

From: [Zeilberger, Daniel](#)
To: [Trials; Wolfe, Michael](#)
Cc: [PH-Entegris-Inpria-IPR; Bergeron, Amy; Williams, Eliot D.; Burke, Katharine; Zhu, Frank](#)
Subject: RE: IPR2025-00267 - Motion for Additional Discovery and Related Proceedings Notice
Date: Thursday, December 4, 2025 6:25:19 PM
Attachments: [image001.png](#)

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Your Honors,

As instructed during the conference call with the Board on December 4, 2025, the parties met and conferred regarding Patent Owner's request for additional discovery. Unfortunately, the parties have not been able to come to an agreement. Therefore, Patent Owner respectfully requests that the Board authorize briefing on Patent Owner's request for additional discovery or grant Patent Owner's requested discovery based on the arguments presented during the conference call without further briefing. The specific, narrowly tailored discovery requests that Patent Owner is seeking are reproduced below for the Board's convenience. Patent Owner respectfully submits that, if Petitioner's representations during the conference call were accurate and forthright, then the effort in responding to these requests by Petitioner is minimal. Tellingly, however, despite Petitioner's representations during the conference call, it has indicated that while it is receptive to Patent Owner's RFP #1 (except for sub-part (f)), directed to written communications, it could not agree to Patent Owner's ROG #1, directed to oral communications or written communications that are no longer available for production.

This is an issue of exceptional importance—if Petitioner improperly omitted Lam as an RPI in its petition, the Petition is time-barred under Section 315(b). *Corning Optical Communications RF, LLC v. PPC Broadband, Inc.*, IPR2014-00440, Paper 68, at 25 (Aug. 18, 2015). Patent Owner believes the evidence of record already has pushed the burden on Petitioner to show that the suspicious relationship between itself and Lam surrounding preparation of the IPR petition here does not establish an RPI relationship—such evidence certainly warrants a motion for additional discovery. *See, e.g., VirnetX Inc. v. Mangrove Partners Master Fund, Ltd.*, 778 F. App'x 897, 904 (Fed. Cir. 2019) (“the Board abused its discretion in denying [patent owner] the ability to even file a motion [for additional discovery]”).

Petitioner indicated during the meet-and-confer that it could not agree to RFP #2 unless Patent Owner agreed to Petitioner's counter-requests, raised for the first time ever during the conference call with the Board (and then broadened even further during the parties' meet-and-confer), for all agreements Patent Owner has entered with Lam and/or Lam's customers relating to the '903 patent. But Petitioner's counter-requests have absolutely nothing to do with whether Lam was an RPI at the time Petitioner filed the petition. *See, e.g., First Data Corp. v. Cardsoft, LLC*, IPR2014-00715, Paper 9 at 9 (Oct. 17, 2014) (“a party who controlled or had the opportunity to control what went into the Petition, is a real party-in-interest despite turning over the reins to another party after all of the work has been done”). Petitioner's counter-requests are a distraction, apparently intended

to either delay Patent Owner's requests or to obtain material that Petitioner intends to use for other, unstated, unrelated purposes. Indeed, Petitioner has never explained how it would satisfy the *Garmin* factors for its requests. The case Petitioner has cited, *Power Integrations, Inc. v. Semiconductor Components Industries, LLC*, 926 F.3d 1306 (Fed. Cir. 2019), dealt with the question of new RPI relationships being *created* post-filing of the petition, which is not relevant to the present dispute.

As Patent Owner suggested on the call, if the Board believes there is insufficient time to handle this request, Patent Owner would not oppose requesting an extension of 30-days (or however much time the Board thinks is appropriate) for the institution decision deadline. During the meet-and-confer, Petitioner indicated that it would agree to giving the Board a 30-day extension, but only if Patent Owner agreed not to proceed with a motion. Petitioner's position demonstrates there is no harm to Petitioner from an extension. In any event, Patent Owner also notes that it first made this request to file a motion for additional discovery three weeks ago, on November 13, 2025. Patent Owner should thus not be prejudiced by the current timing. To the extent the Board feels it must issue an institution decision before the RPI issues can be resolved (which Patent Owner does not concede is appropriate), and assuming the IPR is instituted, the RPI issues would still be relevant to whether the IPR may be maintained, as was the case in *Corning Optical*.

++++ Patent Owner's Requests for Additional Discovery +++++

For purposes of these requests, "Entegris" includes any attorney representing Entegris, whether outside counsel or in-house counsel, or any other individual acting on Entegris's behalf. Similarly, "Lam" includes any attorney representing Lam, whether outside counsel or in-house counsel, or any other individual acting on Lam's behalf.

For purposes of these requests, "communications" include any oral, written, or other contact between Entegris and Lam, including letters, emails, memoranda, telefaxes, telephone conversations, voicemails, meeting invitations, face-to-face meetings, etc.

For purposes of these requests, "Document(s)" shall mean any written, printed, recorded, or graphic matter of any kind, including those that relate to or summarize any of the requested communications, whether produced or reproduced or stored on paper, electronic media, or other storage medium, including originals and non-identical copies and drafts, whether modified or not, and all associated metadata.

RFP #1:

All documents relating to communications between Entegris and Lam regarding the preparation, strategy, or filing of a patent office challenge to U.S. Patent No. 11,673,903, including but not limited to: (a) communications between Entegris and Lam regarding the decision for Entegris to challenge the '903 patent in an IPR; (b) communications between Entegris and Lam regarding the selection of prior art used in the petition filed in IPR2025-00267; (c) communications between Entegris and

Lam regarding any analysis that is contained in the petition in IPR2025-00267; (d) communications between Entegris and Lam regarding the drafting, review, or approval of any portion of the petition filed in IPR2025-00267; (e) communications between Entegris and Lam regarding the timing of the Petition's filing in relation to Lam's statutory bar date under 35 U.S.C. § 315(b); and (f) communications between Entegris and Lam regarding the acquisition, forwarding, or use of the email identified as Exhibit 1028.

ROG #1:

Describe any communications between Entegris and Lam regarding the preparation, strategy, or filing of a patent office challenge to U.S. Patent No. 11,673,903 that are either oral communications or written communications that are no longer available for production under RFP #1, including but not limited to: (a) communications between Entegris and Lam regarding the decision for Entegris to challenge the '903 patent in an IPR; (b) communications between Entegris and Lam regarding the selection of prior art used in the petition filed in IPR2025-00267; (c) communications between Entegris and Lam regarding any analysis that is contained in the petition in IPR2025-00267; (d) communications between Entegris and Lam regarding the drafting, review, or approval of any portion of the petition filed in IPR2025-00267; (e) communications between Entegris and Lam regarding the timing of the Petition's filing in relation to Lam's statutory bar date under 35 U.S.C. § 315(b); and (f) communications between Entegris and Lam regarding the acquisition, forwarding, or use of the email identified as Exhibit 1028.

RFP #2:

All agreements, contracts, or memoranda of understanding between Entegris and Lam that were in effect at any time during the preparation of the petition filed in IPR2025-00267 or as of the filing date that relate to: (a) indemnification, defense, or common interest obligations; (b) the funding or allocation of costs for this Petition; and (c) the scope of the "Strategic Collaboration" referenced in Exhibit 2028 as it pertains to the '903 patent or the products or chemistries that Lam was accused of infringing in the related Delaware litigation.

Petitioner requested that its position be added to this email. It is provided as follows:

Petitioner's Position

Petitioner does not believe discovery is necessary or appropriate because PO has provided no evidence sufficient to show that Lam had any ability to control this IPR and thus nothing has called into question Petitioner's identification of the real parties in interest in the Petition. However, if there is to be discovery and further briefing regarding RPII issues, Petitioner is entitled to obtain any agreements between Patent Owner and Lam conveying rights to the challenged '903 Patent (see Petitioner's Requests below). In particular, the agreement(s) is/are likely to show that Lam has no current interest in invalidating the '903 Patent and thus does not

stand to benefit from invalidation of the patent in this proceeding as of the date the petition is “considered” for institution. *See Power Integrations v. Semiconductor Components*, 923 F.3d 1306, 1316-17 (2019) (rejecting argument seeking to “limit[] evaluation of privity and RPI relationships to only the time of filing” and noting “the petitioner is ...under a continuing obligation to update the Board within 21 days of any change to the RPI, 37 C.F.R. § 42.8(a)(3), (b)(1). This continuing obligation to provide notice would seem to make little sense unless it was relevant to the ongoing proceedings.”). Indeed, Director Squires’s October 28, 2025 Memorandum designating *Corning Optical* as precedential expressly stated that the requirement of §312(a)(2) is for “petitioners to identify the real parties in interest...to their petitions **before institution**” and “§312(a) must be satisfied **before the Director can institute trial.**” Thus, Lam’s interest as of the institution date is highly relevant to Patent Owner’s RPII argument here.

Patent Owner’s proposal for only one-sided discovery on the RPII issue would therefore put Petitioner at an unfair disadvantage, and Petitioner cannot agree to it. Similarly, Patent Owner’s complaint that Petitioner’s request for reciprocal discovery is somehow late is belied by the fact that Patent Owner itself had not articulated what discovery it was seeking prior to yesterday’s conference call, which requests were further expanded to include a duplicative and burdensome proposed interrogatory proposed by PO after the parties’ meet and confer.

As to PO’s proposed document requests, Petitioner would agree to search for and produce any documents responsive to all subparts of Inpria’s RFP 1, except subpart f. That subpart is objectionable because it seeks post-IPR petition communications between LAM and Petitioner related to developments in the District Court proceeding, and is therefore irrelevant to whether Lam funded, directed or controlled this IPR. Petitioner has also already explained how it acquired the email identifying the claims asserted by PO in the district court litigation.

In the event that discovery does go forward on a reciprocal and fair basis, Petitioner would agree to jointly request a 30 day extension of the institution decision deadline to allow the parties and Board to review the produced material and brief and consider the RPII issues, to the extent the Board deems it necessary.

+++++ Petitioner’s Requests for Production +++++

1. Any agreement conveying any right to practice U.S. Patent No. 11,673,903 to Lam and/or its customers.
2. Any settlement agreement between Inpria and Lam related to the dispute entitled *Inpria Corporation v. Lam Research Corp.*, 22-1359 (CJB) in the United States District Court for the District of Delaware.

Respectfully,
Daniel Zeilberger

Counsel for Patent Owner

From: Trials <Trials@USPTO.GOV>

Sent: Monday, December 1, 2025 2:39 PM

To: Wolfe, Michael <michaelwolfe@paulhastings.com>; Trials <Trials@USPTO.GOV>

Cc: PH-Entegris-Inpria-IPR <PH-Entegris-Inpria-IPR@paulhastings.com>; Bergeron, Amy <amy.bergeron@bakerbotts.com>; Williams, Eliot D. <Eliot.Williams@BakerBotts.com>; Burke, Katharine <Katharine.Burke@BakerBotts.com>; Zhu, Frank <frank.zhu@BakerBotts.com>
Subject: [EXT] RE: IPR2025-00267 - Motion for Additional Discovery and Related Proceedings Notice

Counsel,

The Board will schedule a conference call regarding this matter for 1:00 ET on Wednesday, December 3. The dial in number is 540-566-5633 and the meeting ID is 571699417. At that call, both parties should be prepared to discuss (1) what evidence currently exists to suggest that discovery would be likely to lead to further evidence that Lam should have been named as a real party-in-interest in the petition; (2) the conclusions, if any, that should be drawn from the evidence highlighted in Patent Owner's supplemental sur-reply (Paper 19); (3) the nature of any coordination or cooperation between Entegris and Lam regarding the preparation and filing of the petition here; and (4) the timing of any briefing on the proposed discovery motion, the collection of the requested discovery itself, and any follow-on supplemental briefing on real party-in-interest issues.

Regards,

Andrew Kellogg,
Deputy Chief Clerk, Trials
Patent Trial and Appeal Board
USPTO
andrew.kellogg@uspto.gov
(571) 272-5366



From: Wolfe, Michael <michaelwolfe@paulhastings.com>

Sent: Tuesday, November 25, 2025 10:48 AM

To: Trials <Trials@USPTO.GOV>

Cc: PH-Entegris-Inpria-IPR <PH-Entegris-Inpria-IPR@paulhastings.com>; Bergeron, Amy <amy.bergeron@bakerbotts.com>; Williams, Eliot D. <Eliot.Williams@BakerBotts.com>; Burke, Katharine <Katharine.Burke@BakerBotts.com>; Zhu, Frank <frank.zhu@BakerBotts.com>

Subject: RE: IPR2025-00267 - Motion for Additional Discovery and Related Proceedings Notice

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Your Honors,

Patent Owner Inpria is writing to follow-up on the status of the requests below, including Patent Owner's request to file a motion for additional discovery and Patent Owner's request to file the district court's claim construction order.

Respectfully,
Michael Wolfe

From: Wolfe, Michael
Sent: Thursday, November 13, 2025 2:26 PM
To: Trials <Trials@USPTO.GOV>
Cc: PH-Entegris-Inpria-IPR <PH-Entegris-Inpria-IPR@paulhastings.com>; Bergeron, Amy <amy.bergeron@bakerbotts.com>; Williams, Eliot D. <Eliot.Williams@BakerBotts.com>; Burke, Katharine <Katharine.Burke@BakerBotts.com>; Zhu, Frank <frank.zhu@BakerBotts.com>
Subject: RE: IPR2025-00267 - Motion for Additional Discovery and Related Proceedings Notice

Apologies, IPR2025-00267.

From: Trials <Trials@USPTO.GOV>
Sent: Thursday, November 13, 2025 2:22 PM
To: Wolfe, Michael <michaelwolfe@paulhastings.com>; Trials <Trials@USPTO.GOV>
Cc: PH-Entegris-Inpria-IPR <PH-Entegris-Inpria-IPR@paulhastings.com>; Bergeron, Amy <amy.bergeron@bakerbotts.com>; Williams, Eliot D. <Eliot.Williams@BakerBotts.com>; Burke, Katharine <Katharine.Burke@BakerBotts.com>; Zhu, Frank <frank.zhu@BakerBotts.com>
Subject: [EXT] RE: Motion for Additional Discovery and Related Proceedings Notice

Counsel,

Please clarify which proceeding this message is referring to.

Regards,

Andrew Kellogg,
Deputy Chief Clerk, Trials
Patent Trial and Appeal Board
USPTO
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(571) 272-5366



UNITED STATES
PATENT AND TRADEMARK OFFICE ®

From: Wolfe, Michael <michaelwolfe@paulhastings.com>

Sent: Thursday, November 13, 2025 2:20 PM

To: Trials <Trials@USPTO.GOV>

Cc: PH-Entegris-Inpria-IPR <PH-Entegris-Inpria-IPR@paulhastings.com>; Bergeron, Amy <amy.bergeron@bakerbotts.com>; Williams, Eliot D. <Eliot.Williams@BakerBotts.com>; Burke, Katharine <Katharine.Burke@BakerBotts.com>; Zhu, Frank <frank.zhu@BakerBotts.com>

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Your Honors,

On July 2, this proceeding was discretionarily denied because of parallel litigation. Paper 12. On October 31, this proceeding was referred to the Board because the parallel litigation settled. Paper 21. The Deputy Director instructed the Board to address “the merits and other non-discretionary considerations.” Patent Owner raises two issues regarding the merits and other non-discretionary considerations.

Regarding the merits, on September 8, 2025 (after Entegris’s IPR was discretionarily denied, but shortly before the district court case settled), the district court construed a limitation in independent claim 1 of the challenged patent. Pursuant to the Deputy Director’s subsequent September 16 memorandum about prior adjudications and the Board’s General Order on September 20 directing parties to apprise the Board of prior adjudications such as claim construction, Patent Owner respectfully requests authorization to file the district court claim construction order.

Regarding the “other non-discretionary considerations,” Patent Owner has argued Petitioner failed to name the district court defendant (Lam) as an RPI. See Paper 7 at 19; Paper 15 at 3-5; Paper 19 at 1. Entegris argues below that Patent Owner had no “substantive response” regarding Entegris’s attorney arguments denying RPI, but that is simply incorrect. Even without discovery, Patent Owner identified multiple indications of Lam’s RPI status, for example, how Entegris filed in this IPR the email that Patent Owner sent only to Lam’s counsel. Paper 15 at 3 (citing Ex. 1028). The Deputy Director’s rehearing decision did not decide these issues, instead referring the petition to the Board, noting “the Board routinely addresses complex RPI issues such as those raised by Patent Owner.” Paper 21. This referral of RPI issues is in line with current PTO policy.

See October 17 Memo at 2 (noting Director may refer RPI determination to the Board). And per the Director's October 28 Memo, issues under § 312(a), such as proper RPI identification, "must be satisfied **before** the Director can institute trial." October 28 Memo at 1 (emphasis added).

As such, Patent Owner respectfully requests authorization to file a Motion for Additional Discovery directed to information about whether Petitioner has failed to name Lam as an RPI of this proceeding. Patent Owner proposes that its Motion be limited to 5 pages and due within one week of the Board's authorization of the motion, then Petitioner may file a 5-page response one week later, and finally Patent Owner may file a 2-page reply two days later. Patent Owner opposes Petitioner's request below that preemptively requests a sur-reply for Patent Owner's motion.

Patent Owner has conferred with Petitioner, who provides the response below:

Petitioner Entegris does not oppose Patent Owner's request to file the district court claim construction order. Petitioner notes the Board's September 20 General Order, referenced by Inpria, did not issue in this proceeding.

Entegris opposes Patent Owner's request to file a Motion for Additional Discovery on RPI. Patent Owner has already raised the RPI issue in multiple briefs relating to Patent Owner's request for discretionary denial—which was denied, with no opportunity for rehearing until **after** a decision on institution. Paper 21, 3. Indeed, Entegris's continued pursuit of this IPR, after Lam and Inpria settled their own disputes, shows that Entegris has no special relationship with Lam relevant to this proceeding. Paper 10, 8-10; Paper 17. Patent Owner has no substantive response and instead refers to an email relating to a claim reduction deadline in the then-pending Delaware case, which Entegris cited to disprove Patent Owner's assertion of overlap between that case and this IPR. Paper 10, 10-11; Paper 11. Patent Owner did not inform the Board of the claim reduction, and Entegris requested the information from Lam, like any member of the public could. Simply put, Lam has no control over Entegris in this proceeding, and Patent Owner cites nothing beyond its own speculation otherwise.

Further pre-institution briefing and argument on this record do not serve interests of justice and are contrary to the Board's policy of promoting efficiency in IPR proceedings. Inpria has not identified any changed circumstances requiring discovery prior to institution. The October 28 memorandum referenced by Inpria primarily targets **foreign** entities, Oct. 28 Memorandum at 2-4 (discussing

national security risks from failure to identify foreign RPIs), and here, both Entegris (the petitioner) and Lam (the alleged RPI) are United States entities. It has now been 11 months since Entegris filed its Petition. Inpria's attempt to further delay the Board's merits review should be denied.

To the extent the Board grants Patent Owner's request to file the Motion for Additional Discovery, Entegris requests that it be provided a 2 page sur-reply to be due 2 days after Patent Owner's reply.

If a call would be helpful, the parties are available at the following times:

- November 17, 2025: 12 – 2:30 PM or 4-5:30 PM ET
- November 18, 2025: 9 AM – 5:30 PM ET

Thanks,
Michael Wolfe

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