

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TAIWAN SEMICONDUCTOR MANUFACTURING CO. LTD.,

Petitioner

v.

ADVANCED INTEGRATED CIRCUIT PROCESS LLC,

Patent Owner

Case IPR2025-01302

Patent 8,884,373

**PATENT OWNER’S REPLY BRIEF IN SUPPORT OF DISCRETIONARY
DENIAL PURSUANT TO THE BOARD’S MARCH 26, 2025
INTERIM PROCESSES FOR PTAB WORKLOAD MANAGEMENT
[PUBLIC REDACTED VERSION]**

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TSMC’s opposition (“Opp’n”) does not dispute that its five IPR petitions seek to invoke the Board’s limited resources to adjudicate 89 claims, most of which are ***both*** expired ***and*** not asserted in any lawsuit. Nor does TSMC dispute that the trial court can resolve all pertinent validity disputes in a ***single*** proceeding without requiring the Board to undertake ***five*** laborious IPR proceedings. And TSMC admits that the scheduled trial date precedes the projected FWD date by months, Opp’n at 19, meaning that the district court will likely do so well before the Board. Instead, TSMC advances four flawed arguments, none of which merits institution.

I. TSMC’s Examiner Error Arguments Are Flawed

TSMC’s examiner error theory relating to claim 1 of the ’373 patent raises more questions than it answers, and its accompanying merits arguments—particularly its confusing charts with no citations to record evidence, Opp’n at 9-12—are difficult to follow. But several things are clear. As an initial matter, TSMC does ***not*** assert that Tamaki anticipates any claims. *See* Petition at 2 (asserting only obviousness). And TSMC’s opposition echoes that admission, alleging that “two embodiments of Tamaki individually disclose ***or render obvious*** every limitation of claim 1.” Opp’n at 3 (emphasis added). AICP cannot determine which claim 1 limitation(s) TSMC contends are expressly “disclose[d]” by Tamaki’s embodiments and which limitation(s) TSMC concedes are at most “obvious” (and why). AICP

similarly cannot determine how the examiner allegedly erred in failing to assert TSMC's obviousness theory, whatever that obviousness theory is.

Equally unclear is the impact of the claim construction issue that TSMC raises but does not answer. TSMC asserts that while claim 1 only expressly requires that the "second dual-gate electrode be[] separated from the first dual-gate electrode," the applicants argued during prosecution that "Tamaki 'fail[ed] to disclose or suggest a device including two dual-gate electrodes that are separated from each other *and independent of each other.*'" Opp'n at 4 (emphasis added). TSMC's argument suggests a prosecution disclaimer, but the Petition oddly states that "Petitioner does not believe any claim term requires construction to resolve the patentability disputes in this proceeding," Petition at 15. TSMC never explains whether it contends the applicants disclaimed scope and, if so, what "independent of each other" means and how it impacts whether, under that meaning, claim 1 of the '373 patent is rendered obvious by any of Tamaki's embodiments.

TSMC's assertion of "unfair dealings" is unfounded. The applicants were entitled to argue that "Tamaki 'fail[ed] to disclose or suggest a device including two dual-gate electrodes that are separated from each other and independent of each other.'" Opp'n at 4. Tamaki is a published U.S. patent application and "the examiner was free to reach his own conclusions and accept or reject [the applicants'] arguments." *Young v. Lumenis, Inc.*, 492 F.3d 1336, 1349 (Fed. Cir.

1997). It appears the examiner agreed with the applicants. Although TSMC contends that the applicants “obscured” a written opinion by the International Searching Authority by submitting it without a translation, Opp’n at 8, TSMC cites no law requiring the applicants to translate such a document and, in any event, “[t]he details of foreign prosecution are not an additional category of material information.” *ATD Corp. v. Lydall, Inc.*, 159 F.3d 534 (Fed. Cir. 1998).

Further, even if one assumes incorrectly that TSMC had adequately identified some type of examiner error, institution makes little sense. TSMC’s examiner error argument is directed at claim 1. But the Petition challenges all fourteen claims in the patent, Petition at 1, even though *only four of those claims are asserted in the Lawsuit*, EX2010 at 8. Here, institution would require the Board to needlessly address the merits of ten claims that are *not* even asserted in the Lawsuit. For example, claims 5 and 7 are not asserted, EX2010 at 8, and TSMC concedes that “Tamaki does not explicitly disclose [their dependent limitations],” Petition at 53. TSMC instead relies upon a different reference (*i.e.*, Sumi) as allegedly “provid[ing] this teaching.” *Id.* Even assuming examiner error occurred as to claim 1, institution would require the parties and Board to expend significant resources litigating complicated issues pertaining to these and other *unasserted* claims.

TSMC’s theory is in any event a thinly disguised merits argument. AICP has already explained that it is not addressing the Petition’s merits at this stage because

TSMC is using its IPR petitions as tactical stalking horses. *See* Paper 9 at 18. Further, while AICP prepared and filed preliminary responses exposing some of the numerous flaws in six of TSMC’s earlier IPR petitions, doing so created significant expense and duplication even though the Director ultimately granted discretionary denial. *See* Paper 9 at 18-19 (referencing IPR2025-00682, Paper 17 and IPR2025-00828, Paper 17). If proceedings are instituted here, AICP intends to develop rebuttals to the Petition’s grounds and vigorously defend the ’373 patent’s validity.

II. TSMC’s “Settled Expectations” Arguments Are Flawed

The ’373 patent issued eleven years ago. The Director has already (1) held that other similarly situated AICP patents create strong settled expectations for AICP; and (2) rejected the same arguments TSMC now makes. *See id.* and 19-20. AICP’s position is even stronger here because [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]. *Intel Corp. v. Proxense LLC*, IPR2025-00327, Paper-12, 2-3 (June 26, 2025). And the licenses doubtless are in TSMC’s technology space because, as TSMC admits, the four patents focus on a single technology: *i.e.*, “semiconductor design and manufacture.” Opp’n at 21-22.

III. TSMC’s Arguments Relating to the Other *Fintiv* Factors Are Flawed

While TSMC’s *Fintiv* arguments are flawed, two merit special attention.

First, although TSMC admits the trial date precedes the projected FWD due date by months, Opp’n at 19, TSMC nevertheless says *Fintiv* Factor 2 is “at least neutral,” *id.* TSMC is incorrect. *See* Paper 9 at 11-12. And TSMC’s trial statistics have little weight because a firm trial date exists and no evidence suggests that trial will be delayed. TSMC’s example of a trial that was delayed by just three weeks (*i.e.*, from October 3rd to 27th), Opp’n at 20, highlights why, even if trial was delayed, it would likely not invert the order of the trial and FWD dates.

Second, TSMC does not dispute that discovery available only in the district court could eliminate some of the five IPR petitions’ grounds. *See* Paper 9 at 17-18. While TSMC labels such evidence “speculat[ive],” Opp’n at 22, it does not dispute that: (1) regardless of institution, AICP must continue litigating validity in court to obtain the evidence; and (2) if AICP does so successfully, thereby defeating some invalidity theories in court, inconsistent decisions could occur between the district court and the PTAB.

IV. TSMC’s Arguments Relating to National Security Are Flawed

TSMC’s feigned fears over national security are meritless. *See* Paper 9 at 18-19. AICP has waived injunctive remedies with respect to the ’373 patent. *Id.* at 19. And despite the Director’s guidance on the two requirements for asserting this theory, *id.* at 18-19, TSMC refuses to “specifically identify” the relevant products, Opp’n at 24-25, or explain how the patent allegedly relates to national security.

Dated: November 5, 2025

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned certifies that pursuant to 37 C.F.R. § 42.6(e), a copy of the foregoing **Patent Owner's Reply Brief in Support of Discretionary Denial Pursuant to The Board's March 26, 2025 Interim Processes for PTAB Workload Management [Public Redacted Version]**, was served to the following counsel of record for Petitioner addressed as follows:

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