

IN THE UNITED STATES DISTRICT COURT  
FOR THE DISTRICT OF DELAWARE

TECHNOPROBE S.P.A.,  
Plaintiff,  
v.  
FORMFACTOR, INC.,  
Defendant.

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C.A. No. 23-842-JCG  
[REDACTED]

**PLAINTIFF'S INITIAL INFRINGEMENT CONTENTIONS**

Pursuant to Paragraph 3(c) of the Scheduling Order entered in this case, D.I. 40, Technoprobe, S.p.A. (“Technoprobe”) provides its initial infringement contentions, including an initial claim chart relating to FormFactor, Inc.’s (“FormFactor”) infringement of claims 1-23 (“Asserted Claims”) of U.S. Patent No. 11,035,885 (“the ’885 patent”). Technoprobe’s initial infringement contentions identify at least the following apparatuses, devices, or products that are included within or have structure similar to the following FormFactor products: [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

and/or any past, present, and future FormFactor probe head products that include a metallized guide plate (herein, the “Accused Products”). Exhibit A attached hereto and incorporated by

<sup>1</sup> P/N means Part Number. *See* FORMFACTOR\_00000237.

reference herein is an initial claim chart showing how each Accused Product infringes each of the Asserted Claims of the '885 patent, literally and/or under the doctrine of equivalents.

Technoprobe's initial infringement contentions provide preliminary citations to evidence showing FormFactor's infringement of the '885 patent. These contentions are not intended to be an exhaustive citation of all the evidence of FormFactor's infringement and are based on publicly available information and on FormFactor's limited production of technical documents produced on April 18, 2024, pursuant to paragraph 3(b) of the Scheduling Order, D.I. 40 ("Paragraph 3(b)"), as well as its supplemental productions on May 3 and 5, 2024.

Since discovery is in an early stage, Technoprobe anticipates that additional discovery may be obtained that is relevant to its infringement contentions and expressly reserves the right to amend these initial infringement contentions based on such later-received discovery. For example, numerous non-public technical documents showing how the Accused Products work, including but not limited to product design and specification documents, operation manuals, product literature, computer-aided design drawings, and schematics are in FormFactor's possession, have not yet been produced in this case, and contain information relevant to infringement by FormFactor and the Accused Products. In addition, Technoprobe anticipates that additional discovery will reveal additional details regarding the currently produced documents and the Accused Products, including information that would enable Technoprobe to associate certain documents with certain Accused Products and better understand the content and illustrations contained in the produced documents, consistent with how such documents are understood in the ordinary course of business by FormFactor.

The structure and operation of the Accused Products are in significant part proprietary, and comprehensive documents and other discovery showing the mechanical and electrical

structures of each of the Accused Products have not yet been produced or provided by FormFactor and are expected to be the subject of future discovery. Thus, Technoprobe's initial infringement contentions are based on the limited information that FormFactor produced to-date, and Technoprobe reserves the right to amend its contentions when it receives more fulsome product information from FormFactor.

### **Direct Infringement**

Technoprobe asserts that FormFactor is liable for direct infringement pursuant to 35 U.S.C. Section 271(a). FormFactor has directly infringed and is directly infringing at least the Asserted Claims of the '885 patent by selling, offering to sell, making, using, and/or importing the Accused Products in the United States. Based on Technoprobe's investigation to-date, Technoprobe alleges that each element of the Asserted Claims is found literally in the Accused Products as shown in the attached initial claim chart. To the extent that one or more elements of the Asserted Claims are not literally present or practiced in the Accused Products, Technoprobe alleges that the Accused Products infringe under the doctrine of equivalents.

Several elements of the Asserted Claims may be satisfied by more than one component or structure found within the Accused Products. The initial claim chart, therefore, may include alternative contentions and theories. For example, where multiple structures are identified as corresponding to a particular claim element, the multiple structures may be viewed as alternative or supplemental to one another. These disclosures provide examples of infringement that illustrate Technoprobe's preliminary infringement theories. However, the examples are non-limiting and are included to assist in understanding Technoprobe's preliminary infringement theories. For example, details regarding how the Accused Products implement each claim element may vary from product to product in ways not material to the analysis of

the Asserted Claims or not yet understood by Technoprobe based on the limited discovery received to date. The specific products selected for the initial claim chart attached as Exhibit A are representative of other FormFactor products with structures, operation, or other characteristics that do not differ from the products in the initial claim chart in ways material to Technoprobe's preliminary theories of infringement.

### **Willfulness & Indirect Infringement**

Technoprobe asserts that FormFactor is liable for induced and/or contributory infringement pursuant to 35 U.S.C. Sections 271(b) and 271(c). For example, Technoprobe asserts that FormFactor is liable under Sections 271(b) and 271(c) for infringement by distributors in using, selling or offering for sale in the United States the Accused Products and for infringement by FormFactor's customers in using the Accused Products. FormFactor actively and intentionally causes infringement with both knowledge of the '885 patent, the infringement thereof by the Accused Products, and the specific intent to cause its customers to use the Accused Products in an infringing manner.

As one example, FormFactor's SWTest 2023 presentation cited in the Original Complaint and the First Amended Complaint in this case repeatedly promotes the benefits of including Technoprobe's patented metallized guide plate in probe cards to both consumers and other industry members who attended SWTest Conference in June 2023, as well as consumers encountering FormFactor's presentation on FormFactor's website. By emphatically playing up the benefits of this feature, FormFactor is encouraging consumers and others in the industry and its own customers to try to make and use Technoprobe's patented feature as well—all without providing those members with any warning or notice that the feature is actually patented by Technoprobe.

FormFactor knows of its infringement of the '885 patent and has known as much since as early as the publication for the '885 patent issued on October 3, 2019 as U.S. Patent Publication No. 2019/0302148. As one example, Technoprobe sued FormFactor in U.S. District Court for the District of Delaware in 2018 for infringement of patents related to probe head technology. The 2018 litigation commenced July 17, 2018 and was captioned *Feinmetall GmbH and Technoprobe S.p.A v. FormFactor, Inc.*, Civil Action No. 18-01057-RGA (District of Delaware). In the 2018 litigation, Technoprobe as exclusive licensee of U.S. Patent No. 7,850,460 alleged FormFactor's infringement of U.S. Patent No. 7,850,460. In 2020, Technoprobe and FormFactor settled the 2018 litigation.

As another example, FormFactor has known of the Application No. PCT/EP2017/082180 to which the '885 patent claims priority, as well as the applicability of that application's subject matter to FormFactor's own products incorporating a probe head that includes a metallized guide plate, since at least as early as August 3, 2021. *See* FormFactor U.S. Patent No. 11,460,485, titled "Direct Metalized Guide Plate"; *see also* FormFactor's First Response to Technoprobe Interrogatory No. 3 (March 21, 2024) ("FormFactor became aware of the published international application that appears on its face to be related to the '885 patent, WO2018108790A1, by no later than on or about August 3, 2021, when that published application was cited by the Japanese Patent Office during the prosecution of a FormFactor Japanese patent application"). And on August 27, 2021, FormFactor cited the priority Application No. PCT/EP2017/082180 to the United States Patent Office when prosecuting FormFactor's own U.S. Application No. 16/164,326 that ultimately became U.S. Patent No. 11,460,485. *Id.* at 2 (FormFactor U.S. Patent No. 11,460,485 citing WO2018108790, a

publication of Application No. PCT/EP2017/082180 published June 21, 2018 to which the '885 patent claims priority).

As another example, FormFactor has known since at least June 7, 2023 at the SWTest 2023 Conference that its probe cards implementing its advertised “Metallized Guide Plate” feature infringed Technoprobe’s intellectual property. *See, e.g.*, D.I. 13-1 at 57-60. At least one FormFactor representative, such as David Raschko, attended Technoprobe’s presentation with AMD at SWTest 2023 wherein Technoprobe specifically explained that this feature was a “Technoprobe Patented solution.” *See* D.I. 13-1 at 147. Despite learning that Technoprobe has patented technology relating to metallized guide plates, FormFactor has proceeded with either direct knowledge of Technoprobe’s US Application No. 16/442,385 that issued as the '885 patent or purposefully avoided learning of the existence of the same.

Given the totality of the circumstances, FormFactor is, and has been, either actually aware of or willfully blind to the fact that its Accused Products infringe the '885 patent, including at least claim 1 of the '885 patent. Each of the circumstances alleged herein provides actual or constructive notice to FormFactor both of the '885 patent and of its coverage over the same Accused Products alleged to infringe related patents in the ongoing litigation between Technoprobe and FormFactor.

In addition to promoting its infringing products that include a metallized guide plate to customers, FormFactor also actively induces infringement through its technical support functions. FormFactor provides support to consumers who encounter technical problems and helps users overcome those problems so that they can use the Accused Products in an infringing manner. FormFactor also encourages companies to partner with FormFactor and advertises the services of those companies on its website. FormFactor’s encouragement of the use of its

products to these companies actively induces infringement by these companies and by the end users utilizing those products.

FormFactor's other actions include, for example, advertising use of the Accused Products in a way that infringes; training users on how to use the Accused Products; and providing instructions, technical support, and other training to encourage consumers to operate the Accused Products in an infringing manner.

FormFactor's actions further constitute contributory infringement. For example, FormFactor further contributes by providing components with no substantial non-infringing uses and/or induces this infringement by advertising the utility, value, power, speed, price, efficiency, and other features of its products to potential buyers; by providing information about how to use the Accused Products and how to assemble those products; and by providing users with technical support, as just a few representative examples. Specific non-limiting examples of these and other actions that support Technoprobe's indirect infringement allegations can be found on FormFactor's website and third party websites, among numerous other public sources.

Technoprobe incorporates by reference the allegations in its Original Complaint and First Amended Complaint along with the analysis in the attached initial claim charts (Exhibit A) with respect to FormFactor's indirect infringing activity. D.I. 1; 13 (and accompanying exhibits). Technoprobe further expects FormFactor to produce documents and information during the course of discovery that will support its indirect infringement allegations. Technoprobe further believes that FormFactor's infringement of the '885 patent has been and continues to be willful, as stated in Technoprobe's Original Complaint and First Amended Complaint.

FormFactor has yet to provide a fulsome answer to Technoprobe’s Interrogatory No. 3, which asks FormFactor to “[d]escribe in detail the date and circumstances of when, how, and who at FormFactor first became aware of the Asserted [’885] Patent.” *See* Technoprobe Interrogatory No. 3 to FormFactor, (Feb 13, 2024). FormFactor’s responses to date have provided no answer as to when FormFactor first became aware of the ’885 patent itself, and even FormFactor’s limited responses to other, related patents only provide a date range based on *public* information. *See* FormFactor’s First Response to Technoprobe Interrogatory No. 3 (March 21, 2024) (“FormFactor became aware of the published international application that appears on its face to be related to the ’885 patent, WO2018108790A1, by no later than on or about August 3, 2021, when that published application was cited by the Japanese Patent Office during the prosecution of a FormFactor Japanese patent application.”).

### **Reservation of Rights**

Technoprobe reserves the right to supplement or modify its initial infringement contentions herein, including the initial claim chart in Exhibit A, as additional information is obtained and/or in accordance with the Court’s orders, Local Rules, and the Federal Rules of Civil Procedure as appropriate. Discovery is currently ongoing, and additional facts, documents, things, and testimony, whether known or unknown to Technoprobe, may become relevant. Technoprobe reserves the right to amend, alter, or supplement its initial infringement contentions, including the initial claim chart in Exhibit A, based on any further investigation, fact or expert discovery, and any contentions or positions taken by FormFactor and/or its designated experts. By providing these initial infringement contentions and corresponding claim chart, Technoprobe does not waive any right to introduce at trial any subsequently discovered or developed evidence or expert opinions. Technoprobe reserves the right to refer

to, conduct discovery with reference to, or offer into evidence at the time of trial, any and all facts, expert opinions, documents and things notwithstanding the statements in the attached initial claim chart. Technoprobe further reserves its right to refer to, conduct discovery with reference to, or offer into evidence at the time of trial, any and all facts, documents and things that are not currently identified but might be identified at some time in the future. Technoprobe may also rely on documents, testimony, and things produced in the course of fact and expert discovery, including those which have not yet been produced by FormFactor or which Technoprobe has not yet identified or appreciated the significance of in the context of this litigation.

In addition, Technoprobe submits its initial infringement contentions, including the initial claim chart in Exhibit A, without prejudice to Technoprobe's supplementation, amendment, or revision of these disclosures at an appropriate future date. Technoprobe expressly reserves the right to amend or supplement these disclosures for at least any of the following reasons, and as expressly permitted by the Delaware Default Standard for Discovery: FormFactor's disclosure of technical or design documents for the Accused Products, production of other non-public technical documentation or testimony concerning any of the Accused Products and/or their components, the disclosure of FormFactor's claim construction positions, invalidity contentions, or non-infringement contentions, the Court's construction of any of the Asserted Claims or any other legal determination of other issues, or for any other permissible reason.

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Dated: May 31, 2024

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## **CERTIFICATE OF SERVICE**

I hereby certify that on May 31, 2024, this document was served on the persons listed below  
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