

**IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE**

INPRIA CORP.,

Plaintiff,

v.

LAM RESEARCH CORP.,

Defendant.

C.A. No. 22-cv-1359-CJB

**BRIEF OF THE RESEARCH FOUNDATION FOR THE STATE UNIVERSITY OF NEW
YORK AS *AMICUS CURIAE* IN SUPPORT OF RULE 19(b) DISMISSAL OR STAY**

Dated: April 9, 2025

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INTEREST OF AMICUS CURIAE

Amicus curiae is The Research Foundation for The State University of New York (“SUNY RF” or “the RF”). SUNY RF is a non-profit education corporation tax-exempt under Section 501(c)(3), organized under the laws of New York, and based in Albany, New York. It is an owner of the patents asserted in this action, its researchers invented those patents, and its contracts with Plaintiff Inpria Corporation (“Inpria”) are the subject of the existing parties’ claims, counterclaims, and defenses. By law, is the policy of SUNY RF “to encourage such innovation and to take appropriate steps to aid creators and ensure that the public receives the benefit of such innovation in accordance with its public service mission. Appropriate steps include securing research support, identifying and encouraging disclosure of intellectual property, securing appropriate protections, marketing intellectual property through licensing and other arrangements, and managing royalties and other related income, such as litigation proceeds. These activities are undertaken in a spirit of cooperation with governmental agencies and private industry as part of SUNY’s contribution to the economic well-being of the State of New York and of the nation.” 8 CRR-NY 335.28.¹

SUMMARY OF ARGUMENT

The dispute between Plaintiff Inpria and Defendant Lam Research Corporation (“Lam”) over the timing, process, and necessity to obtain discovery from nonparty SUNY RF proves an uncomfortable but necessary truth. This Court must *dismiss* this action without prejudice — unless the Court exercises its discretion to stay it pending resolution of *Rsch. Found. for State Univ. of New York v. Inpria Corp.*, Case No. 1:24-CV-120 (BKS/ML) (N.D.N.Y) (the “Albany Action”).

Federal Rule of Civil Procedure 19(b) provides for the dismissal of an action when an

¹ Amicus certifies no counsel for a party to this case authored this brief in whole or in part; no party or counsel for a party contributed monetarily to the preparation or submission of this brief; and no person other than counsel for amicus curiae contributed money intended to fund preparing or submitting this brief. Amicus has concurrently filed a motion seeking leave to file this brief.

absent party is required to be joined to the action but cannot be joined. Rule 19(b) applies here because SUNY RF is an indispensable party to this action but cannot be joined due to its substantive patent, jurisdictional, and venue rights. Put simply, because this action cannot, “in equity and good conscience,” proceed without SUNY RF, it “should be dismissed.” Fed. R. Civ. P. 19(b); *Tullett Prebon PLC v. BGC Partners, Inc.*, 427 F. App’x 236, 240 (3d Cir. 2011) (“If [the absent party] is then held to be indispensable under Rule 19(b), ‘the action cannot go forward.’”).

It is neither consequential nor surprising that the parties have not moved for such relief. A Rule 19(b) dismissal is warranted *precisely because Inpria and Lam are not protecting the RF’s interests*. For its part, Inpria did not seek the consent of its co-owner SUNY RF to bring this action, and it is now using the action to deny and undermine the RF’s ownership, inventorship, and contractual rights. Lam, on the other hand, refuses to take a license to the asserted patents from the RF — even though it recognizes the RF’s ownership and inventorship rights — and instead seeks to deny the value of this important intellectual property and to prove the asserted patents are not valid or enforceable and that Lam is indemnified against suit. Unable to join SUNY RF as a party, but each needing the RF, Lam and Inpria now seek an end-round of the RF’s rights under Rule 45.

The Supreme Court has stressed that a court “should, on its own initiative, take steps to protect the absent party,” *Provident Tradesmens Bank & Tr. Co. v. Patterson*, 390 U.S. 102, 111 (1968), and “consider *sua sponte* the absence of a required person and dismiss for failure to join.” *Republic of Philippines v. Pimentel*, 553 U.S. 851, 861 (2008). Indeed, “the issue is sufficiently important that it can be raised at any stage of the proceedings.” *McCowen v. Jamieson*, 724 F.2d 1421, 1424 (9th Cir. 1984); *accord* Fed. R. Civ. P. 12(h) (failure to join may be raised “at trial”).

It does not matter that SUNY RF’s ownership and inventorship claims have not yet been finally adjudicated in the RF’s favor. Instead, as the Supreme Court has held — when reversing,

remanding, and ordering another case dismissed — if the absent party’s claims are “nonfrivolous,” Rule 19 is implicated and “[t]he action may not proceed.” *Pimentel*, 553 U.S. at 867. SUNY RF’s claims sail far above the “nonfrivolous” test. They are well-supported by detailed allegations, contemporaneous documents, and a 210-page expert report. In fact, another federal court has *already found* SUNY RF’s ownership claims “plausible” — that is, *far from* frivolous — over Inpria’s motion for judgment on the pleadings in the Albany Action. *See* Ex. 1 (*Rsch. Found. for State Univ. of New York*, 2025 WL 472680, at *25, *18-22, *14, & *24 (N.D.N.Y. Feb. 12, 2025)). And Inpria itself *withdrew* its Rule 12(c) motion directed at the RF’s correction of inventorship claims, after the RF amended its complaint in the Albany Action to add additional factual content.

Nor does it matter that this is the first-filed action concerning the ownership and inventorship of the asserted patents. Just the opposite, an already-underway predicate action in an alternative forum *favors* dismissal under Rule 19(b)(4), it does not cut against it. *Tullett*, 427 F. App’x at 240. And the “absence of jurisdiction over all necessary parties” is a clear exception to the first-filed rule. *Micron Tech., Inc. v. Mosaid Techs., Inc.*, 518 F.3d 897, 904-05 (Fed. Cir. 2008).

In sum, whether this Court should extend the case schedule to permit Lam additional time to seek nonparty discovery from SUNY RF asks the wrong question.² The question required is whether, under Rule 19(b), this action can proceed among Inpria and Lam without SUNY RF. Because the answer is “no,” the Court must dismiss this action unless the Court decides to stay it pending resolution of the ownership and inventorship disputes in the Albany Action.

BACKGROUND

Without notice to or consent of SUNY RF, Inpria filed this action on October 14, 2022,

² This Court does not have jurisdiction over the subpoenaed parties, as it is not the court of compliance for those subpoenas. *See* Fed. R. Civ. P. 45(d). In fact, as explained below, this Court does not even have jurisdiction to resolve these ownership, inventorship, and contractual disputes.

alleging that Lam was infringing the '505, '564, and '684 patents. *See* D.I. 1.

On November 6, 2023, SUNY RF sent a letter to Inpria giving notice “of potential legal action re tin-oxide photoresists and intellectual property.” *See* Ex. 2 (Albany Action, D.I. 24-69). The letter explained that SUNY RF was an owner and inventor of at least the '505, '564, '684, '719, '986, '559, '874, '179, '554, '618, '696, '048, '564, and '924 patents. *Id.* It stated that the RF’s investigation was ongoing, but all this technology was invented at SUNY by Dr. Robert Brainard and his team of researchers, whom Inpria had sought out and elicited for their expertise and research in the field of Molecular Organometallic Resists for EUV (“MORE”). *Id.* The RF requested a pre-suit resolution but noted that any suit would need to be resolved in Albany. *Id.*

On December 12, 2023, without notice to or consent of SUNY RF, Inpria amended its complaint in this action to allege that Lam also infringes the '048 patent that was the subject of the RF’s notice letter to Inpria, as well as the '153, '312, and '081 patents. *See* D.I. 43.

On January 25, 2024, SUNY RF filed suit against Inpria and its parent JSR Corporation in NDNY. *See* Albany Action, D.I. 1. Among other breach of contract and common law counts, the suit alleges that SUNY RF is the owner or co-owner of 25 U.S. patents (and their foreign counterparts) purportedly assigned to Inpria — including all 8 of the patents asserted in this action. SUNY RF also alleges that the inventorship of these 25 patents must be corrected to name Dr. Brainard and various members of his team — including then-SUNY researcher and now-Inpria scientist Brian Cardineau — with whom Inpria had collaborated for years under NDA and two separate Research Agreements. *See* Ex. 3 (Albany Action, D.I. 86 (Amended Complaint)).

On August 22, 2024, Lam served a nonparty documents subpoena in this action on SUNY RF. In response, the RF produced more than 4,100 documents, totaling more than 32,000 pages, from non-custodial and custodial sources alike. Lam never requested any RF-related depositions.

On February 12, 2025, Chief Judge Sannes (NDNY) denied “in its entirety” Inpria’s Rule 12(c) motion for judgment on the pleadings against the RF’s claims. Ex. 1 (Albany Action, D.I. 113). As especially relevant here, the Order held SUNY RF “plausibly alleges patent ownership claims stemming from a contractual agreement, and not solely due to inventorship,” and that Inpria unlawfully converted the patents, breached its contracts with the RF by failing to perfect and protect the RF’s ownership rights, and has “wrongly benefited from its public misrepresentation that Defendants are the sole owners of the Challenged Patents.” *Id.* (*Rsch. Found. for State Univ. of New York*, 2025 WL 472680, at *25, *18-22, *14, & *24 (N.D.N.Y. Feb. 12, 2025)).

On February 25, 2025, Lam first gave SUNY RF notice that it was “preparing a subpoena to SUNY RF for a deposition.” Two days later, Lam stated that it was also considering deposition subpoenas to multiple of the RF’s current and former researchers, including Dr. Brainard, Dan Freedman, Miles Marnell, James Passarelli, Michael Murphy, Ryan Del Re, and Miriam Sortland. Counsel for the RF accepted service of the Brainard and RF subpoenas on March 11, 2025.

On March 17, 2025, SUNY RF sent Lam a letter requesting to meet and confer regarding the deposition subpoenas, and explaining the reasons why those subpoenas must be quashed under Rule 45 absent a global agreement between Lam, Inpria, and the RF. *See* Ex. 4 (D.I. 358-1). The letter explained that, among other defects, the subpoenas did not allow reasonable time to comply; improperly sought testimony outside of the venue that has exclusive jurisdiction over the relevant contracts, claims, and evidence; and imposed undue burden on multiple nonparties. *Id.* at 3-6. The RF nonetheless offered to meet and confer with Lam and Inpria to negotiate a coordinated discovery process, schedule, and framework that was fair and efficient, respected the rights and interests of all parties, and provided for prompt and accurate resolution of both Actions. *Id.*

Lam responded by letter on March 21, 2025, stating that it intended to serve deposition

subpoenas on four additional RF witnesses (including Greg Denbeaux), and that, although it disagreed with the RF's positions, Lam was willing to coordinate discovery between both Actions.

Lam then issued new subpoenas to Dr. Brainard, Daniel Freedman, and Ryan Del Re — maintaining its request for deposition testimony but now adding requests for production. Each subpoena contains the same 12 documents requests, including but not limited: to all documents and communications relating to MORE; relating to Inpria, its relationship and visits with the RF, its researchers, and SEMATECH; relating to Inpria's funding of research at SUNY RF, intellectual property, and reports shared by the RF to Inpria from 2011 through 2019; and relating to the asserted patents, this action, and the Albany Action. *See, e.g.*, Ex. 5 (Brainard subpoena).

On March 26, 2025, the RF learned for the first time that *Inpria* intended to participate in the requested RF-related depositions in this action, even though Inpria is simultaneously *opposing all discovery* in the Albany Action. *See* D.I. 358-1 at 3. The RF only learned of Inpria's intentions when Lam's Emergency Letter to the Court, requesting extension of the discovery deadline to October 31, 2025, was unsealed. *Id.* When Inpria's Response to Lam's Letter was unsealed on April 3, the RF learned that Inpria also opposed any extension of the case schedule. *See* D.I. 412.

In the interim, this Court ordered Lam and Inpria to further meet and confer to reach agreement on a revised schedule that would reasonably allow obtaining the remaining RF-related discovery and still permit the case to be tried in or reasonably close to December 2025. *See* D.I. 383. The Court set an April 11, 2025, deadline for the parties to update the Court on any agreement.

The RF attended a meet and confer between Lam and Inpria regarding their case schedule on April 1, 2025, for the ostensible purpose of coordinating any further RF-related discovery between the Delaware and Albany Actions. Lam and Inpria were unable to come to an agreement on that call. Lam would not stipulate to Inpria's request for a preliminary injunction, and Inpria

would not agree to extend the case schedule in the Delaware Action more than three weeks, much less make any reciprocal disclosures to the RF prior to the SUNY-related depositions. The RF explained that its position was as stated in its prior letters, that it had not been provided the sealed briefing on this dispute (or any of the many others that invoked its interests), and that it remained willing to agree to a fair and efficient process for coordinating discovery between the two Actions.

Following this meet and confer, Inpria and Lam filed multiple sealed letters to the Court regarding their requests for SUNY-related discovery. *See* D.I. 413, 417, 419. Neither the RF nor its counsel is privy to these materials. In the dark — and prejudiced by the existing parties’ refusal to protect the RF’s rights, or to agree to any reasonable accommodations under which the RF could consider relaxing those rights — SUNY RF has no choice but to stand on, protect, and enforce its substantive and procedural rights and interests, including by filing this amicus curiae brief.

LEGAL STANDARD

As relevant here, Federal Rule of Civil Procedure 19 provides:

(a) Persons Required to Be Joined if Feasible.

(1) *Required Party.* A person who is subject to service of process and whose joinder will not deprive the court of subject-matter jurisdiction must be joined as a party if:

(A) in that person’s absence, the court cannot accord complete relief among existing parties; or

(B) that person claims an interest relating to the subject of the action and is so situated that disposing of the action in the person’s absence may:

(i) as a practical matter impair or impede the person’s ability to protect the interest; or

(ii) leave an existing party subject to a substantial risk of incurring double, multiple, or otherwise inconsistent obligations because of the interest.

...

(b) When Joinder Is Not Feasible. If a person who is required to be joined if

feasible cannot be joined, the court must determine whether, in equity and good conscience, the action should proceed among the existing parties or should be dismissed. The factors for the court to consider include:

- (1) the extent to which a judgment rendered in the person's absence might prejudice that person or the existing parties;
- (2) the extent to which any prejudice could be lessened or avoided by:
 - (A) protective provisions in the judgment;
 - (B) shaping the relief; or
 - (C) other measures;
- (3) whether a judgment rendered in the person's absence would be adequate; and
- (4) whether the plaintiff would have an adequate remedy if the action were dismissed for nonjoinder.

Under Rule 19, “the court first must determine whether the absent party is ‘necessary’ under Rule 19(a),” and “if the party is ‘necessary’ and joinder is not feasible, then the court must decide whether the party is ‘indispensable’ under Rule 19(b).” *Tullett*, 427 F. App'x at 239. If the absent party is “held to be indispensable under Rule 19(b), ‘the action cannot go forward.’” *Id.*

“Whether a party is indispensable under Rule 19(b) is a matter of regional circuit law,” *Dainippon Screen Mfg. Co. v. CFMT, Inc.*, 142 F.3d 1266, 1269 (Fed. Cir. 1998) — here the Third Circuit — unless the indispensability and inability to join is a matter of substantive patent law, in which case Federal Circuit law applies. *STC.UNM*, 767 F.3d at 1353. Both are implicated here.

Rule 41(b) provides that dismissal for failure to join a party under Rule 19 should be without prejudice. *Univ. of Pittsburgh v. Varian Med. Sys.*, 569 F.3d 1328, 1332 (Fed. Cir. 2009).

ARGUMENT

I. This Case Must Be Dismissed Without Prejudice Pursuant to Federal Rule 19(b).

A. SUNY RF is a required party to this action.

SUNY RF plainly is a “required party” to this action for at least three independent reasons.

First, under Rule 19(a)(1)(A), SUNY RF is a required party because the Court cannot accord complete relief as to Inpria’s claims without the RF, which is an owner of the asserted patents. It is black-letter patent law that “[a]n action for infringement must join as plaintiffs all co-owners.” *Ethicon, Inc. v. U.S. Surgical Corp.*, 135 F.3d 1456, 1467 (Fed. Cir. 1998); *STC.UNM v. Intel Corp.*, 767 F.3d 1351, 1353 (Fed. Cir. 2014) (“This court has consistently recognized that the substantive right to enforce the patent does not belong unilaterally to each co-owner, but requires all of the co-owners’ agreement.” (Dyk, J., concurring in the denial of rehearing en banc)).³

SUNY RF is *at least* a co-owner of the asserted patents by virtue of both contract and inventorship. Indeed, as explained, the court in the Albany Action has already determined in a 62-page order that SUNY RF “plausibly alleges patent ownership claims stemming from a contractual agreement, and not solely due to inventorship.” *See* Ex. 1 (*Rsch. Found. for State Univ. of New York*, 2025 WL 472680, at *25, *18-22, *14, & *24. Moreover, Inpria did not even *move* to dismiss, and *withdrew* its motion for judgment on the pleadings as to, the RF’s inventorship claims in the Albany Action, which separately bestow ownership rights on the RF and are supported by a 210-page expert report from Dr. Uzodinma Okoroanyanwu. *See* Ex. 6 (Albany Action, D.I. 63-26).

Second, under Rule 19(a)(1)(B)(i), SUNY RF also is a required party because disposing of this action in the RF’s absence may impair or impede the RF’s ability to protect its interests.

To allow this action to proceed without SUNY RF would impair and impede the RF’s rights *not* to participate in this action, to prevent it from continuing without the RF, and to license Lam

³ Although older caselaw often discusses the requirement to join all owners to an infringement suit in terms of “standing,” the Federal Circuit has more recently held, “it is improper to discuss requirements for establishing a statutory cause of action in terms of ‘standing.’” *AntennaSys, Inc. v. AQYR Techs., Inc.*, 976 F.3d 1374, 1378 (Fed. Cir. 2020) (“AntennaSys’s failure to join Windmill as a co-plaintiff impacts AntennaSys’s ability to satisfy the statutory prerequisites for bringing an infringement suit; it does not impact AntennaSys’s Article III standing.”). To maintain consistency with caselaw, this brief sometimes refers to Inpria’s “standing” to mean this statutory prerequisite.

without this action. *See STC.UNM*, 767 F.3d at 1355 (Fed. Cir. 2014) (“[O]rdinarily, one co-owner has the right to impede the other co-owner’s ability to sue infringers by refusing to voluntarily join in such a suit”). Moreover, resolving Lam’s defenses without SUNY RF also would impair the RF’s ability to protect its interests. Lam has not only infused the RF’s ownership and inventorship into this case, but it also is claiming the asserted patents are not valid, enforceable, or valuable; that Lam does not need a license; and that Lam is a SUNY RF indemnitee under the Inpria-RF contracts. *See* D.I. 176 (Lam Answer). Put simply, whether the asserted patents are infringed, valid, enforceable, licensable, and owned and invented by SUNY RF, “has significant implications” for the patents, the RF, its inventors, and the Albany Action. *Tullet*, 427 F. App’x at 239-240.

Further, the parties’ claims and defenses also implicate SUNY RF’s 2013, 2015, and 2017 contracts with Inpria. Absent “contracting parties . . . have been described as ‘the paradigm of an indispensable party.’” *Epsilon Energy USA, Inc. v. Chesapeake Appalachia, LLC*, 80 F.4th 223, at 233 & n.15 (3d Cir. 2023).⁴ Moreover, “[a] loss here, in its absence, could put pressure on the [RF] in the short term to abandon or capitulate to [Inpria or Lam].” *Lee v. Anthony Lawrence Collection, L.L.C.*, 47 F.4th 262, 267 (5th Cir. 2022) (“Because ownership of the mark is what this case is ultimately about, Rule 19’s interest in protecting interested parties and avoiding waste of judicial resources would counsel in favor of the University’s inclusion.”).

Third, under Rule 19(a)(1)(B)(ii), SUNY RF also is a required party because disposing of this action in the RF’s absence will leave Inpria and Lam subject to a substantial risk of incurring

⁴ *Tullet*, 427 F. App’x at 239-240 (holding alleged owners of IP “have a clear interest,” including because claims and defenses required court “to determine the wrongfulness of [party’s] conduct as to the absent subsidiaries” and “to make rulings on legal and factual matters that are at the core of the [absent parties’] pending arbitration”); *Jonesfilm v. Lion Gate Int’l*, 299 F.3d 134, 141 (2d Cir. 2002) (“If the resolution of a plaintiff’s claim would require the definition of a non-party’s rights under a contract, it is likely that the non-party is necessary under Rule 19(a).”).

double, multiple, or otherwise inconsistent obligations because of SUNY RF's interests.

As to Inpria, for example, this Court may order that Inpria is *not* permitted to initiate infringement suits concerning the asserted patents without SUNY RF's consent and joinder, whereas the court in the Albany Action may order that Inpria *is* permitted to initiate such suits without SUNY RF's consent and joinder. Because Inpria could not "comply with one court's order without breaching another court's order," this presents a classic case of "inconsistent obligations" under Rule 19(a). *Delgado v. Plaza Las Americas, Inc.*, 139 F.3d 1, 3 (1st Cir. 1998). Nor would anything prevent SUNY RF from relitigating these issues in Albany. *N. Arapaho Tribe*, 697 F.3d at 1279 (Rule 19(a)(1)(B)(ii) implicated because absent party could "relitigate[e]" the issue).

As to Lam, for example, if this action were to proceed without SUNY RF, Lam would face a substantial risk of paying double damages for the same infringement, or having to decide whether to comply with an infringement injunction from this Court or, instead, to follow a declaration in the Albany Action that the RF is the sole owner and true inventor of the asserted patents. *See STC.UNM v. Intel Corp.*, 754 F.3d 940, 946 (Fed. Cir. 2014) ("[T]he rule requiring in general the participation of all coowners safeguards against the possibility that each coowner would subject an accused infringer to a different infringement suit on the same patent").

Finally, it does not matter that SUNY RF's ownership and inventorship claims and interests have not yet been finally adjudicated in the RF's favor. *See Pimentel*, 553 U.S. at 864. Nor may the court "in effect decide[] the merits of [the RF's] claims to the [asserted patent] assets," or otherwise "proceed on the premise that those claims would be determined against" the RF. *Id.* at 864, 867. Instead, as the Supreme Court has admonished, if the absent party's claims are "nonfrivolous," Rule 19 is implicated and "[t]he action may not proceed." *Id.* at 867.

As the Fifth Circuit has summarized, in short, "the inquiry at this stage is more about

whether the absent party claims a non-frivolous interest, not the ultimate merit of the claim.” *Lee*, 47 F.4th at 266; *see also Jonesfilm*, 299 F.3d at 140 (requiring only a “colorable claim to such an interest”). Any contrary analysis or consideration of the RF’s interests would “much diminish[]” the protections afforded by Rule 19 and its substantive rights “if an important and consequential ruling affecting the [absent party’s] substantial interest is determined, or at least assumed, by a federal court in the [that party’s] absence and over its objection.” *Pimentel*, 553 U.S. at 868-69.

Lam and Inpria may well each dispute at least some of the RF’s interests. “But that begs the question.” *Lee*, 47 F.4th at 266. Moreover, like in *Lee*, resolution of the ownership and inventorship of the asserted patents and the meaning of the Inpria-RF contracts “is already underway” in the Albany Action. Again, the RF’s ownership claims have already been adjudicated on the pleadings in that case in *SUNY RF’s favor* (after full briefing by Inpria) and found to be “plausible” — that is, the *opposite* of “frivolous.” Similarly, its inventorship claims are supported by detailed allegations, hundreds of pages of contemporaneous records, and a 210-page expert report (Ex. 6). And Inpria itself *withdrew* its Rule 12(c) motion as to SUNY RF’s inventorship claims after the RF amended its complaint to add additional factual support for those claims.

B. SUNY RF cannot be involuntarily joined to this action.

Even though it is a required party, SUNY RF cannot be joined to this action for multiple independent reasons: (1) as a matter of substantive patent law; (2) personal jurisdiction; and (3) venue, including the mandatory jurisdiction and forum selection clauses in its contracts with Inpria.

First, the Federal Circuit has “consistently recognized” that co-owners have “a substantive right not to be involuntarily joined in a patent infringement suit.” *STC.UNM*, 767 F.3d at 1353 (“Without agreement, no precedent has held that a co-owner may be involuntarily joined.”).

This substantive right “fully comports with Rule 19.” *Id.*; *STC.UNM*, 754 F.3d at 946 (“[T]he right of a patent co-owner to impede an infringement suit brought by another co-owner is

a substantive right that trumps the procedural rule for involuntary joinder under Rule 19(a).”).

Moreover, neither of the only recognized exceptions to this rule apply to SUNY RF: it has not granted an exclusive license to Inpria for any of the asserted patents, and it has never waived, by agreement or otherwise, its right to refuse to join this action. *See Ethicon, Inc. v. U.S. Surgical Corp.*, 135 F.3d 1456, at n. 9 (Fed. Cir. 1998); *accord STC.UNM*, 754 F.3d at 946.

Therefore, as *at least* a co-owner of the asserted patents — both by contract and by inventorship — the RF cannot be involuntarily joined to this case as a matter of federal patent law.

Second, SUNY RF also cannot be joined to this action because this Court lacks jurisdiction over the RF, which is a non-profit organized under the laws of New York, based in Albany, NY. *See Wright & Miller*, 7 Fed. Prac. & Proc. Civ. § 1610 (3d ed.) (“If the court cannot obtain personal jurisdiction through one of these methods of service of process over an absentee . . . joinder cannot be allowed.”); *E.E.O.C. v. Peabody W. Coal Co.*, 400 F.3d 774, 779 (9th Cir. 2005) (same).

“To exercise personal jurisdiction over a defendant, a court generally must answer two questions: one statutory and one constitutional.” *Pelham v. VBIT Techs. Corp.*, 2025 WL 947867, at *3 (D. Del. Mar. 28, 2025). As to the statutory component, this Court may not exercise personal jurisdiction over SUNY RF pursuant to any of the grounds in Delaware’s long-arm statute. *See 10 Del. C. § 3104(c)(1)-(6)*. Indeed, with the exception of subsection (c)(4), the long-arm statute requires a showing of specific jurisdiction, *see Shoemaker v. McConnell*, 556 F. Supp. 2d 351, 354-55 (D. Del. 2008), and none of the current claims, counterclaims, or the RF’s interests have *any* connection to this forum. Moreover, although subsection (c)(4) confers general jurisdiction, it is only implicated if the party challenging jurisdiction “[c]auses tortious injury,” 10 *Del. C. § 3104(c)(4)*, and the RF has not caused any tortious injury (nor even alleged to have done so).

Although the lack of statutory personal jurisdiction is sufficient to preclude SUNY RF’s

joinder, the Court also lacks personal jurisdiction over the RF under the constitutional component. General jurisdiction is lacking because the RF does not have such continuous and systematic contacts with Delaware to render it “essentially at home” here, and specific jurisdiction is lacking because, again, none of the claims arise out of or relate to activities of the RF in Delaware. *TriDinetworks Ltd. v. NXP USA, Inc.*, 2020 WL 2220152, at *2 (D. Del. May 7, 2020).

Thus, that this Court lacks personal jurisdiction over SUNY RF provides an independent reason it cannot be joined. *In re Toyota Motor Corp.*, 785 F. Supp. 2d 883, 909 (C.D. Cal. 2011).

Third, SUNY RF also cannot be joined to this action because this Court does not have jurisdiction over the RF’s interests and this is not a proper venue for adjudicating them. *See Peabody W. Coal Co.*, 400 F.3d at 779 (no joinder if venue is improper or court lacks jurisdiction).

For example, SUNY RF’s ownership and inventorship, Inpria’s ability to bring its claims, and Lam’s invalidity, unenforceability, and indemnification counterclaims all relate to, arise out of, require construction of, and implicate the RF’s contracts with Inpria, including the 2013 Mutual Confidential Disclosure Agreement (Ex. 7), 2015 Research Agreement (Ex. 8), and 2017 Research Agreement (Ex. 9). *See, e.g.*, D.I. 176 (Lam’s Answer) (citing these contracts at least 47 times, and asserting breach of indemnification counterclaim under the Research Agreements); Ex. 3 (SUNY RF’s Amended Complaint) (citing these contracts at least 146 times). Indeed, *Inpria* has *conceded* both that Lam’s claims “are based on SUNY’s inventorship claims in the litigation between Inpria and [the RF],” and that Lam’s indemnity counterclaim *violates* “the exclusive venue provision” in the Research Agreements. *See* D.I. 194 (Inpria’s Motion To Strike) at 12, 2, 20.

This matters because each of these contracts contains a mandatory forum selection clause providing that jurisdiction and venue “shall be” “exclusively” in the “County of Albany” in the “State of New York.” *See* Ex. 7 at 4; Ex. 8 at 6; Ex. 9 at 6; *In re McGraw-Hill Glob. Educ. Holdings*

LLC, 909 F.3d 48, 54 (3d Cir. 2018) (finding similar clauses constituted “mandatory, exclusive forum selection clauses”); *Claudio-De Leon v. Sistema Universitario Ana G. Mendez*, 775 F.3d 41, 46 (1st Cir. 2014) (affirming dismissal based on improper venue contrary to mandatory and exclusive forum selection clause); *Salis v. Am. Exp. Lines*, 331 F. App’x 811, 814 (2d Cir. 2009) (same); *IAC/InterActiveCorp v. Roston*, 44 F.4th 635, 644–45 (7th Cir. 2022) (same).

In fact, even if SUNY RF had not long ago bargained for these disputes to be resolved exclusively in the County of Albany, New York, the RF still could not be joined to this action pursuant to either the general or patent venue statutes, including because the RF does not reside in Delaware, its interests, claims, and defenses to the parties’ claims did not substantially occur here, and this Court lacks personal jurisdiction over the RF. *See* 28 U.S.C. §§ 1391(b), 1400(b).

In sum, that this Court is neither the proper venue nor has jurisdiction to resolve SUNY RF’s ownership and inventorship interests (or otherwise interpret and construe the underlying Inpria-RF contracts) provides a *third* independent basis that SUNY RF cannot be joined to this action, which cannot proceed without the RF and until its predicate claims are resolved in the mandatory venue by the court with exclusive jurisdiction to resolve them (including so they can inform, as necessary, standing, validity, enforceability, and indemnification in this action).

C. This action cannot proceed among the existing parties without SUNY RF.

Because SUNY RF is a necessary party to this action but cannot be joined to this action, the Court must dismiss this action, unless the Court were to exercise its discretion to stay it.

Substantive patent law requires this result. *See, e.g., STC.UNM*, 754 F.3d at 947 (“Because co-owner Sandia did not consent to join this infringement suit against Intel and cannot otherwise be involuntarily joined on these facts, STC cannot maintain its suit.”).⁵ And so does Rule 19(b). In

⁵ *Int’l Nutrition Co. v. Horphag Rsch. Ltd.*, 257 F.3d 1324, 1331 (Fed. Cir. 2001) (affirming dismissal for failure to join owners after ownership was properly determined by French court under

fact, *all four* Rule 19(b) factors *strongly* compel that this action be dismissed or stayed.

First, under Rule 19(b)(1), a judgment rendered in this action without SUNY RF would substantially prejudice both the RF and the existing parties, “especially in light of the ongoing [Albany Action].” *Tullet*, 427 F. App’x at 240. As to the RF, because the parties’ infringement, inventorship, enforceability, and indemnification claims and defenses “necessarily call[] for a determination” of the RF’s ownership, inventorship, and contractual rights — and would “risk contradictory rulings” with the Albany Action — a disposition in this action “could prejudice the rights” of the RF. *Id.*; *Epsilon*, 80 F.4th at 234-235 (holding that interpretation of the absent party’s contractual rights supports “dismissal and must be considered”). After all, without its participation, the RF would not be able to protect its patents from being found not infringed, not valid, unenforceable, not licensable, and/or owned and invented solely by Inpria. *See Delano Farms Co. v. California Table Grape Comm’n*, 623 F. Supp. 2d 1144, 1159 (E.D. Cal. 2009) (dismissing under Rule 19(b) because “[i]f the patent is declared invalid, the [absent owner] loses the ownership and value of its patents and any royalty derived from the patent” (collecting cases)).

This factor strongly favors dismissal because both Inpria and Lam have made clear that they do not have “a perfect identity of interests” with SUNY RF. *See Epsilon*, 80 F.4th at 235. Instead, each of them is pursuing claims, counterclaims, and defenses that are *expressly adverse* to the RF’s interests. Whereas Inpria shares an interest in ensuring the asserted patents are found valid and enforceable, its case depends on the Court finding that the RF lacks any ownership or inventorship interests in those patents. To wit, Inpria apparently is willing to risk this entire action and all of the asserted patents on its refusal to recognize SUNY RF’s rights. And, whereas Lam

French contract); *Univ. of Pittsburgh*, 569 F.3d at 1332 (“The district court should have dismissed the action without prejudice, which would allow Pitt to file a second action with the standing defect cured through the joinder of the proper parties or an assignment of the necessary patent rights.”).

shares an interest in proving the RF's ownership and inventorship rights, it seeks to do so only to continue its alleged infringement without the need for a license and to render the patents invalid and unenforceable. *Lee*, 47 F.4th at 269 (affirming dismissal because “battle over ownership . . . is the University's” and parties did not have “same personal stake in that battle as the University”).⁶

Second, under Rule 19(b)(2), this prejudice to SUNY RF and the existing parties cannot be lessened or avoided, except to the extent that the Court were to stay (rather than dismiss) this action pending resolution of the Albany Action pursuant to Rule 19(b)(2)(C). *See infra* at 18; *Caytrans Project Servs. Americas, Ltd. v. BBC Chartering & Logistics GmbH & Co.*, 861 F. App'x 556, 563 (5th Cir. 2021) (“In light of our remand of this matter, the district court will have the opportunity to explore whether a stay might be one of the ‘other measures’ contemplated by Rule 19(b).”). Short of a stay, however, the prejudice cannot be avoided because, for example, SUNY RF either is an owner of the asserted patents, or it is not; its researchers either are inventors of the asserted patents, or they are not; and Lam either is indemnified under the Inpria-RF contracts, or it is not. *Pimentel*, 553 U.S. at 870 (holding Rule 19(b)(2) favored dismissal given conflicting claims of ownership, which is “‘a textbook example’” of “‘severe[] prejudice’”); *N. Arapaho Tribe*, 697 F.3d at 1282 (similar given “the all-or-nothing nature of [the absent party's] interests”).

Third, under Rule 19(b)(3), a judgment rendered in this action without SUNY RF also would not be adequate because “[g]oing forward with the action without [the RF] would not further the public interest in settling the dispute as a whole” because the RF “would not be bound by the

⁶ A disposition of these interests without SUNY RF also would prejudice Lam, for example, because resolution of the RF's ownership claims in the Albany Action will prove that the infringement claims asserted against Lam cannot proceed without the RF's consent, such that any judgment entered in this case would need to be undone or redone. *See AsymmetRx, Inc. v. Biocare Med.*, 582 F.3d 1314, 1318 (Fed. Cir. 2009) (“Because we find that AsymmetRx may pursue its infringement action against Biocare only if Harvard also participates in that action, we conclude that the district court's decision must be vacated.”).

judgment” (e.g., as to ownership, inventorship, or its or Inpria’s contractual rights and obligations). *See Pimentel*, 553 U.S. at 870-871. In short, there would be nothing “complete, consistent, or efficient,” *Provident*, 390 U.S. at 111, about the resolution of this action because Inpria will necessarily be required to relitigate these same issues in the Albany Action, with potentially different results. *See N. Arapaho Tribe*, 697 F.3d at 1283; *Epsilon*, 80 F.4th at 235 (“For this factor, a court must practically consider the likelihood of other suits.”). Proceeding first with the Albany Action, however, *would* resolve the ownership dispute⁷ and may well resolve this entire action if the RF were either to license Lam or to maintain its refusal to join this suit.

Fourth, Rule 19(b)(4) also strongly supports dismissal because the plaintiff Inpria would have an adequate remedy if the action were dismissed. It can seek to have the predicate ownership and inventorship issues resolved in its favor in the Albany Action. *See Tullet*, 427 F. App’x at 240 (affirming dismissal given “ongoing arbitration proceedings” and, after that, ability to commence a state court action with respect to any remaining issues); *Lee*, 47 F.4th at 270 (“Because appellants can presumably bring these claims against Collegiate and the Licensees *after* they have established their superior rights to the mark, this factor too weighs in favor of dismissal.”). Dismissal or stay also will provide Inpria “an effective defense against piecemeal litigation and inconsistent, conflicting judgments,” *Pimentel*, 553 U.S. at 872. Regardless, Inpria’s interests *must* give way to SUNY RF’s ownership, inventorship, and contractual rights under Rule 19(b), *id.*, and patent law, *STC.UNM*, 754 F.3d at 946-947 (holding that “equities at play” favored dismissal, not plaintiff).

II. Alternatively, This Case Must Be Stayed Pending Resolution of the Albany Action.

Although dismissal is warranted, the Court may instead stay this action pending resolution of the Albany Action. *In re Republic of Philippines*, 309 F.3d 1143, 1153 (9th Cir. 2002) (staying

⁷ Lam has previously agreed “to be bound by a judgment on the merits” resolving SUNY RF’s ownership and inventorship claims concerning the asserted patents. *See* D.I. 67.

rather than dismissing under Rule 19(b)); *Pimentel*, 553 U.S. at 875 (Stevens, J., concurring in part) (advocating for stay pending resolution of parallel litigation over ownership). After all, the Court and the parties have expended significant resources on this action, any dismissal must be without prejudice, and the Albany Action is in discovery and was just ordered to mediation, D.I. 125 — all of which support a stay. *Names for Dames v. Gimbel*, 1989 WL 82417, at *3 (S.D.N.Y. July 19, 1989) (“[I]t is in the interest of judicial economy and consistent with the flexible approach to resolution of Rule 19(b) motions advocated by the Advisory Committee, to stay this action.”).

The decision in *Televisa, S.A. de C.V. v. Koch Lorber Films* is instructive. See 382 F. Supp. 2d 631, 633 (S.D.N.Y. 2005). In that case, the court held that “the most sensible course at this point is to stay this action pending resolution of the ongoing interpleader action in France, which is likely to resolve the primary issue in this case, *i.e.*, who owns the rights to the movies in question.” *Id.*

Although that case had been “pled as a copyright case,” the court correctly recognized, “the issue of whether any party infringed plaintiff’s copyrights is necessarily subordinate to the essential dispute in this case, which is the ownership of the movie rights.” *Id.* at 634. Indeed, like here, although the defendants were not subject to the French action, they were “irrelevant to the underlying issue of ownership that the French court will determine, since these New York-based defendants do not claim ownership of the movies and their liability, if any exists, turns entirely on whether FSF validly acquired ownership.” *Id.* However, also like here, “due to the absence of [one of the alleged “owners, in whole or in part, of this intellectual property”] from the instant action, the French litigation necessarily will continue regardless of what this Court does, creating the potential for judicial inefficiency and inconsistent verdicts should this case go forward.” *Id.*⁸

⁸ Moreover, whereas the *Televisa* forum “ha[d] no connection” to the ownership dispute, the French “forum ha[d] considerably more connection to the dispute, would be more convenient for other parties and witnesses, and may have a superior ability to adjudicate the key issues.” See *id.* at 635.

But, rather than dismiss the action in deference to the French forum, the *Televisa* court stayed the action because “[w]hen the French action concludes, there may well remain questions that require litigation here, including whether any United States copyrights have been infringed and, if so, what remedies are available.” *Id.*; *Mihailovic-Coello v. Jugobanka*, 1991 WL 161086, at *2 (S.D.N.Y. Aug. 14, 1991) (staying action pending resolution of parallel litigation: “Although plaintiff is the only one among them who has been preliminarily recognized as having rights to the estate, it remains to be seen whether the other claimants’ purported rights are valid”).

The reasoning in these cases would also justify staying this action. Although pled as an infringement case, Lam’s infringement is subordinate to whether this action can proceed without SUNY RF. Further, whereas the RF is not a party and cannot be joined to this action, and will not be bound by this action, Inpria is *already a party* to the Albany Action and *will be bound* by it (and Lam has agreed to be bound by it as to ownership and inventorship). Moreover, whereas Delaware has no connection to these disputes, significant witnesses and substantial evidence *are* in New York and *are* subject to the Albany court’s jurisdiction. Inpria and the RF long ago *agreed* (on three separate occasion) that these disputes would be resolved “exclusively” in Albany, by Albany courts. And although dismissal also would be warranted, a stay will better serve judicial economy and the interests of the existing parties, including so this forum remains available, as necessary, to resolve Lam’s alleged infringement and defenses thereto, following the Albany Action.

CONCLUSION

Titans of industry are fighting over who gets to make, sell, and use cutting-edge semiconductor technology that is owned by SUNY RF and was invented by its researchers, and SUNY RF’s rights are being *trampled*. Because the RF is a required party to this action but cannot be joined to this action, the Court must dismiss this action without prejudice pursuant to Rule 19(b), unless the Court exercises its discretion to stay it pending resolution of the Albany Action.

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Respectfully submitted,

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