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. 11,894,306
Issue Date: February 6, 2024

Title: CHIP PACKAGE

Inter Partes Review No. IPR2026-00067

PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL OF INSTITUTION OF PETITION FOR *INTER PARTES* REVIEW OF UNITED STATES PATENT NO. 11,894,306

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PATENT OWNER'S EXHIBIT LIST

Exhibit No.	Description
2001	U.S. Patent No. 9,615,453
2002	Information Disclosure Statement for U.S. Application No. 17/929,180 dated December 21, 2023
2003	[SEALED] Email chain between Richard Juang, counsel for MYW Semitech, and Daniel Richards, counsel for Apple Inc., regarding production of materials
2004	[RESERVED]
2005	[SEALED] Email chain between Richard Juang, counsel for MYW Semitech, and Daniel Richards, counsel for Apple Inc., regarding availability of source code
2006	[SEALED] Email chain between Richard Juang and Peter Yang, counsel for TSMC, regarding inventorship.
2007	Oral Order for Motion to Stay Pending *Inter Partes* Review, *MYW Semitech, LLC v. Apple Inc.*, 1-25-cv-00504 (DDE) Dkt. 68 (January 21, 2026)
2008	Stipulation and [Proposed] Order to Amend Scheduling Order, *MYW Semitech, LLC v. Apple Inc.*, 1-25-cv-00504 (DDE) Dkt. 58 (December 3, 2025)
2009	[SEALED] Email from Taylor Lepore to Daniel Richards and counsel for Apple regarding Initial Infringement Contentions
2010	Agreed Stipulation Regarding the Discovery of Electronically Stored Information, *MYW Semitech, LLC v. Apple Inc.*, 1-25-cv-00504 (DDE) Dkt. 39 (October 14, 2025)
2011	Revision to Rules of Practice Before the Patent Trial and Appeal Board, 90 Fed. Reg. 48,335 (proposed Oct. 17, 2025) (to be codified at 37 C.F.R. pt. 42).
2012	Declaration of Richard Juang

2013	Default Protective Order

Patent Owner MYW Semitech, LLC, ("MYW" or "Patent Owner") respectfully requests the Director to deny institution of the Petition for *Inter Partes* Review ("Petition") filed by Taiwan Semiconductor Manufacturing Company Ltd. ("TSMC") and Apple Inc. ("Apple") (collectively, "Petitioners") challenging claims 1-27 of U.S. Patent No. 11,894,306 ("the '306 patent").

I. INTRODUCTION

Petitioners are abusing the *inter partes* review ("IPR") process to avoid the consequences of their actions in the pending district court litigation. Apple is the named defendant in the district court case; the accused chips are incorporated and used in various Apple devices. Since the opening of fact discovery in the district court litigation in September 2025, Apple continuously rebuffed Patent Owner's repeated attempts to obtain clarity on the role and extent of TSMC's involvement with the accused chips. Yet in the IPR Proceeding, Apple is declaring TSMC to be a real party-in-interest. Despite Apple's efforts to distance itself from TSMC in the court case and claim it has no ability to obtain relevant technical information about the chips in its Apple devices from TSMC, Apple and TSMC have shown up together as co-petitioners in this proceeding. Moreover, as discussed in detail below, TSMC has recently also raised ambiguous inventorship issues, but then has gone silent in its communications. Apple's and TSMC's disingenuous and shadow conduct in the litigation in contrast to their convenient tactics here is the type of

"gamesmanship" and abuse of the litigation and IPR processes the USPTO has admonished other parties for playing.

Beyond this basis, discretionary denial is appropriate under 35 U.S.C. § 325(d). The PTO already considered Petitioners' Lin-191 reference during prosecution of the '306 patent, and Petitioners cannot show any material error by the examiner during prosecution. Petitioners improperly relies on that same exact Lin-191 reference for each ground in the Petition. Finally, the longstanding *Fintiv* factors further weigh against institution of this Petition.

In short, MYW respectfully submits that under the totality of circumstances, discretionary denial is strongly favored under the rationale of 35 U.S.C. § 325(d), the *Fintiv* factors, and because of Apple's and TSMC's gamesmanship.

II. PARALLEL AND OTHER PROCEEDINGS

On April 24, 2025, MYW filed a complaint against Apple Inc. in *MYW Semitech, LLC v. Apple Inc.*, 1-25-cv-00504 (DDE April 24, 2025), alleging infringement of the '306 patent along with two other patents.

In addition to the present Petition, Apple and TSMC have filed the following Petitions challenging patents from the same district court proceeding:

- IPR2026-00065 challenging the 11,107,768 patent ("the '768 patent").
- IPR2026-00066 challenging the 11,538,763 patent ("the '763 patent").

III. LEGAL STANDARDS

"The Director may not authorize an *inter partes* review to be instituted unless the Director determines that the information presented in the petition … shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition." 35 U.S.C. § 314(a). According to the Director's March 26, 2025 Memorandum, the Director may consider all relevant considerations in determining whether a petitions should be granted, including Board precedent under *Advanced Bionics* and *Fintiv. See* Interim Director Discretionary Process, October 3, 2025 (https://www.uspto.gov/patents/ptab/interim-director-discretionary-process); Interim Processes for PTAB Workload Management, March 26, 2025 (https://www.uspto.gov/sites/default/files/documents/InterimProcesses PTABWorkloadMgmt-20250326.pdf) ("Memorandum").

First, under § 325(d), the Board uses the following two-part framework: "(1) whether the same or substantially the same art previously was presented to the Office or whether the same or substantially the same arguments previously were presented to the Office; and (2) if either condition of first part of the framework is satisfied, whether the petitioner has demonstrated that the Office erred in a manner material to the patentability of challenged claims." *Advanced Bionics, LLC v. MED-EL Elektromedizinische Gertite GmbH,* IPR2019-01469, Paper 6, 8 (PTAB

Feb. 13, 2020) (precedential). Further, the *Becton* factors inform how the two-part framework is applied and considered:

> (a) the similarities and material differences between the asserted art and the prior art involved during examination;
>
> (b) the cumulative nature of the asserted art and the prior art evaluated during examination;
>
> (c) the extent to which the asserted art was evaluated during examination, including whether the prior art was the basis for rejection;
>
> (d) the extent of the overlap between the arguments made during examination and the manner in which petitioner relies on the prior art;
>
> (e) whether petitioner has pointed out sufficiently how the examiner erred in its evaluation of the asserted prior art; and
>
> (f) the extent to which additional evidence and facts presented in the petition warrant reconsideration of the prior art or arguments.

Id., n.10 (citing *Becton, Dickinson & Co. v. B. Braun Melsungen AG*, IPR2017-01586, Paper 8 (PTAB Dec. 15, 2017) (precedential as to § III.C.5, first paragraph).

Second, the discretionary-denial framework advises parties to address all relevant considerations in seeking discretionary denial of institution, which may include:

- Whether there have been changes in the law or new judicial precedent issued since issuance of the claims that may affect patentability;
- The strength of the unpatentability challenge;
- The extent of the petition's reliance on expert testimony;

- Settled expectations of the parties, such as the length of time the claims have been in force; and
- Any other considerations bearing on the Director's discretion.

See Memorandum 2-3.

Finally, discretionary-denial may be issued due to a co-pending litigation, where the Director also weighs the following six *Fintiv* factors:

1. Whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted;
2. Proximity of the court's trial date to the Board's projected statutory deadline for a final written decision;
3. Investment in the parallel proceeding by the court and the parties;
4. Overlap between issues raised in the petition and in the parallel proceeding;
5. Whether the petitioner and the defendant in the parallel proceeding are the same party; and
6. Other circumstances that impact the Board's exercise of discretion, including the merits.

Apple Inc. v. Fintiv, Inc., IPR2020-00019, Paper 11, 5-6 (PTAB Mar. 20, 2020) (precedential) ("*Fintiv*").

IV. ARGUMENT

A. Based on 35 U.S.C. § 325(d), discretionary denial is appropriate because the Lin-191 reference, which is central to Petitioners' grounds, was considered during prosecution.

The Petition should be denied in view of 35 U.S.C. § 325(d) because the examiner already considered the Lin-191 reference (Ex. 1005) based on the factors

discussed in *Advanced Bionics.*

First, the Lin-191 reference was previously presented to the office. Petitioners' Lin-191 reference, U.S. Patent Publication No. 2010/0290191, was cited in an Information Disclosure Statement ("IDS") submitted on the same day the application that matured as the '306 patent was filed on November 12, 2022. Ex. 1002, 11. The examiner considered the Lin-191 reference on November 4, 2023. *Id.*, 313. The Lin-191 reference also appears multiple times throughout the examiner's searches. *See, e.g.*, *id.*, 285, 287, 288, 290, 294, 299, 363, 365, 366, 368, 372, 377. The examiner thoroughly and properly considered the Lin-191 reference (i.e "ALL REFERENCES CONSIDERED EXCEPT WHERE LINED THROUGH. /X.L/"). *Id.*, 313. This shows that the examiner was not simply rubber-stamping or blindly approving all prior art references listed on the IDS but was meaningfully considering each one.

In *Ecto World LLC v. Rai Strategic Holdings Inc.*, the Director found that "[b]ecause the references that Petitioner asserts in this proceeding were provided on the applicant's IDS, the Board correctly determined that the references were previously presented to the Office." IPR2024-01280, Paper 13, 4 (PTAB May 19, 2025) (precedential). The IDS in the present case contained far fewer references than the 1000 that were listed on the IDS in *Ecto World*. *See id.*, 2. Thus, it is clear that Lin-191 was presented previously presented to the Office.

The second step of *Advanced Bionics* is satisfied because TSMC does not even acknowledge the Lin-191 reference was previously cited, let alone show that the examiner erred during prosecution. TSMC will not be able to persuasively argue or demonstrate that the Office erred in evaluating the Lin-191 reference. Even if TSMC argues that it does not agree with the examiner's evaluation of Lin-191, that argument fails because "[i]f reasonable minds can disagree regarding the purported treatment of the art or arguments, it cannot be said that the Office erred in a manner material to patentability." *See Advanced Bionics*, Paper 6 at 9.

Petitioners may attempt to argue that the Petition provides a more detailed analysis because the Petition presents each claim element but that "assertion alone is insufficient to demonstrate material error by the office." *See Tanklogix, LLC v. Sitepro, Inc.*, IPR2025-00761, Paper 10, 2-3 (PTAB Sept. 3, 2025) (citing *Ecto World LLC v. Rai Strategic Holdings Inc.*, IPR2024-01280, Paper 13 at 5 (PTAB May 19, 2025) (precedential)).

All five grounds of invalidity in the Petition rely on Lin-191, which was previously presented to the office. Pet., 2. For that reason alone, the Petition should be denied. *See Ascentcare Dental Products, Inc. v. Solmetex, LLC*, IPR2025-01065, Paper 11, 2-3 (PTAB Oct. 17, 2025) (denying institution because the "Patent Owner persuasively demonstrates that Petitioner relies on references that were

considered by the patent examiner during prosecution or cited by the Patent Owner during prosecution.").

Without Lin-191, all of Petitioners' grounds would be missing a principal reference for each of its two or three-reference obviousness combinations. Petitioners rely on Lin-191 to disclose the following various teachings: a bump structure (Pet., 17-18); metal-pad teachings (Pet., 25); a graphics-processing-unit (GPU) circuit block…and a central-processing-unit (CPU) circuit block (Pet., 30); a multilayered metal interconnect (Pet., 37-38); and aluminum metal pads (Pet., 40). Thus, the already-considered Lin-191 reference is central to Petitioners' grounds.

B. The recent guidance supports discretionary denial

1. Settled expectations support discretionary denial.

MYW has strong settled expectations that weigh in favor of discretionary denial. The '306 patent issued almost two years ago, and is part of a mature MYW-originated portfolio with family members in force since as early as 2013. These patents have remained public and unchallenged for years, creating legitimate reliance interests that favor denial. *See Kahoot! AS v. Interstellar Inc.*, IPR2025-00696, Paper 12, 2-3 (PTAB July 31, 2025) (denying institution due to settled expectations even despite stay). Specifically, the parent U.S. Patent No. 9,615,453 was filed on September 25, 2013 and issued on April 4, 2017. Ex. 2001. With over

a decade and a half of patent prosecution, leading to over a half-dozen issued patents, TSMC fails to provide persuasive reasoning as to why an IPR proceeding is an appropriate use of Board resources. *Dabico Airport Sols. Inc. v. AXA Power ApS*, IPR2025-00408, Paper 21, 3 (PTAB June 18, 2025) (explaining that a petitioner must also "identify reasons *not to exercise discretion to deny institution*.").

Moreover, TSMC has been fully aware of the present patent family. Notably, TSMC's own patent application identified the inventor's patents in its IDSs. *See* Ex. 2002; *see also iRhythm Techs., Inc. v. Welch Allyn, Inc.*, Nos. IPR2025-00363, Paper 10, 2-3 (PTAB June 6, 2025) ("[H]aving cited the then-pending application that issued as the challenged patent in an IDS Petitioner filed in its own patent application—settled expectations favor denial of institution."). TSMC cited U.S. Patent Publication no. 2021/0335714 which would become U.S. Patent No. 11,538,763.[1] Despite this awareness, TSMC never previously challenged these patents.

2. Other considerations support exercise of the Director's discretion for denial.

Discretionary denial is also appropriate because TSMC and Apple are abusing the district court and IPR proceedings. Apple is obfuscating discovery in

[1] Challenged in IPR2026-00066.

the on-going district court proceedings while at the same time, both Apple and TSMC appear as co-petitioners to pursue this IPR. Specifically, Apple has conceded that TSMC plays some undetermined role with the accused products, but it refuses to elaborate. *See* Ex. 2003. Moreover, TSMC and Apple have stymied various attempts to obtain discovery into this relationship and TSMC's involvement. Indeed, Apple's counsel has refused to produce key agreements between Apple and TSMC, declined to produce documents simply because they are not in Apple's possession, and refused to clarify TSMC's role in the development of the accused products. *See id*. Apple's fact-discovery posturing in the court case stands in sharp contrast with Apple's and TSMC's joint filing before this Board, where Apple and TSMC state that they are both real parties-in-interest. Apple's and TSMC's lack of candor should have consequences here. Apple's tactics and refusal to cooperate in discovery in the district court (with TSMC behind the scenes) warrants denial.

Moreover, throughout the litigation, Apple has delayed production of documents or failed to provide substantive responses to discovery, forcing MYW to move certain deadlines. Then, Apple pivots and uses this delay, which Apple manufactured, to suggest that litigation is not as advanced as it currently is. For example, even though Apple was required to make its core technical documents available on November 7, 2025, its production was completely deficient and it

delayed Patent Owner's expert from inspecting the necessary source code by invoking a 30-day notice provision after it had already been required to make source code available. Ex. 2005. Further, Apple has refused to indicate whether certain documents are in TSMC's possession, even though it is coordinating with TSMC in this IPR. Such sleight of hand dealings and gamesmanship should not be rewarded by the institution of this IPR.

And in addition to discovery-hiding and discovery-delaying tactics, TSMC has now recently approached MYW's counsel because it believes there are "issues with inventorship." *See* Ex. 2006. Inventorship issues (with potential related challenges to patent ownership) are well beyond the scope of the Office's IPR. Thus, TSMC's recourse is to address all of its potential issues not through the USPTO but through the district court. For these additional reasons above, the director should deny institution.

C. The *Fintiv* Factors support discretionary denial.

1. Factor 1 weighs in favor of denial because Apple's motion to stay has been denied.

The district court proceedings have not been stayed. After Apple filed a Motion to Stay Pending *Inter Partes* Review, the district court denied the motion one day after Apple filed its reply. In his oral order, Judge Andrews specifically stated "[t]here is no reason to interrupt the schedule based on speculation about what might happen in April or June 2026." Ex. 2007. Further, "I [Judge Andrews]

note that I do not think that I should grant a stay in order to increase Apple's chances of getting an IPR instituted." *Id.* For that reason alone, this factor favors denial.

2. Factor 2 favors denial.

The Director routinely exercises discretion to deny institution despite even "favorable" trial timing where other factors, like those present here, make Board review an inappropriate use of resources. *See, e.g.*, *Apple Inc. v. Advanced Coding Techs. LLC*, IPR2025-00983, Paper 10, 2-3 (PTAB Oct. 3, 2025) (denial based on settled expectations from patent age and lack of material error); *Ascentcare Dental Prods., Inc. v. Solmetex, LLC*, IPR2025-01065, Paper 11, 2 (PTAB Oct. 17, 2025) (denial based on § 325(d) without showing of material error).

Here, MYW filed suit against Apple in the United States District Court for the District of Delaware seven months before Petitioners' filed their petition challenging the '306 patent. Petitioner Apple will challenge the validity of the '306 patent in the district court proceedings. Ex. 2008. The Board is projected to issue a Final Written Decision ("FWD") by June 2, 2027. The trial date in the District Court of Delaware is scheduled for October 18, 2027. Even though the Board may issue a FWD before the district court proceeding concludes, institution would require the Board, the district court, and the parties to invest significant and duplicative resources in parallel validity proceedings. *Advanced Micro Devices,*

Inc. v. XtreamEdge, Inc., IPR2025-00223, Paper 9, 2 (PTAB Jun 12, 2025) ("Even though a district court trial date that occurs after a projected final written decision date reduces the possibility of conflicting decisions, that benefit does not outweigh the efficiencies gained by avoiding parallel proceedings in this instance because of the parties' meaningful investment in the district court proceeding discussed above."). As in these prior proceedings, other considerations—namely, Apple's and TSMC's strategic gamesmanship and MYW's settled expectations, coupled with Petitioners' repeat prior art and arguments without identifying any material error by the PTO—make review of the '306 patent an inefficient use of Board resources.

3. Factor 3 also weighs in favor of discretionary denial.

Factor 3 relates to the "investment in the parallel proceeding by the court and the parties" *at the time of the institution decision*. *Fintiv*, 5-6, 9 (emphasis added). For example, "if, at the time of the institution decision, the district court has issued substantive orders related to the patent at issue in the petition," this factor favors denial. *Id.*, 9-10. "Likewise, district court claim construction orders may indicate that the court and parties have invested sufficient time in the parallel proceeding to favor denial." *Id.*. 10.

This factor weighs in favor of discretionary denial because of the significant investment the parties have already made, as well as the work that will be done before the institution decision. As recognized in *Fintiv*, significant investment by

the parties undermines the likelihood of a stay and increases the risk of duplicative costs.

As of February 2, 2026, the litigation has advanced with initial disclosures exchanged, preliminary infringement contentions served, preliminary invalidity contentions will be served in about two weeks, and significant discovery is ongoing. For example, MYW served infringement contentions on January 9, 2026 spanning *over 100 pages* of detailed claim charts. Ex. 2009. The parties spent significant resources litigating a disputed protective order. The court resolved that dispute and entered both the protective order and the parties' ESI stipulation for discovery. Ex. 2010. Fact discovery is currently underway, with Apple and MYW having exchanged discovery requests, exchanged core technical document productions, and engaged in multiple meet and confers. Further, by the projected institution decision in this case, the parties will be only one month away from all document production being substantially complete.

Additionally, by the projected institution date of June 2, 2026, the parties and court will have invested substantially in the full claim construction process—from initial claim term exchanges and proposed constructions, the disclosures of extrinsic evidence and then to the exchange of multiple claim construction briefs, culminating in the *Markman* hearing on July 7, 2026. This comprehensive claim-construction stage of the district court litigation requires extensive preparation of

written exchanges and briefs, expert identification, evidence production, and narrowing of disputes, all reflecting significant time and resources from both parties and the court. Accordingly, by the projected institution date, the parties in the district court case will have made far more investments in the currently progressing case than early-stage cases favoring institution. These factors favor denial of the Petition to prevent inefficient duplication and resource waste. *See Motorola Sols., Inc. v. Stellar, LLC*, IPR2024-01205, Paper 19, 3 (PTAB Mar. 28, 2025) (vacating institution where parties served expert reports, filed claim construction briefs, and conducted depositions before institution decision); *see also Arthrex, Inc. v. MedShape, Inc.*,, IPR2025-00053, Paper 11, 10-11 (denying institution where parties invested significant time in the district court proceedings).

4. Factor 4 weighs in favor of discretionary denial due to significant overlap of issues.

"[I]f the petition includes the same or substantially the same claims, grounds, arguments, and evidence as presented in the parallel proceeding, this fact has favored denial." *Fintiv*, 12.

Patent Owner recognizes that Petitioners have provided a *Sotera* stipulation. Ex. 1138. But a *Sotera* stipulation is no longer enough to avoid discretionary denial. Memorandum 2-3. Petitioners' stipulation does not overcome the overwhelming weight of other factors favoring discretionary denial. *See, e.g.*, *Cisco Sys., Inc. v. Estech Sys., Inc.*, IPR2021-00333, Paper 12, 12-13 (PTAB July

7, 2021) (denying institution even with *Sotera* stipulation); *see also Motorola Sols. v. Stellar, LLC*, IPR2024-01205, Paper 19, 3-4 (PTAB Mar. 28, 2025) ("[A]lthough Petitioners' Sotera stipulation may mitigate some concern of duplication between the parallel proceeding and this proceeding, the stipulation does not outweigh the substantial investment in the district court proceeding. . . .").

Additionally, on October 17, 2025, the PTO issued a Notice of Proposed Rulemaking ("NPRM") setting forth the PTO's vision for the efficient management of IPR proceedings before the PTAB and to "promote fairness, efficiency, and predictability in patent disputes." Ex. 2011, 2. The PTO explicitly acknowledged that "[s]erial and parallel validity challenges remain a significant problem for the patent system." *Id.*, 4. Here, Petitioners argue for unpatentability in an IPR proceeding, while simultaneously asserting invalidity in the district court litigation.

Recognizing the high cost and unfairness to Patent Owners, the PTO proposed rule changes to "increase the reliability of patent rights and the predictability of patent disputes" to "enhance fairness, efficiency, and predictability." *Id.* The proposed rule changes in the NPRM would mandate that a petitioner stipulate that, if trial is instituted in the IPR, "the petitioner and any real party in interest or privy of the petitioner will not raise grounds of invalidity or unpatentability with respect to the challenged patent under 35 U.S.C. §§ 102 or 103 in any other proceeding." *Id.*, 22. Here, Petitioners' stipulation fails to provide

assurance that there will not be substantial overlap in its obviousness grounds in the Petition and its invalidity contentions in the district court, nor has it filed a stipulation in the district court that it will not pursue invalidity challenges under §§ 102 or 103. Patent Owner expects Apple's invalidity contentions, which Apple will serve just a couple of weeks from now, will include combinations of prior art (including the art asserted in this IPR) with unpublished art, rendering Petitioners' stipulation insufficient to ensure that the IPR proceedings are a "true alternative" to the district court proceedings.

When IPR proceedings cover the same ground as district court litigation, they cease to be an "alternative" and can substantially increase litigation costs. Ex. 2011, 3. That is the opposite of what Congress intended. *Id*. Serial or parallel IPR proceedings can also be wasteful, because they consume Office and party resources re-litigating issues that the Office is considering, has already considered, or that are being litigated elsewhere, such as in district court. *Id.*

Portfolio-wide overlap amplifies the inefficiency concerns under Factor 4. Although this IPR only concerns the '306 patent, it is not in isolation. The '306 patent is one of three asserted patents being litigated together against Apple in a single action, and Petitioners have filed parallel IPRs challenging the rest of the portfolio. The district court will manage invalidity, expert discovery, and trial preparation across the portfolio in an integrated schedule.

Factor four weighs in favor of discretionary denial.

5. Factor 5 weighs in favor of denial as the district court litigation and the Petition involves the same parties.

Fintiv factor five weighs in favor of denying institution because the parties in the parallel litigation are the same. *Fintiv*, 15; *see also HP Inc. v. Universal Connectivity Techs. Inc*., IPR2024-01428, Paper 12, 9-10 (PTAB Apr. 8, 2025) (factor weighs in favor of denial where all parties are involved in the parallel district court litigations). Both MYW and Apple are parties in the parallel district court litigation. Although TSMC is not a named defendant in the litigation, Apple has indicated that TSMC plays some undetermined role as to the accused products and taken the position that TSMC is a real party in interest. Yet Apple claims that relevant documents and facts from its chip-maker TSMC are not within its possession, custody, or control.

Thus, factor five weighs in favor of discretionary denial.

6. Factor 6 weighs in favor of discretionary denial.

The Board should not permit TSMC, a foreign entity, to weaponize the administrative resources of the USPTO while strategically insulating itself behind Apple to avoid discovery obligations of district court litigation. Apple's and TSMC's conduct represents a "shield and sword" maneuver: Apple and TSMC are using TSMC's foreign status as a shield to try to avoid the reach of district court discovery and the risk of a jury verdict, yet simultaneously jointly wield the PTAB

as a sword in an attempt to dismantle MYW's property rights.

Allowing such a lopsided arrangement creates a dangerous precedent where foreign manufacturers can orchestrate the destruction of American innovation from a safe harbor abroad. Fairness demands that if a foreign corporation seeks to invoke the power of a U.S. agency to invalidate a patent, it must not be allowed to do so while purposefully shielding itself behind its U.S. business partner and skirting the very litigation where that patent is being asserted. To hold otherwise would turn the PTAB into a low-risk clearinghouse for foreign proxies to exhaust the resources of inventors without ever facing a court of law.

D. The weakness of the Petition's grounds and overreliance on expert testimony further support discretionary denial.

The strength of Petitioners' unpatentability challenge is weak. Even using Petitioners' three-way reference combination, the Petition is forced to repeatedly rely on impermissible background knowledge to fill the gaps for several limitations. *See* Pet., 2.

Petitioners' excessive reliance on a voluminous expert declaration as its sole evidentiary support for claim limitations further supports denial. Memorandum, 2; *see also* FAQs for Interim Processes for PTAB Workload Management, FAQ No. 22. TSMC's expert declaration is *345* pages long. *See* Ex. 1003. TSMC cites the expert declaration at least *280* times. The Petition relies extensively on the expert declaration to fill gaps and support all of its conclusions of obviousness. *Compare*

Pet. 18-19 *with* Ex. 1003 ¶¶ 153-155, 157-158. Per the guidance of the Office, however, the role of an expert is to provide focused support (*e.g.*, explaining terms of art or relevant context), *not* to substitute and/or provide for limitations and the obviousness rationale from the prior art. For at least these reasons, the Petition fails to demonstrate a reasonable likelihood that any challenged claim is unpatentable.

E. Simplicity of the parallel litigation supports discretionary denial.

The parallel litigation here is relatively simple: three asserted utility patents. This contrasts sharply with cases warranting Board review. *See Tesla, Inc. v. Intellectual Ventures II LLC*, IPR2025-00217, Paper 9, 2-3 (PTAB June 13, 2025) (11 patents, 9 families); *Shenzhen Tuozhu Tech Co., Ltd. v. Stratasys, Inc.*, IPR2025-00531, Paper 10, 3 (PTAB July 17, 2025) (9 patents, 6 families); *Samsung Elecs. Co. v. Wilus Inst. of Standards & Tech. Inc.*, IPR2025- 00933, Paper 11, 3 (PTAB Oct. 10, 2025) (12 patents, 8 families).

V. CONCLUSION

For all of the foregoing reasons, MYW respectfully requests the Director to exercise discretion and deny the Petition.

Dated: February 2, 2026

Respectfully submitted,

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CERTIFICATE OF COMPLIANCE

Pursuant to 37 C.F.R. § 42.24(d) and the Interim Director Discretionary Process § II.C.iii, the undersigned certifies that this Brief in Support of Discretionary Denial complies with the type-volume limitations of those sections because it contains no more than 20 pages.

Dated: February 2, 2026

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that the foregoing PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL OF INSTITUTION OF PETITION FOR *INTER PARTES* REVIEW OF UNITED STATES PATENT NO. 11,894,306 was served electronically via email on February 2, 2026, on the following counsel of record for Petitioners:

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