

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INFINEON TECHNOLOGIES AMERICAS CORP.
Petitioner,

v.

MOSAID TECHNOLOGIES INC.,
Patent Owner.

Inter Partes Review No. IPR2025-01489
Patent No. 7,349,448

PATENT OWNER'S DISCRETIONARY DENIAL BRIEF

~~CONTAINS CONFIDENTIAL MATERIAL~~

TABLE OF CONTENTS

I.	INTRODUCTION	1
II.	FACTUAL BACKGROUND.....	2
A.	The '448 Patent And/Or Its Patent Family Have Been Licensed To [REDACTED] [REDACTED] In The Semiconductor Space.	3
B.	Petitioner And Patent Owner Have Engaged In Extensive, Detailed Discussions Concerning The '448 Patent Dating Back To 2017.....	3
C.	The District Court Action.....	5
III.	ARGUMENT	5
A.	Settled Expectations Favor Denial.	5
B.	Each Of The <i>Fintiv</i> Factors Favors Denial.	10
1.	Factor 1: There Is No Likelihood The Case Will Be Stayed.....	10
2.	Factor 2: The District Court Trial Date Over A Month Before The FWD Deadline.	11
3.	Factor 3: The Parties Have Exchanged Contentions And Will Complete Claim Construction By The Institution Decision Deadline.....	12
4.	Factor 4: Petitioner's Stipulation Promises Two Bites At The Apple And Does Not Outweigh The Advanced Stage Of The Case.	13
5.	Factor 5: The Petitioner And The Defendant In The Parallel Proceeding Are The Same Party.....	15
6.	Factor 6: Other Circumstances Enhance The Case For Denial.	15
C.	The Petition Is Deficient Because It Does Not Disclose Or Reconcile Its District Court Claim Constructions.....	17

IV. CONCLUSION.....	20
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TABLE OF AUTHORITIES

Page(s)

COURT DECISIONS

<i>Maxell, Ltd. v. Apple Inc.</i> , No. 5:19-cv-00036-RWS, 2021 WL 3021253 (E.D. Tex. Feb. 26, 2021)	14
<i>mCom IP, LLC v. Bank of Am. Corp.</i> , No. 6:22-cv-00256-ADA, 2022 WL 22896963 (W.D. Tex. Oct. 20, 2022)	10
<i>Multimedia Content Mgmt. LLC v. DISH Network LLC</i> , No. 6:18-cv-00207-ADA, 2019 WL 11706231 (W.D. Tex. May 30, 2019)	10

AGENCY DECISIONS

<i>10x Genomics, Inc. v. Pres. and Fellows of Harvard Coll.</i> , IPR2023-01299, Paper 15 (Mar. 14, 2024)	19
<i>Adv. Micro Devices v. Concurrent Ventures, LLC</i> , IPR2025-00223, Paper 9 (June 12, 2025)	11, 12
<i>Amazon.com, Inc. v. VirtaMove, Corp.</i> , IPR2025-00563, Paper 10 (July 11, 2025)	7
<i>Amgen Inc. v. Bristol-Myers Squibb Co.</i> , IPR2025-00602, Paper 9 (July 24, 2025)	6
<i>Cambridge Mobile Telematics, Inc. v. Sfara, Inc.</i> , IPR2024-00952, Paper 12 (Dec. 13, 2024)	19
<i>Datadrome S.A. v. Arkose Labs Holdings, Inc.</i> , IPR2025-00693, Paper 13 (Aug. 14, 2025)	9
<i>Green Revolution Cooling, Inc. v. Midas Green Tech., LLC</i> , IPR2025-00196, Paper 15 (July 25, 2025)	15
<i>Intel Corp. v. Advanced Cluster Sys., Inc.</i> , IPR2025-00794, Paper 13 (Aug. 14, 2025)	6
<i>Intel Corp. v. Proxense LLC</i> , IPR2025-00327, Paper 12 (June 26, 2025)	7
<i>Kahoot! AS v. Interstellar Inc.</i> , IPR2025-00696, Paper 12 (July 31, 2025)	6

<i>Motorola Sols., Inc. v. Stellar, LLC</i> , IPR2024-01205, Paper 19 (Mar. 28, 2025)	12
<i>Murata Mfg. Co. v. Georgia Tech. Research Corp.</i> , IPR2025-00383, Paper 14 (July 29, 2025)	8
<i>NVIDIA Corp. v. Neural AI, LLC</i> , IPR2025-00608, Paper 16 (July 31, 2025)	8
<i>NXP USA, Inc. v. Redstone Logics LLC</i> , IPR2025-00485, Paper 11 (July 10, 2025)	11
<i>Orthopediatrics Corp. v. K2M, Inc.</i> , IPR2018-01546, Paper 10 (Feb. 14, 2019)	19
<i>Revvo Techs., Inc. v. Cerebrum Sensor Techs., Inc.</i> , IPR2025-00632, Paper 20 (Nov. 3, 2025) (precedential)	20
<i>Samsung Elecs. Co., Ltd. v. GenghisComm Holdings</i> , IPR2025-00781, Paper 11 (Aug. 14, 2025)	6
<i>Sandisk Techs. Inc. v. Polaris PowerLED Techs., LLC</i> , IPR2025-00515, Paper 15 (July 16, 2025)	6
<i>SAP Am., Inc. v. Cyandia, Inc.</i> , IPR2024-01496, Paper 13 (Apr. 7, 2025)	14
<i>Shenzen Tuozhu Tech. Co., Ltd. v. Stratasys, Inc.</i> , IPR2025-00354, Paper 11 (June 12, 2025)	11
<i>Shenzen Tuozhu Tech. Co., v. Stratasys, Inc.</i> , IPR2025-00531, Paper 10 (July 17, 2025)	7
<i>Tesla, Inc. v. Intellectual Ventures II LLC</i> , IPR2025-00340, Paper 18 (Nov. 5, 2025) (informative)	20
<i>Yangtze Memory Techs. Co., Ltd. v. Micron Tech., Inc.</i> , IPR2025-00500, Paper 10 (Aug. 14, 2025)	6

STATUTES

35 U.S.C. § 112(f)	18, 19
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REGULATIONS

37 C.F.R. § 42.104(b)(3).....	16, 18, 19
37 C.F.R. § 42.104(b)(4).....	18

PATENT OWNER'S EXHIBIT LIST

Exhibit	Description
2001-2003	Reserved
2004	Complaint in <i>MOSAID Technologies Inc. v. Infineon Technologies AG, et al.</i> , No. 1:25-cv-00358 (W.D. Tex.), Dkt. 1 (Mar. 25, 2025) [Complaint]
2005	November 3, 2017 Notice Letter to Cypress Semiconductor Corporation [11/03/17 Letter] (CONFIDENTIAL)
2006	First Amended Scheduling Order in <i>MOSAID Technologies Inc. v. Infineon Technologies AG, et al.</i> , No. 1:25-cv-00358 (W.D. Tex.), Dkt. 43 (Oct. 17, 2025) [Amended-Scheduling-Order]
2007	Defendant's Opening Claim Construction Brief in <i>MOSAID Technologies Inc. v. Infineon Technologies AG, et al.</i> , No. 1:25-cv-00358 (W.D. Tex.), Dkt. 44 (Oct. 27, 2025) [Opening-Claim-Construction-Brief]
2008	Defendants' Election of Asserted Prior Art Grounds in <i>MOSAID Technologies Inc. v. Infineon Technologies AG, et al.</i> , No. 1:25-cv-00358 (W.D. Tex.) (served Nov. 3, 2025) [Election-of-Grounds]
2009-2011	Reserved
2012	Declaration of Boris Teksler [Teksler-Decl.] (CONFIDENTIAL)
2013	Press Release, Infineon Technologies AG completes acquisition of Cypress Semiconductor Corporation (Apr. 16, 2020) [Press-Release-Cypress]
2014	Letter from Cypress (May 5, 2019) [05/05/19 Letter] (CONFIDENTIAL)
2015	Response Presentation (April 2018) [04/18 Presentation] (CONFIDENTIAL)
2016	Cypress Chart (Aug. 1, 2018) [8/1/18 Chart] (CONFIDENTIAL)

Exhibit	Description
2017	Response Presentation (Sept. 26, 2018) [09/26/18 Conversant Presentation] (CONFIDENTIAL)
2018	Conversant Response Presentation (June 21, 2019) [06/21/19 Conversant Response Presentation] (CONFIDENTIAL)
2019	Conversant Response Presentation (Dec. 4, 2019) [12/04/19 Conversant Response Presentation] (CONFIDENTIAL)
2020-2021	Reserved
2022	MOSAID – Infineon/Cypress Presentation (February 28, 2023) [02/28/23 MOSAID-Infineon/Cypress Presentation] (CONFIDENTIAL)
2023	Email chain (April 14, 2023) [4/14/23 Email] (CONFIDENTIAL)
2024	Reserved
2025	Infineon’s Preliminary Invalidity Contentions in <i>MOSAID Technologies Inc. v. Infineon Technologies AG, et al.</i> , No. 1:25-cv-00358 (W.D. Tex.) (served Aug. 15, 2025) [Invalidity-Contentions]

All emphases in quotations are added unless otherwise stated.

I. INTRODUCTION

Under the Director's decisions, the Petition¹ should clearly be denied due to the Patent Owner's strong settled expectations, under *Fintiv*, and because of Petitioner's failure to explain its inconsistent claim construction positions.

Settled expectations. The Director has consistently found that patents that issued six or more years ago give rise to strong settled expectations warranting a denial of institution. *See* Section III.A (citing decisions). Here, the '448 patent issued ***17 years ago***. Additionally, Patent Owner has licensed the '448 Patent and/or its patent family to [REDACTED] technological space. The '448 was, moreover, the subject of extensive, detailed negotiations between Patent Owner and Petitioner's predecessor between November 2017 and August 2024 during which Patent Owner repeatedly made clear that Petitioner's PSoC products infringed, *inter alia*, claim 8—the same claim/product identified in the District Court Action. *See* Ex. 2004 [Complaint] ¶¶ 89–94, 155–158. Despite all of this knowledge, Petitioner did not challenge the '448 patent's validity until 2025.

¹ An earlier case between the parties, IPR2025-01171, is pending and it presents a very strong case for denial. The facts favoring denial here are even stronger. Here, no IPR against the '448 has been brought or instituted and Petitioner's arguments in IPR2025-01171 are either inapplicable and/or meritless. Sections III.A, III.B.6.

Fintiv. *Fintiv* additionally favors denial. No stay has been sought or is likely.

The parties have exchanged infringement and invalidity contentions and by the institution decision deadline will have completed claim construction and discovery will be ongoing. Trial is currently scheduled for January 25, 2027, months before when the FWD is expected to issue.

Claim Construction. Petitioner’s failure to disclose or explain its different claim construction positions also favors denial. In the district court, Petitioner insists that the “logic” terms “***must*** be construed as means-plus-function limitations,” further offering an alternative construction if they are not construed as means-plus-function limitations. Ex. 2007 [Opening-Claim-Construction-Brief] 22–29. Additionally, Petitioner argues that “the first selected signal set” limitation is indefinite. *Id.*, 29–30. By contrast, in the Petition, Petitioner does not mention these constructions and argues that “[n]o formal claim constructions are necessary.” Pet., 8. In accord with the Office’s recent informative and precedential decisions, this unexplained inconsistency is further reason to deny institution.

II. FACTUAL BACKGROUND

The ’448 patent issued on March 25, 2008. Ex. 1001 [’448-Patent]. It is asserted in *MOSAID Technologies Inc. v. Infineon Technologies AG, et al.*, No. 1:25-cv-00358 (W.D. Tex.) (“District Court Action”) along with two other patents, U.S. Patent Nos. 7,111,179 and 7,051,306. While the complaint was filed on March 10,

2025, Petitioner still has not filed an IPR challenging the '179 patent. As discussed below, the '448 patent has been extensively licensed and has been the subject of lengthy negotiations between Patent Owner and Petitioner dating back to 2017.

A. The '448 Patent And/Or Its Patent Family Have Been Licensed To [REDACTED] In The Semiconductor Space.

The '448 patent and/or its patent family have been broadly licensed to [REDACTED]
[REDACTED]. Ex. 2012 [Teksler-Decl.] ¶ 11. Indeed,
[REDACTED]. *Id.*,
¶ 12.

B. Petitioner And Patent Owner Have Engaged In Extensive, Detailed Discussions Concerning The '448 Patent Dating Back To 2017.

Patent Owner and Petitioner (including Petitioner's predecessor-in-interest, Cypress Semiconductor Corporation²) had detailed discussions concerning Petitioner's infringement between 2017 and 2024. On November 3, 2017—nearly eight years ago—Patent Owner (previously named Conversant Intellectual Property Management before changing its name back to MOSAID in 2021), sent Cypress a notice letter stating that “[REDACTED]

² Petitioner and/or its German parent acquired Cypress Semiconductor Corporation, along with its portfolio of microcontrollers and other semiconductor products, in April 2020. Ex. 2013 [Press-Release-Cypress].

_____” Ex. 2005

[11/03/17 Letter] 1. [REDACTED]

██████████, the same products-at-issue in the District Court Action. *See id.*, 2; Ex.

2004 [Complaint] ¶¶ 89–94. The parties exchanged [REDACTED]

██████████. *See, e.g.*, Ex. 2015 [04/18 Conversant Presentation] 2–10 (“██████████

_____”); Ex.

2016 [8/1/18 Chart] 1–7; Ex. 2017 [09/26/18 Conversant Presentation] 2–15; Ex.

2014 [5/5/19 Cypress Response] 5; Ex. 2018 [06/21/19 Conversant Response]

Presentation] 2-10; Ex. 2019 [12/04/19 Conversant Response Presentation] 2-15;

Ex. 2022 [02/28/23 MOSAID-Infineon/Cypress Presentation] 7. In each of these

presentations, Patent Owner made clear its contention that [REDACTED]

Although there was a gap in discussions between March 2021 and February

2023, on April 12, 2023, MOSAID provided a “ [REDACTED]

.Ex. 2023 [4/14/23

Email]. On April 14, 2023, Infineon thanked MOSAID “[REDACTED]

_____” *Id.*

C. The District Court Action.

The District Court Action is far along. Patent Owner served its infringement contentions on June 20, 2025, Petitioner served its invalidity contentions on August 15, 2025, Petitioner filed its Opening claim construction brief on October 27, 2025, the parties completed venue discovery on October 28, 2025, and the parties have narrowed the asserted claims and grounds per claim. Ex. 2006 [Amended-Scheduling-Order] 1–3. Patent Owner’s Responsive claim construction brief is due to be filed on November 6, 2025, the *Markman* hearing is scheduled for January 21, 2026, fact discovery opens on December 5, 2025, and the parties will have served final contentions on February 26, 2026, all before the March 9, 2026 institution deadline. *Id.* Trial is set for January 25, 2027, over a month before the March 9, 2027 FWD deadline. *Id.*, 6.

III. ARGUMENT

Institution should be denied as a consequence of Patent Owner’s strong settled expectations (Section III.A), under *Fintiv* (Section III.B), and because of Petitioner’s failure to disclose, let alone explain, its inconsistent claim constructions (Section III.C).

A. Settled Expectations Favor Denial.

Patent Owner’s strong settled expectations favor denying institution. Here, the ’448 patent issued in 2008—17 years ago. What is more, the ’448 patent and/or

its patent family were licensed to [REDACTED] in Petitioner’s technological space (the semiconductor industry) and was the subject of extensive discussions between the parties dating back to 2017. *See* Section II.A-B. These facts present a clear case for denial.

The Director has made clear that “settled expectations” generally bar institution as to a patent that issued six or more years ago. *See, e.g., Yangtze Memory Techs. Co., Ltd. v. Micron Tech., Inc.*, IPR2025-00500, Paper 10, 2 (Aug. 14, 2025) (strong settled expectations for patent issued in November 2019); *Kahoot! AS v. Interstellar Inc.*, IPR2025-00696, Paper 12, 2 (July 31, 2025) (“the challenged patent has been in force for over six years, creating strong settled expectations”); *Amgen Inc. v. Bristol-Myers Squibb Co.*, IPR2025-00602, Paper 9, 3 (July 24, 2025) (similar); *Samsung Elecs. Co., Ltd. v. GenghisComm Holdings*, IPR2025-00781, Paper 11, 2 (Aug. 14, 2025) (similar); *Intel Corp. v. Advanced Cluster Sys., Inc.*, IPR2025-00794, Paper 13, 2 (Aug. 14, 2025) (similar). Here, the ’448 patent issued **17 years ago**; Patent Owner has a far stronger case for settled expectations than was present in dozens of cases in which institution was denied.

Notably, strong settled expectations alone can outweigh other factors that might favor institution (*e.g.*, because the underlying district court litigation was stayed). *See Kahoot!*, IPR2025-00696, Paper 12, 2; *Sandisk Techs. Inc. v. Polaris PowerLED Techs., LLC*, IPR2025-00515, Paper 15, 2 (July 16, 2025); *Amazon.com*,

Inc. v. VirtaMove, Corp., IPR2025-00563, Paper 10, 2 (July 11, 2025); *see also Intel Corp. v. Proxense LLC*, IPR2025-00327, Paper 12, 2–3 (June 26, 2025) (settled expectations outweighed lack of trial date). Here, the underlying litigation is not stayed and the trial date is after the FWD deadline.

The Director has found that settled expectations may not bar institution where a patent has not been “‘commercialized, asserted, marked, licensed, or otherwise applied’ in Petitioner’s ‘particular technology space.’” *Shenzen Tuozhu Tech. Co., v. Stratasy, Inc.*, IPR2025-00531, Paper 10, 3 (July 17, 2025). This potential exception does not apply here. The ’448 patent and/or its patent family were licensed by [REDACTED], including large semiconductor companies. *See* Section II.A; *see also* Ex. 2012 [Teksler-Decl.] ¶¶ 11–12.

Petitioner also had deep knowledge of the ’448 patent. During an extensive seven-year back-and-forth between Patent Owner and Cypress/Infineon, [REDACTED]
[REDACTED]. *See* Section II.B; *see also* Exs. 2005, 2014-2019, 2022. These exchanges included detailed claim analysis and intensive technical discussions between the parties concerning infringement and validity. Thus, Petitioner was not only aware of the ’448 patent, [REDACTED]
[REDACTED], the very same infringement allegation set forth in the District Court Action. *See* Ex. 2004 [Complaint] ¶¶ 89-94, 186.

As the Director has consistently found, such pre-suit awareness or discussion of the patent favors denial, even as to a patent that issued only two years ago because “Petitioner had actual notice of the challenged patents” but “fail[ed] to seek early review of the patents.” *NVIDIA Corp. v. Neural AI, LLC*, IPR2025-00608, Paper 16, 2–3 (July 31, 2025); *see also Murata Mfg. Co. v. Georgia Tech. Research Corp.*, IPR2025-00383, Paper 14, 2–3 (July 29, 2025) (denying institution where parties discussed “technology space involving the challenged patent” and thus “Petitioner was aware that Patent Owner was involved in the same technology space for a significant amount of time before filing its Petition challenging Patent Owner’s patent.”). Here, the magnitude of the parties’ discussions and Petitioner’s knowledge of the ’448 patent far exceed the facts found to favor denial in *Neural AI* or *Murata*.

That Petitioner did not agree with Patent Owner’s infringement contentions does not overcome Patent Owner’s strong settled expectations:

Petitioner argues that it had settled expectations that the challenged patents would not be asserted against it because the previous patent owner never asserted the challenged patents. Petitioner, however, acknowledges that it has been aware of Patent Owner’s patent portfolio in general since at least 2022, and the challenged patents specifically since 2023, after Patent Owner sent a series of letters to Petitioner identifying the challenged patents. In a letter dated December 1, 2023, Petitioner stated that it did “not believe it requires a license to any of the Identified Arkose Patents.” Ex. 1015, 2. Therefore, Petitioner

had apparently evaluated the challenged patents as of that date but does not provide a sufficient explanation as to why that amounts to settled expectations. For example, a concession of non-infringement by a patent owner may constitute settled expectations for a petitioner. However, a *petitioner's reliance on its own assessment of patents presents a different consideration*. Under these circumstances, Petitioner's assertions of settled expectations do not overcome Patent Owner's strong settled expectations.

See Datadrome S.A. v. Arkose Labs Holdings, Inc., IPR2025-00693, Paper 13, 2–3 (Aug. 14, 2025).

Moreover, Petitioner does not have settled expectations. In its Opposition to Patent Owner's Request for Discretionary Denial in IPR2025-01171, Petitioner alleges that it had settled expectations that Patent Owner would not sue for infringement because of [REDACTED]

[REDACTED]. IPR2025-01171, Paper 12, 5–6. But, emails from the time [REDACTED]

[REDACTED]

[REDACTED], and on April 12, 2023, MOSAID specifically [REDACTED]

[REDACTED] Ex.

2023 [4/14/2023 Email]. On April 14, 2023, Infineon thanked MOSAID “[REDACTED]

[REDACTED]” *Id.*

Regardless, Infineon's delay of more than two years from the resumption of those

discussions to when Infineon filed this Petition creates additional settled expectations for MOSAID.

Here, there is no reason to disturb Patent's Owner's strong settled expectations as to a 17-year-old patent, which has been extensively licensed and was the subject of extensive discussions between the parties from 2017–2024.

B. Each Of The *Fintiv* Factors Favors Denial.

1. Factor 1: There Is No Likelihood The Case Will Be Stayed.

Here, there is no likelihood that Judge Albright will stay the underlying case. Petitioner has not sought nor indicated it would seek a stay. Any such attempt would be unlikely to succeed, where, as here, Petitioner has filed IPRs challenging only two of the three asserted patents. Even if this IPR were instituted the District Court Action would not be simplified. *Multimedia Content Mgmt. LLC v. DISH Network LLC*, No. 6:18-cv-00207-ADA, 2019 WL 11706231, *3 (W.D. Tex. May 30, 2019) (Albright, J.) (“most important factor” in granting stay is whether IPR “will result in simplification of issues before the Court.”). Judge Albright has found that unless a defendant “show[s] that the PTAB is likely to invalidate *all* asserted claims . . . a stay will likely not simplify the issues.” *mCom IP, LLC v. Bank of Am. Corp.*, No. 6:22-cv-00256-ADA, 2022 WL 22896963, *3 (W.D. Tex. Oct. 20, 2022) (Albright, J.) (emphasis in original, cleaned up). Here, Petitioner has challenged two of three

patents; it cannot possibly demonstrate the Board will invalidate “all asserted claims.”

2. Factor 2: The District Court Trial Date Over A Month Before The FWD Deadline.

Factor 2 favors denial because the FWD will be due over a month after the trial date scheduled for January 25, 2027. As the Director has found, “it will be inefficient to maintain two parallel proceedings when the district court scheduled trial date and the projected final written decision due date are in close proximity.” *Shenzen Tuozhu Tech. Co., Ltd. v. Stratasys, Inc.*, IPR2025-00354, Paper 11, 2 (June 12, 2025); *Adv. Micro Devices v. Concurrent Ventures, LLC* (“Concurrent”), IPR2025-00223, Paper 9, 2 (June 12, 2025) (“Even though a district court trial date that occurs after a projected final written decision date reduces the possibility of conflicting decisions, that benefit does not outweigh the efficiencies gained by avoiding parallel proceedings in this instance because of the parties’ meaningful investment in the district court proceeding discussed above.”).

Here, by the institution decision deadline, the parties will have exchanged infringement and invalidity contentions and completed the *Markman* process. *See* Ex. 2006 [Amended-Scheduling-Order] 1–3. The Director has consistently found that completing such activities qualifies as a meaningful investment. *NXP USA, Inc. v. Redstone Logics LLC*, IPR2025-00485, Paper 11, 2 (July 10, 2025) (finding

“meaningful investment” where “the district court has held a *Markman* hearing”). That “meaningful investment” will expand significantly by the time of the final written decision deadline, by which point trial will be completed. *See* Ex. 2006 [Amended-Scheduling-Order] 4–5.

3. Factor 3: The Parties Have Exchanged Contentions And Will Complete Claim Construction By The Institution Decision Deadline.

Factor 3—“investment in the parallel proceeding by the court and the parties”—strongly favors denial. Here, the District Court Action has progressed significantly. The parties have exchanged infringement and invalidity contentions and by the Institution Decision deadline (March 9, 2026), the claim construction process will have concluded and the parties will be actively engaged in fact discovery. Ex. 2006 [Amended-Scheduling-Order] 1–3. This investment by the parties and the Court exceeds that found by the Director to “strongly favor[] discretionary denial.” *Motorola Sols., Inc. v. Stellar, LLC*, IPR2024-01205, Paper 19, 3 (Mar. 28, 2025) (factor 3 “strongly favor[ed] discretionary denial” where parties “served extensive infringement and invalidity contentions,” “filed claim construction briefs,” and district court “construed the disputed claim terms.”); *Concurrent*, 2 (favoring denial where “parties have exchanged infringement and invalidity contentions” and “a *Markman* hearing is scheduled to occur before the due date for an institution decision”).

4. Factor 4: Petitioner’s Stipulation Promises Two Bites At The Apple And Does Not Outweigh The Advanced Stage Of The Case.

Factor 4 favors denial. Here, Petitioner indicates it will not raise any ground it raised or reasonably could have raised in this IPR, any ground based on the combination of system prior art and the IPR references, or any ground “on the basis of system art corresponding to the references that form the basis of any ground raised in” the IPR. *See* Ex. 1012 [Stipulation] 1. Petitioner’s carefully worded stipulation confirms it seeks two bites at the apple.

The stipulation does not prevent Petitioner from propounding its repeated invalidity theories in the District Court Action. Petitioner’s stipulation does not forswear all reliance on system art. Instead, its invalidity contentions identify four prior art systems, including the Cypress PSoC 1 system. *See* Ex. 2025 [Invalidity-Contentions] 12. The Cypress PSoC 1 system also prominently features in Petitioner’s election of grounds. Ex. 2008 [Infineon-Election-of-Grounds] 4–5.

The stipulation does not prevent Petitioner from propounding substantially similar system art in the District Court Action. In addition, Petitioner’s stipulation does not prevent the formulation of unpatentability grounds based on substantially similar or even materially identical prior art systems. The stipulation does not preclude Petitioner from, *e.g.*, presenting different versions of system art that only allegedly do not “correspond[] to the references that form the basis of any ground

raised.” Ex. 1012 [Stipulation]; see *SAP Am., Inc. v. Cyandia, Inc.*, IPR2024-01496, Paper 13, 8–9 (Apr. 7, 2025) (stipulations have “limited practical effect in reducing the overlapping efforts” when IPR prior art does not reduce prior art systems offered in district court). These intentional backdoors limit any possible efficiency gained by this proceeding.

The stipulation does not prevent Petitioner from relying on the same references to show the “state of the art.” Petitioner does not forswear using the IPR references for any purpose leaving open the possibility that Petitioner will try to leverage the references in district court under the guise that they show the “state of the art” or the knowledge of a POSITA. See, e.g., *Maxell, Ltd. v. Apple Inc.*, No. 5:19-cv-00036-RWS, 2021 WL 3021253, *5 (E.D. Tex. Feb. 26, 2021) (“Indeed, courts in the Eastern District have permitted defendants to rely on references that were not included in their invalidity contentions when the references were not proposed as invalidating prior art, but were directed to other purposes, such as showing the state of the art at the time of the invention or rebutting the patentee’s secondary consideration evidence.”) (cleaned up).

Petitioner’s stipulation does not outweigh the advanced stage of this case. It is error to “giv[e] too much weight” even to “enhanced” stipulations where, as here, the parallel district court proceeding is at an “advanced state” and the district court has “not granted a stay.” *Green Revolution Cooling, Inc. v. Midas Green Tech.*,

LLC, IPR2025-00196, Paper 15, 2 (July 25, 2025).³ Thus, Petitioner’s “enhanced” stipulation should similarly be given little weight, particularly here where the stipulation allows Petitioner to rely upon system art. Petitioner’s stipulation therefore increases the probability of inconsistent results.

5. Factor 5: The Petitioner And The Defendant In The Parallel Proceeding Are The Same Party.

Factor 5 strongly favors denial because the Petitioner is the defendant in the District Court Action.

6. Factor 6: Other Circumstances Enhance The Case For Denial.

Factor 6 strongly favors denial. The other circumstances supporting denial include Patent Owner’s strong settled expectations and Petitioner’s failure to acknowledge let alone explain its different claim construction positions.

Settled expectations. Patent Owner’s strong settled expectations alone are a sufficient basis to deny institution. *See* Section III.A (incorporated by reference). Again, the ’448 patent issued 17 years ago, has been heavily licensed, and has been the topic [REDACTED]. And yet, Petitioner did not challenge the ’448 patent until 2025. Patent Owner’s settled expectations strengthen the case for denial under *Fintiv*.

³ In *Green Revolution*, the trial was four months before the FWD. Here too, the trial date would long precede any FWD directed towards any other patents.

Claim construction. Petitioner’s failure to provide its District Court claim constructions in which Petitioner argues for means-plus-function constructions or explain why there is a difference between its claim construction position means Petitioner fails to carry its burden under 37 C.F.R. § 42.104(b)(3). *See* Section III.C.

Petitioner’s previously presented opposition arguments directed towards the ’306 patent are meritless and inapplicable. In IPR2025-01171, Patent Owner presented a compelling argument why discretionary denial is warranted in that case. Petitioner’s arguments in opposition (IPR2025-01171, Paper 12) confirm that the case for discretionary denial is even stronger here. Petitioner first argues that a merits review of the ’306 patent is justified because “multiple decisions” have allegedly found that “the subject matter of the ’306 patent’s claims is likely unpatentable,” relying in large part on a previous decision to institute review of the ’306 patent.⁴ IPR2025-01171, Paper 12, 2–3. But no IPR against the ’448 patent has been brought or instituted. Petitioner also argues that the ’306 patent only issued as the result of “severe examination errors.” *Id.*, 4–5. That argument too does not apply here as the ’448 patent has different claims and issued from a different prosecution. Petitioner next argues that it had settled expectations because of [REDACTED]. But, as explained, Petitioner’s expectations could have hardly been

⁴ MediaTek’s IPR would not have been instituted under the current regime.

“settled” as MOSAID made clear—and Infineon recognized—[REDACTED]
[REDACTED]. See Section III.A; Ex. 2023 [4/14/23
Email].⁵ Petitioner argues that its stipulation will eliminate duplicative efforts.
IPR2025-01171, Paper 12, 8–9. But Petitioner confirms that “the crux of the
invalidity trial” before the jury will be based on system art and does not deny the
advanced stage of the proceeding. *Id.* Thus, Petitioner’s stipulation will not simplify
the issues. Petitioner finally argues that Patent Owner is a “foreign patent assertion
entity” that cannot have settled expectations. But Patent Owner’s country of origin
(Canada) is no more relevant than Infineon’s (Germany).

**C. The Petition Is Deficient Because It Does Not Disclose Or Reconcile
Its District Court Claim Constructions.**

The Petition should also be denied because it does not disclose its district court
claim constructions or explain why those positions are not taken in the Petition.

In the District Court Action, Petitioner argues that the “first,” “second,” and
“third” “stage logic[s]” recited in the asserted claims (4 and 8) “*must* be construed
as means-plus-function limitations.” Ex. 2007 [Opening-Claim-Construction-Brief]

⁵ And, as Ex. 2023 confirms, Petitioner’s argument is equally frivolous as to the ’306
patent because MOSAID similarly made clear—and Infineon recognized—[REDACTED]
[REDACTED]

22. Alternatively, Petitioner argues that the District Court “should construe ‘second stage logic *configured to receive the first data word from the first stage logic...*’ [and the associated language from claim 8] to mean that the second stage logic has an input configured to receive a data word from the output of a first stage logic.” *Id.*, 28–29 (emphasis in original). Petitioner also argues that “the first selected signal set” is indefinite. *Id.*, 29–30.

In the Petition, however, Petitioner makes no mention of these constructions, instead arguing that “[n]o formal claim constructions are necessary.” Pet., 8. Petitioner offers no explanation for why it omits and fails to apply its constructions in this IPR. This omission violates the Office’s rules, which require a petitioner to set forth “how the challenged claim is to be construed” and “how the construed claim is unpatentable.” 37 C.F.R. §§ 42.104(b)(3)–(4). Moreover, “[w]here the claim to be construed contains a means-plus-function ... limitation ... the construction of the claim *must* identify the specific portions of the specification that describe the structure, material, or acts corresponding to each function.” *Id.* And as the CTPG makes clear, even “[w]here the claim language *may be* construed according to 35 U.S.C. § 112(f), a petitioner *must* provide a construction.” CTPG, 45 (“A petitioner who chooses not to address construction under § 112(f) risks failing to satisfy the requirement of 37 C.F.R. § 42.104(b)(3).”).

And Petitioner’s approach has been rejected by the Board. In *10x Genomics*,

the Petitioner advocated for a means-plus-function construction in district court while maintaining that the claim was not subject to such a construction before the Board. As the Board found:

Petitioner should have provided reasons why the limitation is not governed by § 112(f) or provided an express construction of the claim phrase. *See* IPR2018-01546, Paper 10 at 11. Because Petitioner has the burden to show a reasonable likelihood of prevailing in its assertion that at least one claim is unpatentable, our rules require that Petitioner substantively address any claim terms in dispute. Based on the circumstances presented here, by relying solely on [Patent Owner’s] construction for “an error detection or correction system” that “no construction [is] necessary” without further explanation, Petitioner failed to satisfy its burden to set forth “[h]ow the challenged claim is to be construed.” 37 C.F.R. § 42.104(b)(3).

10x Genomics, Inc. v. Pres. and Fellows of Harvard Coll., IPR2023-01299, Paper 15, 11–13 (Mar. 14, 2024) (“Petitioner is now left with the consequences of its strategic choice to not address § 112(f) in the Petition”); *Cambridge Mobile Telematics, Inc. v. Sfara, Inc.*, IPR2024-00952, Paper 12, 5–9 (Dec. 13, 2024) (informative) (similar); *Orthopediatrics Corp. v. K2M, Inc.*, IPR2018-01546, Paper 10, 10–11 (Feb. 14, 2019). Here, Petitioner knew that the parties disputed whether the “logic” limitations were means-plus-function, but chose not to address it in the Petition. Petitioner thus fails to carry its burden under 37 C.F.R. § 42.104(b)(3).

Petitioner also fails to mention or apply its alternative district court construction. Ex. 2007 [Opening-Claim-Construction-Brief] 28; Pet., 8. This too is improper. *Revvo Techs., Inc. v. Cerebrum Sensor Techs., Inc.*, IPR2025-00632, Paper 20, 3–4 (Nov. 3, 2025) (precedential) (“when a petitioner takes alternative positions before the Board and a district court, that petitioner should, at a minimum, explain why alternative positions are warranted.”).

Nor is its irreconcilable position on indefiniteness addressed or reconciled. As the Director recently found, it is improper to maintain that a claim is indefinite in the district court without reconciling that position in an IPR petition. *Tesla, Inc. v. Intellectual Ventures II LLC*, IPR2025-00340, Paper 18, 2–4 (Nov. 5, 2025) (informative); *see also, id.*, 3 (“Petitioner’s statement that it cannot raise indefiniteness challenges in an inter partes review is not a sufficient explanation.”). Petitioner does not even disclose its indefiniteness position, much less justify it.

Here, where Petitioner fails to disclose, reconcile, or justify its inconsistent claim construction positions, institution should be denied.

IV. CONCLUSION

For the foregoing reasons, Patent Owner respectfully requests that the Director deny institution.

Dated: November 10, 2025

Respectfully submitted,

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. §42.6(e), I hereby certify that on November 10, 2025, I electronically filed the foregoing document and served a copy of the same on counsel for Petitioner at the following e-mail address, as authorized in the Petition:

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Dated: November 10, 2025

/s/ Colette Woo
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