

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INFINEON TECHNOLOGIES AMERICAS CORP.,
Petitioner,

v.

MOSAID TECHNOLOGIES INC.,
Patent Owner.

Case IPR2025-01171
Patent 7,051,306

**PETITIONER'S OPPOSITION TO PATENT OWNER'S REQUEST FOR
DISCRETIONARY DENIAL OF INSTITUTION**

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- EX1025 “Computer Systems: Concepts and Design” by Gibson (“Gibson”), excerpts
- EX1026 Multimedia Information Networking” by Sharda (“Sharda”), excerpts
- EX1027 U.S. Patent No. 6,345,362 to Bertin et al. (“Bertin”)
- EX1028 “PowerPC 603 Microprocessor: Power Management” by Suessmith (“Suessmith”)

- EX1029 IEEE Journal of Solid-State Circuits, IEEE Xplore,
<https://ieeexplore.ieee.org/xpl/aboutJournal.jsp?punumber=4>
(accessed June 16, 2025)
- EX1030 Excerpts from Document Landing Page for “A 32-bit PowerPC
system-on-a-chip with support for dynamic voltage scaling and
dynamic frequency scaling,” IEEE Xplore,
<https://ieeexplore.ieee.org/document/1046086/citations#citations>,
<https://ieeexplore.ieee.org/document/1046086/citations?tabFilter=p>
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- EX1031 IEEE History, <https://www.ieee.org/about/ieee-history> (accessed
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- EX1032 IPR2024-00598, Paper 12, Institution Decision (Sep. 26, 2024)
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- EX1036 Prosecution History of Ser. No. 15/192,486 (application for reissue
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- EX1049 Press Release: Department of Justice, Federal Trade Commission to Hold Workshop on Patent Assertion Entity Activities, Archives, U.S. Department of Justice, <https://www.justice.gov/archives/opa/pr/department-justice-federal-trade-commission-hold-workshop-patent-assertion-entity-activities> (accessed October 5, 2025)
- EX1050 Canadian Patents Database, Search Results, Query: “current-owner:(MOSAID) AND (current-status:Patents),” https://www.ic.gc.ca/opic-cipo/cpd/eng/search/results.html?query=current-owner%3A%28MOSAID%29+AND+%28current-status%3APatents%29&start=1&num=10&type=advanced_search&newSearch=0 (generated October 5, 2025)
- EX1051 MOSAID Technologies Website, Patent Licensing page, <https://mosaid.com/patent-category/semiconductor-process-portfolio/> (accessed October 5, 2025)
- EX1052 United States–Canada Income Tax Convention

EX1053	US 10243542
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**All emphasis is added in this brief.*

I. INTRODUCTION

Everyone knows the '306 patent's claims are likely unpatentable, and it would be a blight on the patent system to deny Infineon's Petition as a matter of discretion without at least a preliminary merits review. As MOSAID knew before suing Infineon, the Board found the '306 patent's claims likely unpatentable in view of the same prior art in a recent IPR that was terminated by settlement, and substantially similar claims have also been invalidated or rejected repeatedly in other forums across multiple jurisdictions. Unsurprisingly, the prosecution record shows that the '306 patent only issued because there were severe, demonstrable examination errors.

The '306 patent never should have issued, and it certainly should not have been asserted against Infineon in 2025. MOSAID raised and *abandoned* its infringement allegations [REDACTED], giving Infineon every reason to believe the dispute was over. [REDACTED]
[REDACTED], and later filing suit, is a clear and prejudicial disruption of Infineon's settled expectations.

In addition, this case is an opportunity for the Director to establish that United States patents—even older ones—are not cudgels for *foreign* patent assertion entities to abuse. These entities should not have settled expectations that their scheme of extracting coercive royalties and exporting the profits abroad will benefit from the Director refusing a merits review of the asserted patents merely because they are old.

II. ARGUMENT

A. Multiple Compelling Reasons Support a Merits Review

1. Multiple Decisions in Multiple Forums Show the '306 Patent's Claims Are Likely Unpatentable

It is beyond debate at this point that the subject matter of the '306 patent's claims is likely unpatentable. Patent examiners, judges, and officers around the globe have said so. Most notably, around this time last year, the '306 patent and a related descendant patent with similar claims (US 7,945,885) were both found likely unpatentable in two prior IPRs filed by one of Infineon's competitors. EX1032; EX1034. Instead of defending the '306 patent and its progeny post-institution, MOSAID chose to settle with the prior petitioner, and the Board terminated the IPRs on New Year's Eve of 2024. EX1035. Not even three months into the New Year, MOSAID sued Infineon in district court on the '306 patent. EX2004. Tellingly, although Infineon's Petition relies on the same core prior art as the two settled IPRs, MOSAID still fails to contest the Board's prior negative assessment.

The Board's prior adjudications are not even half of the story—there's so much more. For example, several years ago, MOSAID abandoned an application before the Central Reexamination Unit (CRU) for reissue of yet another '306 patent descendant containing similar claims (US 8,762,923). EX1036, 1–2 (abandonment notice), 494–503 (original claims 1–39). The CRU's first office action rejected the claims, and MOSAID immediately capitulated without traverse by cancelling them.

EX1036, 104–159 (office action), 71–72 (canceling original claims 1–39). The rejection raised the same Nicol reference asserted in Infineon’s Petition, and the CRU correctly found that Nicol satisfies the frequency-selection feature erroneously deemed missing from the prior art by the examiner who allowed the ’306 patent. EX1036, 124–134 (“Nicol discloses...increase the clock frequency”); Pet., 62–64 (citing EX1008 (Nicol), 3:66–4:10 (“frequency is thus determined”)); *infra*, §II.A.2.

This negative view of the ’306 patent’s claimed subject matter is not confined to the USPTO. In 2020, after finding a lack of novelty demonstrated by multiple prior art grounds, the European Patent Office revoked a related patent with claims substantially similar to the ’306 patent’s. EX1037, 8–29. In 2011, the Japanese Patent Office likewise refused to grant substantially similar claims in view of the prior art, forcing MOSAID to withdraw the application. EX1038, 1–11.

The simple truth is this: Everyone knows the ’306 patent’s claims are not patentable. It has been demonstrated time and again, across multiple jurisdictions around the globe. Undeterred, MOSAID chose to continue its assertion of the ’306 patent against semiconductor companies in the United States to extract settlements and licensing royalties. EX2012, ¶¶9–11. For this reason alone, the integrity of the United States patent system compels a merits review of Infineon’s Petition.

2. The '306 Patent is the Product of Severe Examination Errors

The '306 patent issued because of a severe error during prosecution that led to an allowance with no apparent substantive or legal distinction over the cited art.

Responding to the examiner's final rejection, MOSAID argued that a 2004 technical paper called "Akui" is not prior art because the '306 patent *claims* priority to a 2003 provisional application.¹ EX1002, 73–83 (citing "'*Dynamic Voltage and Frequency Management for Low-Power Embedded Microprocessor*' authored by Akui et al."), 66–72 (office action response). MOSAID made no attempt to *perfect* its priority claim by establishing that the provisional application satisfies the enablement and written description requirements with respect to the pending claims, and the record shows no sign that the examiner considered these critical issues. *Id.*; *see also* EX1039 (MPEP, §706(V), §706.02(a), §706.02(b)). Nevertheless, the examiner's next action was a notice allowance citing the claimed frequency-selection feature that Akui disclosed as the key to patentability. EX1002, 40–45.

The examiner's error is material, not procedural or harmless. For one, the provisional application is not a verbatim or near verbatim match for the '306 patent's specification. EX1041, 3–31. It is an internal slide presentation that bears little resemblance to the '306 patent or to a patent application at all. *Id.* Claim features

¹ The examiner's rejection is based on the 2004 Akui document attached as EX1040.

like “determining a target power level for one of the power islands based on needs and operation of the integrated circuit” find no evident support—verbatim or otherwise—in the provisional application.

What’s more, even if the examiner believed the Akui reference was excluded by the provisional, he still should not have granted a notice of allowance for an alleged lack of frequency selection in the prior art. As Infineon’s Petition and the prior settled petitions plainly show, the prior art was replete with printed publications describing the frequency-selection feature taught by Akui. Akui is a fungible reference in this regard, and it was a clear and material error for the examiner to have not searched thoroughly enough to discover the wealth of suitable replacements. To wit, this error was confirmed when, as discussed (*supra*, §II.A.1), the CRU found and applied the Nicol reference for this very purpose.

**3. Infineon’s Settled Expectations Against Assertion Accrued
When MOSAID Abandoned Its Allegations** [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

“Whether this sequence is fairly viewed as a tacit withdrawal of [MOSAID’s infringement allegations], or as misleading silence with respect to [those allegations], the result is the same, for it was reasonable for [Infineon] to infer that [MOSAID] was not continuing the accusation of infringement[.]” *Aspex Eyewear, Inc. v. Clariti Eyewear, Inc.*, 605 F.3d 1305, 1311 (Fed. Cir. 2010) (finding equitable estoppel after years of silence). Thus, consistent with longstanding principles of equity, Infineon developed strong settled expectations against being sued on the ’306 patent. Those expectations support a merits review of Infineon’s Petition.

4. Referral and Institution Will Narrow the Parallel Litigation

i. The Board’s Final Written Decision Deadline Is Before the Scheduled and Projected Trial Dates

The Board’s projected final written decision date is January 8, 2027, more than *two weeks* ahead of the District Court’s scheduled trial date of January 25, 2027. EX2006, 5. And that assumes the district court case stays exactly on schedule, which history says is less than likely.² Judge Albright’s median time to trial is about 26 months, which projects a May 2027 trial date that lags the Board by *five months*.³ EX1042, 1. Given that Judge Albright has previously stayed (and severed) portions of a district court case that pertain to claims found unpatentable by the Board before trial, institution presents an opportunity to significantly narrow the number of patents presented to a jury. EX1044, 1 (“[T]he Court severs and stays Neonode’s claims for infringement of the ’993 Patent against Samsung pending resolution of the appeal from the PTAB’s Final Written Decision”); EX1045, 2–5 (although “[t]rial was set to begin with[in] weeks of this motion,” “the Court will exercise its discretion to stay this case pending the resolution of the IPR appeal”). In a three-patent litigation on

² Infineon has moved to transfer the district court case to a more convenient forum.

³ Judge Albright’s *average* time to trial is even longer—33 months. EX1043, 4.

complex semiconductor technology, taking the '306 patent off the jury's plate would be a meaningful step towards simplification.

MOSAID does not dispute these favorable facts regarding the '306 patent and instead notes that Infineon's challenge of an entirely different patent—the '448 patent in IPR2025-01489—will not produce a final written decision until a month after the scheduled trial date. Br. at 12–13. But this point does not support MOSAID's case for denial. For one, the '448 patent will still have been adjudicated by the Board (March 9, 2027) long before the projected median trial date in May 2027. Additionally, the '448 patent has no relationship to the '306 patent. Thus, the two patents can be severed without prejudice, as Judge Albright has done before.

ii. Infineon's *Sotera+* Stipulation Will Eliminate Wasteful Duplicative Efforts

Infineon's *Sotera+* stipulation leaves only two types of prior art invalidity grounds available for the district court trial—(1) grounds consisting of system prior art that does not correspond to any of the asserted IPR references; and (2) grounds consisting of such system art paired with printed publications that are not the asserted IPR references. EX1033. Infineon's invalidity contentions list only four prior art systems, none of which has a material connection to this IPR. EX2025, 12.

MOSAID's claim that Infineon's *Sotera+* stipulation leaves open the “backdoor” of advancing system art that is substantially similar to the IBM PowerPC

described in the Petition’s Nowka reference is irrelevant conjecture. Br. at 15. None of the four systems in Infineon’s contentions includes an IBM product, much less the PowerPC discussed in Nowka. EX2025, 11–12. As MOSAID points out, if there is a jury trial on the ’306 patent, the crux of the invalidity case will likely be Infineon’s own PSOC™1 product. Br. at 14–15; EX2025, 12. This is the same product Infineon repeatedly told MOSAID would invalidate the ’306 patent under MOSAID’s overly broad claim interpretations (*supra*, §II.A.4.i), and which MOSAID refused to disclose to the Office when pursuing related continuations of the ’306 patent (*infra*, II.B.2.ii). Notably, PSOC™1 cannot be reviewed via IPR and has no relationship to any of the prior art at issue in this IPR. The likelihood of duplicative efforts and inconsistent outcomes from institution is vanishingly small.

5. Infineon’s Repeated Efforts to Conserve Agency, Judicial, and Party Resources Support a Merits Review

Although MOSAID criticizes Infineon for not filing IPR challenges sooner, now is the only reasonable and efficient time to do so given the circumstances that MOSAID created by launching a licensing “campaign” against Infineon that involved [REDACTED]

[REDACTED] See EX2022, 7-8, 11; EX1046, ¶19. Even if spending years and millions of dollars to challenge [REDACTED] was feasible (which it was not), doing so would have been ineffective and incredibly wasteful. EX1046,

¶¶20–21. In the end, MOSAID filed suit on just *six* of the [REDACTED] campaign patents. Compare EX2004, ¶7, and EX1059, ¶7, with EX2022, 7–8. Challenging everything MOSAID identified would have produced [REDACTED] needless post-grant proceedings. Besides, MOSAID would have just flaunted another set of patents and continued harassing Infineon until it got what it wanted—[REDACTED] [REDACTED] EX1046, ¶22.

MOSAID is far from the only patent assertion entity who holds hundreds or thousands of United States patents and brandishes [REDACTED] in simultaneous licensing campaigns aimed at different targets to extract royalties. There are several of these entities operating in the United States, many of them based in foreign jurisdictions like MOSAID. If every target of such a campaign were to launch immediate post-grant challenges, the Office would be overwhelmed with petitions.

Given MOSAID’s approach, Infineon could do little more than [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED] EX1046, ¶23. As discussed (*supra*, §II.A.3), [REDACTED] [REDACTED], and then abruptly reversed course, ultimately filing suit more than [REDACTED]

[REDACTED]

Although MOSAID's unpredictable litigation tactics are beyond Infineon's control, Infineon can and has sought to conserve resources for the Board, the District Court, and the parties. To start, Infineon did not file IPRs against all six of MOSAID's asserted patents, but instead selected the four patents where a challenge based on printed publications before the PTAB would be most sensible and effective (Case Nos. IPR2025-01171, IPR2025-01456, IPR2025-01487, IPR2025-01489). In all four IPRs, Infineon submitted broad *Sotera+* prior art stipulations to avoid overlapping issues and any risk of inconsistent decisions (*supra*, II.A.4.ii). EX1047. More, Infineon took the extraordinary additional step of offering a compromise to immediately terminate all four IPRs in exchange for MOSAID narrowing its district court assertions to one patent of its choosing per district court case. EX1048. "This consolidated approach will save time, conserve resources, and avoid jury confusion from presenting multiple unrelated patents on complex semiconductor technology against the same Accused Product. MOSAID, meanwhile, will retain control of selecting the specific patent and claims that go to trial." *Id.* MOSAID acknowledged Infineon's offer but has yet to accept.

Infineon has consistently pursued opportunities to conserve resources and avoid burdening the Board with unnecessary post-grant petitions. These efforts support referral.

B. MOSAID's Discretionary Denial Arguments Are Unavailing

1. MOSAID's Settled Expectations Are Objectively Weak

i. MOSAID Cannot Have Strong Settled Expectations Regarding a Patent It Knew or Should Have Known Is Likely Unpatentable

MOSAID cannot reasonably have settled expectations that the '306 patent is valid, enforceable, and categorically exempt from a merits review. As discussed (*supra*, §II.A.1), authorities around the world have told MOSAID that the '306 patent's claimed subject matter is likely not patentable—including the Board one year ago. As discussed (*supra* §II.A.2), MOSAID knows or should know that the '306 patent's examiner committed a material error at least by not replacing the Akui reference with the Nicol reference later cited by the CRU. And, as discussed (*supra*, II.A.3), MOSAID signaled abandonment of its infringement allegations against Infineon [REDACTED].

ii. MOSAID, a Foreign Patent Assertion Entity Using the United States Patent System to Siphon Value from the United States Semiconductor Industry, Does Not Have Settled Expectations Against a Merits Review

MOSAID also cannot reasonably have strong settled expectations that a United States government agency will assert the power of its discretion to refuse even a preliminary merits review of patent rights that a *foreign* entity openly wields against the domestic semiconductor industry.

MOSAID, a private company with undisclosed ownership, is a longstanding patent assertion entity (PAE) based in Canada. EX2004, 1; EX1049, 1–2 (listing MOSAID’s Vice President as a speaker at the FTC’s 2012 “Workshop on Patent Assertion Entity Activities”). [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED] Notably, despite being a Canadian company, records from the Canadian Patent Office suggest MOSAID holds no active patents at all in Canada. EX1050, 1. [REDACTED]

[REDACTED]

[REDACTED] backed by the strong United States court system and financially sheltered by an international tax treaty. EX1051, 1 (“All MOSAID patents are available for review at the U.S. Patent Office”); EX1052, 63 (“Payments for the use of, or the right to use any patent...arising in a Contracting States and beneficially owned by a resident of the other Contracting State shall be taxable only in that other State[.]”). Thanks to its extensive United States patent portfolio, [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

To summarize, MOSAID establishes its home base in Canada and reaches across the northern border to [REDACTED]

[REDACTED]

MOSAID's attack on Infineon is no different. Infineon has been a trusted partner and contributor to the United States semiconductor industry for years, injecting billions of dollars directly into the domestic economy, creating thousands of jobs for Americans, strengthening domestic semiconductor technology development, [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED] and they are used extensively in the United States for applications ranging from IoT consumer products to devices with integrated AI systems. EX1046, ¶¶9–15.

To be sure, the law does not prevent or even discourage foreign PAEs like MOSAID from extracting value via patent licensing or litigation against companies like Infineon who are highly invested and aligned with the United States semiconductor industry. Nevertheless, such a foreign entity *should not expect* that the United States government will refuse to conduct even a preliminary merits review of the underlying patent rights powering such a scheme.

2. MOSAID’s Abusive Licensing Tactics and Failure to Cite Material Prior Art Undercuts Any Settled Expectations MOSAID May Have Had as the Owner of an Old Patent

i. Abusive Licensing Tactics

To the extent MOSAID has any legitimate settled expectations regarding the ’306 patent (which it does not), they are rendered moot by MOSAID’s abusive licensing negotiation tactics.

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED] *see Brulotte v. Thys*

Co., 379 U.S. 29, 32 (1964) (“[W]e conclude that a patentee’s use of a royalty agreement that projects beyond the expiration date of the patent is unlawful per se.”).

MOSAID's expectation that it can harass the domestic semiconductor industry with unfair patent licensing campaigns launched from across the northern border absent any and all oversight from the United States Government does not support denial.

Patent	Expiration Date
7,111,179	20 Jan 2023
7,596,710	27 Jan 2023
7,051,306	07 May 2024
7,945,885	07 May 2024
8,782,590	07 May 2024
6,294,904	04 Aug 2019
6,353,876	12 Mar 2018
6,489,834	16 Mar 2021
7,157,895	12 Oct 2024
7,349,448	27 Apr 2026
7,465,974	08 Sep 2022
8,063,417	01 Mar 2022
6,587,383	19 Mar 2022
7,685,393	07 Dec 2027
8,427,897	30 Dec 2025
9,972,381	30 Dec 2025
10,224,098	30 Dec 2025
10,140,028	15 Feb 2028
6,017,801	13 Jan 2018
6,223,331	30 Jul 2018
7,316,973	10 Nov 2025

ii. Failure to Cite Material Prior Art

MOSAID's purported "settled expectations" are further eroded by its habit of

[REDACTED]

[REDACTED] See 37 C.F.R. § 156 (outlining the "duty to disclose" that serves the "public interest" and promotes "the most effective patent examination").

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

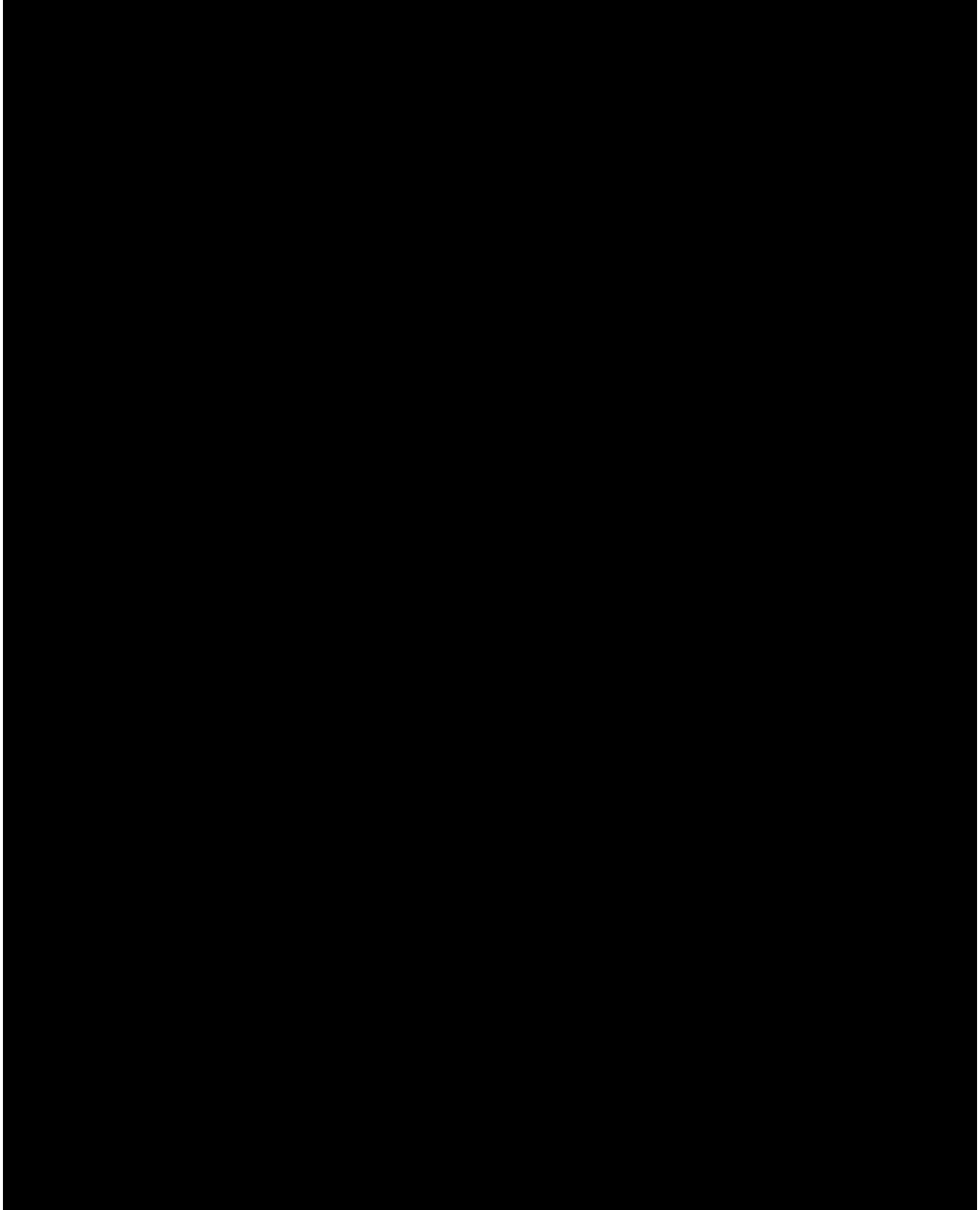
[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED] MOSAID was accused of doing the very same thing years ago when it asserted the '306 patent and its progeny against NVIDIA. EX1056, 21–30 (¶¶57–105); EX1057, 2–10. There, as here, it came to light that NVIDIA identified a pre-existing product including the accused functionality, and MOSAID decided not to tell the Office about it when pursuing downstream continuations from the '306 patent. *Id.* MOSAID cannot credibly expect the Office to shield its patents from a merits review when MOSAID refuses to follow the rules.



C. MOSAID’s “Playbooking” Concerns Are a Direct Consequence of Its Serial Litigation Tactics

MOSAID has no credible complaint about improper playbooking under *General Plastic*. Infineon and the prior petitioner, MediaTek, are direct competitors in the marketplace, not affiliated parties like in the *Valve* case. The only connection between Infineon and MediaTek concerning the ’306 patent is that both companies—like the rest of the United States semiconductor industry—are a victim of MOSAID’s predatory licensing and litigation tactics.

The only reason MOSAID is facing two petitions against the ’306 patent based on the same prior art is because MOSAID decided to settle the earlier instituted IPR before immediately launching a lawsuit against Infineon on the very same patent—a patent MOSAID knows or should know is likely unpatentable, [REDACTED]

[REDACTED]

[REDACTED] To conserve resources, and because the Board already found the ’306 patent likely invalid on this basis, Infineon naturally maintained the prior art grounds from MediaTek’s petition. Introducing entirely new grounds would have been pointlessly inefficient and undoubtedly drawn criticism from MOSAID. Infineon also addressed the claim interpretation issues raised in the MediaTek IPR and the prior district court litigations, not to be

unfair, but because the Board should account for those adjudications in the present case. Again, had Infineon done otherwise, MOSAID would have cried foul.

There is nothing unfair or untoward about Infineon's Petition, it is the natural consequence of MOSAID's litigation choices.

III. CONCLUSION

This case is an important one that must be decided on the merits. The '306 patent's claimed subject matter has been deemed outright invalid or likely unpatentable multiple times, by multiple authorities, including the Board. If that were not reason enough—and it is—a merits review is warranted because Infineon's settled expectations that MOSAID abandoned its infringement allegations outweigh any expectation MOSAID might have that a foreign PAE can conduct abusive licensing campaigns from across the border with no oversight by the United States government agency that granted the asserted patent rights in the first place. For all these reasons, Infineon respectfully asks that this case be referred to a Board panel.

Respectfully submitted,

Dated: October 8, 2025

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CERTIFICATE OF SERVICE

Pursuant to 37 CFR §42.6(e)(4), the undersigned certifies that on October 8, 2025, a complete and entire copy of this Petitioner's Opposition and its supporting exhibits were provided via email, to the Patent Owner by serving the email correspondence addresses of record as follows:

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