

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INNOSCIENCE AMERICA, INC.,
Petitioner,

v.

INFINEON TECHNOLOGIES AUSTRIA AG,
Patent Owner.

Case No. IPR2025-00721
Patent No. 9,899,481

PATENT OWNER'S DISCRETIONARY DENIAL BRIEF

TABLE OF CONTENTS

I.	INTRODUCTION	1
II.	THE BOARD HAS ALREADY REJECTED A PETITION FILED BY THE SAME PETITIONER PRESENTING THE SAME GROUNDS RELYING ON THE SAME PRIOR ART AND ARGUMENTS	6
A.	Petitioner’s New Claim Construction Arguments Do Not Warrant a Second Petition	8
1.	Petitioner’s New Claim Construction Arguments Use the Board’s Prior Decision as a Roadmap	8
2.	The Board Could Not Have Erred by Failing to Accept Petitioner’s New Claim Construction Arguments Because They Were Never Raised in the First Petition.....	12
3.	The Board Already Considered and Rejected Petitioner’s New Claim Construction Arguments.....	13
B.	“New” Inventor Testimony Is Irrelevant Because It Only Relates to a Disclaimed Claim	15
1.	The Testimony Petitioner Cites Only Relates to a Disclaimed Dependent Claim.....	16
2.	The Inventor’s Testimony on the Meaning of “Lateral Transistor” is Consistent with the Board’s Finding	16
C.	The Board Has Already Rejected Petitioner’s Baseless Assertions that Patent Owner Misrepresented and Doctored the Evidence and Explained that the Board Was Not Misled into Denying Petitioner’s First Petition	18
D.	Conclusion: The Justifications Petitioner Advanced for Its Second Serially-Filed Petition Fail	21
III.	DISCRETIONARY DENIAL CONSIDERATIONS	21
IV.	PETITIONER’S FOLLOW-ON PETITION SHOULD BE DENIED UNDER <i>GENERAL PLASTIC</i>	23
A.	The <i>General Plastic</i> Factors Favor Discretionary Denial.....	24
1.	Factor 1: The Same Petitioner Previously Filed a Petition Directed to the Same Claims of the Same Patent.....	25

2. Factor 2: Petitioner Knew of the Art Asserted in the Present Petition Because Petitioner Admits that the Grounds and “Cited References” are “the Same”	25
3. Factor 3: Petitioner Had the PPOR and the Board’s Decision Denying Institution of its First Petition When Filing this Follow-On Petition	25
4. Factor 4: Petitioner Waited Nine Months Before Filing this Follow-On Petition	27
5. Factor 5: Petitioner Offers No Acceptable Explanation for the Delay.....	27
6. Factors 6 and 7: It Would Be Inefficient for the Board to Have a Trial that Reconsiders Grounds Already Rejected by the Office	28
B. Conclusion: the <i>General Plastic</i> Factors Favor Denial of Institution.....	29
V. THE DIRECTOR SHOULD DISCRETIONARILY DENY THIS PETITION UNDER 35 U.S.C. § 325(D)	30
A. The Statute Provides the Director with Discretion to Deny this Petition and <i>Advanced Bionics</i> Provides the Framework the Board Has Applied in Determining Whether to Exercise Such Discretion	30
B. Application of the <i>Advanced Bionics</i> Framework Reveals that this Petition Should be Discretionarily Denied Under § 325(d)	33
1. Petitioner Admits that <i>Advanced Bionics</i> Step 1 Is Met	33
2. <i>Advanced Bionics</i> Step 2 Is Met Because Petitioner Cannot Make the Required Showing of Material Error	33
a. Factor (c): The “Same” Grounds Were Evaluated by the Board in Petitioner’s Prior Petition.....	34
b. Factor (e): Petitioner Fails to Establish that the Office Materially Erred in its Prior Evaluation.....	35
i. The Board Could Not Have Erred in Not Accepting Petitioner’s Claim Construction Argument Because It Was Not Presented in the IPR2024-00975 Petition	36
ii. The Board Fully Considered and Rejected Petitioner’s New Arguments and its Rehearing Decision Refutes Petitioner’s Allegations of Error	38

c. Factor (f): Petitioner Cites No Additional Evidence Warranting Reconsideration	40
3. Conclusion: The Board Should Deny Institution Under § 325(d)	41
IV. THE PARALLEL ITC INVESTIGATION BETWEEN THE SAME PARTIES WARRANTS DISCRETIONARY DENIAL UNDER <i>FINTIV</i>	41
1. Factor 1: The ITC Case Is Not and Will Not Be Stayed.....	43
2. Factor 2: Proximity of a Trial Date to the Board’s Projected FWD	44
3. Factor 3: Investment in the Parallel Proceeding	46
4. Factor 4: Overlapping Issues.....	49
5. Factor 5: Same Parties	52
6. Factor 6: Other Circumstances, Including the Merits	52
a. The Board Has Already Rejected the Petition’s Grounds on the Merits	52
b. That an ITC Invalidity Ruling Would Not Bind the Office or the Courts Does Not Weigh Against Denying Institution.....	52
c. No Other Factors Weigh Against Denial of Institution	53
7. Conclusion: This Petition Should be Discretionarily Denied Under <i>Fintiv</i>	53
V. CONCLUSION.....	54

TABLE OF AUTHORITIES

CASES

<i>Advanced Bionics v. Med-El Elektromedizinische Geräte</i> , IPR2019-01469, Paper 6 (PTAB Feb. 13, 2020)	passim
<i>Apple Inc. v. Fintiv, Inc.</i> , IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020).....	passim
<i>Apple Inc. v. Fintiv, Inc.</i> , IPR2020-00019, Paper 15 (PTAB May 13, 2020).....	44
<i>Apple Inc. v. Koss Corporation</i> , IPR2022-00053, Paper 10 (PTAB April 4, 2022).....	27
<i>Becton, Dickinson and Company v. B. Braun Melsungen AG</i> , IPR2017-01586, Paper 8 (PTAB Dec. 15, 2017).....	31, 40
<i>Canadian Solar Inc. et al. v. Solaria Corp.</i> , IPR2021-00095, Paper 12 (PTAB May 26, 2021).....	51
<i>Canadian Solar Inc. et al. v. Solaria Corp.</i> , IPR2021-00659, Paper 14 (PTAB Sept. 30, 2021)	51
<i>Cuozzo Speed Techs., LLC v. Lee</i> , 579 U.S. 261 (2016)	21
<i>Garmin International, Inc. et al v. Koninklijke Philips N.V.</i> , IPR2020-00754, Paper 11 (PTAB Oct. 27, 2020).....	50
<i>General Plastic Industrial Co. v. Canon Kabushiki Kaisha</i> , IPR2016-01357, Paper 19 (PTAB Sept. 6, 2021)	passim
<i>Google LLC v. EcoFactor Inc.</i> , IPR2021-00982, Paper 12 (PTAB Nov. 9, 2021)	51
<i>Harmonic Inc. v. Avid Tech., Inc.</i> , 815 F.3d 1356 (Fed. Cir. 2016).....	21
<i>In re Princo Corp.</i> , 478 F.3d 1345 (Fed. Cir. 2007)	42

<i>Innoscence America, Inc. v. Infineon Technologies Americas Corp.</i> , IPR2025-00010, Paper 11 (PTAB May 16, 2025)	passim
<i>Intel Corp. v. Koninklijke Philips N.V.</i> , IPR2021-00328, Paper 16 (PTAB Mar. 29, 2022)	42, 43, 47, 53
<i>Intel Corp. v. Koninklijke Philips N.V.</i> , IPR2021-00328, Paper 9 (PTAB July 16, 2021)	42, 43, 48
<i>Motorola Sol’ns, Inc. v. Stellar, LLC</i> , IPR2024-01205, Paper 19 (PTAB Mar. 28, 2025)	49, 51
<i>Philip Morris Products SA v. RAI Strategic Holdings, Inc.</i> , IPR2020-00919, Paper 9 (PTAB Nov. 16, 2020)	44
<i>SK Innovation Co., Ltd. et al v. LG Chem, Ltd. et al.</i> , IPR2020-01036, Paper 13 (PTAB Nov. 30, 2020)	44, 48, 50
<i>Videndum Production Solutions, Inc. v. Rotolight Limited</i> , IPR2023-01218, Paper 9 (PTAB Jan. 25, 2024)	28

STATUTES

35 U.S.C. § 314(a)	1, 3, 29, 41
35 U.S.C. § 325(d)	passim

REGULATIONS

37 C.F.R. § 42.104	37
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LISTING OF EXHIBITS

Exhibit	Description
2001	<i>Innoscence America, Inc. v. Infineon Technologies Austria AG</i> , IPR2024-00975, Paper 10, DECISION Denying Petitioner’s Request for Rehearing of Decision Denying Institution of <i>Inter Partes</i> Review (PTAB April 14, 2025)
2002	Disclaimer in Patent under 37 CFR 1.321(a), filed April 9, 2025
2003	Stewart, C.M., “Interim Processes for PTAB Workload Management,” Memorandum dated March 26, 2025
2004	Email from Lavenue, Lionel RE: Stay, Infineon v. Innoscence – NDCA (Aug. 27, 2024)
2005	<i>Infineon Technologies Austria AG v. Innoscence (Suzhou) Technology Company, Ltd. et al.</i> ; Case No. 4:24-cv-01553-YGR, Dkt. No. 55, Joint Stipulation to Stay Pending ITC Proceeding; [Proposed] Order (N.D. Cal. Aug. 30, 2024)
2006	<i>Infineon Technologies Austria AG v. Innoscence (Suzhou) Technology Company, Ltd. et al.</i> ; Case No. 4:24-cv-01553-YGR, Dkt. No. 56, Order Staying and Conditionally Closing Case for Statistical Purposes (N.D. Cal. Aug. 30, 2024)
2007	<i>In the matter of Certain Semiconductor Devices and Products Containing the Same</i> ; Inv. No. 337-TA-1414. Order No. 5, Initial Determination Setting an 18-Month Target Date and Order Setting Preliminary Conference (ITC Sept. 18, 2024)
2008	<i>In the matter of Certain Semiconductor Devices and Products Containing the Same</i> ; Inv. No. 337-TA-1414. Order No. 6, Setting the Procedural Schedule (ITC Sept. 27, 2024)
2009	<i>In the matter of Certain Semiconductor Devices and Products Containing the Same</i> ; Inv. No. 337-TA-1414. Order No. 25, Amending the Procedural Schedule (ITC Feb. 27, 2025)
2010	<i>In the matter of Certain Semiconductor Devices and Products Containing the Same</i> ; Inv. No. 337-TA-1414. Order No. 32, Amending the Procedural Schedule (ITC Apr. 8, 2025)
2011	<i>In the matter of Certain Semiconductor Devices and Products Containing the Same</i> ; Inv. No. 337-TA-1414. Order No. 27, Initial Determination Granting Complainants’ Unopposed Motion for Partial Termination of the Investigation (ITC Apr. 3, 2025)
2012	<i>In the matter of Certain Semiconductor Devices and Products Containing the Same</i> ; Inv. No. 337-TA-1414. Order No. 46, Initial

Exhibit	Description
	Determination Granting Complainants’ Unopposed Motion for Partial Termination of the Investigation (ITC Apr. 30, 2025)
2013	United States Patent Office, “Guidance on USPTO’s rescission of ‘Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation” (March 24, 2025), available at https://www.uspto.gov/sites/default/files/documents/guidance_memo_on_interim_procedure_rescission_20250324.pdf
2014	<i>In the matter of Certain Semiconductor Devices and Products Containing the Same</i> ; Inv. No. 337-TA-1414. Order No. 29, Construing Certain Claim Terms (ITC Apr. 4, 2025)
2015	<i>In the matter of Certain Semiconductor Devices and Products Containing the Same</i> ; Inv. No. 337-TA-1414. Respondents’ Invalidity Contentions (ITC Jan. 24, 2025)
2016	<i>In the matter of Certain Semiconductor Devices and Products Containing the Same</i> ; Inv. No. 337-TA-1414. Respondents’ Invalidity Contentions Appendix A-1 (ITC Jan. 24, 2025)
2017	<i>In the matter of Certain Semiconductor Devices and Products Containing the Same</i> ; Inv. No. 337-TA-1414. Respondents’ Invalidity Contentions Appendix A-2 (ITC Jan. 24, 2025)
2018	Email from Giunta, Richard RE: RE: IPR2024-00975, Innoscience America v Infineon Technologies (Feb. 21, 2025)
2019	<i>Innoscience America, Inc. v. Infineon Technologies Ausria AG</i> , IPR2024-00975, Exhibit 1003, Declaration of Michael Lebby, Ph.D.

I. INTRODUCTION

The '481 Patent is one of two patents owned by Patent Owner that are the subject of ITC Investigation No. 337-TA-1414 brought against Petitioner.

Petitioner also filed an IPR petition against the other patent asserted in the ITC case in IPR2025-00010. The Board has discretionarily denied that other IPR under § 314(a) and *Fintiv* based on the parallel ITC investigation. *See Innoscience America, Inc. v. Infineon Technologies Americas Corp.*, IPR2025-00010, Paper 11 (May 16, 2025) (hereafter “*Innoscience*”). The Director should do the same here. The facts weigh even more heavily in favor of discretionary denial of this case because the ITC investigation was even further along when this Petition was filed. There are also additional reasons to discretionarily deny this Petition.

Nine months ago, Petitioner filed a petition that challenged the same claims of the '481 Patent based on the same grounds, relying on the same prior art and arguments. *Compare* Petition with Ex-1025 (petition in IPR2024-00975). The Board denied institution of that prior petition on the merits. Ex-1027. Petitioner then filed a request for rehearing. Ex-1028. While that rehearing request was pending, Petitioner filed this second Petition. Approximately one month after this second Petition was filed, the Board issued a decision denying Petitioner's rehearing request. Ex-2001. Thus, despite Petitioner's misrepresentation to the contrary, Petitioner did not file “Parallel Petitions.” Paper 3 (title). This is a second

serially-filed petition that Petitioner admits presents “the same cited references and arguments” the Board already rejected in IPR2024-00975. *Id.* at 2. Petitioner purports to justify this re-filing of its denied petition by alleging that the Board “erred” in denying it the first time around because the Board was misled by alleged “misrepresentations” and “doctored evidence” in the Patent Owner Preliminary Response (“POPR”) filed in IPR2024-00975. *Id.* at 2-4. But Petitioner’s rehearing request in IPR2024-00975 already advanced these same baseless arguments and the Board soundly rejected them in its decision denying rehearing. *See* Ex-2001 at 8-12 (rejecting Petitioner’s allegations of “misrepresentations” and “doctored evidence” as baseless, explaining that the Board was not “misled,” and finding that Petitioner failed to demonstrate that any of the Board’s fact findings was in error).

The Board should not devote its limited resources to considering a follow-on petition that Petitioner admits presents the “same” grounds using “the same cited references and arguments” that the Board already rejected in IPR2024-00975 (*see* Paper 3 at 2-4), and grounds that the ITC will have resolved well before the Board would issue an FWD. The Director should discretionarily deny this Petition for three independent reasons: (1) as a follow-on petition under *General Plastic*; (2) under 35 U.S.C. § 325(d) and *Advanced Bionics*; and/or (3) under *Fintiv* based on the parallel ITC proceeding.

General Plastics - “multiple, staggered petition filings, such as those here, are an inefficient use of the *inter partes* review process and the Board’s resources” and “raise the potential for abuse” and unfairness to the patent owner. *General Plastic Industrial Co. v. Canon Kabushiki Kaisha* (“*General Plastic*”), IPR2016-01357, Paper 19 at 16-17 and 21 (Sept. 6, 2021) (precedential as to § II.B.4.i). The *General Plastic* factors strongly favor denying institution under 35 U.S.C.

§ 314(a). This follow-on Petition is from the same Petitioner and directed to the same claims of the same patent (Factor 1). Petitioner knew of the prior art asserted in this Petition when Petitioner filed its first petition (Factor 2) because Petitioner admits the two petitions present “the same” grounds using “the same cited references and arguments.” Paper 3 at 2-4. Petitioner also had the benefit of Patent Owner’s POPR (Ex-1026) and the Board’s decision denying institution (Ex-1027) in IPR2024-00975 before filing this Petition – they are attached as exhibits to this Petition (Factor 3). Petitioner waited nine months after filing its first petition before filing this Petition (Factor 4) and offers no adequate explanation for the delay given that the only purported justification Petitioner offers for filing this second Petition – that the Board was misled by “doctored evidence” and “misrepresentations” by Patent Owner in IPR2024-00975 – was expressly rejected by the Board in denying Petitioner’s rehearing request in the first IPR (Factor 5). *Compare* Paper 3 *with* Ex-2001. The Board should not waste its limited resources

re-considering “the same” grounds using the “the same cited references and arguments ... [that] were presented in petition IPR2024-00975” (Paper 3, 2-4) when the Board already denied institution of that prior petition on the merits (Factors 6 and 7). Considering Petitioner’s staggered second serially-filed petition would be a woefully “inefficient use of the *inter partes* review process and the Board’s resources” and would be unfair to patent owner. *General Plastic*, Paper 19 at 16-17 and 21. That is reason enough why this Petition should be discretionarily denied.

§ 325(d)/*Advanced Bionics* - this Petition should also be denied under 35 U.S.C. § 325(d) and *Advanced Bionics v. Med-El Elektromedizinische Geräte* (“*Advanced Bionics*”), IPR2019-01469, Paper 6 at 8 (Feb. 13, 2020) (precedential). Petitioner admits it previously presented to the Office “the same cited references *and* arguments” in IPR2024-00975 and that “*Advanced Bionics*, step 1 (*BD* factors (a), (b), (d)) is satisfied.”¹ Paper 3 at 2. Petitioner alleges that *Advanced Bionics* Step 2 favors institution because the Board “erred ... by relying on Patent Owner’s misrepresentations of the patent, its prosecution history and the prior art.” *Id.* at 3. Petitioner made the same arguments in its request for rehearing in IPR2024-00975. Ex-1028. The Board rejected Petitioner’s allegations of “misrepresentations” and

¹ All emphasis is added unless otherwise indicated.

“doctored evidence” as baseless and noted that Patent Owner only added “correct” expressly-identified “annotations” to exhibits. Ex-2001 at 8-12. The Board also explained that it could not have been “misled” because it only relied on the underlying evidence. *Id.* The Board denied the rehearing request because Petitioner “*fail[ed] to demonstrate we made clearly erroneous factual findings*” and noted that once again Petitioner failed to show “adequately that the asserted prior art teaches a ‘lateral transistor’” as claimed. *Id.* at 4. Petitioner’s purported showing of “error” fails because it based on nothing but blatant mischaracterizations of the record and the Board’s findings in IPR2024-00975, and because the Board already considered and rejected these arguments in denying Petitioner’s rehearing request. Institution should also be discretionarily denied under § 325(d) and *Advanced Bionics*.

Fintiv. Institution should be discretionarily denied based on the parallel ITC investigation under *Apple Inc. v. Fintiv, Inc.* (“*Fintiv*”), IPR2020-00019, Paper 11 at 8 (PTAB Mar. 20, 2020) (precedential). ITC Investigation No. 337-TA-1414 involves the same parties and Petitioner challenges validity of the ’481 Patent based on the same prior art and arguments as in the Petition. The ITC’s evidentiary hearing was already conducted the week of May 19, 2025. The ITC Administrative Law Judge (“ALJ”) will issue a Final Initial Determination by Oct. 30, 2025, and the ITC will issue a Final Determination by March 2, 2026. Both dates are long

before the September 2026 date on which an FWD would be due. A trial here would mean that multiple tribunals would “be adjudicating validity at the same time” which would “increase duplication and expenses for the parties and the tribunals.” *See* Ex-2013 at 2 (Memorandum from Chief Judge Boalick providing “Guidance on USPTO’s rescission of ‘Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation’”). The Director should discretionarily deny institution based on ITC Investigation No. 337-TA-1414 just as the Board did in IPR2025-00010. *Innoscence*, Paper 11.

II. THE BOARD HAS ALREADY REJECTED A PETITION FILED BY THE SAME PETITIONER PRESENTING THE SAME GROUNDS RELYING ON THE SAME PRIOR ART AND ARGUMENTS

Nine months ago, Petitioner filed a petition that challenged the same claims of the ’481 Patent based on the same grounds, relying on the same prior art and arguments. *Compare* Petition with Ex-1025 (petition in IPR2024-00975). The Board denied institution of that prior petition on the merits. Ex-1027. Petitioner then filed a request for rehearing. Ex-1028. While that rehearing request was pending, Petitioner filed this second Petition. Approximately one month after this second Petition was filed, the Board issued a decision denying Petitioner’s rehearing request. Ex-2001.

Petitioner admits that the “Grounds for challenging the claims of the ’481 patent for both petitions are the same” and that this Petition relies on “the same

cited references and arguments” as Petitioner’s first petition. Paper 3 at 2-4; *compare* Petition at 3 *with* Ex-1025 at 3.

Patent Owner could identify only three substantive differences between the petitions: (1) the Petition adds claim construction arguments about the proper meaning of a “lateral” transistor that were absent from the first petition; (2) the Petition adds argument that discretionary denial under *Fintiv* is not warranted because the Board allegedly erred in denying institution of the first petition due to alleged misrepresentations by the Patent Owner; and (3) the Petition adds argument that discretionary denial under *Fintiv* is not warranted because a named inventor allegedly admitted that dependent claim 5 is flawed. As explained in detail below, arguments (1)-(2) were already presented in Petitioner’s rehearing request in IPR2024-00975 and rejected by the Board (*see infra* §§ II.A and II.C) and argument (3) is moot because dependent claim 5 has been disclaimed (*see infra* § II.B).

None of these differences between the petitions warrant giving Petitioner a second bite at the apple. The Director should discretionarily deny institution as a follow-on petition under *General Plastic* (discussed *infra* § IV.A) rather than sending this case to a merits panel to have the Board consider Petitioner’s identical grounds a second time. That would be a waste of the Board’s limited resources.

A. Petitioner’s New Claim Construction Arguments Do Not Warrant a Second Petition

Petitioner alleges that this second serially-filed Petition is justified because the Board misconstrued the term “lateral transistor” in rejecting Petitioner’s first petition. Paper 3 at 2-4.² That assertion fails for three reasons detailed below:

(1) Petitioner’s new claim construction arguments about the meaning of “lateral transistor” result from improper road-mapping in an attempt to overcome the reason why Petitioner’s first petition was denied; (2) Petitioner could have made these arguments in its first petition but failed to do so; and (3) the Board already considered and rejected these same arguments in denying Petitioner’s request for rehearing of Petitioner’s first petition. These new claim construction arguments provide no reason to grant Petitioner a second bite at the apple and weigh heavily in favor of discretionary denial.

1. Petitioner’s New Claim Construction Arguments Use the Board’s Prior Decision as a Roadmap

Petitioner’s first petition provided no claim construction analysis for “lateral transistor” – or any other term – and instead argued that “[f]or the purposes of this IPR, the plain meaning of each term can be applied.” Ex-1025 at 3.

² Petitioner’s Paper 3 argued this in connection with 35 U.S.C. § 325(d), which is addressed *infra* § V.

In denying institution of Petitioner’s first petition, the Board found that “Petitioner does not show sufficiently that Nega [or Liu] teaches a lateral transistor” because the Board “*agree[d] with Patent Owner* that Petitioner has not shown sufficiently that Nega [or Liu] teaches a transistor in which current flows in a direction parallel to the surface, rather than in a direction normal to the surface.” Ex-1027 at 11 (Nega-based Grounds 1A-F) and 15-16 (Liu-based Grounds 2A-F).

Petitioner then filed a request for rehearing. Ex-1028. Petitioner’s rehearing request, as the Board found, presented new arguments (e.g., prosecution history disclaimer) and cited new evidence seeking to create a claim construction dispute about the meaning of “lateral” transistor by alleging that the location of transistor’s electrodes is what differentiates “lateral” and “vertical” transistors. Ex-2001 at 4-5. While its rehearing request was pending, Petitioner re-packaged those new claim construction arguments and included them in this second Petition. Petition, 24-25 (discussing what “*defines*” a transistor as “lateral” or “vertical” and alleging that “Patent Owner disclaimed ‘vertical’ transistors by *defining them based on the electrode locations*”); Paper 3 at 4 (arguing that the Petition’s “further discussion” of the meaning of “lateral transistor” warrants the filing of this second Petition). Approximately one month after Petitioner filed this second Petition, the Board rejected as “unpersuasive” Petitioner’s new claim construction arguments in its decision denying rehearing of Petitioner’s first IPR. Ex-2001 at 4-5.

As discussed *infra* § IV, inclusion of the new claim construction arguments in this second Petition favor discretionary because they lay bare that Petitioner seeks to use Patent Owner’s arguments and the Board’s decision in the first IPR as a roadmap in an attempt to avoid denial of Petitioner’s re-packaged second petition for the same reasons Petitioner’s first petition was denied.

Any suggestion from Petitioner that it did not engage in road-mapping, and that its new claim construction arguments simply “underscore[] the plain & ordinary meaning of the ‘lateral transistor’ element” argued in the first petition (Paper 3 at 3-4), is directly refuted by the findings the Board made in denying rehearing of Petitioner’s first petition. The Board found that the first Petition argued that no claim terms required construction and “at most obliquely suggested that a lateral transistor is one in which current flows in a ‘lateral drift path.’” Ex-2001 at 4-5 (quoting Ex-1025 at 24 and citing Ex-1025 at 3, which states “[f]or the purposes of this IPR, the plain meaning of each term can be applied”). The Board then found that Petitioner’s rehearing request newly argued that (1) “the ‘**481 patent** provides an explicit construction of a lateral transistor ‘***defined [solely] by the location of the electrodes***’” and (2) “Patent Owner made a ***prosecution disclaimer*** that ‘electrode location should have impacted how the lateral transistor term was construed.’” Ex-2001 at 5 (quoting Ex-1028 at 4-6). Petitioner re-used these same new claim construction arguments in its second Petition. Petition at 24-

25 (alleging that “[t]he *’481 patent defines* a transistor” as lateral or vertical “based on (1) current drift path and (2) the *electrode placement*” and that a *prosecution “disclaime[r]”* supports this). As the Board found, these were “new” claim construction arguments never raised in Petitioner’s first petition. Ex-2001 at 5.³

As the Board’s above-discussed fact findings make clear, Petitioner seeks to use Patent Owner’s arguments and the Board’s decision in the first IPR as a roadmap in an attempt to avoid denial of Petitioner’s re-packaged second petition for the same reasons Petitioner’s first petition was denied.

³ Petitioner’s new claim construction arguments alleging that electrode placement determines whether a transistor is a “lateral transistor”— rather than the direction of current flow – attempt to overcome the reason the Board found that Petitioner’s first petition failed. Ex-1027 at 11 and 15-16 (“Petitioner has not shown sufficiently that Nega [or Liu] teaches a transistor in which *current flows* in a direction parallel to the surface, rather than in a direction normal to the surface.”).

**2. The Board Could Not Have Erred by Failing to Accept
Petitioner’s New Claim Construction Arguments Because
They Were Never Raised in the First Petition**

In trying to justify this second serially-filed Petition, Petitioner argues that “the ’481 patent definitively *defines* a ‘lateral transistor’” in a particular way and that the Patent Owner “disclaimed” a broader ordinary meaning during prosecution. Paper 3 at 3-4; Petition at 24-25. That is irreconcilably inconsistent with what Petitioner said to the Board in its first petition, which was that “[f]or the purposes of this IPR, the plain meaning of each term can be applied.” Ex-1025 at 3. The same claim term cannot be both entitled to its “plain meaning” and be a term “defined” in the specification and subject to a “disclaimer” that limits the scope of the term under its plain meaning.

Based on this, the Board correctly found that Petitioner’s claim construction arguments alleging that “lateral transistor” was a “defined” term in the patent and the subject of a prosecution “disclaimer” that limited a “lateral transistor” to being defined by electrode placement were never raised in Petitioner’s first petition. Ex-2001 at 5. As discussed in greater detail *infra* § V.B.2 in connection with Petitioner’s failure to show that the Board materially erred under *Advanced Bionics* step 2 in connection with considerations under § 325(d), Petitioner cannot establish that the Board erred by failing to consider a claim construction argument that the first Petition never made.

3. The Board Already Considered and Rejected Petitioner's New Claim Construction Arguments

Despite finding that Petitioner's claim construction arguments were not properly raised in the first Petition, the Board considered and rejected them on the merits in denying Petitioner's rehearing request. Ex-2001 at 5-8 ("Even if we were to consider this [new claim construction] argument ... we would find it unpersuasive in showing that our Decision was clearly erroneous on this issue.").

The Petition purports to support its argument that the "'481 patent defines a transistor—either a 'lateral' or 'vertical' transistor—based on (1) the current drift path and (2) the electrode placement" by citing the '481 Patent's disclosure that "lateral" means "a direction or extent that runs generally parallel to the lateral extent of a semiconductor material or semiconductor carrier" (Ex-1001 at 3:14-18) and its disclosure of "a lateral device which has a lateral drift path" (*id.* at 4:37-41). Petition at 24-25. The Petition also cites an embodiment of a lateral transistor with all the electrodes on the same side and an embodiment of a vertical transistor with electrodes on opposite sides. *Id.* (citing Ex-1001 at 5:56-6:3).

The Board considered this same evidence and claim construction argument in rejecting Petitioner's request for rehearing of Petitioner's first petition. Ex-2001 at 5-8. The Board noted that its decision denying institution "***rejected Petitioner's contention*** that placing the electrodes and gate on the same lateral plane of a transistor necessarily results in a lateral transistor." Ex-2001 at 5-6. As the Board

correctly found, Petitioner’s evidence “shows that transistors with their electrodes all located on a single surface *may* be lateral transistors, *not* that such an electrode location *necessarily* indicates that a transistor is lateral.” *Id.* at 6. The Board considered the ’481 Patent’s embodiments but correctly found that the ’481 Patent does not disclose that a transistor with electrodes all on one side is “necessarily” a lateral transistor, particularly “in light of the other evidence of record” showing that a vertical transistor can also have all of its electrodes on the same side. *Id.* at 6-7 (citing evidence).

The Board also considered and rejected “Petitioner’s newly cited evidence in the prosecution history” and Petitioner’s “prosecution disclaimer” argument. *Id.* at 7 (“we do not reach the same conclusion” that Petitioner argues for in view of the prosecution history). The Board “agree[d] with Petitioner” that statements in the prosecution history “could be interpreted as suggesting that the placement of a transistor’s electrodes on a single surface or on opposing surfaces might be an indicator of whether a transistor is lateral or vertical” but rejected Petitioner’s argument that there was a disclaimer of claim scope. *Id.* Instead, the Board found that “[i]n light of all the other evidence of record to the contrary ... we do not interpret this language as stating either that electrode location is the *sole* determinant of a transistor’s lateral or vertical nature *or that all transistor devices with their electrodes on a single surface necessarily are lateral transistors.*” *Id.*

The Board concluded by finding that none of the new claim construction arguments and evidence Petitioner advanced in its rehearing request – which mirror the new arguments and evidence in this second Petition – persuaded the Board that they got it wrong in finding that a “lateral transistor” is a “transistor in which current flows in a direction parallel to the surface of the transistor.” *Id.* at 8.

Thus, Petitioner’s new claim construction argument and evidence was already expressly considered and rejected by the Board during the first IPR. Petitioner’s re-packaging of this argument in this second Petition provides no justification for Petitioner to get a second bite at the apple, or for the Board to devote its limited resources to reconsidering the same arguments and evidence the Board rejected just a few months ago.

B. “New” Inventor Testimony Is Irrelevant Because It Only Relates to a Disclaimed Claim

The Petition alleges that discretionary denial under *Fintiv* is not warranted because a named inventor allegedly admitted that dependent claim 5 “should never have issued.” Petition at 111-112. Petitioner also alleges that submission of this testimony⁴ warrants the filing of this second Petition so that the Board “may

⁴ The Board was aware of this deposition testimony from the ITC investigation before issuing its decision on rehearing. *See* Ex-2018.

consider the Grounds in light of the new named-inventor testimony and address errors pertaining to the patentability of the challenged claims.” Paper 3 at 4-5.

1. The Testimony Petitioner Cites Only Relates to a Disclaimed Dependent Claim

Claim 5 recites the claimed compound semiconductor device as being a “vertical transistor,” whereas claim 1 – from which claim 5 depends – recites the claimed compound semiconductor device as being a “lateral transistor.” Ex-1001 at 15:64-67 and 16:15-18. That was an artifact of an amendment made during prosecution whereby independent claim 1 was narrowed to be limited to a lateral transistor. Ex-1002 at 26. Patent Owner has now disclaimed claim 5. Ex-2002. The inventor’s testimony about claim 5 is moot. It cannot justify Petitioner getting a second bite at the apple, or the Board devoting its limited resources to reconsidering this Petition that presents the “same” grounds based on the “same cited references and arguments” as Petitioner’s already-rejected first petition. Paper 3 at 2-4.

2. The Inventor’s Testimony on the Meaning of “Lateral Transistor” is Consistent with the Board’s Finding

While the rehearing request was pending, Petition engaged in meet and confer with Patent Owner and alleged that there was testimony in the transcript (Ex-1030) of the inventor’s testimony before the ITC that was inconsistent with arguments that Patent Owner had advanced during the IPR. *See* Ex-2018. That is

plainly wrong. *Id.* But given that Patent Owner had nothing to hide, Patent Owner informed Petitioner that it had no objection to the transcript being provided to the Board if the Board thought it might be relevant. Patent owner lightly redacted the confidential transcript and served it on Petitioner so that Petitioner could seek leave from the Board to submit the transcript.

The Board was made aware of this via emails, attached as Ex-2018. After Petitioner emailed the Board and included arguments about cherry-picked snippets of the inventor's testimony, Patent Owner provided a responsive email that cited other portions of the inventor's testimony, revealing that the inventor's testimony was consistent with Patent Owner's arguments and the Board's findings in denying Petitioner's first IPR. *Id.* Unsurprisingly, the Board never asked either party to submit the deposition transcript before denying Petitioner's baseless rehearing request.

The inventor's testimony before the ITC provides no justification for Petitioner to file this second serially-filed Petition that presents the "same" grounds based on "the same cited references and arguments" as Petitioner's failed first petition. Paper 3 at 2-4.

C. The Board Has Already Rejected Petitioner’s Baseless Assertions that Patent Owner Misrepresented and Doctored the Evidence and Explained that the Board Was Not Misled into Denying Petitioner’s First Petition

The Petition supplements the first petition’s assertion that *Fintiv* factor 6 does not favor discretionary denial by alleging that the Board erred in denying the first petition “by relying on Patent Owner’s misrepresentations of the patent, its prosecution history, and the prior art.” Petition at 111-112 (alleging that “the sole reason for denying the original IPR was based on misrepresentations by the Patent Owner.”).

In its Paper purporting to explain why Petitioner filed multiple petitions, Petitioner similarly alleges that its second serially-filed⁵ Petition is warranted because the Board “erred” in denying Petitioner’s “same” grounds the first time around after being “misled” by “misrepresentations of the patent, its prosecution history, and the prior art” and “doctored evidence.” Paper 3 at 2-4. But as detailed below, the Board flatly rejected every one of these allegations. The Board found that “Patent Owner did not, in Petitioner’s words, ‘doctor’ or ‘alter’ any evidence” and indeed only added annotations that the Board found to be “correct.” Ex-2001

⁵ Paper 3’s title mischaracterizes the two *serially*-filed petitions as “PARALLEL PETITIONS.”

at 10. The Board also explained that it relied only on the underlying evidence, rather than Patent Owner’s annotations, and was not “misled.” *Id.* at 10-11.

Despite the extraordinary accusations that Petitioner now makes about the POPR filed in IPR2024-00975, Petitioner never sought a pre-institution reply to address any of the alleged “doctored evidence” or “misrepresentations” in the POPR. It was only after its first IPR was denied institution that Petitioner concocted these baseless allegations in a desperate attempt to resurrect its failed IPR. Petitioner first presented these accusations in its rehearing request filed in IPR2024-00975 on January 10, 2025. Ex-1028. While its rehearing request was pending, Petitioner used these baseless accusations again in Paper 3 (filed March 13, 2025) seeking to justify this second Petition. About a month later, the Board rejected each and every one of these arguments in its decision denying rehearing in IPR2024-00975 on April 14, 2025. *See* Ex-2001.

Petitioner cannot refute that its rehearing request advanced these same baseless arguments that the Board was “misled” by “doctored evidence” and alleged misrepresentations of the record – they were the focus of Petitioner’s rehearing request. *See e.g.*, Ex-1028 at Table of Contents (alleging that “Infineon Misrepresented and Doctored Evidence” which caused the Board to “Misapprehend the Record”). In denying Petitioner’s rehearing request, the Board addressed “Petitioner’s Contention that Patent Owner Mischaracterized the

'481 Patent and Prosecution History" (Ex-2001 at 4-8) and "Petitioner's Contention that Patent Owner Misrepresented the Prior Art" (*id.* at 8-12), including more specifically "Petitioner's Accusation that Patent Owner 'Doctored' Exhibit 2002" (*id.* at 8-10), "Petitioner's Argument that Patent Owner 'Omitted Teachings' from Exhibit 2003" (*id.* at 10-12), and "Petitioner's Argument that Patent Owner Misrepresented Liu" (*id.* at 12).

Time and again, the Board rejected Petitioner's baseless assertions that Patent Owner mischaracterized the record and "doctored" evidence and explained that the Board relied on the underlying evidence and was not "misled" by anything. *Id.* at 4-12; *see e.g. id.* at 4 ("Petitioner's [Rehearing] Request ... fails to demonstrate that we made clearly erroneous fact findings with respect to the construction of a 'lateral transistor'" or that "Petitioner showed adequately that the asserted prior art teaches a 'lateral transistor'"); 5-8 (analyzing the '481 Patent and the prosecution history and rejecting Petitioner's claim construction and disclaimer arguments for the reasons discussed *supra* § II.A), 8-10 (noting with respect to Ex. 2002 of the first petition that "Petitioner accuses Patent Owner nine times of 'doctoring' ... the evidence" but finding that "contrary to its arguments, Petitioner has not identified any changes Patent Owner made to the actual evidence" because Patent Owner simply annotated a figure, acknowledged that the figure was annotated, and the Board found the annotations to be "correct"), 10 (finding that

the Board was not “misled” by Patent Owner’s annotations and based its “conclusion” on Ex. 2002 itself), 10-12 (rejecting Petitioner’s assertion that Patent Owner “omitted” teachings from Ex. 2003 of the first petition as “unpersuasive for essentially the same reasons discussed above with respect to Petitioner’s argument about Exhibit 2002” because the annotations were not “misleading” and noting that the Board based its decision on the underlying evidence and was not “misled”), 12 (rejecting Petitioner’s argument that Patent Owner misrepresented Liu because Petitioner’s argument was based on Petitioner’s claim construction argument that the Board rejected).

D. Conclusion: The Justifications Petitioner Advanced for Its Second Serially-Filed Petition Fail

As demonstrated above, none of the modifications Petitioner made to its first petition justify this second serially-filed Petition. An application of the Board’s precedent demonstrates that this Petition should be discretionarily denied for multiple independent reasons.

III. DISCRETIONARY DENIAL CONSIDERATIONS

Instituting a petition under § 314(a) is “a matter committed to the Patent Office’s discretion.” *Cuozzo Speed Techs., LLC v. Lee*, 579 U.S. 261, 273 (2016); *see also Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1367 (Fed. Cir. 2016) (under § 314(a) “the PTO is permitted, but never compelled, to institute an IPR proceeding”).

The recently issued Director’s Memorandum makes clear that the Director will continue to consider the “discretionary considerations enumerated in existing Board precedent (including *Fintiv*, *General Plastic*, and *Advanced Bionics*).” Ex-2003 at 2. The Director’s Memorandum notes that “the parties are permitted to address all relevant considerations, which may include:

- Whether the PTAB or another forum has already adjudicated the validity or patentability of the challenged patent claims;
- Whether there have been changes in the law or new judicial precedent issued since issuance of the claims that may affect patentability;
- The strength of the unpatentability challenge;
- The extent of the petition's reliance on expert testimony;
- Settled expectations of the parties, such as the length of time the claims have been in force;
- Compelling economic, public health, or national security interests; and
- Any other considerations bearing on the Director’s discretion.”

Id. at 2-3.

A straightforward application of the discretionary considerations enumerated in each of the three precedential Board cases the Director’s Memorandum references – *Fintiv*, *General Plastic*, and *Advanced Bionics* – reveals that this Petition should be discretionarily denied under any and all of those cases.

IV. PETITIONER’S FOLLOW-ON PETITION SHOULD BE DENIED UNDER *GENERAL PLASTIC*

Petitioner cannot avoid *General Plastic* by mischaracterizing its first and second petitions as “Parallel Petitions.” Paper 3 (title). This Petition is a second *serially*-filed petition that Petitioner admits presents the “same grounds” using the “same cited references and arguments” that the Board already rejected in Petitioner’s first-filed petition in IPR2024-00975. Paper 3 at 2 and 4. This follow-on Petition should be discretionarily denied under 35 U.S.C. § 314(a) and the Board’s precedential *General Plastic* decision.

Petitioner filed its first petition in IPR2024-00975 nine months before this second Petition and challenged the same claims of the same patent using the same grounds. The Board was persuaded by arguments presented by Patent Owner in Petitioner’s first IPR and denied institution on the merits. *See supra* § II and Ex-1027 at 11, 15-16 (the Board “*agree[d] with Patent Owner* that Petitioner has not shown sufficiently that Nega [or Liu] teaches a transistor in which current flows in a direction parallel to the surface, rather than in a direction normal to the surface”).

In this follow-on Petition, Petitioner modified its first petition to include a new claim construction argument about “lateral transistor” in an attempt to overcome the deficiency that Patent Owner identified in the first petition and that the Board credited in denying institution of Petitioner’s first petition. *See supra*

§ II.A and Petition at 24-25. This follow-on Petition should be discretionarily denied.

A. The *General Plastic* Factors Favor Discretionary Denial

General Plastic lists several factors the Board considers in evaluating whether to exercise discretion under 35 U.S.C. § 314(a) to deny a follow-on petition challenging a previously-challenged patent. *General Plastic* at 16. Those factors are:

1. whether the same petitioner previously filed a petition directed to the same claims of the same patent;
2. whether at the time of filing of the first petition the petitioner knew of the prior art asserted in the second petition or should have known of it;
3. whether at the time of filing of the second petition the petitioner already received the patent owner's preliminary response to the first petition or received the Board's decision on whether to institute review in the first petition;
4. the length of time that elapsed between the time the petitioner learned of the prior art asserted in the second petition and the filing of the second petition;
5. whether the petitioner provides adequate explanation for the time elapsed between the filings of multiple petitions directed to the same claims of the same patent;
6. the finite resources of the Board; and

7. the requirement under 35 U.S.C. § 316(a)(11) to issue a final determination not later than 1 year after the date on which the Director notices institution of review.

Id.

The Director should discretionarily deny this Petition under § 314(a) because the *General Plastic* factors overwhelmingly favor denial.

1. Factor 1: The Same Petitioner Previously Filed a Petition Directed to the Same Claims of the Same Patent

Factor 1 is met because the same petitioner, Innoscience America, Inc., previously filed a petition directed to the same claims 1-17 of the same '481 Patent. *Compare* Petition with Ex-1025.

2. Factor 2: Petitioner Knew of the Art Asserted in the Present Petition Because Petitioner Admits that the Grounds and “Cited References” are “the Same”

Factor 2 is met because at the time Petitioner filed its first petition in IPR2024-00975, Petitioner indisputably knew of the prior art asserted in this second Petition because Petitioner admits that the grounds and “cited references” used in the two petitions “are the same.” Paper 3 at 2-4.

3. Factor 3: Petitioner Had the PPOR and the Board’s Decision Denying Institution of its First Petition When Filing this Follow-On Petition

Factor 3 is met because Petitioner had the benefit of Patent Owner’s preliminary response to the petition in IPR2024-00975 and the Board’s decision

denying institution of that petition before filing this second Petition. Indeed, Petitioner attached both as exhibits to this Petition. *See* Ex-1026 and Ex-1027.

Petitioner used Patent Owner's arguments and the Board's decision in IPR2024-00975 as a roadmap by including in this follow-on Petition a new claim construction argument about "lateral transistor" in an attempt to overcome a deficiency that Patent Owner identified and that the Board credited in denying institution of Petitioner's first petition. *See supra* § II.A and Petition at 24-25. Under *General Plastic*, that is reason enough why this follow-on Petition should be discretionarily denied:

[*General Plastic*] factor 3 is directed to Petitioner's potential benefit from receiving and having the opportunity to study Patent Owner's Preliminary Response, as well as our institution decisions on the first-filed petitions, prior to its filing of follow-on petitions. As discussed in our Decisions Denying Institution, we are concerned here by the shifts in the prior art asserted and the related arguments in follow-on petitions. *See* Dec. 11. Multiple, staggered petitions challenging the same patent and same claims raise the ***potential for abuse***. The absence of any restrictions on follow-on petitions would allow petitioners the opportunity to strategically stage their prior art and arguments in multiple petitions, ***using our decisions as a roadmap***, until a ground is found that results in the grant of review. **All other factors aside, this is unfair to patent owners and is an inefficient use of the inter partes review process and other post-grant review processes.**"

General Plastic at 17-18.

4. Factor 4: Petitioner Waited Nine Months Before Filing this Follow-On Petition

Factor 4 is met because the length of time that elapsed between the time Petitioner learned of the prior art asserted in the second petition and the filing of the second petition is at least nine months. Petitioner learned of the prior art before filing its first petition on June 14, 2024 (Ex-1025) and did not file this Petition until March 13, 2025, nine months later. Petition at 114; *Apple Inc. v. Koss Corporation*, IPR2022-00053, Paper 10, 12 (April 4, 2022) (“Petitioner was aware of the prior art asserted here at least by the time Bose filed the IPR612 Petition on March 3, 2021 — more than seven months prior to filing the present Petition. ... We conclude that, given the unexplained seven-month delay, this fourth *General Plastic* factor weighs in favor of denying institution of the proceeding.”).

5. Factor 5: Petitioner Offers No Acceptable Explanation for the Delay

Factor 5 is met because Petitioner can offer no acceptable explanation for the delay. As discussed *supra* § II, Petitioner’s paper that purports to provide “reasons” justifying the filing of this second Petition alleges that this second Petition is warranted because “the Board erred in a manner material to the patentability of the challenged claims [in denying Petitioner’s first petition] by relying on Patent Owner’s misrepresentations of the patent, its prosecution history,

and the prior art.” Paper 3 at 1. That alleged reason fails because, as explained *supra* § II.C, the Board’s decision denying rehearing of Petitioner’s first petition rejected every one of these assertions.

The only other “reason” Petitioner offered to justify the filing of this second follow-on Petition was that “the named-inventor acknowledge[ed] that at least claim 5 should never have issued.” Paper 3 at 1. That reason is moot because claim 5 has been disclaimed. *See supra* § II.B.

6. Factors 6 and 7: It Would Be Inefficient for the Board to Have a Trial that Reconsiders Grounds Already Rejected by the Office

Under *General Plastic* factors six and seven, the Board considers “the finite resources of the Board” and “the requirement under 35 U.S.C. § 316(a)(11) to issue a final determination not later than 1 year after the date on which the Director notices institution of review.” *General Plastic* at 16. “The sixth and seventh factors are efficiency considerations.” *Videndum Production Solutions, Inc. v. Rotolight Limited*, IPR2023-01218, Paper 9 (“*Videndum*”) at 17 (Jan. 25, 2024) (citing the Nov. 2019 Consolidated Trial Practice Guide, 56).

“[H]aving multiple petitions challenging the same patent, especially when not filed at or around the same time as in this case, is *inefficient and tends to waste resources*.” *Id.* “[A]llow[ing] petitioners the opportunity to strategically stage their prior art and arguments in multiple petitions, using our decisions as a

roadmap, until a ground is found that results in the grant of review ... is an *inefficient* use of the inter partes review process and other post-grant review processes.” *General Plastic* at 17-18.

Devoting the Board’s finite resources to considering the merits of Petitioner’s follow-on Petition that presents the “same” grounds (Paper 3 at 4) relying on the “same cited references and arguments” (*id.* at 2) that the Board already considered in denying IPR2024-00975 would be “an inefficient use of the inter partes review process.” *General Plastic* at 17-18.

B. Conclusion: the *General Plastic* Factors Favor Denial of Institution

It is difficult to imagine a more egregious example of a follow-on petition that warrants discretionary denial that this Petition in which Petitioner seeks a second bite at the apple using the “same” grounds (Paper 3 at 4) relying on the “same cited references and arguments” (*id.* at 2) that the Board already rejected, and with a modified claim construction argument that uses the Patent Owner’s prior arguments and the Board’s prior decision as a roadmap in an attempt to evade the reason why Petitioner’s first petition was denied. This Petition should be discretionarily denied under *General Plastic* and § 314(a).

V. THE DIRECTOR SHOULD DISCRETIONARILY DENY THIS PETITION UNDER 35 U.S.C. § 325(D)

Petitioner concedes that this second serially-filed Petition presents “the same” grounds based on “the same cited references and arguments” that Petitioner presented to the Office in its first petition. Paper 3 at 2-4. The Director should deny institution under 35 U.S.C. § 325(d).

A. The Statute Provides the Director with Discretion to Deny this Petition and *Advanced Bionics* Provides the Framework the Board Has Applied in Determining Whether to Exercise Such Discretion

In § 325(d), Congress was explicit that “[i]n determining whether to institute or order a[n IPR] proceeding ... the Director may take into account whether, and *reject the petition* or request *because, the same or substantially the same prior art or arguments previously were presented to the Office.*”

Petitioner acknowledges that the Board’s leading caselaw on the application of § 325(d) is *Advanced Bionics* (Paper 3 at 2), and the Director recently confirmed that this precedent will be applied in her discretionary denial determinations.

Director’s Memorandum at 2. *Advanced Bionics* explains that:

under § 325(d), the Board uses the following two-part framework: (1) whether the same or substantially the same art previously was presented to the Office or whether the same or substantially the same arguments previously were presented to the Office; and (2) if either condition of first part of the framework is satisfied, whether the

petitioner has demonstrated that the Office erred in a manner material to the patentability of challenged claims.

Advanced Bionics at 8.

Step 1 derives directly from the statute and requires a determination of “whether the same or substantially the same art previously was presented to the Office or whether the same or substantially the same arguments previously were presented to the Office.” When Step 1 is met, the analysis proceeds to *Advanced Bionics* Step 2, which requires a showing by the petitioner of a material error in the Office’s prior evaluation. “At bottom, this framework reflects a commitment to defer to previous Office evaluations of the evidence of record unless material error is shown.” *Id.* at 9.

In evaluating *Advanced Bionics* Step 1, the Board considers *Becton, Dickinson*⁶ factors (a)-(b) and (d), and in evaluating *Advanced Bionics* Step 2 the Board considers *Becton, Dickinson* factors (c) and (e)-(f), because these factors provide “useful insight into how to apply the framework under 35 U.S.C. § 325(d).” *Advanced Bionics* at 9.

⁶ See *Becton, Dickinson v. B. Braun Melsungen* (“*Becton, Dickinson*”), IPR2017-01586, Paper 8 (Dec. 15, 2017) (precedential as to § III.C.5, first paragraph) .

Advanced Bionics characterizes the *Becton Dickinson* factors (hereafter the “*BD* factors”) as follows:

- (a) the similarities and material differences between the asserted art and the prior art involved during examination;
- (b) the cumulative nature of the asserted art and the prior art evaluated during examination;
- (c) the extent to which the asserted art was evaluated during examination, including whether the prior art was the basis for rejection;
- (d) the extent of the overlap between the arguments made during examination and the manner in which petitioner relies on the prior art;
- (e) whether petitioner has pointed out sufficiently how the examiner erred in its evaluation of the asserted prior art; and
- (f) the extent to which additional evidence and facts presented in the petition warrant reconsideration of the prior art or arguments.

Advanced Bionics at 9 (footnote 10).

Advanced Bionics is explicit that a discretionary denial consideration under § 325(d) may be triggered when the same prior art was previously presented to the office during an “*AIA post-grant proceeding*” involving the challenged patent.”

Advanced Bionics at 8.

B. Application of the *Advanced Bionics* Framework Reveals that this Petition Should be Discretionarily Denied Under § 325(d)

As explained below, a straightforward application of the *Advanced Bionics* framework makes clear that this Petition should be discretionarily denied because Petitioner concedes that Step 1 is met and Petitioner cannot carry its burden to show material error under Step 2.

1. Petitioner Admits that *Advanced Bionics* Step 1 Is Met

While presenting either the same prior art or the same arguments to the Office a second time would suffice to meet § 325(d) and *Advanced Bionics* Step 1, Petitioner concedes that this Petition does ***both***. Thus, as Petitioner expressly concedes, *Advanced Bionics* step 1 is met. Paper 3 at 2 (“Advanced Bionics, step 1 (BD factors (a), (b), (d)) is satisfied as the ***same cited references and arguments*** in this petition were presented in petition IPR2024-00975, which the Board denied institution”); *compare* Petition at 3 with Ex-1025 at 3.

2. *Advanced Bionics* Step 2 Is Met Because Petitioner Cannot Make the Required Showing of Material Error

When *Advanced Bionics* Step 1 is satisfied, “then the Board’s decisions generally have ***required*** a showing that the office erred in evaluating the art or arguments” and “the Director generally will exercise discretion not to institute *inter partes* review” when “the petitioner fails to make a showing of material error.” *Advanced Bionics* at 8-9.

Step 2 evaluates *BD* factors (c), (e), and (f) which relate to whether the petitioner has demonstrated a material error by the Office. *Advanced Bionics* at 10. These *BD* factors all favor denial because: **(c)** the Board extensively analyzed the same grounds relying on the same prior art and arguments in IPR2024-00975; **(e)** Petitioner fails to establish that the Board materially erred in its evaluation of the same grounds because Petitioner already filed a rehearing request alleging the same errors and the Board expressly rejected them; and **(f)** Petitioner cites no additional evidence or facts warranting reconsideration of the same grounds a second time.

a. Factor (c): The “Same” Grounds Were Evaluated by the Board in Petitioner’s Prior Petition

Factor (c) evaluates “the extent to which the asserted art was evaluated during examination, including whether the prior art was the basis for rejection.” Here, Petitioner admits that “the same cited references and arguments in this petition were presented in petition IPR2024-00975, which the Board denied institution.” Paper 3 at 2; *see also id.* at 4 (“The Grounds challenging the claims of the ’481 patent for both petitions are the same”).

The Board carefully evaluated this same “asserted art” during IPR2024-00975 and wrote a well-reasoned eighteen-page decision explaining why Petitioner’s “same” grounds failed. Ex-1027.

Petitioner then requested rehearing and presented the new claim construction argument advanced in the Petition and the same arguments that Paper 3 presents to purportedly establish that the Board erred in its first evaluation of the same “asserted art.” Ex-1028; *see supra* § II.C (establishing that the arguments alleging error in Paper 3 were included in the rehearing request). The Board again carefully evaluated Petitioner’s arguments about this same “asserted art” and wrote a well-reasoned thirteen-page decision rejecting Petitioner’s arguments. Ex-1027. In denying Petitioner’s rehearing request, the Board explained that Petitioner’s allegations of error were misplaced because they were based on a new claim construction argument not advanced in Petitioner’s first petition. *See supra* § II.A; Ex-2001 at 4-5. But the Board went further than it needed to and considered Petitioner’s new arguments and cited evidence before finding that they failed on the merits. *See supra* § II.A; Ex-2001 at 5-8.

Thus, the same prior art and arguments that Petitioner presents in this Petition were extensively “evaluated” by the Office during IPR2024-00975. Factor (c) strongly favors discretionary denial.

b. Factor (e): Petitioner Fails to Establish that the Office Materially Erred in its Prior Evaluation

BD factor (e) evaluates “whether petitioner has pointed out sufficiently how the [Office] erred in its evaluation of the asserted prior art.” *Advanced Bionics* at 9.

Petitioner's allegations that the Office materially erred in its evaluation of the asserted art fail for two reasons discussed below.

i. The Board Could Not Have Erred in Not Accepting Petitioner's Claim Construction Argument Because It Was Not Presented in the IPR2024-00975 Petition

Petitioner alleges that the Board "erred" in denying Petitioner's "same" grounds the first time around because the Board erred in its claim construction of "lateral transistor" after being "misled" by "misrepresentations of the patent [and] its prosecution history" in Patent Owner's POPR in IPR2024-00975. Paper 3 at 2-4. These very same arguments were advanced in Petitioner's rehearing request in IPR2024-00975.

As the Board explained in denying Petitioner's rehearing request, Petitioner's accusations that Patent Owner mischaracterized the '481 Patent and the prosecution history were advanced to create a "claim-construction dispute [about the meaning of lateral transistor] where none existed previously." Ex-2001 at 4-5. The Board correctly found that Petitioner did not timely raise any arguments that "lateral transistor" was a "defined" term in the '481 Patent and the subject of a prosecution "disclaimer." *Id.* ("Petitioner failed to adequately raise

this claim-construction dispute in its Petition” and failed to request a preliminary reply to the POPR).⁷

The Board’s rules govern “Content” a petition “must” have. *See e.g.*, 37 C.F.R. § 42.104. Among the required content, a petition “must” identify “[h]ow the challenged claim is to be construed” and “[h]ow the construed claim is unpatentable.” 37 C.F.R. § 42.104 (b)(3)-(4). Thus, it was Petitioner’s obligation in its first petition to explain how the term “lateral transistor” was to be construed. As the Board’s findings in its rehearing decision make clear, the Board could not have “erred” in denying institution in IPR2024-00975 by failing to construe “lateral transistor” in the manner that Petitioner now advocates because “Petitioner failed to adequately raise this claim-construction dispute in its Petition” and never even sought a preliminary reply to the POPR to raise this issue. Ex-2001 at 5.

⁷ The Board also noted that Petitioner’s allegations that the POPR “doctored” evidence and misrepresented the “prior art” were also not timely raised and noted that “Petitioner could have requested leave to submit a preliminary reply to Patent Owner’s Preliminary Response addressing this issue but chose not to do so.” Ex-2001 at 9.

After failing to persuade the Board that its grounds render the claims unpatentable when “lateral transistor” is given its “plain meaning” as Petitioner’s first petition proposed (Ex-1025 at 3), Petitioner appears to have buyer’s remorse and wishes it had argued for a different claim construction. But Petitioner cannot demonstrate that the Board committed material error by applying the “plain meaning” construction that Petitioner’s first petition advocated for, rather than a different construction (based on an alleged “disclaimer” and definition in the ’481 Patent) that Petitioner never timely put before the Board during IPR2024-00975.

**ii. The Board Fully Considered and Rejected
Petitioner’s New Arguments and its Rehearing
Decision Refutes Petitioner’s Allegations of Error**

As explained *supra* § II.A.3, in addition to finding Petitioner’s arguments that mirror its accusations of error here untimely, the Board went ahead and considered them on the merits anyway. The Board made detailed findings that refute every one of the accusations of “error” in Paper 3. *See supra* § II.A.3.

The Board considered and rejected “Petitioner’s Contention that Patent Owner Mischaracterized the ’481 Patent and Prosecution History” (Ex-2001 at 4-8) and “Petitioner’s Contention that Patent Owner Misrepresented the Prior Art” (Ex-2001 at 8-12), including “Petitioner’s Accusation that Patent Owner ‘Doctored’ Exhibit 2002” (Ex-2001 at 8-10), “Petitioner’s Argument that Patent

Owner ‘Omitted Teachings’ from Exhibit 2003” (Ex-2001 at 10-12), and “Petitioner’s Argument that Patent Owner Misrepresented Liu” (Ex-2001 at 12).

The Board flatly rejected Petitioner’s baseless assertions that Patent Owner mischaracterized the record and “doctored” evidence, explaining that the Board relied on the underlying evidence and was not “misled” by anything. *Id.* at 4-12; *see also supra* § II.C.

BD Factor (e) strongly favors denying institution because Petitioner cannot establish that the Board erred in a manner material to patentability. That Petitioner disagrees with the Board’s findings does not establish error. As *Advanced Bionics* makes clear: “If reasonable minds can disagree regarding the purported treatment of the art or arguments, it cannot be said that the Office erred in a manner material to patentability. At bottom, this framework reflects a commitment to defer to previous Office evaluations of the evidence of record unless material error is shown.” *Advanced Bionics*, 9.

The Director should defer to the Board’s previous evaluation of the “same” grounds in IPR2024-00975 and discretionarily deny this Petition. It would be a waste of the Board’s limited resources to have the merits panel review Petitioner’s grounds a second time, particularly given that the panel has already expressly rejected all of Petitioner’s arguments alleging error.

c. Factor (f): Petitioner Cites No Additional Evidence Warranting Reconsideration

Factor (f) considers “the extent to which additional evidence and facts presented in the petition warrant reconsideration of the prior art or arguments.” *Becton, Dickinson* at 18, 25-28. This factor also weighs heavily in favor of denial. In addition to relying on the “same” grounds using the “same cited references and arguments” as in Petitioner’s failed first petition (Paper 3 at 2-4), Petitioner relies on a declaration from the same expert who offers substantively the same testimony offered in Petitioner’s failed first petition. *Compare* Ex-1003 (Lebby Declaration attached to this Petition) *with* Ex-2019 (Lebby Declaration attached to the petition in IPR2024-00975). And as discussed *supra* § II, none of the minor differences between the petitions can avoid factor (f) weighing strongly in favor of discretionary denial because none of this is “additional” relevant⁸ evidence beyond what the Board already considered in denying Petitioner’s first failed petition and rejecting Petitioner’s request for rehearing in IPR2024-00975. *BD* factor (f) weighs strongly in favor of denying institution.

⁸ The inventor testimony about dependent claim 5 is not relevant because claim 5 has been disclaimed. Ex-2002.

3. Conclusion: The Board Should Deny Institution Under § 325(d)

Petitioner admits that “the same ...prior art” and “the same ... arguments previously were presented to the Office” (§ 325(d)) so that the first step of *Advanced Bionics* is met, and application of the relevant *BD* factors all favor denial because Petitioner cannot demonstrate material error. The Director should deny this Petition under § 325(d).

IV. THE PARALLEL ITC INVESTIGATION BETWEEN THE SAME PARTIES WARRANTS DISCRETIONARY DENIAL UNDER *FINTIV*

Ongoing ITC Investigation No. 337-TA-1414 between Patent Owner and Petitioner involves two patents - the '481 Patent and the '755 Patent that Petitioner challenged in IPR2025-00010. As discussed above, on May 16, 2025, the Board discretionarily denied IPR2025-00010 under § 314(a) and *Fintiv* based on the parallel ITC investigation. *See Innoscience America, Inc. v. Infineon Technologies Americas Corp.*, IPR2025-00010, Paper 11 (May 16, 2025) (hereafter “*Innoscience*”). The Director should do the same here. Given Petitioner’s delay in filing this second serially-filed Petition, the facts here weigh even more heavily in favor of discretionary denial than in *Innoscience* because the ITC investigation was even further along when this Petition was filed.

The parties are also involved in a parallel district court proceeding concerning the '481 Patent. *See* Petition at 113 (listing N. D. Cal. Case No. 3:24-

cv-01553 as well as ITC Investigation No. 337-TA-1414). Petitioner informed Patent Owner of its intention to file a request for a “mandatory” 28 U.S.C. § 1659 stay of the N. D. Cal. district court case pending the ITC investigation, which Patent Owner joined and the district court granted. Ex-2004; Ex-2005; Ex-2006. The purpose of a § 1659 stay is to “avoid[] litigation in two forums at once.” *In re Princo Corp.*, 478 F.3d 1345, 1355 (Fed. Cir. 2007). Thus, at Petitioner’s urging, the district court litigation is stayed.

Where, as here, district court litigation is stayed “because of the ITC investigation at Petitioner’s request” then “the ITC investigation... is the relevant parallel proceeding” the Board “must evaluate under the *Fintiv* factors.” *See Intel Corp. v. Koninklijke Philips N.V.* (“*Intel*”), IPR2021-00328, Paper 9 at 9 (July 16, 2021); *see also id.*, Paper 16 at 4, 6; *see also id.*, Exhibit 2019 (showing the *Intel* parties’ joint stipulation in IPR2021-00328).

In the IPR involving the other patent at issue in the parallel ITC proceeding, Petitioner argued that the Board should “analyz[e] discretionary denial for the district court action.” IPR2025-00010, Paper 8, at 3. *Id.* The Board correctly rejected these arguments. *Innoscence*, Paper 11 at 7 (“we agree with Patent Owner that the ITC investigation is the relevant parallel proceeding for evaluating the *Fintiv* factors”). When there is a parallel district court proceeding that is stayed in view of an ongoing parallel ITC proceeding, the *Fintiv* factors are applied *to the*

ITC proceeding instead of the stayed district court proceeding, because (1) the factors “are designed to assess whether efficiency, fairness, and the merits support the exercise of authority to deny institution in view of an earlier trial date in the parallel proceeding,” and (2) “the ITC investigation... is where the investment in the parallel proceeding is occurring, and where the overlap in issues is considered.” *Intel*, IPR2021-00328, Paper 16 at 8-9 (March 29, 2022) (denying rehearing); *see also id.* at 6 (“The eventual effect of the stayed district court proceedings will be determined by the resolution of the ITC investigation, such that we are not persuaded that the stayed proceeding has much effect on our exercise of discretion in this proceeding.”); *see also id.*, Paper 9 at 9 (“[T]he ITC investigation is... the relevant parallel proceeding we must evaluate under the *Fintiv* factors” when other “proceedings were stayed because of the ITC investigation at Petitioner’s request”).

The ITC proceeding, and not the stayed district court proceeding, is thus the correct proceeding to consider here just as the Board found in *Innoscence*.

1. Factor 1: The ITC Case Is Not and Will Not Be Stayed

Petitioner has not requested a stay in ITC Investigation No. 337-TA-1414. Stays in ITC investigations are rarely granted, and a stay based on institution of IPR is especially unlikely here, given that the ITC’s five-day evidentiary hearing was *already* held the week of May 19, 2025. Ex-2007; *cf. SK Innovation*, IPR2020-

01036, Paper 13 at 9 (“[W]e agree with Patent Owner that a stay of the ITC investigation is unlikely given that the hearing in the ITC investigation is scheduled to begin on [the IPR institution decision due date].”). *Fintiv* Factor 1 favors denial.

2. Factor 2: Proximity of a Trial Date to the Board’s Projected FWD

The already-completed ITC evidentiary hearing began May 19, 2025. That was about four months before the due date for an Institution Decision in this proceeding, and almost ***16 months*** before the projected date of the Board’s FWD. Ex-2007. The ITC ALJ will issue a Final Initial Determination by Oct. 30, 2025 (nearly eleven months before the Board’s projected FWD), and the ITC is targeting completion of its investigation by March 2, 2026 (over six months before the FWD). Ex-2007.

This greater than six-month gap between the ***conclusion*** of the parallel proceeding (here, the ITC investigation) and the Board’s projected FWD date is larger than in *Fintiv*, where this factor was found to weigh in favor of denial. *Fintiv*, IPR2020-00019, Paper 15 at 13 (the district court trial was scheduled two months before a projected FWD). The over six-month gap is also larger than the gap between the conclusion of an ITC investigation and the Board’s FWD in other IPRs – including *Innoscence* – where the Board has found that this factor favored denial. *Philip Morris*, IPR2020-00919, Paper 9 at 9 (considering a two-month

gap); *Innoscience*, IPR2025-00010, Paper 11 at 9 (considering an almost three-month gap).

In *Innoscience*, Petitioner argued that alleged “uncertainty of the target date for the Commission’s final determination” means that Factor 2 did not strongly favor denial. IPR2025-00010, Paper 8, at 4-5. The Board rejected that baseless assertion in finding that Factor 2 favors denial and the Director should as well.

Innoscience, Paper 11 at 9-10 (“we weigh the second *Fintiv* factor as favoring discretionary denial”). Throughout the ITC case, there has been ***no*** movement of the target date for the Commission’s final determination (Ex-2008; EX-2009; EX-2010)—let alone any hint of a lengthy ***six-month delay*** that could result in an FWD in this case issuing before the Commission’s final determination.

Additionally, two of the patents that were previously at issue before the ITC have already been dropped, simplifying the case and facilitating completion by the Commission’s target date. Ex-2011; Ex-2012. Petitioner’s alleged “uncertainty” in the target date is manufactured and baseless. Indeed, the best Petitioner could do in *Innoscience* was find examples where the ITC briefly delayed its final determination by less than two months; Petitioner could not cite a single example of an ITC case that was delayed by anywhere near ***six-months***. There is every reason to believe that the ITC case will be over well before the Board would issue an FWD.

As the Board noted in its March 24, 2025 Memorandum providing guidance on the rescission of the Interim Procedure, “instituting an IPR or a PGR where the ITC has set a target date for completing its investigation (i.e., the full Commission’s final determination) to occur earlier than the Board’s deadline to issue a final written decision in a challenge involving the same patent claims means that multiple tribunals may be adjudicating validity at the same time, which may increase duplication and expenses for the parties and the tribunals. Thus, the Board is more likely to deny institution where the ITC’s projected final determination date is earlier than the Board’s deadline to issue a final written decision.” EX-2013, 2. It is undisputed that “the ITC’s projected final determination date is earlier than the Board’s deadline to issue a final written decision” here.

Fintiv Factor 2 strongly favors denial.

3. Factor 3: Investment in the Parallel Proceeding

As the Board recently found in connection with very same ITC investigation, “work by the ITC and the parties is at an *advanced stage*” so *Fintiv*

factor 3 “***strongly*** favors exercising our discretion to deny institution.”

Innoscence, IPR2025-00010, Paper 11 at 10-12.⁹

Indeed, the parties have already completed *Markman* briefing before the ITC, and the ALJ has already issued his claim construction decision. EX-2014. The parties have exchanged contentions and expert reports on validity, conducted all depositions, filed summary determination motions, completed pre-hearing briefing (including on validity), conducted the final pre-hearing conference before the ALJ, prepared and exchanged witness statements, prepared witnesses for the evidentiary hearing, and ***completed*** the ITC’s evidentiary hearing. EX-2008; EX-2009; EX-2010. By the time the Board would issue an institution decision (due by September

⁹ Petitioner alleged that Factor 3 did not favor denial because the district court action was stayed. IPR2025-00010, Paper 8, at 5. The Board correctly rejected that argument. *Innoscence*, Paper 11 at 7 (“the ITC investigation is the relevant parallel proceeding for evaluating the *Fintiv* factors); *see also Intel*, IPR2021-00328, Paper 16 at 4 (“the stay of district court litigation... occurred because of the ITC investigation at Petitioner’s request... As such, the amount of investment at the district court proceedings is not relevant.”).

17, 2025), the parties will have *also* filed their initial and responsive post-hearing briefs and exhibits. *Id.*

Indeed, given Petitioner’s delay¹⁰ in filing this second serially-filed Petition as compared to when Petitioner filed its petition in *Innoscience*, as of the date the institution decision is due in this case the work by the parties and the ITC will be at *even more of “an advanced stage”* than the Board found to “strongly favor[] exercising our discretion to deny institution” in *Innoscience*. *Innoscience*, IPR2025-00010, Paper 11 at 10-12; *see also SK Innovation*, IPR2020-01036, Paper 13 at 12 (finding Factor 3 to favor denial due to “extensive” investment in an ITC

¹⁰ In *Innoscience*, Petitioner alleged that Factor 3 did not favor denial because Petitioner diligently filed its petition only two months after the ITC investigation was instituted. *Innoscience*, IPR2025-00010, Paper 8, at 5. Petitioner cannot make the same argument here. Regardless, the Board rejected that argument and found that the advanced stage of the ITC investigation “strongly favors” denial under Factor 3. *Innoscience*, Paper 11 at 10-12; *see also Intel*, IPR2021-00328, Paper 9 (same).

proceeding where “contentions and expert reports on validity” “have already been exchanged.”).

In a recent decision (dated March 28, 2025) vacating an instituted IPR, the Director found that Factor 3 “strongly favor[ed] discretionary denial” where “the parties had served extensive infringement and invalidity contentions, served opening and rebuttal expert reports, filed claim construction briefs, and conducted several depositions,” the “court... had held a claim construction hearing and construed the disputed claim terms,” and the “parties had invested substantial time and resources in the parallel proceeding preparing for a... trial date.” *Motorola Sol’ns, Inc. v. Stellar, LLC*, IPR2024-01205, Paper 19 at 3 (Mar. 28, 2025). The parties and the tribunal have made all those same resource investments here.

Fintiv Factor 3 strongly favors denial.

4. Factor 4: Overlapping Issues

There is significant overlap in the validity issues raised in the Petition and in the parallel ITC investigation. The *same* prior art and arguments that serve as the basis of the Petition’s grounds (Petition at 3) are *also* advanced by Petitioner against all the claims asserted in the ITC investigation (claims 1-4, 6, and 17). Ex-2015, 18-20; Ex-2016; Ex-2017.

The fact that the Petition challenges some claims not asserted in the ITC litigation, so there “is not complete overlap,” does not preclude Factor 4 from

weighing in favor of discretionary denial. *SK Innovation*, IPR2020-01036, Paper 13 at 14. All of the independent claims are at issue in the ITC proceeding, where Petitioner’s validity challenges also rely on the Nega and Liu references used in the Petition’s grounds. *See* Petition at 3 (presenting “Nega Grounds” 1A-1F and “Liu Grounds 2A-2F). Thus, as in *SK Innovation*, “the ITC investigation will necessarily address validity issues relating to base claim 1, and therefore the ‘foundational validity issues [in the IPR] will be addressed at the ITC.’” *SK Innovation*, IPR2020-01036, Paper 13 at 14. Thus, *Fintiv* Factor 4 favors denial.

But even if the Director were to find that Factor 4 favored institution because of the lack of ***complete*** overlap in validity issues, that would not outweigh the other *Fintiv* factors favoring denial, especially given that the ITC will address significant portions of the same validity analysis the Board would address in its FWD. That is precisely what the Board found in *Innoscience*, where the Board found that Factor 4 weighed “***slightly*** against exercising our discretion to deny institution” (*Innoscience*, Paper 11 at 14) but that “on balance, the evidence of record favors exercising our discretion to deny institution,” with the investment of the parties and the tribunal in the ITC proceeding “***strongly*** favoring discretionary denial” (*id.* at 19). *See also* *Garmin*, IPR2020-00754, Paper 11 at 14-16, 18-19 (denying institution where “much (but not all) of the analysis and evaluation of the challenged claims may be gained from the analysis and evaluation done by the

ITC” despite finding that “the overlap between the asserted claims is not complete” and that Factor 4 favored institution).

Petitioner has not stipulated to withdraw from the ITC investigation any reference or argument used in the IPR should the Board institute IPR. But even if Petitioner did so stipulate, Factor 4 would at most “weigh[] marginally in favor of not exercising discretion to deny institution,” and would not outweigh the other *Fintiv* factors that favor denial. *Google LLC v. EcoFactor Inc.*, IPR2021-00982, Paper 12, at 12, 14 (Nov. 9, 2021) (denying institution even where Petitioner stipulated to drop from the ITC all invalidity arguments used in the IPR petition); *see also Canadian Solar Inc. et al. v. Solaria Corp.*, IPR2021-00659, Paper 14 at 14-15 (Sept. 30, 2021) (same); *Canadian Solar Inc. et al. v. Solaria Corp.*, IPR2021-00095, Paper 12 at 13-15 (May 26, 2021) (same); *Motorola*, IPR2024-01205, Paper 19 at 2-4 (vacating institution of IPR: “The Board did not give enough weight to the investment in the parallel proceeding and gave too much weight to Petitioner’s *Sotera* stipulation (i.e., a stipulation that Petitioner will not pursue in district court any ground it raised or reasonably could have raised in the inter partes review (IPR)) and its potential to reduce overlap with the issues raised in the parallel proceeding... although Petitioner’s *Sotera* stipulation may mitigate some concern of duplication between the parallel proceeding and this proceeding, the stipulation does not outweigh the substantial investment in the [parallel]

proceeding or *Fintiv* factors 1, 2, and 5, which the Board found weighed in favor of denial.”) (internal citations omitted).

5. Factor 5: Same Parties

The same parties involved in this proceeding are also involved in the ITC proceeding. Ex-1034 at 5. *Fintiv* Factor 5 strongly favors denial.

6. Factor 6: Other Circumstances, Including the Merits

a. The Board Has Already Rejected the Petition’s Grounds on the Merits

As explained *supra* § II, this Petition presents the “same” grounds the Board already rejected in denying institution of Petitioner’s first petition (Ex-1027), and the Board denied Petitioner’s rehearing request (Ex-2001) which advanced all the same arguments Petitioner alleges demonstrate alleged error in the Board’s institution denial. This “other circumstance” weighs heavily in favor of discretionary denial.

b. That an ITC Invalidity Ruling Would Not Bind the Office or the Courts Does Not Weigh Against Denying Institution

As *Fintiv* noted, “as a practical matter, it is difficult to maintain a district court proceeding on patent claims determined to be invalid at the ITC.” *Fintiv*, IPR2020-00019, Paper 11 at 9. Despite awareness of the well-known non-binding nature of ITC invalidity rulings, the Board has found that a parallel ITC case can be the basis for discretionary denial. *Id.*; *see also* Ex-2013 (March 24, 2025

memorandum from Chief Judge Boalick); *Intel*, IPR2021-00328, Paper 16 at 6-7 (“non-binding effect of the ITC’s decision” did not “turn” *Fintiv* factor 6 to “*strongly* weighing” in favor of institution) (emphasis original); *Innoscence*, Paper 11 at 14 (acknowledging that ITC final invalidity determinations lack preclusive effect) and 19 (discretionarily denying institution based on the ITC case).

c. No Other Factors Weigh Against Denial of Institution

The other additional considerations mentioned in the Director’s Memorandum are neutral or weigh in favor of discretionary denial. The ’481 Patent issued more than seven years ago. To the extent the Director considers an institution denial on the merits to be an “adjudicate[ion],” then the PTAB has already adjudicated the patentability of the challenged claims over the very “same” grounds as in the present Petition. The ’481 Patent does not implicate public health, national security, or public interest issues. This is a dispute between Patent Owner and Petitioner that will be resolved by the ITC and, if the stay is lifted, by the district court.

Fintiv Factor 6 favors denial.

7. Conclusion: This Petition Should be Discretionarily Denied Under *Fintiv*

There is no reason to resolve this case differently than the Board just resolved IPR2025-00010 – between the same parties involving a patent involved in the same ITC investigation – in which the Board discretionarily denied the IPR

based on the advanced stage of the ITC investigation. *See Innoscience*, Paper 11. Indeed, the case for discretionary denial of this Petition is even stronger given that the Board has already rejected the merits of this Petition so that discretionary denial is also independently warranted of this follow-on petition under *General Plastic* and under § 325(d) and *Advanced Bionics*.

V. CONCLUSION

It would be a highly inefficient waste of the limited resources of the Board and the parties to send this case to a merits panel. Doing so would ask the Board to consider a second time Petitioner's same grounds challenging the same claims the Board already rejected, and would duplicate the ITC's efforts. The Director should exercise her discretion to deny institution.

Respectfully submitted,
Infineon Technologies Austria AG

Date: May 28, 2025

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CERTIFICATE OF WORD COUNT

Pursuant to 37 C.F.R. § 42.24, the undersigned certifies that the foregoing **PATENT OWNER'S DISCRETIONARY DENIAL BRIEF** contains 11,675 words excluding; a table of contents, a table of authorities, a certificate of service or word count, or appendix of exhibits or claim listing. Patent Owner has relied on the word count feature of the word processing system used to create this paper in making this certification.

Date: May 28, 2025

/Dara Del Rosario/
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CERTIFICATE OF SERVICE UNDER 37 C.F.R. § 42.6 (e)(4)

I certify that on May 28, 2025, a copy of the foregoing document, including any exhibits filed therewith, is being served via electronic mail, as previously consented to by Petitioner, upon the following:

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