

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

TAIWAN SEMICONDUCTOR MANUFACTURING COMPANY LTD.
AND APPLE INC.,
Petitioner,

v.

MARLIN SEMICONDUCTOR LTD.,
Patent Owner.

IPR2025-00847 (Patent 7,745,847 B2)
IPR2025-00848 (Patent 9,953,880 B1)
IPR2025-00864 (Patent 9,184,292 B2)
IPR2025-00865 (Patent 9,147,747 B2)
IPR2025-00879 (Patent 9,093,473 B2)

Before COKE MORGAN STEWART, *Acting Under Secretary of
Commerce for Intellectual Property and Acting Director of the United States
Patent and Trademark Office.*

DECISION

Denying Institution of *Inter Partes* Review in IPR2025-00848,
IPR2025-00864, IPR2025-00865, and IPR2025-00879 and
Referring the Petition to the Board in IPR2025-00847

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Marlin Semiconductor Ltd. (“Patent Owner”) filed a request for discretionary denial (Paper 7, “DD Req.”) in the above-captioned cases, and Taiwan Semiconductor Manufacturing Company Ltd. (“TSMC”) and Apple Inc. (collectively, “Petitioner”) filed an opposition (Paper 10, “DD Opp.”).¹

After considering the parties’ arguments and the record, and in view of all relevant considerations, discretionary denial of institution is appropriate in IPR2025-00848, IPR2025-00864, IPR2025-00865, and IPR2025-00879, but is not appropriate in IPR2025-00847. This determination is based on the totality of the evidence and arguments the parties have presented.

In particular, the projected final written decision due date for each of these cases is November 15, 2026. The hearing in the parallel U.S. International Trade Commission (“ITC”) investigation is set for February 2, 2026. DD Req. 14. As such, it is unlikely that a final written decision in these proceedings will issue before the ITC trial occurs, resulting in significant duplication of effort, additional expense for the parties, and a risk of inconsistent decisions. In addition, the patents challenged in IPR2025-00848, IPR2025-00864, IPR2025-00865, and IPR2025-00879 have been in force for seven, nine, nine, and ten years, respectively, creating strong settled expectations for Patent Owner, and Petitioner does not provide persuasive reasoning why an *inter partes* review is an appropriate use of Board resources. *Dabico Airport Sols. Inc. v. AXA Power ApS*, IPR2025-

¹ Citations are to papers in IPR2025-00847. The parties filed similar papers in IPR2025-00848, IPR2025-00864, IPR2025-00865, and IPR2025-00879.

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00408, Paper 21 at 2–3 (Director June 18, 2025). These factors favor discretionary denial.

Petitioner argues that national security, economic, and public interest considerations counsel against discretionary denial because “[t]he semiconductor chips manufactured by TSMC are vital to leading U.S. companies (from Apple and NVIDIA to Amazon and Tesla) . . . and national security and defense through TSMC’s CyberShuttle program.” DD Opp. 31. Petitioner, however, does not explain in sufficient detail why review of the challenged patents is in the interest of national security, the economy, or the public. That is, Petitioner’s arguments are not narrowly-tailored towards particular products or manufacturing methods, and Petitioner does not sufficiently explain how national security, economic, or public interests warrant review of the specific patents challenged in these proceedings.

The patent challenged in IPR2025-00847 presents different circumstances. In particular, Petitioner provides persuasive reasoning, supported by evidence, that the Office erred in a manner material to the patentability of the challenged patent during patent examination, and, accordingly, discretionary denial under 35 U.S.C. § 325(d) is not appropriate. Specifically, during prosecution of the challenged patent, the patent examiner applied Chien770² to reject the claims, but subsequently allowed the claims after the applicant amended them. DD Opp. 5–6. Petitioner persuasively demonstrates that the patent examiner overlooked

² US Pat. 6,815,770, Nov. 9, 2004 (Ex. 1037).

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certain teachings in Chien770 that appear to disclose the claimed features that the patent examiner indicated were not taught by the prior art of record, including Chien770. *Id.* at 7–10. Although the challenged patent has been in force for fifteen years, Petitioner appears to show a material error by the Office, and it is an appropriate use of Office resources to review the potential error.

Although certain arguments are highlighted above, the determinations in this Decision are based on a holistic assessment of all of the evidence and arguments presented. Accordingly, the Petitions in IPR2025-00848, IPR2025-00864, IPR2025-00865, and IPR2025-00879 are denied under 35 U.S.C. § 314(a), and the Petition in IPR2025-00847 is referred to the Board to handle the case in the normal course, including by issuing a decision on institution addressing the merits and other non-discretionary considerations, as appropriate. In consideration of the foregoing, it is:

ORDERED that Patent Owner’s requests for discretionary denial in IPR2025-00848, IPR2025-00864, IPR2025-00865, and IPR2025-00879 are *granted*;

FURTHER ORDERED that the Petitions in IPR2025-00848, IPR2025-00864, IPR2025-00865, and IPR2025-00879 are *denied*, and no trial is instituted;

FURTHER ORDERED that Patent Owner’s request for discretionary denial in IPR2025-00847 is *denied*;

FURTHER ORDERED that the Petition in IPR2025-00847 is referred to the Board; and

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FURTHER ORDERED that neither party shall file a request for rehearing or Director Review of the decision to deny Patent Owner's request for discretionary denial in IPR2025-00847 until the Board issues a decision on institution.

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FOR PETITIONER:

Joseph Long
Aidan Skoyles
Carlos Duarte-Guevara
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER, LLP
jp.long@finnegan.com
aidan.skoyles@finnegan.com
carlos.duarte-guevara@finnegan.com

Walter Renner
Thomas Rozylowicz
Minseung Ahn
FISH & RICHARDSON P.C.
renner@fr.com
rozylowicz@fr.com
ahn@fr.com

FOR PATENT OWNER:

William Meunier
Adam Rizk
Michael Renaud
Michael Dokhanchy
Tawfik Goma
MINTZ, LEVIN, COHN, FERRIS, GLOVSKY AND POPEO, P.C.
wameunier@mintz.com
arizk@mintz.com
mtrenaud@mintz.com
rdokhanchy@mintz.com
tawfik@gomalaw.com