

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.

IPR2025-01456
Patent 10,140,028 B2

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

DECISION
Denying Institution of *Inter Partes* Review

Infineon Technologies Americas Corp. (“Petitioner”) filed a Petition challenging claims 1–17 of U.S. Patent No. 10,140,028 B2 (Paper 2, “Pet.”), and 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, with authorization, Petitioner filed a Reply to the Preliminary Response (Paper 22, “Pet. Reply”) and Patent Owner filed a Sur-reply (Paper 23, “PO Sur-reply”). On February 9, 2026, after considering the parties’ arguments and the record, and in view of all relevant considerations, I issued a Notice indicating that although previously referred, *inter partes* review is denied in this proceeding in view of *Revvo Techs., Inc. v. Cerebrum Sensor Techs., Inc.*, IPR2025-00632, Paper 20 (Director Nov. 3, 2025) (precedential) (“*Revvo*”). See Paper 24 at 1 n.1.

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 the different positions are warranted. Prelim. Resp. 3 (citing *Revvo*, Paper 20 at 7–8). In the Petition, Petitioner first states that “no claim terms presently require a formal construction for purposes of addressing the grounds in this Petition.” Pet. 7. Petitioner then states that “[t]his Petition maps the prior art based on two interpretations of ‘clock’ signal.” *Id.* at 8. In district court, Petitioner construes the term “clock output signal” to mean “a periodic signal used to synchronize system operations.” Ex. 2007 (Opening Claim-Construction-Brief), 7; Prelim. Resp. 7–8. Patent Owner contends that neither of

Petitioner's two interpretations of "clock output signal" in the Petition is consistent with Petitioner's district court construction. *Id.*

Petitioner acknowledges that it presents distinct grounds in its Petition to address the parties' respective anticipated constructions of "clock output signal." Pet. Reply 2–3. According to Petitioner, Grounds 1B and 1D track its district court construction, and Grounds 1A and 1C are "based on [Patent Owner's] anticipated district court construction, as gleaned from its infringement allegations." *Id.* Petitioner contends that "Grounds 1A/1C merely ensure that [Patent Owner] does not gain an unfair advantage if the district court later adopts its broader construction." *Id.* at 3.

If a petitioner takes different claim construction positions before the Board and district court, the "petitioner should, at a minimum, explain why alternative positions are warranted." *Revvo*, Paper 20 at 3–4. Here, Petitioner fails to adequately reconcile its statement in the Petition that "no claim terms presently require a formal construction for purposes of addressing the grounds in this Petition" with its specific claim construction for the term "clock output signal" in district court. *See Revvo*, Paper 20 at 3–4. Accordingly, discretionary denial of the Petition is appropriate. *See Sun Pharmaceuticals Ind. v. Nivagen Pharma., Inc.*, IPR2025-00893, Paper 18, 3 (Director Sept. 19, 2025) (informative).

Additionally, Petitioner's presentation of alternative grounds, each involving different prior art, purportedly based on its own construction in district court and Patent Owner's anticipated construction in district court is problematic. *See* Pet. 4. Unless a petitioner has a sufficient explanation for taking alternative positions, a petitioner should present a single construction and apply that construction consistently before the Board and the district

court. Petitioner has not done so here, and has not offered a sufficient explanation for its actions. Petitioner’s assertion that its action ensures Patent Owner will not gain an unfair advantage if the district court later adopts a broader construction is speculative and not persuasive. Petitioner seeks to gain an unfair advantage by asserting multiple unpatentability theories at once, and allowing the district court or the Board to decide which is its best argument. We are not in the business of aiding parties to stress test claim constructions to see which will prevail. As stated repeatedly, a petitioner should pick one, and one consistent with its asserted District Court position. Petitioner’s argument thus additionally detracts from the Office’s goal of “providing greater predictability and certainty in the patent system.” *Revvo*, Paper 20 at 4–5.

Petitioner further offers certain stipulations, including that it will “abide in this IPR by any constructions reached by the district court; . . . and withdraw Grounds 1A and 1C from this proceeding if the district court adopts [Petitioner’s] construction of ‘clock output signal.’” Pet. Reply 3. Petitioner’s “wait and see” approach again seeks the same unfair advantage discussed above. *See, e.g., Revvo Technologies, Inc. v. Tire Stickers LLC*, IPR2025-00631, Paper 34 (Director Feb. 3, 2026). As such, it is appropriate to deny institution of *inter partes* review.

Accordingly, it is:

ORDERED that the Petition is denied, and no trial is instituted.

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FOR PETITIONER:

Kenneth Darby
David Hoffman
FISH & RICHARDSON PC
kdarby@fr.com
hoffman@fr.com

FOR PATENT OWNER:

Kenneth Weatherwax
Parham Hendifar
Jamie McDole
LOWENSTEIN & WEATHERWAX LLP
weatherwax@lowensteinweatherwax.com
hendifar@lowensteinweatherwax.com
jamie.mcdole@haynesboone.com