

From: [Director Discretionary Decision](#)
To: [Gordon, Lori A](#); [Director DI](#); [Director Discretionary Decision](#); [Trials](#)
Cc: [Dokhanchy, Reza](#); [Meunier, William](#); [Rizk, Adam](#); [Renaud, Michael](#); [Goma, Tawfik](#); [Agarwal, Pavan K.](#); [Houston, Michael R.](#); [Goma, Tawfik](#); [Konstantakopoulos, Theodoros](#)
Subject: RE: IPR2025-01054, -01082: Authorization to Seek Additional Discovery
Date: Tuesday, November 18, 2025 2:01:32 PM
Attachments: [image001.png](#)
[image002.png](#)
[image003.png](#)
[image004.png](#)
[image005.png](#)
[image006.png](#)
[image007.png](#)

Petitioner's request for a deposition is denied. Petitioner is authorized to serve a narrowly tailored document request regarding the licenses to Intel and Samsung Electronics Co., Ltd. relied on by Patent Owner in their request for discretionary denial. Paper 9, 4-5.

From: Gordon, Lori A <LoriGordon@goodwinlaw.com>
Sent: Tuesday, November 18, 2025 10:45 AM
To: Director_DI <Director_DI@uspto.gov>; Director_Discretionary_Decision <Director_Discretionary_Decision@uspto.gov>; Trials <Trials@USPTO.GOV>
Cc: Dokhanchy, Reza <RDokhanchy@mintz.com>; Meunier, William <WAMeunier@mintz.com>; Rizk, Adam <ARizk@mintz.com>; Renaud, Michael <MTRenaud@mintz.com>; Goma, Tawfik <TAGoma@mintz.com>; Agarwal, Pavan K. <PAgarwal@foley.com>; Houston, Michael R. <MHouston@foley.com>; Goma, Tawfik <TAGoma@mintz.com>; Konstantakopoulos, Theodoros <tkonstantakopoulos@goodwinlaw.com>
Subject: RE: IPR2025-01054, -01082: Authorization to Seek Additional Discovery

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IPR2025-01054
IPR2025-01082

Honorable Director –

Petitioner is the above-referenced proceedings is following up on its original November 6 request and November 14 follow-up email regarding its request for authorization to seek additional discovery. Petitioner can provide updated availability for this week for a conference call should the Director deem a call is necessary.

Regards-
Lori Gordon
Lead Counsel – IPR2025-01054

Lori Gordon



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From: Gordon, Lori A

Sent: Friday, November 14, 2025 10:56 AM

To: 'Director_DI@uspto.gov' <Director_DI@uspto.gov>; 'Director_Discretionary_Decision' <director_discretionary_decision@uspto.gov>

Cc: 'Dokhanchy, Reza' <RDokhanchy@mintz.com>; 'Meunier, William' <WAMeunier@mintz.com>; 'Rizk, Adam' <ARizk@mintz.com>; 'Renaud, Michael' <MTRenaud@mintz.com>; 'Goma, Tawfik' <TAGoma@mintz.com>; 'Agarwal, Pavan K.' <PAgarwal@foley.com>; 'Houston, Michael R.' <MHouston@foley.com>; 'Goma, Tawfik' <TAGoma@mintz.com>; Konstantakopoulos, Theodoros <tkonstantakopoulos@goodwinlaw.com>

Subject: RE: IPR2025-01054, -01082: Authorization to Seek Additional Discovery

IPR2025-01054

IPR2025-01082

Honorable Director:

Petitioner in the above-referenced proceedings is following up on its November 6 request for authorization to seek additional discovery. The parties can provide updated availability for a conference call should the Director deem a call is necessary.

Regards-
Lori Gordon

Lead Counsel – IPR2025-1054

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From: Gordon, Lori A
Sent: Thursday, November 6, 2025 4:14 PM
To: 'Director_DI@uspto.gov' <Director_DI@uspto.gov>; Director_Discretionary_Decision <director_discretionary_decision@uspto.gov>
Cc: 'Dokhanchy, Reza' <RDokhanchy@mintz.com>; Meunier, William <WAMeunier@mintz.com>; Rizk, Adam <ARizk@mintz.com>; Renaud, Michael <MTRenaud@mintz.com>; Goma, Tawfik <TAGoma@mintz.com>; Agarwal, Pavan K. <PAgarwal@foley.com>; Houston, Michael R. <MHouston@foley.com>; Goma, Tawfik <TAGoma@mintz.com>; Konstantakopoulos, Theodoros <tkonstantakopoulos@goodwinlaw.com>
Subject: IPR2025-01054, -01082: Authorization to Seek Additional Discovery

IPR2025-01054

IPR2025-01082

Honorable Director:

Petitioner in both above-referenced proceedings seeks authorization to serve additional discovery and/or to file a motion for additional discovery from Patent Owner limited to the following:

- The licenses to Intel Corporation and Samsung Electronics Co., Ltd. identified in paragraph 3 of the “Declaration of Paul Ahern” (2104) and any other license to the challenged patents in Patent Owner’s possession
- Deposition of Mr. Paul Ahern. Petitioner is willing to agree to a single 4-hour deposition provided Patent Owner agrees that the deposition transcript can be used in each of the above-referenced proceedings.

Good cause exists for the above discovery based on the arguments made in PO’s discretionary denial brief relying on prior licenses and on PO’s settled expectations. For example, to support its claimed commercialization argument, Patent Owner states that “Intel Corporation and Samsung Electronics Co., Ltd. have taken licenses to” the challenged patents. Moreover, the only support for the existence of these licenses is a single sentence in the Declaration of Paul Ahern which further states that Intel and Samsung “operate in and import licensed products into the United States” but Mr. Ahern does not provide the dates of the licenses or any details regarding the relevant terms. The

alleged bare statement that a license exists does not end the inquiry for discretionary denial purposes. Petitioner is entitled to review the licenses and depose Mr. Ahern to assess the timing and scope of the license as to the challenged patents. The information sought by Petitioner is therefore directly responsive to these arguments and are the type of information that the PTAB has said “weigh against a patent owner’s claim of settled expectations.” See *Intel Corp. v. Proxsense LLC*, IPR2025-00327 at *2-*3 (PTAB June 26, 2025).

Petitioner contacted Patent Owner’s counsel on Monday morning November 3 regarding this request. On Tuesday after 5pm ET, Patent Owner’s counsel indicated that they were “conferring with” their client. Patent Owner responded yesterday (Wednesday) at 6pm indicating its initial opposition alleging that TSMC “already has a copy of the underlying license agreements (which Marlin/Longitude produced under the ITC’s protective order).” However, IPR counsel is not counsel in the ITC and per review of the ITC protective order TSMC and IPR counsel is barred from access to any confidential ITC discovery and such confidential information produced under the ITC protective order cannot be used in other proceedings.

Throughout today, the parties continued to negotiate regarding Petitioner’s discovery request but have not been able to come to a resolution which permits Petitioner to access and use this information in the above-referenced IPR proceedings. Patent Owner indicated in their last communication that they would not oppose IPR counsel entering an appearance in the ITC matter and accessing the license agreements. However, this is not sufficient resolution because the ITC protective order bars use of ITC confidential information in any other proceeding. Patent Owner indicated that after IPR counsel files a notice of appearance in the ITC matter and accesses the agreements, only at that point, are they willing “to discuss production of the licenses at the PTAB, subject to obtaining third party consent and a suitable PO to protect the disclosure.” Patent Owner did not provide any insight into timeframe for such later discussions.

Patent Owner continues to oppose any deposition of Mr. Ahern.

Given the limited time for discovery during the discretionary denial phase, Petitioner is seeking authorization for the limited additional discovery outlined above.

Should the Director deem a call is necessary or helpful to resolve this request, Petitioner’s counsel in both matters is available any time after 10am ET on Friday (11/7) and will follow-up with availability of Patent Owner’s counsel.

Regards-

Lori A. Gordon
Lead Counsel – IPR2025-01054

Pavan Agarwal
Counsel – IPR2025-01082

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