

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TAIWAN SEMICONDUCTOR
MANUFACTURING COMPANY LTD. and APPLE INC.
Petitioners

v.

MYW SEMITECH, LLC,
Patent Owner

U.S. Patent No. 11,538,768
Issue Date: August 31, 2021

Title: CHIP PACKAGE

Inter Partes Review No. IPR2026-00065

**PATENT OWNER'S AUTHORIZED RESPONSE TO PETITIONERS'
OPPOSITION TO DISCRETIONARY DENIAL**

TABLE OF AUTHORITIES

Page(s)

Cases

<i>BASCOM Glob. Internet Servs. v. AT&T Mobility LLC</i> , 827 F.3d 1341 (Fed. Cir. 2016)	2
--	---

Statutes

35 U.S.C. §101	2
----------------------	---

The Examiner did not err during prosecution of U.S. Patent No. 11,538,763 (“the ’763 patent” or Ex. 1001). Petitioners argue that the CTE limitation was critical to the Examiner’s allowance of the pending claims. Paper 10, 3-5. But that is not true. In the Statement of Reasons for Allowance contained in the April 26, 2021 Notice of Allowance, the Examiner provided his explanation for allowing application claim 31 (*i.e.*, patent claim 16). Ex. 1002, 488, 620. The Examiner never cited the CTE limitation as one of the claim limitations warranting allowance. Ex. 1002, 449 (bottom half of page), 450 (top 4 lines of page). Unlike application claim 21, application claim 31 did not recite the CTE limitation. Ex. 1002, 436-440. The Examiner was fully aware that the CTE limitation could not be relied upon to allow application claim 31 because the CTE limitation was not in that claim. Indeed, nearly all of the claim limitations the Examiner did rely on to support patentability of application claim 31 in the April 26, 2021 Notice are found in patent claim 16. Thus, any subsequent amendments to application claim 31 did not affect or negate the reasons why the Examiner allowed application claim 31.

Petitioners argue that the June 22, 2021 Notice of Allowance also relied upon the CTE limitation as the basis for allowing application claim 31. Paper 10, 3-4. That is not true either. The Examiner’s reasons for allowance reads “independent claims 21 and 31 are allowable because the closest prior art does not appear to disclose, alone or in combination, the limitations of material and

structure of the chip package in combination with the other required elements of claim 21 or 31.” Ex. 1002, 551. This statement does not mention a CTE limitation. Instead, it appears to refer back to the limitations the Examiner cited from the prior April 26, 2021 Notice. Ex. 1002, 449-450.

The next paragraph—relied on by Petitioners—describe an inventive concept, not anticipation or obviousness. Ex. 1002, 552 (“limitations are material to the **inventive concept** of the application in hand to forming a polymer interconnect with sufficient coefficient of expansion to enable holes and other features formed inside with improved chemical durability, strength and optical properties.”) (emphasis added). An “inventive concept” is relevant to patentable subject matter – *i.e.*, 35 U.S.C. §101 – not whether a claim is novel or non-obvious. *See, e.g., BASCOM Glob. Internet Servs. v. AT&T Mobility LLC*, 827 F.3d 1341, 1349 (Fed. Cir. 2016) (“An inventive concept that transforms the abstract idea into a patent-eligible invention must be significantly more than the abstract idea itself ...”). This same paragraph appeared in the April 26, 2021 Notice of Allowance which provided several limitations that distinguished the claims over the prior art. Ex. 1002, 450. As is clear from the April 26, 2021 Notice, the Examiner never relied upon the CTE limitation as the basis for allowing application claim 31. Application claim 31 did not include a CTE limitation when the Examiner issued the April 26, 2021 Notice of Allowance, the June 22, 2021

Notice of Allowance, or the July 9, 2021 Notice of Allowance.

Petitioners argue that the Examiner made a second error by not searching in the right locations and by not using the right search terms. Petitioners argue that if the Examiner had conducted the correct searches, he would have located the Haba reference. Paper 10, 5-7. The Examiner used dozens of search terms while examining the '768 patent application. Ex. 1002, 570-580. Three of the search terms were “ppm/.degree.C”, “polymer same expansion adj coefficient” and “polymer near10 expansion adj coefficient”. Ex. 1002, 575. Collectively, just those three search terms returned over 2,200 hits. *Id.* Haba includes statements such as “coefficient of thermal expansion of less than 8 ppm/°C” (Ex. 1009, Abstract), “a coefficient of thermal expansion of less than 8 parts per million per degree Celsius (ppm/°C.)” (*Id.*, 1:53-55, 3:36-38), and “8 parts per million per degree Celsius (‘ppm/° C.’)” (*Id.*, 5:58-59). Petitioners do not explain why the search terms used by the Examiner did not return Haba.

Moreover, the Examiner cited at least one other reference for disclosure of the CTE limitation. In the September 21, 2020 Rejection, the Examiner relied on Tiedtke 2011/0257716 as disclosing the CTE range. Ex. 1002, 257. Even if the Examiner did not find Haba, Haba would only have been redundant of Tiedtke.

Dated: March 16, 2026

Respectfully submitted,

By: / Donald L. Jackson /

Donald L. Jackson (USPTO Reg. No. 41,090)

Richard Juang (USPTO Reg. No. 71,478)*

Chandran B. Iyer (USPTO Reg. No. 48,434)

Ronald M Daignault*

Erin Hadi (USPTO Reg. No. 79,904)*

djackson@daignaultiyer.com

rjuang@daignaultiyer.com

cbiyer@daignaultiyer.com

rdaignault@daignaultiyer.com

ehadi@daignaultiyer.com

DAIGNAULT IYER LLP

8229 Boone Boulevard, Suite 450

Vienna, VA 22182

**Not admitted in Virginia*

Attorneys for MYW Semitech, LLC

CERTIFICATE OF SERVICE

The undersigned hereby certifies that the foregoing PATENT OWNER'S
AUTHORIZED RESPONSE TO PETITIONERS' OPPOSITION TO
DISCRETIONARY DENIAL was served electronically via email on March 16,
2026, on the following counsel of record for Petitioners:

Jennifer C. Bailey
Paul R. Hart
Justin Grimes
ERISE IP, P.A.
jennifer.bailey@eriseip.com
paul.hart@eriseip.com
justin.grimes@eriseip.com
PTAB@eriseip.com

Dated: March 16, 2026

Respectfully Submitted,

By: / Donald L. Jackson /
Donald L. Jackson
USPTO Reg. No. 41,090