument alleging Examiner error for Meyers is one sentence alleging that Inpria “adopted an irrelevant synthesis method (in the case of Deelman and Meyers).” Pet. at 26-27. Entegris appears to confuse that Inpria’s declarations during prosecution were about Hänssgen and Deelman—not Meyers. Thus, the Examiner during prosecution was considering the four corners of the Meyers reference, which does not disclose any particular purity.

To the extent that Entegris is implying that the Examiner might have come to a different conclusion if it had access to Entegris’s new experimental testing combining Meyers and Deelman, this is not the sort of “misapprehending or overlooking specific teachings of the relevant prior art” that are considered error under *Advanced Bionics*. *Advanced Bionics*, Paper 6, at 8-9 n.9. Nor do Entegris’s experiments themselves show that the Examiner erred in considering Meyers. Entegris’s first experiment fails to achieve the claimed purity using Entegris’s test procedures based on Meyers (Ex. 1003 at ¶ 37), which suggests the Examiner was correct in allowing the claims over Meyers, rather than showing the Examiner erred.

Entegris attempts to leverage this failure as a reason to adjust its experiments—but that is hindsight rationale, not a showing that the Examiner erred. Specifically, Dr. Parkin expressly relies on the failed results of the first test as a basis for “optimizing” Meyers. After analyzing the first test results (which would not have

been in the knowledge of a POSA), Dr. Parkin concludes, “[i]t is apparent that Example 7 of Meyers was not optimized for achieving high purity monoalkyltin triamide.” Ex. 1002 at ¶ 120. He then uses this as a basis to “instruct[] Dr. Hood to modify the synthesis process.” *Id.* at ¶ 121. But using December 2024 test results as a motivation to modify the prior art is textbook hindsight. *See Honeywell Int’l Inc. v. Mexichem Amanco Holding S.A. DE C.V.*, 865 F.3d 1348, 1354 (Fed. Cir. 2017) (“use of inherency in the context of obviousness must be carefully circumscribed because that which may be inherent is not necessarily known and that which is unknown cannot be obvious” (internal quotation omitted)). Thus, even if the Examiner had Entegris’s test results, they would have been correct to disregard them.

d) Entegris Fails to Establish That the Office Erred in its Consideration of Jones

Entegris fails to identify error in the Office’s consideration of Jones, instead only arguing it was “not properly considered” because the “Examiner did not rely on or substantively address [Jones] for any rejections.” Pet. at 24. But this does not excuse Entegris’s failure to show error. *See e.g., Ecto World, LLC v. Rai Strategic Holdings, Inc.*, IPR2024-01280, Paper 10, at 10 (Mar. 6, 2025) (institution denial under 325(d) where Petitioner failed to show error in examination despite arguing the references in question were “buried in a massive [Information Disclosure Statement] dump of over 1,000 references”).

* * *

For these reasons, every piece of prior art in this Petition was presented to the Examiner, and Entegris has not demonstrated that the Examiner erred when considering the prior art. Accordingly, Entegris'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 '903 patent.

Respectfully submitted,

Dated: May 12, 2025

By: /Naveen Modi/
Naveen Modi (Registration No. 46,224)
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, 7,295 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/
Naveen Modi (Registration No. 46,224)
Counsel for Patent Owner

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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