

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE OFFICE OF THE UNDER SECRETARY OF COMMERCE
FOR INTELLECTUAL PROPERTY AND DIRECTOR OF THE
UNITED STATES PATENT AND TRADEMARK OFFICE

INFINEON TECHNOLOGIES AMERICAS CORP.,
Petitioner,

v.

MOSAID TECHNOLOGIES INC.,
Patent Owner.

IPR2025-01487
Patent 9,972,381 B1

Before JOHN A. SQUIRES, *Under Secretary of Commerce for Intellectual
Property and Director of the United States Patent and Trademark Office.*

DECISION
Granting Institution of *Inter Partes* Review
35 U.S.C. § 314

Infineon Technologies Americas Corp. (“Petitioner”) filed a Petition seeking *inter partes* review of claims 1–21 of U.S. Patent No. 9,972,381 B1 (“the ’381 patent”). Paper 2 (“Pet.”). MOSAID Technologies Inc. (“Patent Owner”) filed a Preliminary Response. Paper 16 (“Prelim. Resp.”). Patent Owner also filed a request for discretionary denial (Paper 7) and Petitioner filed an opposition (Paper 13). On January 9, 2026, I issued a Notice indicating that this proceeding would be reviewed for merits and non-discretionary considerations. Paper 21.

Subsequently, Petitioner filed a Preliminary Reply (Paper 22, “Prelim. Reply”) and Patent Owner filed a Preliminary Sur-reply (Paper 23) directed to claim construction proceedings in the related district court action. On February 18, 2026, I issued a Notice indicating that *inter partes* review is granted in this proceeding. Paper 24.

Patent Owner argues that Petitioner proposes claim construction positions in the district court that are inconsistent with those presented in the Petition and fails to sufficiently explain why those different positions are warranted. Prelim. Resp. 3–4, 9 (citing *Revvo Techs., Inc. v. Cerebrum Sensor Techs., Inc.*, IPR2025-00632, Paper 20 (Director Nov. 3, 2025) (precedential) (“*Revvo*”). In particular, Patent Owner notes that in District Court, Petitioner has proposed a construction of the term “clock output signal” in dependent claims 4, 5, and 19 as being “a periodic signal that synchronizes system operations.” *Id.* at 9 (quoting Ex. 2007, 12). In the Petition, however, Petitioner contends that “no claim terms require a formal construction for purposes of addressing the grounds in this Petition.” Pet. 2.

Petitioner’s failure to provide an explanation for its different positions is problematic, and typically weighs in favor of denying institution. *See*,

e.g., Revvo Technologies, Inc. v. Tire Stickers LLC, IPR2025-00631, Paper 34 (Director Feb. 3, 2026). Here, however, Petitioner’s conduct only affects three dependent claims out of twenty-one challenged claims. Nevertheless, in the forthcoming *inter partes* review, Petitioner is bound by its proposed district court construction of “clock output signal,” thereby ensuring consistency in claim construction between the two proceedings. *Revvo*, Paper 20 at 4.

Furthermore, Petitioner filed a Search Disclosure Declaration (SDD) in accordance with my Memorandum dated November 17, 2025, titled *Voluntary Search Disclosure Statements as a Favorable Factor in Institution Decisions*.¹ Ex. 1012. In accordance with the Memorandum, Petitioner’s search disclosure declaration was a favorable discretionary consideration in this case. Petitioners are reminded that such disclosures may include information regarding sophisticated search methodologies and/or analytics not routinely used by the office, as well as search terms, filters, queries or classification pathways employed, with the goal being to improve examination processes and procedures.²

¹ Available at https://www.uspto.gov/sites/default/files/documents/vsdd_as_a_favorable_factor_in_institution_decisions.pdf?utm_campaign=subscrip%20tioncenter&utm_content=%26utm_medium=email&utm_name=%26utm_source=govdelivery&utm_term=

² To further facilitate the exchange of valuable information that may be useful internally at the Office, Petitioners are further reminded that they may file an SDD under seal to protect against public disclosure of any confidential business information.

Accordingly, it is:

ORDERED that, pursuant to 35 U.S.C. § 314(a), an *inter partes* review of claims 1–21 of the '381 patent is *instituted*;

FURTHER ORDERED that Petitioner shall be bound by its proposed district court construction of the term “clock output signal” in its analysis of claims 4, 5, and 19 of the '381 patent; and

FURTHER ORDERED that, pursuant to 35 U.S.C. § 314(c) and 37 C.F.R. § 42.4(b), notice is hereby given of the institution of trial.

IPR2025-01487
Patent 9,972,381 B1

FOR PETITIONER:

Kenneth Darby
Nicholas Stephens
David Hoffman
John-Paul Fryckman
FISH & RICHARDSON P.C.
kdarby@fr.com
nstephens@fr.com
hoffman@fr.com
fryckman@fr.com

FOR PATENT OWNER:

Kenneth Weatherwax
Parham Hendifar
Lowenstein & Weatherwax LLP
weatherwax@lowensteinweatherwax.com
hendifar@lowensteinweatherwax.com

Jamie McDole
Winstead PC
jmcdoe@winstead.com