

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 PRELIMINARY RESPONSE

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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

Patent Owner Inpria, Corp. (“PO” or “Inpria”) respectfully submits this Preliminary Response to the Petition for *inter partes* review (Paper 1) (the “Petition” or “Pet.”) filed by Lam Research Corp. (“Petitioner” or “Lam”) against claims 1-20 (“the challenged claims”) of U.S. Patent No. 11,537,048 (“the ’048 patent”). First, the Petition should be discretionarily denied for the reasons argued in Patent Owner’s Brief Supporting Discretionary Denial, filed concurrently with this Preliminary Response. Second, the Petition should be denied under 35 U.S.C. § 315(b) as time barred.

II. BACKGROUND

The ’048 patent issued from U.S. Patent Application No. 16/987,120 (“the ’120 application”) filed on August 6, 2020, and claims priority to:

1. U.S. Patent Application No. 16/238,779 (“the ’779 application”) filed on January 3, 2019,
2. U.S. Patent Application No. 15/291,738 (“the ’738 application”) filed on October 12, 2016,
3. Provisional Patent Application No. 62/297,540 (“the ’540 provisional”) filed on February 19, 2016, and
4. Provisional Patent Application No. 62/240,812 (“the ’812 provisional”) filed on October 13, 2015.

A. District of Delaware Litigation

The '048 patent is currently being litigated in the District of Delaware. *See Inpria Corp. v. Lam Research Corp.*, 1:22-cv-01359 (D. Del.) (“the Delaware litigation”). 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, 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).

Patent validity issues have been moving forward in district court. On May 14, 2024, Lam served its Initial Invalidity Contentions. *Id.* at 8 (D.I. 117); Ex. 2003 at 14-15. On October 18, 2024, the parties filed a Joint Claim Construction Brief, *id.* at 34 (D.I. 199), which Lam cites throughout its Petition and uses to frame its arguments (and those of Patent Owner) on the construction of claim terms and the priority date of the '048 patent. Pet. at 5-10 (citing Ex. 1010).

On February 20, 2025, Lam served Final Invalidity Contentions. Ex. 2001 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 system

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.

art (including in combination with art at issue in the IPR) and based on Section 112 in a manner that parallels Lam’s priority argument for the ’048 patent here.

B. The ’048 Patent Prosecution

Inpria’s ’048 patent underwent a thorough review during prosecution. There were three non-final office actions and two final office actions. Ex. 1002 at 70-85, 144-158, 206-222, 282-293, 478-490.

III. LEVEL OF ORDINARY SKILL

For purposes of this Preliminary Response, Inpria adopts Lam’s definition of a person of ordinary skill in the art (“POSITA”). Inpria reserves the right to propose an alternative definition of a POSITA should the Board grant institution.

IV. CLAIM CONSTRUCTION

Lam raises five claim constructions based on means plus function. *See* Pet. at 4-9; Ex. 1010. But Lam’s own arguments indicate determining whether the claims recite means-plus-function terms is unnecessary to resolve the dispute. Pet. at 4 (arguing “Even if Inpria argues these terms fall outside §112(6),^[2] the prior art still teaches the claimed limitations.”). Thus, the Board need not make a means-plus-

² Lam throughout its Petition refers to 35 U.S.C. § 112(6). Patent Owner clarifies that the applicable statute under the Leahy-Smith America Invents Act is 35 U.S.C. § 112(f).

function determination. *See Toyota Motor Corp. v. Cellport Sys., Inc.*, IPR2015-00633, Paper 11, at 16 (Aug. 14, 2015) (citing *Vivid Techs., Inc. v. Am. Sci. & Eng'g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999)). Under any reasonable construction of the claim terms, Lam has failed to demonstrate that the prior art discloses or suggests the challenged claims.

In any case, Lam fails to overcome the presumption against 35 U.S.C. § 112(f). Lam argues that “[t]he terms ‘structure’ and ‘configuration’ act as generic placeholders for unspecified functions, similar to ‘means,’” but relies solely on conclusory statements from its expert. Pet. at 5 (citing Ex. 1003 at ¶ 25). Lam ignores that the claims provide sufficient structure by reciting, *inter alia*, inputs, outputs, and connections. *See Inventio AG v. Thyssenkrupp Elevator Ams. Corp.*, 649 F.3d 1350, 1358-59 (Fed. Cir. 2011) (holding that “modernizing device” was not a means-plus-function limitation because the claims “delineate the components that the modernizing device is connected to, describe how the modernizing device interacts with those components, and describe the processing that the modernizing device performs”). Claim 1 of the ’048 patent recites, for instance, (i) the structure’s connections, which are the “structure configured to deliver flow from a supply of an inert gas” and the “inlet” of the “deposition chamber,” (ii) the structure’s input, which is an “organotin compound” and “an inert gas” as a “carrier gas,” and (iii) the structure’s output, which is the “organotin compound with the inert gas as a carrier

gas” delivered through the “inlet,” such that the structure can “deliver flow of a first precursor vapor from the supply of the organotin compound with inert gas as a carrier gas” to “provide for formation of an organotin layer on the substrate surface with the deposition chamber.” Ex. 1001 at 34:49-35:30.

V. ARGUMENT

A. 35 U.S.C. § 315(b) – Lam’s Petition is Time Barred

Lam’s Petition should be denied as time barred. Inpria first asserted the ’048 patent in an Amended Complaint served on December 13, 2023. Ex. 2001 at 17 (D.I. 43-44); *see also* Ex. 2029. Lam failed to file within one year of being served the Amended Complaint alleging infringement of the ’048 patent—*i.e.*, by December 13, 2024—as required by 35 U.S.C. § 315(b). Lam’s attempts to excuse this delay are meritless.

Lam’s unsubstantiated statements (*see, e.g.*, Ex. 1023 at ¶ 4) fail to demonstrate that the Petition and supporting exhibits were filed on December 13, 2024, and are directly contrary to the PTACTs website, which states that all documents were filed on December 14, 2024. As such, Lam has failed to meet its burden of establishing that the Petition and supporting evidence were filed as of the critical date. *See Teva Pharms. USA, Inc. v. MonoSol RX, LLC*, IPR2016-00281, Paper 21 (May 23, 2016), at 9-13; *Terremark N. Am. LLC v. Joao Control Monitoring Sys.*, IPR2015-01482, Paper 10 (Dec. 28, 2015), at 7-8. Because filing

within one year is required by statute and, therefore, cannot be waived, Lam’s failure to file its petition on December 13, 2024 is alone sufficient to end the inquiry. *Cultec, Inc. v. StormTech LLC*, IPR2017-00526, Paper 14 (July 17, 2017), at 8, 10. Lam also failed to timely pay its fees and serve Inpria as part of its statutory obligations.

Any excuse raised by Lam to avoid its failure to comply with statutory obligations is meritless. Lam has failed to establish any legitimate basis for changing the accorded filing date of December 14, 2024, instead offering insufficient excuses for its unsuccessful attempt to file two petitions on the same patent at the very last moment. As the Board has previously cautioned, “[w]aiting until the last minute—without explanation—is ill advised and had Petitioner not done so, any alleged delays caused by ‘technical issues’ would have been moot.” *Teva*, Paper 21, at 10 (May 23, 2016). Lam’s request to change its filing date should therefore be denied, and Lam’s alternative assertion that its Petition was timely is contradicted by the district court record and without merit.

First, while Lam asserts that it submitted the Petition on December 13, 2024, all of the evidence suggests that assertion is incorrect. Paper 10, Motion to Correct Filing Date or, Alternatively, Deem Petition Timely (“Mot.”), 1-2. Lam bases its assertion on testimony regarding the P-TACTS “Case Viewer” showing a “December 13, 2024” date. Ex. 1023 at ¶ 4 (citing *id.* at 5). The referenced Case

Viewer, however, appears to have been generated using a computer set to the “Pacific Time” zone. *Compare* Ex. 1023 at Ex. A, *with* Ex. 2022 at 1 (created with “Pacific Time”), *and* Ex. 2024. When set to the “Eastern Time” zone, “Case Viewer” shows a filing date of “December 14, 2024.” Ex. 2021 (created with “Eastern Time”); Ex. 2023. *Compare* Ex. 2021 (created with “Eastern Time”), *and* Ex. 2023, *with* Ex. 2022 (created with “Pacific Time”), *and* Ex. 2024. Because P-TACTS filings are governed by Eastern Time, *see* 37 C.F.R. § 1.6(a)(4), this discrepancy confirms that Lam’s Petition was untimely. This alone warrants denying Lam’s Petition as time barred.

Second, Lam *admits* that its Petition and exhibits were not filed “accompanied by payment of the fee” pursuant to 35 U.S.C. § 312(a)(1) until December 14, 2024. *See* Mot. at 3; Ex. 1023 at ¶ 5. Lam only offers uncorroborated testimony that the “Submit Payment” button was pressed on December 13, 2024. Ex. 1023 at ¶ 5. But even if this testimony were true—which appears incorrect for the reasons discussed above—the Board’s “rules follow the statutory requirement ... that a payment must be received, not merely tendered, in order to be considered as ‘accompanying’ the petition.” *Cultec*, Paper 14, at 7. Because payment of fees is required by statute and cannot be waived, Lam’s admission that it failed to pay the required fees by December 13, 2024 justifies denying Lam’s Petition.

Lam’s uncorroborated reference to “potentially ... slow processing from high system traffic,” *see* Mot. at 1; Ex. 1023 at ¶ 7, does not excuse its failure to timely file, serve, and pay the required fee. *See Teva*, Paper 21, at 9-13; *Terremark*, Paper 10, at 7-8. Tellingly, Lam does not indicate *when* the “Submit Payment” button was pressed or provide any time-stamped corroborating evidence, only alleging it was “pressed on December 13.” *See* Mot. at 1; Ex. 1023 at ¶ 5.

Third, Lam failed to serve the Petition and supporting evidence until after December 13, 2024, notwithstanding its certificate of service, which incorrectly states that service was effected on time. *See* Pet. at Certificate of Service; Ex. 1024 at ¶¶ 5-7; *see also* 35 U.S.C. § 312(a)(5). However, a petition “will not be accorded a filing date until” the petitioner “[e]ffects service of the petition on the correspondence address of record as provided in § 42.105(a).” 37 C.F.R. § 42.106(a)(2); *see also* 37 C.F.R. § 42.105(a). The evidence indicates that service on the correspondence address of record was effective when received by USPS on December 14, 2024 at 10:52 p.m. *See* Ex. 1024 at Ex. B; Ex. 2017; *see also* Ex. 1024 at ¶ 6 (confirming electronic service on December 14, 2024); Ex. 2013. Because all of Lam’s evidence indicates that the Petition and supporting exhibits were served on December 14, 2024, Lam’s Petition is time barred and should be denied.

For electronic service, the Gillen Declaration and Inpria’s exhibits confirm that electronic service was not effected until 12:40 AM ET on December 14, 2024. Mr. Gillen testified that he “served via email a courtesy copy [wherein] [t]he service email was transmitted on December 14, 2024 at 12:40 am ET.” Ex. 1024 at ¶¶ 6-7 (identifying Exhibit C as the service email). As such, electronic service for this proceeding was effected early in the morning of December 14, 2024.

For physical service, the Gillen Declaration includes a photograph that Mr. Gillen testifies “shows a time of 10:00 pm PT / 1:00 am ET” for a package stated to have tracking number “EJ680364635US” underneath the barcode. Ex. 1024 at ¶ 4, Ex. A. But the tracking number under the barcode in this photograph is actually “EJ680364621US,” which reflects the tracking number for service of IPR2025-00256. Ex. 1024 at ¶ 4, Ex. A; Ex. 2015 (packing slip with tracking numbers EJ680364635US and EJ680364621US). But despite taking a picture of the service package at “10:00 pm PT / 1:00 am ET,” and confirming that electronic service was only sent on December 14, 2024, the Gillen Declaration curiously omits any mention of when the package was actually provided to USPS. Tracking details for both packages confirms, however, that the packages were not received by USPS until late at night on December 14, 2024, at 10:52pm. *Compare* Ex. 2016 (USPS.com document showing that the box with tracking number EJ680364621US was received by USPS on December 14, 2024 at 10:52 p.m. PT), *with* Ex. 1024 at ¶ 5, Ex. B

(USPS.com document showing the box with tracking number EJ680364635US was also received by USPS on December 14, 2024 at 10:52 p.m. PT); *see also* Ex. 2017. Thus, the great weight of evidence indicates that Lam did not provide the package to USPS for service until December 14, 2024.

Lam's reliance on *2Wire*, *ABB*, *Apple*, and *Conmed*, *see* Mot. at 3-4, is misplaced because "none of them addressed the combination of a failure to file, serve, and pay the required fee as set out in our Rules and governing statute." *Terremark*, Paper 10, at 10-13; *see also* *Teva*, Paper 21, at 12-13. *Terremark* and *Teva* are more apt because those involved one-day-late (and in *Teva*, minutes-late) filing, service, and payment. *See* *Teva*, Paper 21, at 4-6, 9-13; *Terremark*, Paper 10, at 5, 7-13; *see also* *Cultec*, Paper 14, at 7-8.

Even assuming the statutory and regulatory requirements can be waived, which Patent Owner does not concede, Lam's failure to timely file, serve, and pay the required fee should not be excused. Lam has failed to show good cause or that doing so would be in the interests of justice. *See* 37 C.F.R. § 42.5(c)(3). Since December 13, 2023, when the '048 patent was first asserted, Lam has been actively litigating the '048 patent in district court, including serving invalidity contentions, setting forth non-infringement contentions, and submitting claim construction briefs. And despite being represented by at least two large law firms in the district court litigation, Lam chose to wait until the final possible moment to attempt filing its

Petition—then blamed its untimeliness on “potentially . . . slow processing from high system traffic.” Mot. at 1. Such speculation and self-inflicted delay does not constitute good cause for waiving any statutory or regulatory requirements.

Lam also theorizes that Inpria’s Amended Complaint, served in the afternoon on December 13, 2023, should not trigger the one-year IPR bar until December 14, 2023. This assertion, however, is contradicted by Lam’s own conduct. Lam implicitly conceded December 13, 2024 was the correct bar date in attempting (and failing) to file on that day. Moreover, Lam has repeatedly acknowledged that the Amended Complaint was served on December 13, 2023. For instance, in the district court, the parties agreed that “Inpria will file the Amended Complaint on or before December 13, 2023.” Ex. 2025 at 1. Lam never once argued that Inpria failed to meet this agreed-upon deadline. In a joint letter filed on December 19, 2023, both parties confirmed that “[o]n December 13, 2023, Inpria filed an amended complaint.” Ex. 2026 at 2. Lam then filed an Answer to Inpria’s “Amended Complaint filed December 13, 2023” without including any objections to Inpria’s filing timing or service. Ex. 2027 at 1.

Further, Lam fails to establish that the District of Delaware’s local rule governing electronic service applies to Inpria’s Amended Complaint. Lam fails to explain why the Amended Complaint should not be considered an “initial pleading” exempt from the rule—particularly given that this was the first time Inpria asserted

the '048 patent against Lam, thereby triggering the one-year time bar. *See* D. Del. Admin. Proc. Elec. Filing & Service (Rev. Aug. 2022) at (F) (listing “motions, briefs, appendices, and discovery responses” as exemplary filings subject to the rule). The only rationale Lam provides is a conclusory opinion buried in a declaration. Ex. 1022 at ¶ 12. This unsupported opinion does nothing to justify what remains an inexcusable delay without good cause that Lam implicitly acknowledges.

Lam’s Petition should be denied as time barred because all of Lam’s evidence indicates that Lam’s Petition and supporting exhibits were not filed and served within one year of being served the Amended Complaint alleging infringement of the '048 patent—*i.e.*, by December 13, 2024—as required under 35 U.S.C. § 315(b).

VI. CONCLUSION

For these reasons, Inpria respectfully requests that the Board deny the Petition for *inter partes* review of the '903 patent.³

³ If trial is instituted, Inpria reserves the right to raise additional arguments as to why Lam has failed to carry its burden and why the challenged claims should be confirmed.

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 Preliminary Response contains, as measured by the word-processing system used to prepare this paper, 2,769 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/
Naveen Modi (Registration No. 46,224)
Counsel for Patent Owner

CERTIFICATE OF SERVICE

I hereby certify that on May 12, 2025, I caused a true and correct copy of the foregoing Patent Owner's Preliminary Response to be served via email on Petitioner at the following addresses:

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