

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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EXCELLIANCE MOS CORPORATION,

Petitioner,

v.

FORCE MOS TECHNOLOGY CO. LTD.,

Patent Owner

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*Inter Partes Review* No. IPR2025-01433

U.S. Patent No. 7,629,634

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**PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL**

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**PATENT OWNER'S EXHIBIT LIST**

| <b>Exhibit</b> | <b>Description</b>                                                                                                                                                                                                                                                                                                                                                                   |
|----------------|--------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|
| <b>2001</b>    | Complaint, as filed at ECF 1 in <i>Force MOS Tech., Co., Ltd. v. ASUSTeK Computer, Inc.</i> , No. 2:22-cv-460 (E.D. Tex. Nov. 28, 2022)                                                                                                                                                                                                                                              |
| <b>2002</b>    | ASUSTeK Computer, Inc., Consolidated Financial Statements (3rd Quarter 2019, September 30, 2019), ( <i>available at</i> <a href="https://www.asus.com/event/investor/content/attachment_en/2019_q3_finacial_report.pdf">https://www.asus.com/event/investor/content/attachment_en/2019_q3_finacial_report.pdf</a> )                                                                  |
| <b>2003</b>    | ASUSTeK Computer, Inc., Annual Report (2023), ( <i>available at</i> <a href="https://www.asus.com/EVENT/Investor/Content/attachment_en/2023_Annual_Report.pdf">https://www.asus.com/EVENT/Investor/Content/attachment_en/2023_Annual_Report.pdf</a> )                                                                                                                                |
| <b>2004</b>    | Excelliance MOS Corporation, Annual Report (2024), ( <i>available at</i> <a href="https://www.excelliancemos.com/en/investors/report-detail/137/">https://www.excelliancemos.com/en/investors/report-detail/137/</a> )                                                                                                                                                               |
| <b>2005</b>    | Plaintiff's First Amended Infringement Contentions, as served in <i>Force MOS Tech., Co., Ltd. v. ASUSTeK Computer, Inc.</i> , No. 2:22-cv-460 (E.D. Tex. May 7, 2024)                                                                                                                                                                                                               |
| <b>2006</b>    | Defendant/Counterclaim-Plaintiff's Answer, Affirmative Defenses, And Counterclaims, as filed at ECF 6 in <i>Force MOS Tech., Co., Ltd. v. ASUSTeK Computer, Inc.</i> , No. 2:22-cv-460 (E.D. Tex. Feb. 27, 2023)                                                                                                                                                                     |
| <b>2007</b>    | Email from C. McMahon re: ASUSTeK (Force MOS) Summary of Pre-Trial Conference (Dec. 4, 2024), as filed in <i>Inergy Technology Inc., v. Force MOS Technology Co., Ltd.</i> , Case No. 2024-Min-Gong-Shang-Zih No. 2, Taiwan Intellectual Property and Commercial Court: Ping Judicial Section, as Exhibit 37 to Inergy Technology Inc.'s Civil Answer Brief No. III (April 11, 2025) |

| <b>Exhibit</b> | <b>Description</b>                                                                                                                                                                                                                                                                                                                                                                          |
|----------------|---------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|
| <b>2008</b>    | Email string including email from C. McMahon re: ASUSTeK Mediation and Trial Update (Feb. 15, 2025), as filed in <i>Inergy Technology Inc., v. Force MOS Technology Co., Ltd.</i> , Case No. 2024-Min-Gong-Shang-Zih No. 2, Taiwan Intellectual Property and Commercial Court: Ping Judicial Section, as Exhibit 38 to Inergy Technology Inc.'s Civil Answer Brief No. III (April 11, 2025) |
| <b>2009</b>    | Invalidity Expert Report of Stanley R. Shanfield, Ph.D., as served in <i>Force MOS Tech., Co., Ltd. v. ASUSTeK Computer, Inc.</i> , No. 2:22-cv-460 (E.D. Tex. May 20, 2024)                                                                                                                                                                                                                |
| <b>2010</b>    | Amened Final Judgment, <i>Force MOS Tech., Co., Ltd. v. ASUSTeK Computer, Inc.</i> , No. 2:22-cv-460 (E.D. Tex. June 13, 2025)                                                                                                                                                                                                                                                              |
| <b>2011</b>    | Trial Transcript, Vol. 1 (Feb. 7, 2025), as filed at ECF 369 in <i>Force MOS Tech., Co., Ltd. v. ASUSTeK Computer, Inc.</i> , No. 2:22-cv-460 (E.D. Tex. Feb. 7, 2025)                                                                                                                                                                                                                      |
| <b>2012</b>    | Defendant ASUSTeK Computer, Inc.'s Motion to Stay Pending Resolution of <i>Inter Partes</i> Reviews, <i>Force MOS Tech., Co., Ltd. v. ASUSTeK Computer, Inc.</i> , No. 2:22-cv-460 (E.D. Tex. Nov. 30, 2023)                                                                                                                                                                                |
| <b>2013</b>    | Memorandum Opinion and Order Denying Defendant ASUSTeK Computer, Inc.'s Motion to Stay Pending Resolution of <i>Inter Partes</i> Reviews, <i>Force MOS Tech., Co., Ltd. v. ASUSTeK Computer, Inc.</i> , No. 2:22-cv-460 (E.D. Tex. Apr. 11, 2024)                                                                                                                                           |
| <b>2014</b>    | Defendant ASUSTeK Computer, Inc.'s Patent Initial Disclosures (Invalidity Contentions), as served in <i>Force MOS Tech., Co., Ltd. v. ASUSTeK Computer, Inc.</i> , No. 2:22-cv-460 (E.D. Tex. July 18, 2023)                                                                                                                                                                                |
| <b>2015</b>    | IPR2024-00093, Petition, Paper No. 1 (Oct. 27, 2023)                                                                                                                                                                                                                                                                                                                                        |
| <b>2016</b>    | Defendant's Notice of Final Invalidity Theories and Equitable Defenses, as served in <i>Force MOS Tech., Co., Ltd. v. ASUSTeK Computer, Inc.</i> , No. 2:22-cv-460 (E.D. Tex. Jan. 6, 2025)                                                                                                                                                                                                 |

| <b>Exhibit</b> | <b>Description</b>                                                                                                                                                                                                    |
|----------------|-----------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|
| <b>2017</b>    | IPR2024-00093, Final Written Decision, Paper No. 38 (May 16, 2025)                                                                                                                                                    |
| <b>2018</b>    | IPR2024-00093, Petitioner's Notice of Appeal, Paper No. 39 (July 17, 2025)                                                                                                                                            |
| <b>2019</b>    | Trial Transcript, Vol. 4 (Feb. 12, 2025), as filed at ECF 372 in <i>Force MOS Tech., Co., Ltd. v. ASUSTeK Computer, Inc.</i> , No. 2:22-cv-460 (E.D. Tex. Feb. 10, 2025)                                              |
| <b>2020</b>    | PTACTS Docket of IPR2024-00093 (accessed October 20, 2025)                                                                                                                                                            |
| <b>2021</b>    | PACER Docket of Force Mos Technology Co., Ltd. v. ASUSTeK Computer, Inc., Case No. 2:22-cv-00460-JRG (E.D. Tex.) (accessed October 20, 2025)                                                                          |
| <b>2022</b>    | Trial Transcript (Redacted), Vol. 2 (Feb. 10, 2025), as filed at ECF 403-1 in <i>Force MOS Tech., Co., Ltd. v. ASUSTeK Computer, Inc.</i> , No. 2:22-cv-460 (E.D. Tex. Feb. 10, 2025)                                 |
| <b>2023</b>    | Jury Verdict as filed at ECF 358 in <i>Force MOS Tech., Co., Ltd. v. ASUSTeK Computer, Inc.</i> , No. 2:22-cv-460 (E.D. Tex. Feb. 7, 2025)                                                                            |
| <b>2024</b>    | Trial Transcript (Redacted), Vol. 3 (Feb. 11, 2025), as filed at ECF 403-2 in <i>Force MOS Tech., Co., Ltd. v. ASUSTeK Computer, Inc.</i> , No. 2:22-cv-460 (E.D. Tex. Feb. 7, 2025)                                  |
| <b>2025</b>    | Findings of Fact and Conclusions of Law, as filed at ECF 420 in <i>Force MOS Tech., Co., Ltd. v. ASUSTeK Computer, Inc.</i> , No. 2:22-cv-460 (E.D. Tex. June 11, 2025)                                               |
| <b>2026</b>    | Specification Sheet for Excelliance EMB20N03V MOSFET                                                                                                                                                                  |
| <b>2027</b>    | Notice of Attorney Appearance by Charles M McMahon on behalf of ASUSTeK Computer, Inc., as filed at ECF 115 in <i>Force MOS Tech., Co., Ltd. v. ASUSTeK Computer, Inc.</i> , No. 2:22-cv-460 (E.D. Tex. Feb. 7, 2025) |

| Exhibit | Description                                                                                                                                                                                                                    |
|---------|--------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|
| 2028    | Excelliance MOS Corporation, Annual Report (2025), ( <i>available at</i> <a href="https://www.excelliancemos.com/en/investors_document-detail/0/291/">https://www.excelliancemos.com/en/investors_document-detail/0/291/</a> ) |
| 2029    | <i>LinkedIn</i> entry for V. Tsai ( <i>available at</i> <a href="https://www.linkedin.com/in/tseng-catherine-518b9556/">https://www.linkedin.com/in/tseng-catherine-518b9556/</a> )                                            |
| 2030    | Email string including email from R. Garsson re: Discovery Meet and Confer Summary, as exchanged in <i>Force MOS Tech., Co., Ltd. v. ASUSTeK Computer, Inc.</i> , No. 2:22-cv-460 (E.D. Tex. Feb. 8, 2024)                     |

## **I. INTRODUCTION**

This IPR should be discretionarily denied institution, as it is an example of repeated, harassing attempts to invalidate a patent by an adjudged infringer. Indeed, this IPR has actually been filed on behalf of EMC's customer, shareholder, and affiliate—undisclosed real party-in-interest ASUSTek Computer Inc. ("ASUS"). Force MOS first asserted the '634 Patent against ASUS in a complaint filed nearly three years ago in District Court. That case has already proceeded to trial, where ASUS abandoned its invalidity defense for the '634 Patent, resulting in a judgment of infringement against ASUS. The '634 Patent was also subject to IPR2024-00093, ostensibly filed by one of ASUS's other suppliers (Inergy Technologies), but which expressly identified ASUS as a real party-in-interest. In that IPR, the Board found all challenged claims of the '634 Patent to be valid.

Petitioner and ASUS are more than merely supplier and customer. ASUS is one of Petitioner's largest shareholders. ASUS itself is a corporate director of Petitioner, and two ASUS employees serve on the board of directors of Petitioner. Petitioner's products were specifically identified as infringing in the litigation long before this Petition was filed. And, Petitioner actively participated in the EDTX litigation, receiving detailed communications on its status from ASUS's litigation counsel, and assisting ASUS's expert in developing non-infringement theories. Indeed, the Petition is specifically calculated to challenge claims found infringed

by ASUS at the EDTX trial—claims 1-3. As such, there is little question that ASUS is the intended beneficiary of the present petition and should be found to be a real party in interest, or in privity, with Petitioner.

Thus, there are many reasons that this proceeding should be discretionarily denied institution: (1) the validity of the '634 Patent has already been fully litigated in IPR2024-00093, brought on behalf of ASUS by another of its suppliers; (2) denial is appropriate under *General Plastic* because this petition was filed well after IPR2024-00093, and benefits from seeing Patent Owner's arguments in that IPR; (3) denial is appropriate under *Fintiv* because the co-pending district court litigation has already proceeded to trial and final judgment; (4) this Petition presents excessive, redundant grounds without good reason; and (5) settled expectations of the parties justify discretionary denial.

Indeed, in IPR2025-00920, the Acting Director already discretionarily denied an IPR filed by a different of ASUS's suppliers challenging another of Force MOS's patents asserted in the EDTX case. There is no reason to depart from that result in this IPR.

## **II. FACTUAL BACKGROUND**

On November 28, 2022, Patent Owner filed a complaint in Case No. 2:22-cv-460-JRG in the Eastern District of Texas ("the EDTX case") against ASUSTeK Computer, Inc. ("ASUS"), alleging, among other things, infringement of the '634

Patent. Ex. 2001 at 10, 17. During the EDTX case, ASUS asserted claims and defenses alleging invalidity of the '634 Patent, and litigated those claims through expert reports and pretrial motions. Ex. 2006 at 8, 13-14; Ex. 2009 at 25-103; Ex. 2021. ASUS only withdrew its invalidity defense for the '634 Patent on January 6, 2025, shortly before trial. Ex. 2016; Ex. 2019 at 1004:18-22.

The EDTX case against ASUS ultimately proceeded to a jury trial on February 7-13, 2025. Ex. 2021 at 45-46 (ECF Nos. 349-361). In that case, Force MOS demonstrated that certain accused MOSFETs incorporated in ASUS products infringed claims 1-3 of the '634 Patent and U.S. Patent No. 7,812,409 ("the '409 Patent"). In particular, the accused MOSFETs included Petitioner EMC's EMB20N03V MOSFET. Ex. 2022 at 345:20-346:17, 396:20-397:6, 432:14-436:4. The jury issued a verdict on February 13, 2025, finding for Force MOS on all issues—including the infringement of the '634 Patent—and awarding \$10.5 million in damages. Ex. 2023 at 5, 9. After a bench trial on inequitable conduct, the District Court issued findings of fact and conclusions of law ruling against ASUS's inequitable conduct defense. Ex. 2025. The District Court subsequently entered an amended judgment on June 13, 2025 in favor of Force MOS and against ASUS. Ex. 2010 at 2. Currently, various post-trial motions, including ASUS's motions for new trial and renewed motions for judgment as a matter of law, remain pending in the EDTX case. Ex. 2021 at 53-60.

On October 27, 2023, Inergy Technology, Inc.—an indirect supplier to ASUS of some of the MOSFETs accused of infringement in the EDTX case—filed IPR2024-00093 challenging the '634 Patent. Ex. 2015 at 75; Ex. 2011 at 244:18-24; Ex. 2022 at 623:8-13. ASUS was expressly identified as an admitted real-party-in-interest in IPR2024-00093, as was ASUS's indirect supplier Panjit International, Inc. Ex. 2015 at 1. IPR2024-00093 was instituted and thereafter proceeded through trial, briefing, depositions, and the oral hearing on February 21, 2025. Exs. 2016, 2021. On May 16, 2025—after the EDTX case verdict but before the judgment—the Board issued a Final Written Decision in IPR2024-00093 finding claims 1-9 patentable. Ex. 2017. On June 17, 2025, Petitioner appealed IPR2024-00093 to the Federal Circuit, and that appeal remains pending. Ex. 2018.

On August 15, 2025—after the EDTX jury verdict, and after the Final Written Decision in IPR2024-00093, Petitioner Excelliance Mos Corporation filed the present IPR Petition challenging claims 1-9 of the '634 Patent. Pet. at 16. Notably, the Petition only identifies Excelliance Mos Corporation as a real party-in-interest. Pet. at 13. Although the Petition notes the existence of IPR2024-00093 and the EDTX case (*id.* at 14), it contains no substantive attempt to address discretionary denial. Notably, the Petition is entirely silent as to the relationship between Petitioner and ASUS (discussed in further detail below).

### III. ARGUMENT

#### A. DISCRETIONARY DENIAL IS APPROPRIATE BECAUSE THE VALIDITY OF THE '634 PATENT HAS BEEN PREVIOUSLY ADJUDICATED

Discretionary denial is appropriate where “the PTAB . . . has already adjudicated the validity or patentability of the challenged patent claims.” March 26, 2025 Interim Process Memorandum at 2. Here, the '634 Patent has already been subject to a challenge to validity in the EDTX case (at least until the eve of trial), as well as in IPR2024-00093, which already found claims 1-9 of the '634 Patent to be valid. Ex. 2017 at 2, 35; Ex. 2009 at 25-103. Additionally, ASUS litigated the issues of whether Hshieh '384 anticipates or renders obvious the '634 Patent in the context of its inequitable conduct materiality theories, which the District Court rejected. Ex. 2025 at 7-11, 38, 40-41 (FF#31-52; CL#9, 21-28). These prior challenges to the validity of the '634 Patent favor discretionary denial.

This mirrors the same concerns expressed in the Acting Director's decision in *uPI Semiconductor Corp. v. Force MOS Tech. Co. Ltd.*, IPR2025-00920, Paper 12 (PTAB Sept. 12, 2025). Like this IPR, that IPR was brought by one of ASUS's MOSFET suppliers regarding a different patent asserted in Patent Owner's EDTX case against ASUS, and that patent was also subject to a prior IPR filed by Inergy. In *uPI*, the Acting Director found discretionary denial was appropriate because “the challenged patent was involved in a district court proceeding in which claim 1

of the patent was found not invalid” and was “the subject of a pending inter partes review in which the Board issued a final written decision finding claims 1 and 3–5 unpatentable, and claims 2 and 6 not unpatentable.” *Id.* at 2. The main difference between this IPR and *uPI* is that ASUS elected to drop its invalidity defenses for the '634 Patent after expert reports and pre-trial motions but *prior* to the jury trial. Exs. 2009, 2016. By contrast, ASUS elected to present its invalidity defense on the '409 Patent to the jury. Ex. 2016. But that should not change the calculus of discretionary denial. That ASUS and its proxies made Force MOS engage in the burden and expense of defending the '634 Patent's validity in one forum through completion (IPR2024-00093) and in another forum through near completion (the EDTX case) demonstrates that a further bite at the apple is inappropriate.

**B. THIS IPR WAS FILED ON BEHALF OF ASUS—  
AN UNDISCLOSED REAL PARTY-IN-INTEREST**

The Petition asserts that the sole real party-in-interest is “Excelliance Mos Corporation.” Pet. at 13. However, it is clear that ASUSTeK Computer, Inc. (“ASUS”) is an undisclosed real party-in-interest and privy in this IPR.

The RPI rules “seek[] to protect patent owners from harassment via successive petitions by the same or related parties, to prevent parties from having a ‘second bite at the apple.’” Office Patent Trial Practice Guide, 84 Fed. Reg. 64,280 at 12 (Nov. 21, 2019) (“Trial Practice Guide”). As to privity, “[a] common

consideration is whether the non-party exercised or could have exercised control over a party's participation in a proceeding.” *Id.* at 16.

“Determining whether a non-party is [an RPI] demands a flexible approach that takes into account both equitable and practical considerations, with an eye toward determining whether the non-party is a clear beneficiary that has a preexisting, established relationship with the petitioner.” *Apps. in Internet Time, LLC v. RPX Corp.*, 897 F.3d 1336, 1351 (Fed. Cir. 2018). “[T]wo questions [lie] at [the] heart [of this inquiry:] whether a non-party ‘desires review of the patent’ and whether a petition has been filed at a nonparty’s ‘behest.’” *Id.* The inquiry focuses on who “will benefit from the redress that the chosen tribunal might provide . . . and should extend to parties to transactions and other activities relating to the property in question.” *Id.* at 1349. “[A] non-party may be a real party-in-interest even in the absence of control or an opportunity to control.” *Cisco Sys., Inc. v. Hewlett Packard Enter. Co.*, IPR2017-01933, Paper 9 at 12 (PTAB Mar. 16, 2018).

In this IPR, publicly available information confirms that ASUSTek Computer Inc.—the disclosed real party in interest in IPR2024-00093 and the defendant in the EDTX case—is a real party in interest and/or privy of Petitioner. As early as 2019, ASUS identified in its public financial reports that Petitioner was a related party. *Ex.* 2002 at 67. Further, ASUS’s 2023 Annual Report confirms

that the ASUS group of companies was, at the time, the “single largest shareholder” of Petitioner, with a 12.50% equity interest. Ex. 2003 at 261. Moreover, this Annual Report also specifically identifies Petitioner as an “Associate” and Related Party of ASUS. *Id.* at 285. Petitioner’s own 2024 Annual Report identifies that ASUS, as an entity, is a Director of Petitioner, with ASUS’s Deputy Manager of Investment Division, Yueh-Lun Huang, acting as ASUS’s representative on Petitioner’s Board of Directors. Ex. 2004 at 26. ASUS’s former Chief Investment Officer, Chih-Hao Lee, also serves as a Director on EMC’s Board. Ex. 2028 at 36. And, in 2025, ASUS’s Chief Financial Officer, Chang Wu, began serving as the ASUS representative on Petitioner’s Board. *Id.* at 34. EMC’s 2025 Annual Report also identifies a 4.42% ownership interest by its Director, ASUS. *Id.* at 66. ASUS’s substantial, and continuing, ownership in Petitioner, as well as ASUS’s identification of Petitioner as a related entity, with ASUS currently acting as a Director on Petitioner’s Board, demonstrate that Petitioner is an RPI and in privity with ASUS, the defendant in the EDTX litigation. Moreover, ASUS’s officers, directors, and other employees hold positions of control at EMC. As previously identified, two of ASUS’s employees or former employees, Chang Rong Wu and Chih-Hao Lee, are on Petitioner’s Board of Directors. *Id.* at 34, 36.

Still further, EMC’s products have long been accused of infringing in the

district court litigation against ASUS. For example, in correspondence to ASUS's counsel sent on February 8, 2024, Force MOS's counsel first identified ASUS products containing Petitioner's EMB20N03V MOSFET as "Accused Products." Ex. 2030 at 4-5; Ex. 2026. And, in Force MOS's First Amended Infringement Contentions served in the EDTX case on May 7, 2024, Force MOS mentioned Petitioner by name and identified ASUS products incorporating Petitioner's EMB20N03V as infringing. Ex. 2005 at 2. Moreover, Patent Owner demonstrated that such products infringe the '634 Patent at the EDTX trial. Ex. 2022 at 345:20-346:17, 396:20-397:6, 432:14-436:4; Ex. 2010 at 2. Furthermore, EMC actively assisted ASUS in the EDTX trial by providing information to ASUS's technical expert witness for use at the trial. Ex. 2024 (Trial Tr. Vol. 3) at 828:20-831:7. As such, Petitioner has plainly long been aware that its products have been accused of infringing the '634 Patent in Patent Owner's EDTX case against ASUS. And, as a supplier of components to ASUS, Petitioner certainly has some form of indemnification obligation to ASUS for infringement caused by inclusion of EMC's MOSFETs. *See* U.C.C. § 2-312.

Indeed, emails that have been made publicly available in Taiwan court proceedings confirm EMC's participation in the EDTX litigation. In particular, ASUS's litigation counsel from Benesch Friedlander Coplan & Aronoff, Mr. Charles McMahon, sent detailed communications regarding the status of Force

MOS's EDTX case against ASUS to Vera Tsai (Vera.Tsai@excellancemos.com), who was then "Project Manager Sales Division" at EMC. Ex. 2007; Ex. 2008;<sup>1</sup> Ex. 2027 (Mr. McMahon's entry of appearance); Ex. 2029. These emails confirm that EMC was actively involved in the co-pending district court litigation.

In a similar situation, the Board held that a retailer was RPI in an IPR filed by the supplier in *Luminex International Co. v. Signify Holding BV*, IPR2024-00101, Paper 10 (PTAB May 9, 2024). Specifically, the Board found that the supplier's indemnification obligations showed that the petition was filed at the customer's "behest," making the customer RPI as to the supplier for purposes of the one-year bar. *Id.* at 37. The Board determined that the customer was therefore RPI of the supplier because it was "a clear beneficiary that has a preexisting, established relationship with the petitioner." *Id.* at 42. The prior Director reversed the Board's decision in *Luminex*, but on grounds that are readily distinguishable from the present case, holding that "a standard, non-exclusive, manufacturer-customer indemnification agreement relating to patent infringement can be sufficient to support a finding of real party in interest and trigger the one-year time bar." *Luminex International Co. v. Signify Holding BV*, IPR2024-00101, Paper 20

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<sup>1</sup> Ms. Tsai's full "excellancemos.com" email address appears in the email header later in the email chain, near the bottom of page 2 of Ex. 2008.

at 11 (PTAB Nov. 21, 2024). Thus, the prior Director decided that a mere supplier-customer relationship, with standard indemnification provisions, would not create an RPI relationship between the supplier and customer “without more.” *Id.*

However, as discussed, the relationship between Petitioner and ASUS involves *significantly* more than a standard indemnification relationship. As discussed, Petitioner is identified as a related party of ASUS, and ASUS is one of Petitioner's Directors as well as one of the largest, and at some times the largest, owners of Petitioner. Ex. 2002 at 67; Ex. 2003 at 261, 285; Ex. 2004 at 26, 44. Further, Petitioner actively communicated with ASUS's litigation counsel regarding the ongoing status of the co-pending District Court Litigation, and provided information to assist ASUS's technical expert in the EDTX case. Ex. 2007; Ex. 2008; Ex. 2024 (Trial Tr. Vol. 3) at 828:17-831:2. And, because the defendant in the EDTX case, ASUS, “is a clear beneficiary that has a preexisting, established relationship with the petitioner,” it is a RPI. *RPX*, 897 F.3d at 1351; *see also Worlds Inc. v. Bungie, Inc.*, 903 F.3d 1237 at 1242, 1246 (Fed. Cir.

2018).<sup>2</sup> Thus, the Board should therefore find that ASUS is RPI and in privity with Petitioner for these reasons..

Moreover, even if ASUS's relationship with Petitioner did not rise to the level of privity or RPI, discretionary denial is still appropriate because all of the same facts demonstrate a "significant relationship" between Petitioner and ASUS sufficient for discretionary denial of institution. *See Valve Corp. v. Electronic Scripting Prods., Inc.*, IPR2019-00062, Paper 11 at 10 (PTAB Apr. 2, 2019).

**C. THIS IPR SHOULD BE DENIED AS AN IMPROPER FOLLOW-ON PETITION UNDER *GENERAL PLASTIC***

Under the Interim Process Memorandum, the factors enumerated in the Board's precedential *General Plastic* decision form part of "all relevant considerations" regarding whether to grant a request for discretionary denial. March 26, 2025 Interim Process Memorandum at 2.

Because, as shown above, this petition, like IPR2024-00093, was filed on behalf of ASUS, it should be discretionarily denied as an improper follow-on IPR under *General Plastic*. *See General Plastic Industrial Co., Ltd. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 (PTAB Sept. 6, 2017). Each of the

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<sup>2</sup> Because ASUS is an RPI, this IPR is barred under 35 U.S.C. § 315(b), as it was filed more than one year after the '634 Patent's assertion against ASUS. Ex. 2001 at 10, 17. The time bar is relevant to this IPR's lack of compelling merits.

factors demonstrate that discretionary denial is appropriate.

**1. *General Plastic* Factor 1: whether the same petitioner previously filed a petition directed to the same claims of the same patent**

This petition challenges claims 1-9, which were all also challenged in IPR2024-00093. Pet. at 16; Ex. 2015 (IPR2024-00093 Pet.) at 4. Moreover, as shown above, this petition, like IPR2024-00093, was filed on behalf of ASUS. Thus, this factor weighs in favor of discretionary denial. *Valve*, IPR2019-00062, Paper 11 at 10 (factor 1 weighs toward discretionary denial where there is a “significant relationship” between petitioners in the current and prior IPRs).

**2. *General Plastic* Factor 2: whether at the time of filing of the first petition the petitioner knew of the prior art asserted in the second petition or should have known of it**

This factor weighs strongly towards discretionary denial since ASUS and Petitioner knew or should have known of all of the prior art asserted in this IPR long ago. ASUS served its invalidity contentions for the '634 patent on July 18, 2023—more than two years ago—which identified the Hshieh '384 reference as prior art. Ex. 2014 at 5, 9, 25, 52. And, Hshieh '384 was a primary reference for the '634 Patent in ASUS's invalidity expert report. Ex. 2009 ¶¶ 67, 91-92, 199-253. Uno (U.S. Patent 6,984,864) was also directly cited in ASUS's invalidity contentions, and discussed in that expert report. Ex. 2014 at 10; Ex. 2009 ¶¶ 416-418. As discussed, Petitioner was actively involved in the ASUS litigation. Exs.

2007-2008; Ex. 2024 at 828:20-831:7. Thus, ASUS and Petitioner knew or should have known of all of the cited prior art references in this Petition no later than July 18, 2023—which strongly weighs in favor of discretionary denial.

**3. *General Plastic* Factor 3: whether at the time of filing of the second petition the petitioner already received the patent owner's preliminary response to the first petition or received the Board's decision on whether to institute review in the first petition**

This factor weighs strongly towards discretionary denial. Indeed, not only did Petitioner wait until receiving Force MOS's preliminary response, it waited until after the institution, Patent Owner's response, Patent Owner's surreply, the oral hearing, and the Board's Final Written Decision in IPR2024-00093. Ex. 2020.

**4. *General Plastic* Factor 4: the length of time that elapsed between the time the petitioner learned of the prior art asserted in the second petition and the filing of the second petition**

This factor weighs strongly towards discretionary denial. More than two years have passed since ASUS's invalidity contentions.

**5. *General Plastic* Factor 5: whether the petitioner provides adequate explanation for the time elapsed between the filings of multiple petitions directed to the same claims of the same patent**

This factor weighs strongly towards discretionary denial. Petitioner provides no explanation, and instead misleadingly asserts that it was not a party to the prior IPR (without disclosing its relationship to ASUS). Pet. at 13.

**6. *General Plastic* Factor 6: the finite resources of the Board; and**

This factor weighs strongly towards discretionary denial. The Board has

fully litigated an entire IPR of the '634 Patent for ASUS once already.

**7. *General Plastic* Factor 7: the requirement under 35 U.S.C. § 316(a)(11) to issue a final determination not later than 1 year after the date on which the Director notices institution of review.**

This factor weighs strongly towards discretionary denial. As IPR2024-00093 has concluded, the proceedings cannot be coordinated or consolidated.

**D. DISCRETIONARY DENIAL IS APPROPRIATE UNDER *FINTIV***

Under the Interim Process Memorandum, the *Fintiv* factors form part of “all relevant considerations” that in determining whether to grant a request for discretionary denial. March 26, 2025 Interim Process Memorandum at 2. Each of the *Fintiv* factors counsel in favor of discretionary denial. *See Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020).

**1. *Fintiv* Factor 1: Likelihood of a District Court Stay**

In the EDTX case, the Court has already entered final judgment of infringement of the '634 Patent after a jury trial. Exs. 2010, 2023. Also, ASUS previously requested a stay of the pending litigation (Ex. 2012), which the district court denied. Ex. 2013. Thus, factor 1 weighs in favor of discretionary denial.

**2. *Fintiv* Factor 2: Proximity of Trial Date to the Projected Statutory Deadline**

Trial in the EDTX case has already occurred, with the Court finding the '634 Patent to be infringed. Ex. 2010. Currently, all that remains is for the Court to resolve post-trial motions. Ex. 2021 at 53-60. Since validity of the '634 Patent

was contested until shortly before trial in the EDTX case (Ex. 2019 at 1004:18-22) there is significant overlap in resources that have already been invested in the parallel proceeding. Thus, factor 2 weighs in favor of discretionary denial.

**3. *Fintiv* Factor 3: Investment in the Parallel Proceeding**

Trial and post-trial briefing in the EDTX case has concluded, and thus nearly all investment in the EDTX case has already occurred. Exs. 2010, 2023; Ex. 2021 at 53-60. Factor 3 weighs in favor of discretionary denial.

**4. *Fintiv* Factor 4: Overlap of Issues**

There is substantial overlap of issues in the present litigation and in the co-pending District Court litigation. As discussed above in *General Plastic* factor 2, in the EDTX case, real party-in-interest ASUS served invalidity contentions which listed some of the art asserted here and related art. *Supra* III.C.2. And, as discussed, ASUS litigated whether the Hsieh '384 Patent anticipated or rendered obvious the '634 Patent in the context of the bench trial on inequitable conduct in the EDTX case. Ex. 2025 at 8-11 (FF#40-50). Thus there is substantial overlap of issues between this IPR and the EDTX case, which therefore weighs heavily in favor of discretionary denial in the present case.

**5. *Fintiv* Factor 5: Whether Petitioner and the Defendant in the Parallel Proceeding are the Same Parties**

“If a petitioner is unrelated to a defendant in an earlier court proceeding,” this may weigh against exercising discretion to deny institution.” *Fintiv*, Paper 11

at 13–14. As explained in detail above, ASUS is an undisclosed privy and real party-in-interest. *Supra* III.B. And, Petitioner supplies MOSFETs accused of infringement by ASUS in the EDTX case, where Patent Owner is the plaintiff. *Id.* Further, as explained above, Petitioner participated in the EDTX case, ASUS is one of Petitioner's largest owners, and ASUS serves as a director of Petitioner. *Id.* Given the close relationship between ASUS and Petitioner, this factor weighs in favor of discretionary denial.

**6. *Fintiv* Factor 6: Other Considerations, Including the Merits**

As explained above and herein, other circumstances disfavor institution, including the prior adjudication of the '634 Patent's validity by the Board. Moreover, this Petition plainly lacks compelling merits. Indeed, Petitioner argues that Grounds 1 and 2 invalidate claims 1-9 as obvious under § 103(a), but Petitioner identifies no substantial motivation to combine or modify the references in Grounds 1 and 2, nor does Petitioner establish any anticipation grounds under §102. Pet. at 16, 22. The motivation to combine arguments for Ground 3 are improperly conclusory, evidencing hindsight bias. *See* Pet. at 136-137 (reciting boilerplate obviousness explanations).

Moreover, in connection with the bench trial on ASUS's inequitable conduct claim in the EDTX case, the District Court already found that the Hsieh '384 reference did not anticipate or render obvious claim 1 of the '634 Patent. Ex. 2025

at 8-11 (FF #40-50). And, because Petitioner's theory that a "lateral contact layer" is present in Uno are substantially the same as ASUS's materiality theory for that limitation in Hsieh '384 in the EDTX case, Petitioner's theories based on Uno are likely to fail for similar reasons. *Compare* Ex. 2025 at 8-11 (FF#40-50) with Pet. at 115-117. And, as discussed above, there are no compelling merits because this Petition is subject to non-discretionary denial due to the 1-year bar of 35 U.S.C. § 315(b). *See* Ex. 2001; *supra* III.B.

**E. THE PETITION SHOULD BE DISCRETIONARILY DENIED FOR EXCESSIVE AND REDUNDANT GROUNDS**

The Petition contains three separate obviousness grounds—each of which challenge claims 1-9 of the '634 Patent over Hsieh and Uno. Pet. at 16. The Petition contains no explanation for why three different grounds for only two references are needed. Thus, discretionary denial is appropriate. *See Adaptics Ltd. v. Perfect Co.*, IPR2018-01596 Paper 20 at 17-18 (March 6, 2019).

**F. SETTLED EXPECTATIONS FAVOR DISCRETIONARY DENIAL**

The then-Acting Director's Guidance Memorandum identifies that the "[s]ettled expectations of the parties, such as the length of time the claims have been in force" as a consideration relevant to the discretionary denial determination. Guidance Memorandum, 2. The '634 Patent issued on December 8, 2009, nearly *sixteen years* ago. Settled expectations have been found to counsel for

discretionary denial for patents that have issued far more recently than the '634 Patent. For example, in *iRhythm Tech., Inc. v. Welch Allyn, Inc.*, IPR2025-00363, Paper 10 (PTAB June 6, 2025), the Acting Director granted discretionary denial of a petition directed towards a patent that had been “in force since as early as 2012,” or approximately thirteen years. Similarly, in *Apotex Inc., v. Alkermes Pharma Ireland Limited*, IPR2025-00514, Paper 10 (PTAB July 2, 2025), the Acting Director denied institution of a petition challenging a patent that had been in force for more than 14 years and specifically identified that this length of time created “strong settled expectations.” Because the '634 Patent issued more than fifteen years ago, the settled expectations in the present case indeed exceed the settled expectations in all of these decisions.

Moreover, EMC's prior knowledge of the '634 Patent without challenging it until now further bolsters the settled expectations. Indeed, Force MOS has been awarded over 150 U.S. Patents, and the company is so proud of its patented innovations that it displays its patents on the walls of its conference room. Ex. 2011 (Trial Tr. Vol. 1) at 180-182. Second, beyond being competitors in the same industry of trenched MOSFETs, Petitioner would have specifically been aware of the '634 Patent on or around February of 2024, when Force MOS's counsel first identified ASUS products containing Petitioner's EMB20N03V as Accused Products. Ex. 2030 at 4-6; Ex. 2026; *see also* Exs. 2007-2008 (Petitioner's

employee receiving updates from ASUS's trial counsel regarding EDTX case). As such, the settled expectations of the parties counsel in favor of discretionary denial.

#### **IV. CONCLUSION**

For the foregoing reasons, Patent Owner respectfully submits that the Director and the Board should exercise their discretion under 35 U.S.C. § 314(a) and deny institution of the Petition.

Dated: October 20, 2025

Respectfully submitted,

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**CERTIFICATE OF SERVICE**

Pursuant to 37 C.F.R. § 42.6(e), I certify that on this 20th day of October, 2025, a true and correct copy of the foregoing **PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL** was served by electronic mail on Petitioner's counsel at the following email addresses:

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