

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ENTEGRIS, INC.,
Petitioner,

v.

INPRIA CORP.,
Patent Owner.

IPR2025-00267
Patent 11,673,903 B2

Before CHRISTOPHER M. KAISER, DEBRA L. DENNETT, and
DAVID COTTA, *Administrative Patent Judges*.

KAISER, *Administrative Patent Judge*.

ORDER
Additional Discovery
37 C.F.R. § 42.51(b)(2)

BACKGROUND

On December 12, 2024, Entegris, Inc. (“Petitioner”) filed a Petition (Paper 1) requesting *inter partes* review of claims 1–4 and 6–10 of U.S. Patent No. 11,673,903 B2. Following briefing on discretionary issues, the Acting Director denied institution of trial. Paper 12. Petitioner moved for rehearing of that decision (Paper 13), and the Deputy Director vacated the decision denying institution and referred the Petition to the Board. Paper 21. In the decision referring the Petition, the Deputy Director instructed us to consider both the merits of the Petition “and other non-discretionary considerations, as appropriate,” highlighting among those non-discretionary considerations the “complex RPI issues . . . raised by Patent Owner.” *Id.* at 2–3. The Deputy Director also instructed us to “issue a decision on institution within 60 days.” *Id.* at 3.

After the referral of the case to us, Patent Owner contacted the Board requesting authorization to file a motion for additional discovery related to the question of whether Petitioner failed to include an entity, Lam Research Corporation (“Lam”), who Petitioner should have included in its list of named real parties-in-interest. Because we cannot consider a petition for *inter partes* review unless the petition identifies all real parties-in-interest, *Corning Optical Communications RF, LLC v. PPC Broadband, Inc.*, IPR2014-00440, Paper 68 (PTAB Aug. 18, 2015) (precedential, except for § II.E.1), Patent Owner argued that determination of the proper real parties-in-interest was crucial to resolving the question of institution in this proceeding. In addition, Patent Owner argued that the additional discovery it would request in such a motion was necessary to resolving the issue of whether Petitioner should have identified Lam as a real party-in-interest.

On December 3, 2025, in an attempt to determine whether to authorize Patent Owner's requested motion, we held a telephone conference with representatives from both parties and heard argument about whether the discovery Patent Owner sought was warranted. Following a reminder from us that 37 C.F.R. § 42.51(b)(2)(i) permits "[t]he parties [to] agree to additional discovery between themselves" and the expression of some optimism by both parties that an agreement could be reached, we ordered the parties to meet and confer and to inform us on December 4, 2025, of whether they had reached an agreement. The parties have since informed us that they have not been able to reach an agreement. Ex. 3001. Accordingly, to resolve the issues expeditiously and to comply with the Deputy Director's instruction regarding the timing of an institution decision, we enter this order.

DISCUSSION

Patent Owner proposes three discovery requests. *Id.* We address each of them in turn. Patent Owner's first request is for production of

[a]ll 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.

Id. We note that, during our telephone conference, counsel for Petitioner represented on the record that no such communications exist to be produced. In addition, we are mindful of the time limit placed on the pre-institution discovery process by the Deputy Director's instruction to issue an institution decision within 60 days, as well as of the requirement of the precedential decision in *Corning Optical* that we completely resolve the real party-in-interest issue before institution. In view of counsel's representation, and in view of the need to quickly resolve these issues without adding unnecessary complication to the discovery process, we are not persuaded that ordering compliance with this document request would be in the interests of justice.

Patent Owner next proposes an interrogatory:

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.

Id. Because it seeks information regarding the same communications as Patent Owner’s first request for production of documents, and because it stretches that request even further to include information regarding “communications that are no longer available for production,” *id.*, this request can be resolved in the same fashion as the first request for production. We are not persuaded that requiring Petitioner to respond to this interrogatory would be in the interests of justice in the present proceeding.

Patent Owner’s third request seeks production of

[a]ll 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 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.

Id. This request is limited in time, seeking only agreements “that were in effect at any time during the preparation of the petition filed in [the present proceeding].” *Id.* In addition, it is limited in scope, seeking only production of “agreements, contracts, or memoranda of understanding,” as opposed to “any communications between Entegris and Lam” or “[a]ll documents relating to communications between Entegris and Lam,” as Patent Owner seeks in its first two requests. *Id.* Moreover, the limitation of this request to documents relating to “indemnification, defense, or common interest obligations,” “funding or allocation of costs for this Petition,” and “the scope of the ‘Strategic Collaboration’ referenced in Exhibit 2028” makes this request particularly targeted to information that could help resolve the real party-in-interest issue. *Id.* Thus, this request is both helpful to resolving the

relevant issues and can be completed quickly enough to satisfy the deadline to issue a decision on institution. Accordingly, we are persuaded that the production of the documents sought in this request is in the interests of justice.

In addition to Patent Owner's proposed discovery requests, during our telephone conference, Petitioner requested that Patent Owner produce the settlement agreement between Patent Owner and Lam, reasoning that that agreement might show Lam's lack of interest in the present proceeding. Petitioner renews that request in its proposed discovery requests, seeking both the settlement agreement and "[a]ny agreement conveying any right to practice U.S. Patent No. 11,673,903 to Lam and/or its customers." *Id.* We note that the relevant issue for us to resolve is whether Lam should have been named as a real party-in-interest at the time the Petition was filed in this proceeding. The settlement agreement in question was reached some nine months after the Petition was filed. *Compare* Pet. 75 (dating Petition to December 12, 2024), *with* Ex. 2040; Ex. 2041 (reporting settlement agreement on September 15, 2025). We are not persuaded that a settlement agreement from September 2025 can inform the question of whether Lam was a real party-in-interest in December 2024, because Lam's interest in this proceeding could have changed in the meantime. Thus, we are not persuaded that production of the settlement agreement or any associated agreements conveying the right to practice the challenged patent would be in the interests of justice in the present proceeding.

For the reasons discussed above, we order Petitioner to produce [a]ll 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.

Ex. 3001. Because the real party-in-interest issue must be resolved so quickly, and because we have narrowed the additional discovery to this single, targeted request, we order this production to be complete by December 12, 2025.

Following the production of this additional discovery, we authorize Patent Owner to file, no later than December 17, 2025, and not exceeding five pages, a supplemental brief regarding the real party-in-interest issue. If Patent Owner files a supplemental brief in response to this order, Petitioner is authorized to file, no later than December 19, 2025, and not exceeding five pages, a responsive brief addressing the real party-in-interest issue. Both Patent Owner’s and Petitioner’s briefs may be accompanied by documentary evidence produced by Petitioner in response to this order.

Because the real party-in-interest issue must be resolved so quickly, we see very little room for flexibility on the dates set in this order. If any date proves to be impossible to meet, however, we direct the parties to contact us immediately to determine the best course of action.

ORDER

For the reasons discussed above, it is hereby:

ORDERED that Petitioner shall produce to Patent Owner, not later than December 12, 2025, 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 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;

FURTHER ORDERED that Patent Owner is authorized to file, no later than December 17, 2025, and not exceeding five pages, a supplemental brief regarding the real party-in-interest issue; and

FURTHER ORDERED that, if Patent Owner files a supplemental brief, Petitioner is authorized to file, no later than December 19, 2025, and not exceeding five pages, a responsive brief addressing the real party-in-interest issue.

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