

troutman.com

Tim Tingkang Xia, Ph.D.
D 404.870.4698
Tim.xia@troutman.com

July 17, 2025

VIA E-MAIL

(rchorush@hpcllp.com; mheim@hpcllp.com; climbacher@hpcllp.com; lglick@hpcllp.com;
kfriesen@hpcllp.com; aicppllit@hpcllp.com; jnelson@susmangodfrey.com;
jtruelove@mckoolsmith.com)

Russell A. Chorush
Michael F. Heim
Christopher L. Limbacher
Lily R. Glick
Kyle Friesen
HEIM, PAYNE & CHORUSH, LLP
609 Main Street, Suite 3200
Houston, TX 77002

Justin A. Nelson
SUSMAN GODFREY L.L.P.
1000 Louisiana Street, Suite 5100
Houston, TX 77002

Jennifer Leigh Truelove
MCKOOL SMITH, P.C. - Marshall
104 East Houston Street, Suite 300
Marshall, TX 75670

**Re: *United Microelectronics Corp. and UMC Group (USA) v. Advanced Integrated Circuit Process LLC*, IPR2025-01076 for US Patent No. 7,579,227;
Advanced Integrated Circuit Process LLC v. United Microelectronics Corp., Civil Action No. 2:24-cv-00730 (E.D. Tex.) (Lead Case);
Advanced Integrated Circuit Process LLC v. Taiwan Semiconductor Manufacturing Co. Ltd., Civil Action No. 2:24-cv-00623 (E.D. Tex.) (Consolidated Member Case)
TPL Ref: 632329.000003**

Dear Counsel:

We write regarding a petition for *inter partes* review ("IPR") filed June 2, 2025 (Paper 1) with the United States Patent and Trademark Office, Patent Trial and Appeal Board ("PTAB") in IPR2025-01076 (the "Petition") to challenge claims 1, 2, 7, 8, and 14 (the "Challenged Claims") of U.S. Patent No. 7,579,227. The table below lists the grounds asserted by United

Microelectronics Corporation and UMC Group (USA) (collectively, “Petitioner”) in the Petition, along with the Challenged Claims against which the grounds are asserted. Petitioner hereby stipulates that in the event (a) the PTAB institutes an IPR in response to the Petition, and does not subsequently vacate institution or (b) in response to the petition filed by Taiwan Semiconductor Manufacturing Co. Ltd. (“TSMC”) against U.S. Patent No. 7,579,227 (IPR2025-00828), the PTAB institutes an IPR and the instituted IPR is not subsequently vacated or terminated before Final Written Decision, Petitioner will not pursue in the subject parallel litigation in U.S. District Court (the “Litigation”) invalidity of the Challenged Claims based on:

1. the grounds listed in the below table against the corresponding claims listed in the below table for those grounds, as identified in the Petition,
2. any other grounds that could have reasonably been raised before the PTAB in IPR2025-01076 (i.e., any ground that could have reasonably been raised under pre-AIA §102 or §103 on the basis of prior art patent(s) or prior art printed publication(s)), or
3. any other invalidity ground under pre-AIA §102 or §103 involving any type of legally recognized prior art, including patent, printed publication, or system art.

Ground	Basis	Claims	Reference(s) in IPR2025-01076
I	§ 103	1 and 2	U.S. Patent Application Publication No. 2003/0025135 A1 (“Matsumoto”) (Ex. 1009)
II	§ 103	7, 8, and 14	U.S. Patent Application Publication No. 2003/0025135 A1 (“Matsumoto”) (Ex. 1009) and U.S. Patent Application Publication No. 2006/0131672 A1 (“Wang”) (Ex. 1012)
III	§ 103	7 and 8	U.S. Patent Application Publication No. 2003/0025135 A1 (“Matsumoto”) (Ex. 1009) and U.S. Patent Application Publication No. 2005/0045938 A1 (“Mutou”) (Ex. 1019)
IV	§ 103	14	U.S. Patent Application Publication No. 2003/0025135 A1 (“Matsumoto”) (Ex. 1009) and U.S. Patent Application Publication No. 2005/0051856 A1 (“Ono”) (Ex. 1013)
V	§ 102	1 and 2	JP2003-258241 (“Kajiyama”) (Ex. 1010/1011)
VI	§ 103	14	JP2003-258241 (“Kajiyama”) (Ex. 1010/1011)

For the sake of clarity, and to avoid any doubt, if the PTAB declines to institute the grounds identified in the above table for whatever reason, Petitioner reserves the right to assert such grounds and all other available arguments for invalidity in the Litigation, including without limitation, under §112.

If institution of the Petition is granted, Petitioner further stipulates that it will submit a parallel stipulation in the Litigation as well as seek a stay of that Litigation pending resolution of the instituted IPR.

Best regards,

/s/ Tim Tingkang Xia

Tim Tingkang Xia (Petitioner Counsel IPR2025-01053)
Emma A. Bennett (Petitioner Counsel IPR2025-01053 and Defendant Counsel)
Mark Hannemann (Defendant Counsel of Record)
Ryan E. Dornberger (Defendant Counsel of Record)

cc: Counsel of Record via email

Plaintiff Counsel of Record in Lead 2:24-cv-00730	Defendant Counsel of Record in Lead 2:24-cv-00730	Consolidated Defendant Counsel of Record in 2:24-cv-00623
Justin Adatto Nelson (LEAD ATTORNEY) jnelson@susmangodfrey.com	Mark Hannemann (LEAD ATTORNEY) mark.hannemann@troutman.com	Jennifer Leigh Truelove (LEAD ATTORNEY) jtruelove@mckoolsmith.com
Andrew Jamal Nassar anassar@susmangodfrey.com	Emma Anne Bennett emma.bennett@troutman.com	Anthony Van Nguyen nguyen@fr.com
Bianca Rey brey@susmangodfrey.com	Ryan E. Dornberger ryan.dornberger@troutman.com	Benjamin Christoff christoff@fr.com
Claire Abernathy Henry claire@millerfairhenry.com		Christian A Chu chu@fr.com
Ian M. Gore igore@susmangodfrey.com		Conrad Gosen conradgosen@quinnemanuel.com
Kalpana Srinivasan ksrinivasan@susmangodfrey.com		Gyushik Jang kevinjang@quinnemanuel.com
Ravi Paul Singh Bhalla rbhalla@susmangodfrey.com		Iman Lordgooei imanlordgooei@quinnemanuel.com
Andrea Leigh Fair andrea@millerfairhenry.com		Jacqueline T Moran jtmoran@fr.com
		James Lee Huguenin-Love huguenin-love@fr.com
		James E Quigley jqigley@mckoolsmith.com
		Jodie W Cheng jodiecheng@quinnemanuel.com
		Karolina Jesien jesien@fr.com
		Karrie E. Washenfe Wheatley wheatley@fr.com
		Kevin K. Su su@fr.com
		Michael J McKeon mckeon@fr.com
		Sean S. Pak seanpak@quinnemanuel.com