

From: [Giunta, Richard F.](#)
To: [Trials](#)
Cc: [PTAB Jason Balich](#); [PTAB Jie Xiang](#); [Corbett, Gregory F.](#); [Steenburg, Charles](#); [Specht, Kara](#); [Jones, Forrest](#); [Green, Alissa](#); [Coverstone, Caitlin](#); [Smiley, Deanna](#); [Innoscence-Infinion-IPR](#); [Lavenue, Lionel](#)
Subject: RE: IPR2024-00975, Innoscence America v Infineon Technologies
Date: Friday, February 21, 2025 5:51:28 PM
Attachments: [image001.png](#)
[image003.png](#)

Honorable Board,

Patent Owner Infineon objects to Petitioner's email as including improper argument not authorized by the Board. Because Petitioner's email mischaracterizes Mr. Otremba's testimony as "inconsistent with the statements made in Infineon's Patent Owner's Response" and mischaracterizes the meet and confer between the parties, Infineon is compelled to respond.

Infinion informed Petitioner on February 18, 2025 that Infineon had no objection to the transcript of Mr. Otremba's deposition being provided to the Board if the Board thought it might be relevant. Infineon then worked to de-designate virtually the entire transcript, including all the testimony that Petitioner alleged was relevant to this IPR, and served that lightly-redacted transcript on Petitioner so that Petitioner could seek leave from the Board to submit the transcript. What Infineon refused to agree to was Petitioner including in its email to the Board Petitioner's one-sided arguments about alleged relevance of Mr. Otremba's testimony in this proceeding. Over Infineon's objection, Petitioner went ahead and included improper argument in its email to the Board. Petitioner's argument about cherry-picked snippets mischaracterizes Mr. Otremba's testimony. If the Board believes that the deposition transcript could have any relevance to this proceeding at this stage, there is other testimony in the Otremba deposition transcript (cited below as "Otremba") that the Board should consider as it lays bare that Petitioner has mischaracterized Mr. Otremba's testimony.

- With respect to what characterizes a transistor as a vertical or lateral transistor:
 - "the lateral transistor is characterized by the majority of the current having a lateral flow as the vertical transistor has the characteristics of having the majority of the current flow be in a vertical direction." Otremba, **45:4-8**.
 - "It describes a vertical transistor because there is a vertical current flow." Otremba, **17:20-22**.
 - "I would define a vertical transistor via the vertical current flow, where the dominant part of the current is running vertically." Otremba, **100:5-7**.
 - "For me, the arrangement of the electrodes within the housing is important, but it's not the only thing that is important for the current flow and the arrangement of the electrodes. There can be iterations where a vertical current flow is not due to the arrangement of electrodes on opposite sides. But the -- the building plan's schematics here explicitly describe it like this with the electrodes on the top and on the bottom, and that resembles the current flow as well." Otremba, **93:21-94:9**.
 - "In many cases the positioning of the electrons is -- of the electrodes is also on opposing sides, but there -- there are also cases where this is not the case, where a vertical building element could also have both electrodes on the top side or surface." Otremba, **100:11-16**.
 - Mr. Otremba's testimony is consistent with the POPR and the Board's Decision denying institution.
- With respect to Nega Fig. 2:
 - The testimony Petitioner identifies is not inconsistent with the POPR's argument (at 45-53) and the Board's finding (DI, 11) that the Petition failed to prove that Nega's transistor is a lateral transistor.
 - Petitioner's email also ellipses out Mr. Otremba's answer at 143:14-22 where he qualified his testimony -- "but I'm not a device expert."
- With respect to Mr. Otremba's area of expertise:
 - "Again, I'm a package expert. I -- it's really hard for me to, like, give, you know, testimony to the inner structures." Otremba, **132:21-133:1**.
 - "Q: I thought the inner structures were what tells you what is lateral and vertical? A: Tells the device expert how the arrangement or the current flow is in the end. The package expert, I -- I use the electrodes where they are arranged, so in this case on top and bottom. But the reason why they are arranged where they are, I can't really deduce from this picture." Otremba, **133:2-133:10**.
 - "I use the arrangement to generate an advantage in the package. For that I don't need the understanding of what the inner structure looks like." Otremba, **136:5-9**.
- With respect to Murari Fig. 1.7c:
 - Petitioner's cited snippet from 136:1-16 suggesting that Mr. Otremba testified that Fig. 1.7c is "a lateral element" responds to a question "from a packaging perspective."
 - "Q Didn't you say it was a lateral element? A No, it has aspects of both. There are areas that show both a lateral and a horizontal current flow. For me, it seems to be a combination of both, but I can't really assign it." Otremba, **138:1-5** (the audio recording is clear that the witness's actual testimony (in German) referencing both types of current flow was to vertical and lateral current flow; the transcript will be corrected by errata).
 - "Q And as you can see, the electrodes are all in the upper surface, so, as you were saying, would that mean these are all lateral devices? MR. STEENBURG: Objection, scope. Calls for expert testimony. A I can't -- I can't deduct this from these structures, really. Specifically see the picture. When we chose both structures lateral and vertical in terms of current flow, I can't really assign this properly" Q Are you referencing specifically to 1.7C? A Yes." Otremba, **134:4-15**.
 - "Q So you're saying this [Murari Fig. 1.7c] is a combination, so it would be incorrect to label this as a vertical transistor, correct? MR. STEENBURG: Object. Objection, scope. Calls for expert testimony. A I really can't assess this. It has traits of both for me." Otremba, **134:16-22**.
 - Q: "But you would agree that Figure 1.7C is not like the vertical device in [Murari] Figure 1.6?" A: "Yes, they are different, yes. But if these differences are sufficient to put them into different categories of devices, I do not know." Otremba, **139:15-20**.
 - Q: "Just to clarify, Figure 1.7C is a lateral device from your perspective? MR. STEENBURG: Objection, scope, expert testimony, asked and answered. A I cannot really define the inner structure, so I can't really say what it is." Otremba, **137:17-22**.
 - Mr. Otremba's testimony that, as a packaging expert, the question of whether Murari Fig. 17c's transistor is a vertical or horizontal transistor is

outside of his expertise is not “inconsistent” with any argument in the POPR as Petitioner’s email to the Board alleged.

- With respect to dependent claim 5:
 - Petitioner’s assertion that Mr. Otremba’s testimony is “inconsistent with statements made in Infineon’s [POPR]” is false because the POPR said nothing about claim 5’s language. And while Petitioner neglected to inform the Board of it, Infineon has notified Petitioner that Infineon will shortly be filing a disclaimer that disclaims dependent claim 5.

Despite Petitioner having been served with the Otremba transcript in this proceeding, Petitioner’s email stops short of asking the Board for leave to submit it. Infineon’s understanding of the rules is that at this stage of the proceeding Infineon cannot file the deposition transcript without the Board’s authorization. If the Board would like to review the transcript, Infineon is more than willing to provide it so that the Board can draw its own conclusions about whether the transcript has any relevance to this proceeding.

Respectfully submitted,

 **Richard F. Giunta**
Shareholder; Post Grant Proceedings
Admitted to Practice: Massachusetts,
USPTO
Rich.Giunta@wolfgreenfield.com
O: 617.646.8322 | C: 617.851.4347
Wolf, Greenfield & Sacks,
P.C.
BOSTON | NEW YORK |
WASHINGTON DC
wolfgreenfield.com | [LinkedIn](https://www.linkedin.com/company/wolfgreenfield)

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From: Lavenue, Lionel <lionel.lavenue@finnegan.com>

Sent: Friday, February 21, 2025 3:47 PM

To: Trials <Trials@USPTO.GOV>; Giunta, Richard F. <Rich.Giunta@WolfGreenfield.com>

Cc: PTAB Jason Balich <JBalich-PTAB@wolfgreenfield.com>; PTAB Jie Xiang <JXiang-PTAB@WolfGreenfield.com>; Corbett, Gregory F.

<Gregory.Corbett@WolfGreenfield.com>; Steenburg, Charles <Charles.Steenburg@WolfGreenfield.com>; Specht, Kara <Kara.Specht@finnegan.com>; Jones, Forrest <Forrest.Jones@finnegan.com>; Green, Alissa <Alissa.Green@finnegan.com>; Coverstone, Caitlin <Caitlin.Coverstone@finnegan.com>; Smiley, Deanna <Deanna.Smiley@finnegan.com>; Innoscience-Infineon-IPR <Innoscience-Infineon-IPR@finnegan.com>

Subject: IPR2024-00975, Innoscience America v Infineon Technologies

Honorable Board,

We advise that there was a deposition of one of the named inventors of the ‘481 patent, Ralf Otremba, on February 12, 2025.

We contacted Infineon’s counsel on February 13, 2024, stating that we believe excerpts of the transcript should be made available to the Board for review.

Today, Infineon agreed to submit portions of the transcript to the Board if the Board would like the transcript submitted.

The parties dispute whether the statements in the deposition are inconsistent with the statements made in Infineon’s Patent Owner’s Response. The parties specifically dispute the following portions of the transcript:

- With respect to Fig. 2 from the Nega prior art reference
 - “I would say it’s a [] lateral building element . . . Q: And just to confirm, lateral building element means lateral device? A: Yep.” R. Otremba, Dep. Trs., pp. 143:14-22.
- With respect to Fig. 1.6 from the Murari prior art reference
 - “It’s the source and electrodes on opposing sides. For me as packaging expert, for me that means a vertical device.” R. Otremba, Dep. Trs., pp. 133:13-22.
- With respect to Fig. 1.7c from the Murari prior art reference
 - “It is undoubtedly a lateral element.” R. Otremba, Dep. Trs., pp. 136:10-16.
 - “Q: Do you see the figure caption for Figure 1.7? A: Yes. Q: Does that indicate it’s a lateral device? . . . A: Nope. It says horizontal structures . . . I really can’t tell you if there is a difference there between lateral and horizontal.” R. Otremba, Dep. Trs., pp. 137:16-139:20.
- With respect to claim 5 of the ‘481 patent
 - “Q: And you said you reviewed the claims before they were submitted to the patent office? [] A: Yes. I didn’t recognize that. Q: Did you or Infineon ever inform the patent office that this claim was unexplainable? A: I just – I just realized that right now, just now.” R. Otremba, Dep. Trs., pp. 99:9-100:3.
 - “A: I didn’t realize until now when claims didn’t fit anymore. Q: Do you plan to submit a revision to the USPTO? A: I can’t say how we have to deal with that now . . . Q: Do you understand that a duty of candor is an obligation on an individual basis? A: I really don’t know that very well – all that very well.” R. Otremba, Dep. Trs., pp. 127:2-128:9.

In an effort to resolve this dispute, Infineon agrees to provide a copy of Mr. Otremba’s deposition transcript to the Board, if the Board wishes to have the

parties submit the transcript.

Regards,

Lionel

From: Trials <Trials@USPTO.GOV>

Sent: Thursday, January 16, 2025 12:02 PM

To: Lavenue, Lionel <lionel.lavenue@finnegan.com>; Giunta, Richard F. <Rich.Giunta@WolfGreenfield.com>; Trials <Trials@USPTO.GOV>

Cc: PTAB Jason Balich <JBalich-PTAB@wolfgreenfield.com>; PTAB Jie Xiang <JXiang-PTAB@WolfGreenfield.com>; Corbett, Gregory F. <Gregory.Corbett@WolfGreenfield.com>; Steenburg, Charles <Charles.Steenburg@WolfGreenfield.com>; Specht, Kara <Kara.Specht@finnegan.com>; Jones, Forrest <Forrest.Jones@finnegan.com>; Green, Alissa <Alissa.Green@finnegan.com>; Coverstone, Caitlin <Caitlin.Coverstone@finnegan.com>; Smiley, Deanna <Deanna.Smiley@finnegan.com>; Innoscience-Infineon-IPR <Innoscience-Infineon-IPR@finnegan.com>

Subject: RE: Further Update, IPR2024-00975, Innoscience America v Infineon Technologies

Counsel,

From the Board –

Patent Owner's request for authorization to file a response to Petitioner's request for rehearing is denied. The parties' communications with the Board will be entered in the record as Exhibit 3001.

Regards,

Esther Goldschlager
Supervisory Paralegal Specialist
Patent Trial & Appeal Board
U.S. Patent & Trademark Office

From: Lavenue, Lionel <lionel.lavenue@finnegan.com>

Sent: Wednesday, January 15, 2025 8:02 PM

To: Giunta, Richard F. <Rich.Giunta@WolfGreenfield.com>; Trials <Trials@USPTO.GOV>

Cc: PTAB Jason Balich <JBalich-PTAB@wolfgreenfield.com>; PTAB Jie Xiang <JXiang-PTAB@WolfGreenfield.com>; Corbett, Gregory F. <Gregory.Corbett@WolfGreenfield.com>; Steenburg, Charles <Charles.Steenburg@WolfGreenfield.com>; Specht, Kara <Kara.Specht@finnegan.com>; Jones, Forrest <Forrest.Jones@finnegan.com>; Green, Alissa <Alissa.Green@finnegan.com>; Coverstone, Caitlin <Caitlin.Coverstone@finnegan.com>; Smiley, Deanna <Deanna.Smiley@finnegan.com>; Innoscience-Infineon-IPR <Innoscience-Infineon-IPR@finnegan.com>

Subject: Further Update, IPR2024-00975, Innoscience America v Infineon Technologies

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To the Honorable Board,

Petitioner apologies for this second email.

But, Patent Owner's email omits Petitioner's positions, which counsel for Petitioner provided to counsel for Patent Owner to include in its email to the Board (but which was omitted).

Importantly, Petitioner never stated that it fully opposes additional briefing.

Also, while the Parties did meet and confer with respect to Patent Owner's request for a five-page response, Patent Owner never raised the two alleged "good causes," which it now raises with the Board.

Nevertheless, with respect to Patent Owner's request for a five-page response, we provide an exact copy of Petitioner's excluded position that Patent Owner omitted (and remains Petitioner's position):

"Petitioner recognizes that this is an exceptional case, given the misrepresentations made in Patent Owner's preliminary response. Because of the duty to correct the misstatements, Petitioner does not oppose Patent Owner filing a paper to correct or recant its prior misstatements, which Petitioner previously asked Patent Owner to do prior to the filing of the rehearing request. As to the remaining issues raised, Patent Owner has not provided any reasons why the standard operating procedures of the Board, as to issuing requests for any additional briefing that the Board wishes after it has had a chance to review the rehearing request, would not be adequate here."

If the Board believes it would be helpful to have the prior communications regarding the prior requests to correct the record, between Petition and Patent Owner, Petitioner can provide them at any time.

Finally, counsel for Petitioner confirms that, if needed, it is available for a conference call on the following days and times:

Monday, January 20, 2025, before 11 am ET
Tuesday, January 21, 2025, after 1 pm ET
Any time on Wednesday, January 22, 2025.

Respectfully Submitted,

Lionel Lavenue
Counsel for Petitioner

Lionel M. Lavenue | Bio
Attorney at Law

Finnegan, Henderson, Farabow, Garrett & Dunner, LLP
1875 Explorer Street, Suite 800, Reston, VA 20190-6023
571.203.2750 | fax: 202.408.4400 | Lionel.Lavenue@finnegan.com | www.finnegan.com | [LinkedIn profile](#)

FINNEGAN

From: Giunta, Richard F. <Rich.Giunta@WolfGreenfield.com>

Sent: Wednesday, January 15, 2025 3:25 PM

To: Trials@USPTO.GOV

Cc: PTAB Jason Balich <JBalich-PTAB@wolfgreenfield.com>; PTAB Jie Xiang <JXiang-PTAB@WolfGreenfield.com>; Corbett, Gregory F. <Gregory.Corbett@WolfGreenfield.com>; Steenburg, Charles <Charles.Steenburg@WolfGreenfield.com>; Lavenue, Lionel <lionel.lavenue@finnegan.com>; Specht, Kara <Kara.Specht@finnegan.com>; Jones, Forrest <Forrest.Jones@finnegan.com>; Green, Alissa <Alissa.Green@finnegan.com>; Coverstone, Caitlin <Caitlin.Coverstone@finnegan.com>; Smiley, Deanna <Deanna.Smiley@finnegan.com>; Innoscience-Infineon-IPR <Innoscience-Infineon-IPR@finnegan.com>

Subject: IPR2024-00975, Innoscience America v Infineon Technologies

Dear Honorable Board,

Patent Owner Infineon requests a conference call to seek authorization to file a short five-page response to Petitioner's request for rehearing.

Patent Owner stands ready to demonstrate on the call that good cause exists for a response given two unusual aspects of Petitioner's rehearing request: (1) Petitioner did not request pre-institution briefing to address alleged inaccuracies in the POPR so the rehearing request has new characterizations of the evidence to which Patent Owner has had no opportunity to respond and (2) Patent Owner requests the opportunity to respond on the record to the rehearing request's serious and baseless accusations of misconduct, including an allegation that Patent Owner "doctored evidence" by annotating a reference to highlight the current flow direction in the channel between the source and drain regions which the POPR explained characterizes a transistor as vertical or lateral.

The parties have met and conferred and Petitioner opposes Patent Owner's request to file a response to the rehearing request. Patent Owner will make itself available at the Board's convenience for a conference call, while Petitioner has indicated that it is available on the following days and times:

Monday, January 20, 2025, before 11 am ET
Tuesday, January 21, 2025, after 1 pm ET
Any time on Wednesday, January 22, 2025.

Respectfully Submitted,



Richard F. Giunta

Shareholder; Co-Chair, Post Grant Proceedings

Admitted to Practice: Massachusetts, USPTO

Rich.Giunta@wolfgreenfield.com

O: 617.646.8322 | C: 617.851.4347

Wolf, Greenfield & Sacks, P.C.

BOSTON | NEW YORK | WASHINGTON DC

wolfgreenfield.com | [LinkedIn](#)

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