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 IPR2025-01456
Patent 10,140,028

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

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**All emphasis is added in this brief.*

I. INTRODUCTION

This case shows what happens when crucial steps of patent examination are not faithfully executed—bad patents issue and critical domestic industries suffer.

The ’028 patent issued not because its claims survived rigorous examination, but because the Examiner ignored explicit Office guidelines. As a result, while the ’028 patent sailed to issuance without a single rejection, the European Patent Office (EPO) rejected the same subject matter using references right under the Examiner’s nose. Had the Examiner followed the Office’s longstanding guidance on patent examination, he would have uncovered and applied the very same references that doomed the claims in Europe, and the ’028 patent would never have issued.

Not only was the ’028 patent’s issuance wrong, but so is its ongoing assertion against Infineon. MOSAID raised and *abandoned* its infringement allegations [redacted], giving Infineon every reason to believe the dispute was over for good. [redacted] and later filing suit, is a prejudicial disruption of Infineon’s settled expectations.

In addition, this case is an opportunity for the Director to reiterate that foreign entities should not have settled expectations that their coercive litigation schemes will benefit from discretionary denial merely because the patents they assert are old. Just as the Director recently instituted review on another of MOSAID’s old asserted patents in IPR2025-01171, Infineon respectfully asks the Director to do so here.

II. COMPELLING CIRCUMSTANCES WARRANT A MERITS REVIEW

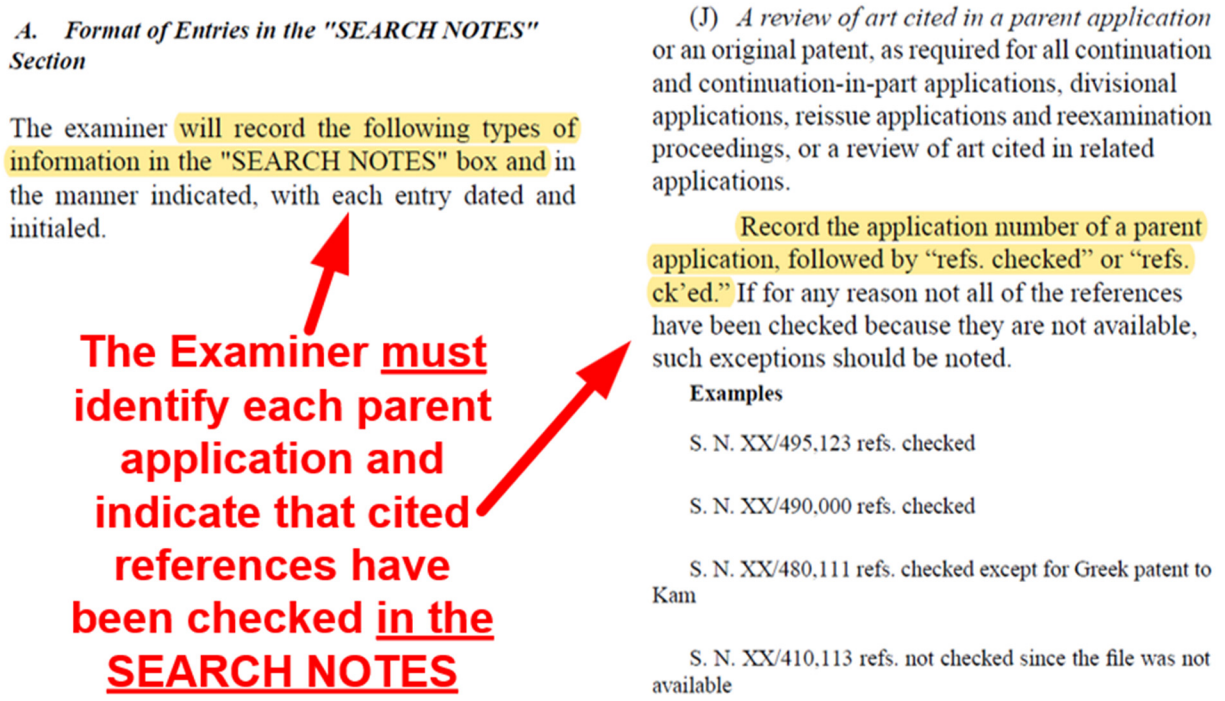
A. The ’028 Patent Is the Product of Severe Examination Errors

The examination that led to the ’028 patent was grossly inadequate. For one, the Examiner neglected prior art references in the ’028 patent’s parent applications. If the Examiner had considered these references, he would have discovered the prior art that the EPO used to reject similar claims. The Examiner then compounded this error with another: His search lasted less than two hours and bypassed the very claim limitations he later said were the key to allowance. These shortcomings violated Office guidelines and compromised the integrity of the examination process.

1. The Examiner Failed to Consider Art Cited in Parent Applications, Ignoring a Strict Office Guideline

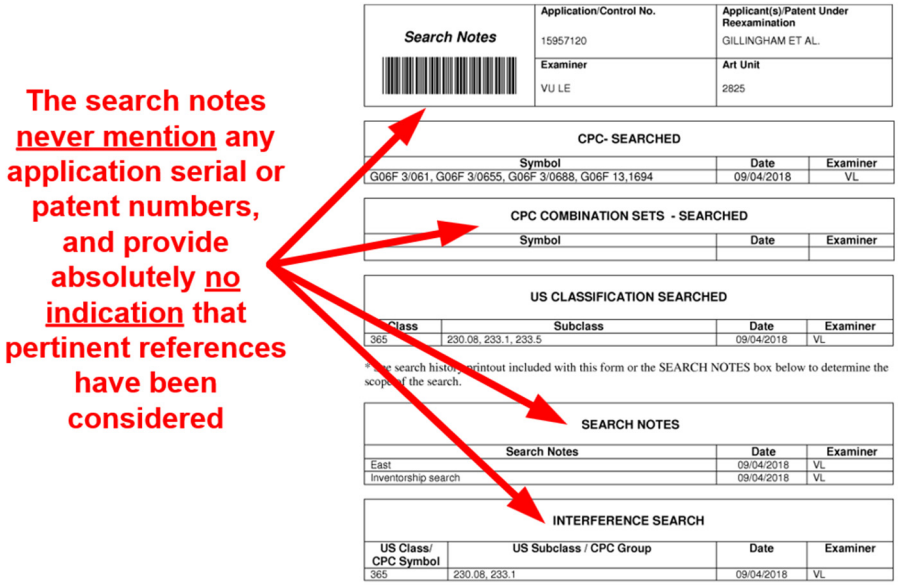
A patent examiner is supposed to “conduct a thorough search of the prior art.” EX1105, 41; *see also id*., 45 (“a careful and comprehensive search”); 37 C.F.R. 1.104 (“thorough investigation”). Doing so is a “must,” not an option. *Id*. It requires “obtain[ing] a thorough understanding of the invention disclosed and claimed,” and “search[ing] the prior art as disclosed in patents and other published documents.” EX1105, at 40. As part of this thorough search, examiners are instructed to “consider prior art which was cited and considered in [any] parent application[s].” *Id*. If this task is completed, an examiner will make a corresponding record in the Official Correspondence Search Notes. *Id*.; EX1106, 371, 374, 376. For each parent

application, the examiner is to (1) record the application serial number, and (2) indicate that the cited references have been checked. *Id*.



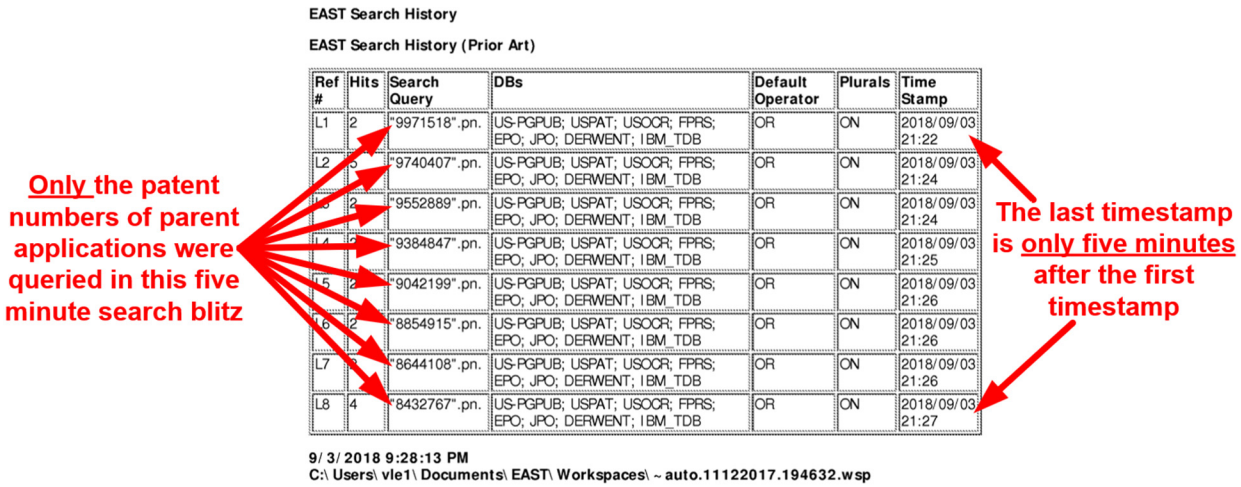
EX1106, 374, 376 (annotated).

The '028 patent has numerous parent applications identified in the Application Data Sheet and the body of the specification. EX1002, 3-4, 10. But the '028 patent's file wrapper shows no sign that the Examiner considered pertinent prior art from any of these parent applications. For example, the Examiner's search notes (1) do not list the serial or patent number of any parent applications, and (2) do not otherwise indicate that any pertinent parent prior art references were checked.



EX1002, 115 (annotated).

The only consideration the Examiner appears to have given the parent applications was a cursory search of eight issued patent numbers that lasted only *five minutes*. EX1002, 106. This is nowhere near enough time to consider the pertinent prior art references that were cited and considered in the parent applications. *E.g.*, EX1108 (US8,432,767), Pages 1–2 (56) (a parent listing numerous cited references).



EX1002, 106 (annotated).

The Examiner's error was a significant and material one. Numerous pertinent prior art references were cited in the parent applications of the '028 patent, including two invalidating references asserted in the Petition—Grundy (EX1009) and Akashi (EX1008). Instead of immediately allowing the claims, the Examiner should have rejected them as obvious.

2. Underscoring the Examiner's Error, a Foreign Patent Office Rejected Similar Claims

A fact underscoring the Examiner's error is that the EPO rejected claims that are strikingly similar to the challenged claims of the '028 patent based on two references—Grundy (EX1009) and Ooishi (EX1007)—that were cited and considered in one of the overlooked ancestors (US8,432,767). EX1107, 2–4. The EPO's rejection was so effective that MOSAID made no attempt to fight it, and instead offered extensive narrowing amendments to obtain an allowance. *Id*., 19-20; *see also id*., 3–4. Had the Examiner properly considered the prior art cited and considered in the ancestors, he would have arrived at a similar rejection against the '028 patent's claims. Yet the Examiner issued a first-action Notice of Allowance of the originally presented claims, granting MOSAID a significantly broader right to exclude in the United States than in Europe. EX1002, 101–103.

3. The Examiner's Deficient Search Resulted in Erroneous Reasons For Allowance

The "EAST Search History" reveals that the Examiner's entire prior art search lasted for less than two hours and did not focus on search terms relevant to key features of the claims.

The Examiner's reasons for allowance state that "[t]he prior art fails to disclose or suggest" several limitations of claim 1 including:

- "a *configurable clock input buffer* configurable to one of a *single ended signaling configuration* and a differential signaling configuration"; and
- "one or more *configurable output buffers*…to transfer the output data…synchronized with the clock output signal in a *double data rate* configuration."

EX1002, 100–104. But the Examiner's search strategy did not include any search strings that specifically targeted these limitations. EX1002, 110.

The search strings instead featured broad terms like "clock input buffer," "common data port," "clock mode," "differential signal," and "double rate." None of them targeted the kind of *configurable clock input buffer* in the '028 patent's claims. EX1002, 110. To wit, straightforward and highly relevant search terms like "configurable" and "single ended signaling configuration" were completely omitted from the search. The corpus of search terms also lacked any reference to a *configurable output buffer*. *Id*. Including such search terms would have surfaced

pertinent and invalidating references like Cole, Arcoleo, and Grundy. Indeed, Cole is entitled "*Configurable* Enabling Pulse Clock Generation For Multiple Signaling Modes" and discloses a circuit that is "*configurable* for use…to facilitate data transfer via *single-ended signaling*, or…via differential signaling," Arcoleo discloses an "*output buffer*" that is configurable using a "drive strength selecter (*sic*)," and Grundy discloses a memory device that performs "*double-data rate* capture." EX1005, Title, [0018]; EX1006, 6:10-36; EX1009, [0088].

Simply put, had the Examiner used appropriate keywords, the search would have identified references that expressly disclose the limitations he mistakenly thought were novel. That Infineon's more competent and comprehensive search produced better results is hardly a surprise. EX1104 (voluntary search declaration).

B. Infineon's Settled Expectations Against Assertion Accrued When MOSAID Abandoned Its Allegations [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 '028 patent. Those expectations support a merits review of Infineon's Petition.

C. Institution Will Narrow the Parallel Litigation

1. The Board Will Reach a Final Decision Before Trial

The Board's projected final written decision date is March 10, 2027, nearly a month *before* the District Court's scheduled trial date of April 5, 2027. EX2006, 5. And Judge Albright's median time to trial is about 26 months, which projects an even later date of May 2027.[1] EX1110, 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. EX1112, 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"); EX1113, 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 complex semiconductor technology, taking the '028 patent off the jury's plate would be a meaningful step towards simplification.

[1] Judge Albright's *average* time to trial is even longer—33 months. EX1111, 4. Moreover, Infineon has moved to transfer the district court case.

2. 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. EX1103. 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 is "carefully worded" to "seek[] two bites at the apple" is irrelevant conjecture. Br. at 14. Note, for example, MOSAID's failure to allege that even one of the four systems in Infineon's contentions bears any resemblance to the Ryu, Cole, Arcoleo, and Grundy references in the Petition's obviousness grounds. *See* Br. at 13–16. These systems cannot be reviewed via IPR and have 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.

D. 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

[redacted]. *See* EX2022, 7-8, 11; EX1109, ¶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. EX1109, ¶¶20–21. In the end, MOSAID filed suit on just *six* of the [redacted] *Compare* EX2004, ¶7, *and* EX1114, ¶7, *with* EX2022, 7–8. Challenging everything MOSAID identified would have produced more than a dozen needless post-grant proceedings. Besides, MOSAID would have just flaunted another set of patents and continued harassing Infineon until it got what it wanted—an eight-figure payday. EX1109, ¶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 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] EX1109, ¶23. As discussed (*supra*, §II.B), [redacted]

[redacted], and then abruptly reversed course, ultimately filing suit more than [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.C.2). EX1115. 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. EX1116. "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 and responded to 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 institution.

III. MOSAID'S DISCRETIONARY ARGUMENTS ARE UNAVAILING

A. 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, ¶¶3–6; EX1117, 1–2 (listing MOSAID's Vice President as a speaker at the FTC's 2012 "Workshop on Patent Assertion Entity Activities"). [redacted] Despite being a Canadian company, records from the Canadian Patent Office suggest MOSAID holds no active patents at all in Canada. EX1118, 1. [redacted]

[redacted] backed by the strong United States court system and financially sheltered by an international tax treaty. EX1119, 1 ("All MOSAID patents are available for review at the U.S. Patent Office"); EX1120, 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[.]"). [redacted]

To summarize, MOSAID establishes its home base in Canada and reaches across the northern border [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] and they are used extensively in the United States for applications ranging from robotics products to industrial automation. EX1109, ¶¶11–12.

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.

B. 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

1. Abusive Licensing Tactics

To the extent MOSAID has any legitimate settled expectations regarding the '028 patent (which it does not), they are rendered moot by MOSAID's abusive licensing negotiation tactics.

[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.

2. Failure to Cite Material Prior Art

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

Unfortunately, this is not a one-time occurrence, MOSAID was accused of doing the very same thing years ago when it asserted a set of patents against NVIDIA. EX1121, 21–30 (¶¶57–105); EX1122, 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. *Id*. MOSAID cannot credibly expect the Office to shield its patents from a merits review when MOSAID refuses to follow the rules and abide its duty of disclosure.

C. [redacted]

[redacted]

[redacted]

IV. INFINEON'S DISTRICT COURT CLAIM CONSTRUCTIONS ARE CONSISTENT WITH POSITIONS TAKEN IN THE PETITION

Infineon's district court indefiniteness positions do not conflict with the Petition and do not affect any of the Petition's grounds. EX2007, 11-12.

Prioritizing procedure over substance, MOSAID faults Infineon for not reconciling its district court position in a petition that predates the complained-of claim construction brief by nearly two months. *See* Br. at 18–20. But those procedural complaints fall flat because Infineon's Petition accurately states that "no

claim terms presently require a formal construction for purposes of addressing the grounds in this Petition" (Pet., 7); and because this brief is the appropriate time and vehicle for Infineon to further expound in answer to MOSAID's unfounded critique.

To be clear, the prior art in Grounds 1A–1B can be evaluated regardless of whether dependent claim 2 is indefinite. For example, Cole expressly discloses a *positive clock input signal* labeled "xxStbP" and a *negative clock input signal* labeled "xxStbN" EX1005, [0026], FIG. 2A. Because Cole unquestionably describes the claimed "positive" and "negative" clock signals, the Board can easily evaluate the merits of Grounds 1A–1B. MOSAID does not argue otherwise.

As a matter of law, that a "claim [is] indefinite for purposes of determining when infringement occurs…does not speak to whether the claim is also invalid for obviousness." *Samsung Elecs. Am., Inc. v. Prisua Eng'g Corp*., 948 F.3d 1342, 1355 (Fed. Cir. 2020). Here, the indefiniteness problem is that the specification does not sufficiently elucidate the terms "positive" and "negative," leaving the precise outrebounds of the claims undefined. EX2007, 11-12. And while that presents a problem for reliably detecting infringement, it does not prevent mapping to a disclosure like Cole's that lands at the heart of the claim. *See* Pet., 50. Here, too, MOSAID does not argue otherwise.

V. CONCLUSION

This case is an important one that must be decided on the merits. The '028 patent issued because the Examiner's search was perfunctory, misguided, and incomplete. 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 the Director to enter this case into the preliminary merits phase.

Respectfully submitted,

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CERTIFICATE OF SERVICE

Pursuant to 37 CFR §42.6(e)(4), the undersigned certifies that on December 10, 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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