

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. 11,537,048

PATENT OWNER'S DISCRETIONARY DENIAL BRIEF

TABLE OF CONTENTS

I.	INTRODUCTION	1
II.	BACKGROUND	1
A.	District of Delaware Litigation	1
III.	ARGUMENT.....	3
A.	The <i>Fintiv</i> Factors Favor Discretionary Denial	4
1.	Factor 1 – Whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted.....	4
2.	Factor 2 – Proximity of the court’s trial date to the Board’s projected statutory deadline for a final written decision	6
3.	Factor 3 – Investment in the parallel proceeding by the court and the parties	8
4.	Factor 4 – Overlap between issues raised in the petition and in the parallel proceeding	11
5.	Factor 5 – Whether the petitioner and the defendant in the parallel proceeding are the same party.....	12
6.	Factor 6 – The merits are weak.....	12
IV.	CONCLUSION.....	12

TABLE OF AUTHORITIES

Cases	Page(s)
<i>Apple Inc. v. Fintiv, Inc.</i> , IPR2020-00019, Paper 11 (March 20, 2020)	<i>passim</i>
<i>Apple Inc. v. Fintiv, Inc.</i> , IPR2020-00019, Paper 15 (May 13, 2020).....	6
<i>Cisco Systems Inc v. Estech Systems Inc</i> , IPR2021-00333, Paper 12 (Jul. 7, 2021)	11
<i>Ingenico Inc. v. Ioengine, LLC</i> , No. 2023-1367, 2025 U.S. App. LEXIS 10956 (Fed. Cir. May 7, 2025)	11
<i>Motorola Solutions, Inc. v. Stellar, LLC</i> , IPR2024-01205, -01206, -01207 & -01208, Paper 19 (Mar. 28, 2025)	6, 11
<i>NHK Spring Co., Ltd. v. Intri-Plex Techs., Inc.</i> , IPR2018-00752, Paper 8 (Sept. 12, 2018).....	6
<i>Nokia of Am. Corp. v. Godo Kaisha IP Bridge</i> , IPR2022-00755, Paper 9 (Nov. 2, 2022)	6
<i>Sotera Wireless, Inc. v. Masimo Corporation</i> , IPR2020-01019, Paper 12 (December 1, 2020)	<i>passim</i>
Statutes	
35 U.S.C. § 315(b)	12

LIST OF EXHIBITS

Exhibit No.	Description	Previously Submitted
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)	
2004-2005	<i>Reserved</i>	
2006	Lam's Initial Invalidity Contentions, Ex. 4, <i>Inpria Corp. v. Lam Research Corp.</i> , C.A. No. 22-01359-CJB (D. Del.) (Sept. 24, 2024)	
2007	Lam's Final Invalidity Contentions, Ex. 048-C, <i>Inpria Corp. v. Lam Research Corp.</i> , C.A. No. 22-01359-CJB (D. Del.) (Feb. 20, 2025)	
2008	Lam's Final Invalidity Contentions, Ex. 048-J, <i>Inpria Corp. v. Lam Research Corp.</i> , C.A. No. 22-01359-CJB (D. Del.) (Feb. 20, 2025)	
2009-2012	<i>Reserved</i>	
2013	Email from Stephen Gillen (Dec. 14, 2024, 12:40 AM ET)	
2014	<i>Reserved</i>	
2015	USPS Packing Slip - EJ680364635US and EJ680364621US	
2016	USPS.com® - USPS Tracking® Results - EJ680364621US	
2017	USPS.com® - USPS Tracking® Results - EJ680364635US	
2018	<i>Reserved</i>	
2019	April 15, 2025 letter from Lam Counsel to Inpria counsel, <i>Inpria Corporation v. Lam Research Corp.</i> ,	

	<i>Case No. 22-1359-CJB (D. Del.) and IPR2025-00309, regarding Sotera-type stipulation</i>	
2020	<i>Reserved</i>	
2021	IPR2025-00309 P-TACTS Case Viewer (Eastern Time Zone)	X
2022	IPR2025-00309 P-TACTS Case Viewer (Pacific Time Zone)	X
2023	Date and Time Settings Eastern Time	X
2024	Date and Time Settings Pacific Time	X
2025	Stipulation and [Proposed] Order Entering and Modifying Deadlines, <i>Inpria Corp. v. Lam Rsch. Corp.</i> , C.A. No. 22-1359-CJB, D.I. 40 (D. Del. Dec. 11, 2023)	X
2026	Letter to the Honorable Christopher J. Burke Regarding Proposed Scheduling Order and Checklist, <i>Inpria Corp. v. Lam Rsch. Corp.</i> , C.A. No. 22-1359-CJB, D.I. 45 (D. Del. Dec. 19, 2023)	X
2027	Defendant Lam Research Corp.'s Answer, Defenses, and Counterclaims to Plaintiff Inpria Corporation's Amended Complaint, <i>Inpria Corp. v. Lam Rsch. Corp.</i> , C.A. No. 22-1359-CJB, D.I. 52 (D. Del. Jan. 12, 2024)	X
2028	<i>Reserved</i>	
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)	
2030-2038	<i>Reserved</i>	

I. INTRODUCTION

Lam Research Corp.’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. In particular, 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. 11,537,048 (“the ’048 patent”) will be decided on the same issues at a trial scheduled to occur four months before any Final Written Decision would issue here. This repetition cannot be avoided: the final invalidity contentions in the district court combine system art with the references from Lam’s Petition. Accordingly, the Petition should be denied.

II. BACKGROUND

A. District of Delaware Litigation

The ’048 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 ’048 patent in an Amended Complaint served on December 13,

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.

2023, *id.* at 17 (D.I. 43-44). *See also* 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 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.*

Patent validity issues have been moving forward in district court. For example, on May 14, 2024, Lam served its Initial Invalidity Contentions. *Id.* at 24 (D.I. 117); Ex. 2003 at 14-15 (relying on the same references as in this Petition). On October 18, 2024, the parties filed a Joint Claim Construction Brief. Ex. 2001 at 34 (D.I. 199). And on February 20, 2025, Lam served Final Invalidity Contentions. *Id.* at 45 (D.I. 288). Lam is advancing arguments based not only on the references at issue in this Petition and other patents and printed publications, but also based on the same priority argument, system art (including in combination with art at issue in the IPR), and Section 112.

III. ARGUMENT

There are several reasons to discretionarily deny the Petition. Taking all the issues collectively, this is a compelling case for discretionary denial. This Petition presents references and arguments that are redundant with the validity issues 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. Lam submitted a

*Sotera*² stipulation, but Lam presents system art and other invalidity arguments in the Delaware litigation that are not covered by the stipulation and thus Lam's stipulation does not materially reduce overlap between the proceedings.

A. The *Fintiv*³ 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.⁴ This makes it extremely unlikely the district court would grant a stay due to the IPRs themselves. Lam appeared to

² *Sotera Wireless, Inc. v. Masimo Corporation*, IPR2020-01019, Paper 12 (Dec. 1, 2020) (precedential).

³ *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (March 20, 2020) (precedential).

⁴ 10,732,505; 9,823,564 (IPR2024-00033); 9,310,684; 10,642,153; 11,537,048 (IPR2025-00256 and IPR2024-00309); 11,673,903 (IPR2025-00267); 11,693,312; 11,809,081. Ex. 2001 at 13 (D.I. 3), 17 (D.I. 44).

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 '048 patent). Ex. 2001 at 24 (D.I. 116); Ex. 2002. 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 Spring Co., Ltd. v. Intri-Plex Techs., Inc.*, IPR2018-00752, Paper 8, at 20 (Sept. 12, 2018) (precedential) (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. 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 the 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 Lam could have challenged the ’048 patent earlier, but instead chose to wait and see the district court and the parties make (and continue to make) significant investments in the parallel district court proceeding.⁵

The Delaware litigation started on October 14, 2022. Ex. 2001 at 12 (D.I. 1). Lam was accused of infringing the ’048 patent on December 13, 2023. *Id.* at 17 (D.I. 43). Instead of filing this Petition shortly thereafter, Lam made the parties first make the following significant investments in the Delaware litigation:

- Initial Invalidity Contentions: Lam showed no interest in the efficiencies of resolving patentability before the Board because instead of filing this Petition, Lam served Initial Invalidity Contentions on May 14, 2024. *Id.* at 24 (D.I. 117). Lam could have filed this Petition much

⁵ Factor 3 additionally favors denial when “the evidence shows that the petitioner did not file the petition expeditiously.” *Fintiv*, Paper 11, at 11-12.

earlier because the Initial Invalidity Contentions relied on the references that Lam ultimately used in this Petition. Ex. 2003 at 14-15; Ex. 2006.

- Claim construction: On October 18, 2024, the parties filed a Joint Claim Construction Brief, including on terms appearing in the '048 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 this Petition in addition to other references, as well as the same priority argument, system art (including in combination with art at issue in the IPR), and Section 112. *Id.* at 45 (D.I. 288); Ex. 2007; Ex. 2008.⁶
- Preliminary Injunction: On March 10, 2025, Inpria filed a Motion for Preliminary Injunction, Ex. 2001 at 50 (D.I. 315), and both parties filed

⁶ Inpria can only file public portions of Lam's final invalidity contentions with this paper because Lam designated other portions as Attorney Eyes Only under the district court Protective Order.

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.*⁷

While the parties made significant investments into the Delaware litigation, dealing with some of the very issues Lam argues in the Petition, Lam chose to strategically try to wait until the last second to initiate this IPR. Lam should not be rewarded for delaying its Petition in order to narrow the binding effect of the proceeding and to throw a wrench in the parallel litigation that is gearing up for trial. Accordingly, Factor 3 very strongly weighs in favor of denial.

⁷ 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).

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

Factor 4 strongly favors denial notwithstanding the *Sotera* stipulation submitted by Lam. *See* Ex. 2019. Lam’s *Sotera* stipulation does not prevent Lam from raising the references in this Petition in combination with system art, as it is doing in its invalidity contentions.⁸ By asserting system art in combination with the references in this Petition, both the Board and the district court would analyze the references presented in this Petition. Moreover, as explained in relation to Factors 1 and 2, the district court would do so before the Board’s FWD. *See Motorola*, Paper 19, at 4 (when “invalidity arguments in the district court are more expansive and include combinations of the prior art asserted in these proceedings with unpublished system prior art ... the stipulation does not outweigh the substantial investment in the district court proceeding or *Fintiv* factors 1, 2, and 5”).⁹ The *Sotera* stipulation

⁸ Nor will statutory estoppel apply. *See Ingenico Inc. v. Ioengine, LLC*, No. 2023-1367, 2025 U.S. App. LEXIS 10956, at *19 (Fed. Cir. May 7, 2025).

⁹ Before former Director Vidal’s 2022 memorandum, which is now rescinded, the Board also denied institution when the trial date was scheduled before the FWD despite a *Sotera* stipulation. *See Cisco Systems Inc v. Estech Systems Inc*, IPR2021-00333, Paper 12, at 11-13 (Jul. 7, 2021).

is not meaningful when it cannot prevent Lam from presenting the same references to both the Board and the district court.

For all these reasons, Factor 4 weighs in favor of denial.

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

Lam is both the Petitioner and the defendant in the Delaware litigation. Accordingly, Factor 5 weighs in favor of denial.

6. Factor 6 – The merits are weak

As explained in Inpria's Preliminary Response filed herewith, Lam's merits are weak. Moreover, as also explained in the Preliminary Response, the Petition was served late and is barred under 35 U.S.C. § 315(b). Accordingly, Factor 6 weighs in favor of denial.

IV. CONCLUSION

For these reasons, Inpria respectfully requests that the Board deny the Petition for *inter partes* review of the '048 patent.

Respectfully submitted,

Dated: May 12, 2025

By: /Naveen Modi/
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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, 2,665 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/
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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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