

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE

INPRIA CORPORATION,

Plaintiff,

v.

LAM RESEARCH CORP.,

Defendant.

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) C.A. No. 22-1359-CJB
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**LETTER TO THE HONORABLE CHRISTOPHER J. BURKE
REGARDING PROPOSED SCHEDULING ORDER AND CHECKLIST**

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Dated: December 19, 2023

Dear Judge Burke:

Pursuant to the Court's November 29, 2023 Oral Order (D.I. 36), Plaintiff Inpria Corporation ("Inpria") and Defendant Lam Research Corp. ("Lam") submit this letter, a proposed case schedule, and a copy of Your Honor's Case Management Checklist (Exhibit A).

Description of Case

On October 14, 2022, Inpria filed its complaint for patent infringement (D.I. 1) against Lam alleging infringement of three patents—U.S. Patent Nos. 10,732,505 (the "'505 Patent"), 9,823,564 (the "'564 Patent"), and 9,310,684 (the "'684 Patent")—of which Inpria alleges that it is the assignee and sole owner of all right, title, and interest. All of these patents relate to metal oxide photoresist design and manufacturing. Inpria's Complaint accused Lam's dry resist processes and products of infringement. Inpria alleged that Lam's infringement was and continues to be willful.

On December 13, 2023, Inpria filed an amended complaint (D.I. 43) against Lam alleging infringement of the same three patents and five additional patents—the '505 Patent, the '564 Patent, the '684 Patent, and U.S. Patent Nos. 10,642,153 (the "'153 Patent"), 11,537,048 (the "'048 Patent"), 11,673,903 (the "'903 Patent"), 11,693,312 (the "'312 Patent"), 11,809,081 (the "'081 Patent") (collectively the "Asserted Inpria Patents")—of which Inpria alleges that it is the assignee and sole owner of all right, title, and interest. All of the Asserted Inpria Patents relate to metal oxide photoresist design and manufacturing. And the Amended Complaint accuses the same dry resist processes and products offered by Lam of infringement. Inpria continues to allege that Lam's infringement was and continues to be willful. Lam has not yet answered.

Parties' Positions Regarding Any Disputed Items in the Scheduling Order

The parties orally conferred on December 18, 2023, and continued to confer via e-mail thereafter. The parties did not agree to a case schedule.

Inpria's position: Inpria has proposed a schedule that allows for trial in July 2025. A trial in 2025 is extremely important to Inpria given the parties are competitors and the lawsuit has been pending since October 2022. Additionally, there may come a time where Inpria must move for a preliminary injunction to protect its rights. Inpria's schedule, which concentrates discovery in the first half of 2024 and sets trial for July 2025, would potentially obviate the need for such a motion or, at a minimum, result in substantial completion of the discovery needed to resolve any such motion. To avoid burdening the Court with a dispute over schedule, Inpria proposed a compromise schedule that would allow for trial a few months later, but the parties could not reach agreement.

In addition to the trial date, other aspects of Lam's schedule are also unworkable. For example, under the Delaware Default Standard of Discovery, core technical documents must be produced within 30 days of Plaintiff's identification of the accused products. Inpria will serve its identification of accused products by tomorrow, December 20, 2023. Thus, under the default rules, Lam should produce core technical documents by January 19, 2024, and then serve its initial invalidity contentions 60 days thereafter. Lam, however, seeks to delay these deadlines such that core technical documents are not due until February 28, 2024, and its initial invalidity contentions are not due until May 30, 2024. While Inpria believes there is no justification for

deviating from the default Delaware rules—especially because Inpria first identified the accused product when it filed its original Complaint over a year ago—Inpria offered a compromise proposal where core technical documents are due on February 2, 2024, which Lam has not accepted.

Lam's proposed schedule also includes unnecessary delays between, for example, claim construction deadlines, between final contentions and the close of fact discovery, and between the completion of briefing on case dispositive motions and trial.

Lam asks the Court to phase this case or, at a minimum, to adopt a late trial date because it believes there are complex inventorship, ownership, and license issues. Yet, when pressed during the meet and confer, Lam could not provide any details substantiating its belief, beyond stating innocuous facts such as a prior employee from The State University of New York now works at Inpria. Such speculation is no reason to phase or inject delay into the case now. Lam is free to explore these alleged issues during discovery, and the parties can litigate these issues without phasing the case or delaying trial.

Lam also believes a late trial date is warranted because the Amended Complaint added five more patents. Those patents, however, are asserted against the same products identified in the original Complaint filed in November 2022, so there is no additional discovery burden on Lam justifying such a lengthy delay.

Finally, it is improper to argue the merits of Lam's potential motion to transfer in this letter, which Lam first raised with Inpria two business days ago. Inpria will provide its position if and when Lam files a motion. And any request for a stay pending such a motion is premature. Given Lam has proceeded before this Court for over a year, this appears to be yet another attempt by Lam to inject delay.

Lam's position: Lam intends to move to transfer this case to the Northern District of California on convenience grounds. This case has no connection to Delaware apart from Lam and Inpria being incorporated in Delaware. During meet and confer on this issue, Inpria's counsel could not identify any likely witnesses in this District or any other connection to this District apart from incorporation. Because Inpria and Lam are based on the West coast (Oregon and California, respectively), there are strong grounds to transfer this case for convenience of both parties and their likely witnesses. Lam submits that the Court should stay the case so the parties can focus on completing briefing and the Court can decide whether to transfer the case.

Should the Court decline to stay the case, Lam submits that this case should be phased to first address threshold issues relating to inventorship, ownership, and licensing of the asserted patents. Prioritizing discovery into and resolution of these issues will resolve whether Inpria has standing to bring this action. Further, resolution of issues relating to the scope of licenses, (including covenants not to sue), may be dispositive of whether Inpria's indirect infringement claims are premised on the activities of licensed users and, as such, are not actionable. It is important to resolve these matters up front to ensure there are no standing defects before this case progresses, and that resources are not wasted pursuing fact and expert discovery into and a trial on indirect infringement by third parties for which there can be no liability.

If the Court declines to phase the case as proposed above, Lan respectfully submits that its proposed schedule with a July 2026 trial date should be adopted. This case more than

doubled in size and complexity last week when Inpria filed an amended complaint adding five asserted patents that relate to complex semiconductor manufacturing processes and compounds. Lam learned of these new patents last week, and is still evaluating Inpria's new claims. Lam's proposal accounts for the increased scope and complexity of this case by affording Lam a fair opportunity to analyze Inpria's new patents and to identify and gather relevant core technical documents. In virtually every patent case before this Court, the scheduling order is not set until after the pleadings close, and thus, an accused infringer typically has many months from the assertion of a patent before it is required to produce core technical documents. Here, Lam's schedule merely seeks just over two months from the filing of the amended complaint asserting new patents to gather and produce its technical documents.

Further, Lam's proposal accounts for the fact that complex inventorship, ownership, and license issues will likely require extensive third-party discovery that is anticipated to take significant time to complete. Inpria's assertion that an early trial date is "extremely important to Inpria" is belied by its actions. This case was stayed for almost a year due to a pending motion to disqualify, yet Inpria waited until just days before a scheduled hearing to substitute counsel and allow the case to go forward. Given this history and the recently added patents, Lam submits that its proposal is consistent with other patent cases in this District and should be adopted.

Three Most Significant Topics Discussed (other than Scheduling Order Disputes)

ESI (Email) Production: The parties generally agreed that email discovery would be necessary. The parties also generally agreed that such discovery would be governed by an Electronically Stored Information ("ESI") protocol to be submitted at a later date, including an identification of a certain number of custodians and an exchange of search terms.

Technical Documents and Agreements: The parties discussed the importance of Lam's core technical documents and sources of information pertaining Lam's customers and other third parties, including collaborators. Inpria identified examples of key documents that it contends must be quickly produced in this case. The parties discussed the importance of Inpria's documents related to conception and reduction to practice and any alleged interactions with and allegations of ownership by The State University of New York and its personnel related to the subject matter of the patents, as that information has a direct bearing on whether Inpria has standing to pursue this case. Lam pointed out that Inpria employees that previously worked at SUNY were named as inventors on asserted patents, that published material from SUNY employees disclosed subject matter in the patents, and asked about Inpria's interactions with SUNY. Inpria's counsel did not say whether there had been any interactions or if SUNY has contested Inpria's inventorship or ownership of the asserted patents. The parties also discussed the importance of Inpria's early production of any agreements, including licenses and covenants not to sue, that restrict Inpria's rights related to any of the asserted patents.

IPR Challenges: The parties discussed Lam's having already filed an IPR petition against one of the three patents asserted in the original Complaint and that Lam may file additional challenges to the recently added patents. Inpria noted that the one-year bar date has passed for two of the patents asserted in the original Complaint with no IPR having been filed.

If Your Honor has any questions concerning the foregoing, counsel remain available at the Court's convenience.

Respectfully,

/s/ Adam W. Poff

Adam W. Poff (No. 3990)

EXHIBIT A

Case Management Checklist

Case Name and Number Inpria Corporation v. Lam Research Corp., 22-1359-CJB

Counsel

Lead Counsel for	<u>Inpria Corporation</u>	<u>Naveen Modi</u>
Delaware Counsel for	<u>Inpria Corporation</u>	<u>Adam Poff</u>
Lead Counsel for	<u>Lam Research Corporation</u>	<u>Michael Lyons</u>
Delaware Counsel for	<u>Lam Research Corporation</u>	<u>John V. Gorman</u>

Meet and Confer

Counsel have met and conferred and have made good faith efforts to discuss, in person and/or by telephone, each of the topics listed in the Checklist below, and will be prepared to address these topics at the Case Management Conference (“CMC”).

Discovery

- What are the core technical documents?
- Does any party intend to request production of electronic mail? If so, why? How many custodians should be searched? What methods will be used to search for electronic documents (e.g., key word searches, predictive coding)?
- How can the Court best assist the parties to provide meaningful interrogatory responses to avoid discovery disputes over the adequacy of such responses?
- If sourcecode is going to be produced, when, where, and how will it be made available?

Claim Construction

- What are the 1 or 2 most important claim terms requiring construction?
- Should the Court consider a “super-early” limited claim construction hearing on those most important terms?
- What is the maximum number of claim terms the parties will ask the Court to construe?
- How can the parties help the Court achieve its goal of ruling on claim construction disputes within 60 days of the claim construction hearing?

Narrowing the Case

- At what point(s) in the case will it be appropriate to limit/reduce the number of accused devices/functionalities, asserted patents, asserted claims, invalidity defenses (including obviousness combinations), and prior art references?
- Are there products that are not colorably different than the currently-accused products that Plaintiff expects or Defendant should expect will be added to the case?
- Should damages or any other portion of the case be bifurcated?

Related Cases

- What related cases are pending, in any Court, and what is their filing date and current status?
- Does Plaintiff plan to file additional related cases and, if so, on what schedule and how should that plan affect how this case will proceed?
- Has any patent-in-suit been litigated before and how soon is Plaintiff willing to produce the results of any such litigation, including settlement agreements?

Remedies

- What initial revenue/sales information does Plaintiff need to assess the value of the case and how soon is Defendant willing to produce such information?
- What type of relief is Plaintiff seeking: lost profits, reasonable royalties, injunction, and/or any other form of relief?
- What does Plaintiff contend is the “smallest saleable unit”?
- Has the patent been licensed or offered for any license and how soon is Plaintiff willing to produce licensing information?

Amendments

- What will be the deadline for proposed amendments to the pleadings, including adding allegations of indirect and/or willful infringement as well as inequitable conduct?
- What will be the deadline for adding or altering the accused devices/functionalities, asserted claims, and prior art?

Supplementation

- Will expert declarations/affidavits be permitted to be filed with case-dispositive and other motions, without other parties’ agreement or leave of the Court?
- What will be the deadline for supplementing infringement, invalidity, damages, and other contentions?

Protective Order

- Are there any reasons this case requires provisions that are not typical of the protective order generally entered in this Court's patent cases?

Motions to Dismiss/Transfer/Stay

- Have any of these motions been filed and/or does any party anticipate filing such a motion?
- Will the parties consent to magistrate judge jurisdiction at least for the limited purpose of resolving these motions?¹
- Should discovery and other exchanges of information (e.g., Default Standards ¶ 4 disclosures) be stayed during pendency of these motions?

Motions for Summary Judgment

- Are there any motions that are potentially fully case dispositive – or that would be dispositive of such a significant portion of the case that its resolution would greatly enhance the likelihood of a cost-effective pre-trial disposition – and that the parties agree the Court should hear early?
- If the Court is to hear any early summary judgment motion, which, if any, other parts of the case should be stayed?
- If the Court is to hear any early summary judgment motion, what is the moving party going to give up (e.g., the opportunity to file a motion on the same subject matter later in the case)?

Other Matters

- Are any post-grant review procedures underway or planned that might affect the manner in which this case should proceed?
- Would the Plaintiff be willing to stipulate to a maximum damages figure in exchange for restrictive discovery and an accelerated trial date?
- How soon can this case be ready for alternative dispute resolution?

Scheduling

- Address each matter listed in the Revised Patent Form Scheduling Order and submit, along with this Checklist, a joint proposed scheduling order, clearly identifying points of disagreement.

¹The identity of any party or parties declining to consent should not be disclosed to the Court at any point, only the fact that there is not unanimous consent.