

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

**PATENT OWNER'S AUTHORIZED SURREPLY TO
PETITIONER'S REPLY**

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Petitioner’s arguments confirm that institution should be denied.

Petitioner first argues that when it filed its petition on August 29, 2025, it “had only reserved a list of terms” proposed for construction in the district court, and had not yet “crystallized” its constructions. Reply, 1. But Petitioner does not cite any support for its implicit position that a district court’s schedule somehow limits or qualifies an IPR petitioner’s obligation to identify “[h]ow [each] challenged claim is to be construed.” 37 C.F.R. § 42.104(b)(3). Nor does the district court’s schedule obviate the Office’s goal of “minimiz[ing] inconsistency in claim construction between forums.” *See Revvo Techs., Inc. v. Cerebrum Sensor Techs., Inc.*, IPR2025-00632, Paper 20, 4 (Nov. 3, 2025) (precedential) (“*Revvo*”).

Petitioner was aware of the terms it would propose for construction by the time it filed its IPR. The record includes analysis relating the cited art to the ’028 patent and other patents, served on Patent Owner on August 15—*before* Petitioner filed its IPRs—with sections relating to the terms in the ’028 patent that Petitioner later argued about in district court and here. *See e.g.*, Ex. 2025 [Petitioner’s-Preliminary-Invalidity-Contentions] 63 (making arguments relating to “clock signals wherein the first clock input signal is a positive clock input signal” in the sense of the ’028 patent), 55–56 (making arguments relating to a “clock output signal” in the sense of the ’028 patent). Taken to their logical conclusion, Petitioner’s timing arguments would suggest that “minimiz[ing] inconsistency in

claim construction between forums” only matters if a district court scheduling order happens to require “crystalliz[ing] [] constructions” prior to filing an IPR. Such a policy would not “further the Office’s goal of ‘providing greater predictability and certainty in the patent system.’” *Revvo*, 4 (quoting 83 Fed. Reg. at 51,342–43).

Petitioner then argues that its district court position that “positive clock input signal” and “negative clock input signal” are indefinite is reconciled with its IPR position because one of the references cited in its grounds uses similar terms as the ’028 patent. Reply, 1–2 (arguing that “Cole expressly discloses a **positive** clock input signal labeled “xxStb**P**” and a **negative** clock input signal labeled “xxStb**N**,” and calling Cole an “express and verbatim matching disclosure”). Mere comparison of labels and terminology is not a showing of how the cited art teaches a “positive clock input signal” or “negative clock input signal” *in the sense of the ’028 patent*, particularly in view of Petitioner’s indefiniteness position. To be clear, Petitioner’s district court position includes argument that “the words ‘positive’ and ‘negative’ make little sense in the context of a clock signal” and that it is “internally incoherent” to “assign[] static labels (‘positive’ and ‘negative’) to a signal whose essence is dynamic.” Ex. 2007 [Opening-Claim-Construction-Brief] 7–8. Even now, Petitioner offers no real explanation of how claim elements argued to be “internally incoherent” in another forum are nevertheless present in an IPR reference.

Finally, Petitioner offers a stipulation “[t]o further ensure consistency between

this IPR and the district court case.” Reply, 3. Petitioner’s stipulation only confirms that a gap existed between Petitioner’s district court arguments and the Petition. Given that the district court has yet to hold a *Markman* hearing (let alone issue claim construction ruling), Petitioner’s proposal to “abide in this IPR by any constructions reached by the district court”—whatever constructions those may be—is unlike the stipulation in *Caption Health*, in that it does not give the Board any present guidance on how to construe the terms prior to the institution of trial. *Cf. Caption Health, Inc. v. University of British Columbia*, IPR2025-01422, Paper 15, 3 (Dec. 18, 2025) (accepting petitioner’s “consent” to the use of a district court proposal “as a stipulation to construe” a term “as Petitioner proposed in district court”). The Board’s authority to consider Petitioner’s proposal to “withdraw Grounds 1A and 1C from this proceeding if the district court adopts Infineon’s construction of ‘clock output signal’” is also entirely unclear. *See, e.g., SAS Inst., Inc. v. Iancu*, 584 U.S. 357 (2018). Because “it is the petition, not the Board’s ‘discretion,’ that defines the metes and bounds of an inter partes review,” *Koninklijke Philips N.V. v. Google LLC*, 948 F.3d 1330, 1336 (Fed. Cir. 2020) , the Director should not allow Petitioner to arrange, by stipulation, that IPR proceedings initiated without a clear statement of how a petitioner interprets claim terms, can somehow later be made to conform to what happens in a district court. The Director should instead deny institution.

Respectfully submitted,

Dated: January 15, 2026

By: /Kenneth Weatherwax/

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that the following documents were served by electronic service, by agreement between the parties, on the date below:

**PATENT OWNER'S AUTHORIZED SURREPLY TO
PETITIONER'S REPLY**

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Respectfully submitted,

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Date: January 15, 2026