

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LAM RESEARCH CORP.,
Petitioner,

v.

INPRIA CORP.,
Patent Owner.

Case IPR2025-00309
Patent No. 11,537,048¹

**PETITIONER'S SUPPLEMENTAL PAPER AND NOTICE RANKING
PETITIONS**

¹ Petitioner is filing a substantively identical document in IPR2025-00256.

I. INTRODUCTION

Pursuant to the Consolidated Trial Practice Guide, Lam Research Corp. (“Petitioner”) ranks, and explains the need to file, two Petitions challenging Inpria’s (“Patent Owner”) U.S. Patent No. 11,537,048 (the “’048 Patent”). The Board should grant each of the petitions filed against the ’048 Patent. The two petitions rely on different grounds with different prior art, each based on one of two different potential priority date. The Trial Practice Guide specifically recognizes that disputes about a priority date often require arguments using multiple prior art references, necessitating two petitions. That is the case here, and the Board should grant both petitions.

II. EXPLANATION FOR TWO PETITIONS

As explained below, the Board should institute both petitions.

A. The Two Petitions Present Different Grounds

The two petitions present the following grounds of unpatentability, respectively, each based on entirely different prior art references and challenging all 20 claims of the ’048 Patent:

IPR2025-00256			
Ground	Basis	Reference(s)	Claims
1	§ 103	Meyers and Weidman	1-20
2	§ 102	Berney	1-5, 8-20
3	§ 103	Berney and Molloy	6, 7

IPR2025-00309			
Ground	Basis	Reference(s)	Claims
1	§ 103	Dhas and Cardineau	1-6, 8-20
2	§ 103	Dhas, Cardineau, and Molloy	7
3	§ 103	Weissman and Cardineau	1-5, 8-20
4	§ 103	Weissman, Cardineau, Molloy	6, 7

B. A Single Petition Would Not Have Been Sufficient To Address Both Potential Priority Date Scenarios. .

In cases involving a priority dispute, the Board has allowed Petitioners to pursue multiple petitions. The PTAB Trial Practice Guide notes that “the Board recognizes that there may be circumstances in which more than one petition may be necessary, including, ... when **there is a dispute about priority date** requiring arguments under **multiple prior art references.**” Consolidated Trial Practice Guide, p. 26 (emphasis added).

Where a party has presented petitions based on different possible priority dates, the Board has considered and instituted both petitions. In *Medtronic, Inc. v. Teleflex Innovations S.A.R.L.*, for example, the Board instituted a second petition that addressed a dispute over the priority date of the challenged patent. IPR2020-00136, Paper 20 at 39 (PTAB June 26, 2020). The Board explained that “[g]iven the possibility that we may determine that [intervening art] does not qualify as prior art after fully considering Patent Owner’s priority date arguments, we determine that Petitioner provides a sufficient explanation as to why it was necessary to rely upon the obviousness challenges presented here as an alternative

basis for unpatentability. Indeed, this is precisely one of the circumstances recognized in our Trial Practice Guide ‘in which more than one petition may be necessary.’” *Id.*; see also *10X Genomics, Inc. v. Bio-Rad Labs., Inc.*, IPR2020-00088, Paper 8 at 47 (PTAB Apr. 27, 2020) (noting that more than one petition may be necessary where there is a priority date dispute).

Here, two petitions are needed to provide grounds addressing each of the two potential priority dates. In short, during prosecution of the ’048 Patent, Patent Owner improperly introduced new matter, including a new figure and accompanying text. This has led to a dispute in the corresponding district court case regarding whether Patent Owner is entitled to their earliest claimed priority date. EX1010, p. 45-51. Because of the uncertainty as to whether the claims will ultimately be afforded the earlier priority date, Petitioner has appropriately split the arguments into two petitions, one that addresses each potential priority determination. The Board should accordingly grant both petitions, as contemplated in the Trial Practice Guide.

C. The Challenged Claims Include Multiple Means-Plus Function Limitations Directed to the New Matter.

The independent claim includes no fewer than 3 means-plus-function (“MPF”) claim limitations, almost all of which relate to the added matter giving rise to the priority dispute. Given that MPF limitations are construed based on an

analysis of the corresponding structures disclosed in the specification, the numerous MPF limitations related to new matter require Petitioner to devote significant space in each Petition to analyzing the scope of the challenged claims. Given these further complications related to the Challenged Claims, a single petition would not provide sufficient space to adequately address the competing priority scenarios.

D. Submitting One Petition Would Risk Negatively Impairing Petitioner's Rights

By submitting only one of the two petitions, Petitioner would risk surrendering its right to challenge the '048 Patent based on the most relevant prior art under each of the two potential priority dates.

E. The *General Plastics* Factors Favor Institution

The *General Plastics* factors also favor institution of both petitions. The first five *General Plastics* factors favor institution because Petitioner is filing both petitions for the first time and on the same day. *See Intex Recreation Corp. v. Team Worldwide Corp.*, IPR2018-00873, Paper 14 at 8-12 (PTAB Oct. 29, 2018) (noting factors 1-5 “do not weigh in favor of exercising discretion to deny” where petitions were filed on the same day). No other petitions challenging the '048 Patent have ever been filed by any petitioner. Factors 6 and 7 also favor institution. The two petitions only rely on six prior art references (one of which is

only being used for a limited number of dependent claims), so the Board’s ability to render timely final decisions should not be impeded.

III. RANKING OF PETITIONS

Because Petitioner strongly believes that the late added figure and corresponding text in the ’048 Patent constitute improper new matter, Petitioner prioritizes the petition that relies on the later priority date corresponding to the date on which the new matter was added. *See* IPR2025-00256.

Rank	Petition
1	IPR2025-00256
2	IPR2025-00309

IV. CONCLUSION

A single petition would have been insufficient to adequately address all grounds raised in the two petitions, which rely on different primary references depending on which of two potential priority dates are afforded to the ’048 patent. As such, Petitioner requests that the Board institute and consolidate both Petitions “if it identifies one petition that satisfies petitioner’s burden under 35 U.S.C. § 314(a).” Consolidated Trial Practice Guide, 59-60.

Dated: December 13, 2024

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), lead counsel for Petitioner hereby certifies that on December 12, 2024, a copy of this PETITIONER'S SUPPLEMENTAL PAPER AND NOTICE RANKING PETITIONS was sent via Priority Mail Express to the correspondence address of record for the '048 patent:

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A courtesy copy of this PETITIONER'S SUPPLEMENTAL PAPER AND NOTICE RANKING PETITIONS was also served via email on December 12, 2024 on Patent Owner's counsel of record in the district court litigation against Lam Research Corp.:

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