

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

Inter Partes Review Case No. IPR2026-00067
U.S. Patent No. 11,894,306

**PETITIONERS' OPPOSITION TO
PATENT OWNER'S REQUEST FOR DIRECTOR REVIEW**

TABLE OF CONTENTS

I.	INTRODUCTION.....	1
II.	P&O APPLIES IN BOTH THIS IPR AND THE PARALLEL LITIGATION	2
A.	SUMMARY OF FACTS	2
B.	PETITIONERS TAKE THE CONSISTENT POSITION IN IPR AND DISTRICT COURT THAT P&O APPLIES	3
C.	PATENT OWNER’S “HIDING” OR “NARROWING” ACCUSATIONS CONFLICT WITH THE FACTS AND ITS OWN ADMISSIONS	5
D.	THE DIRECTOR SHOULD REJECT PATENT OWNER’S GAMESMANSHIP AND DENY ITS REQUEST	6
III.	PATENT OWNERS’S NEW § 112 ARGUMENTS ARE IRRELEVANT AND DO NOT SUPPORT DIRECTOR REVIEW	8
A.	APPLE DOES NOT RAISE AND WILL NOT CHALLENGE INDEFINITENESS OF ANY CLAIM TERM	8
B.	PATENT OWNER’S NEW WRITTEN DESCRIPTION AND ENABLEMENT ARGUMENTS DO NOT WARRANT DIRECTOR REVIEW.....	10
C.	PATENT OWNER’S § 112 ARGUMENTS ARE WAIVED	11

TABLE OF AUTHORITIES

CASES

<i>Belden Inc. v. Commscope, Inc.</i> , No. CV 22-783-RGA, 2026 WL 1091253 (D. Del. Apr. 22, 2026)	9
<i>Caption Health v. The Univ. of British Columbia</i> , IPR2025-01422, Paper 15 (Director Dec. 18, 2025)	4
<i>Ford Motor Co. v. AutoConnect Holdings, LLC</i> , IPR2025-01342, Paper 27 (Director May 12, 2026)	9
<i>Idenix Pharms. LLC v. Gilead Scis. Inc.</i> , 941 F.3d 1149 (Fed. Cir. 2019).....	11
<i>Integra LifeSciences Corp. v. HyperBranch Med. Tech., Inc.</i> , 223 F. Supp. 3d 202 (D. Del. 2016)	8
<i>Juno Therapeutics, Inc. v. Kite Pharma, Inc.</i> , 10 F.4th 1330 (Fed. Cir. 2021)	11
<i>Motorola Mobility LLC v. Ironworks Patents, LLC</i> , IPR2021-00421, Paper 21 (PTAB Oct. 7, 2021)	12
<i>Phillips v. AWH Corp.</i> , 415 F.3d 1303 (Fed. Cir. 20025)	3
<i>Process Control Corp. v. HydReclaim Corp.</i> , 190 F.3d 1350 (Fed. Cir. 1999)	10
<i>Samsung Elecs. Co., Ltd. v. Wilus Inst. of Standards & Tech. Inc.</i> , IPR2025- 01069, Paper 16 (PTAB Dec. 10, 2025)	5
<i>Terumo BCT Inc. v. Haemonetics Corp.</i> , IPR2025-01374, Paper 20 (Director May 12, 2026).....	9
<i>Tesla, Inc. v. Intellectual Ventures II LLC</i> , IPR2025-00340, Paper 18 (Director Nov. 5, 2025)	10

STATUTES

35 U.S.C. § 112	8
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I. INTRODUCTION

A Request for Director Review is not an opportunity for a do-over. The Director has already considered and rejected Patent Owner's arguments regarding inconsistent claim constructions. The facts that existed when the Director instituted this IPR have not changed, nor has the law. Petitioner Apple's position¹ in the Parallel Litigation remains unchanged before and after the IPR institution: the same plain and ordinary (P&O) meaning for the claimed "semiconductor chip" should apply in both the Parallel Litigation and IPR. And Patent Owner recognizes that Petitioners' position has not changed and admits as much in its Request for Director Review ("Request"). Patent Owner, on the other hand, still refuses to reveal what it thinks the P&O meaning of "semiconductor chip" is, even though Patent Owner is *required* to tell the District Court so under the controlling Scheduling Order in the Parallel Litigation.

Regarding Patent Owner's § 112 arguments, Petitioner Apple does not and will not challenge indefiniteness of any claim term in the Parallel Litigation. And for written description and enablement on other claim terms, Patent Owner's §112

¹ While there are two Petitioners in this IPR, only Apple is a party in the Parallel Litigation. Thus, discussions regarding positions taken in the Parallel Litigation only reference Petitioner Apple.

arguments are contrary to the law, and the Director has never denied institution based on written description and enablement. Indeed, it is well-settled law, including Patent Owner's cited cases, that claim terms with plain meaning are not indefinite even if the claims themselves lack enabling written description.

Contrary to Patent Owner's allegation of gamesmanship at play in this IPR, it is Patent Owner employing it. The Director has considered the facts on the alleged inconsistent claim construction before institution and, properly, rejected them. Petitioners respectfully request that the Director deny Patent Owner's request and allow this IPR to proceed.

II. P&O APPLIES IN BOTH THIS IPR AND THE PARALLEL LITIGATION

A. Summary of Facts

The Parties in this IPR agreed that no construction was necessary to decide the patentability of the '306 Patent. Paper 1, p. 2; Paper 10, p. 5. After the IPR was filed, **both Parties** proposed a P&O construction to the District Court for the claim term "semiconductor chip." EX2015, p. 4. The District Court's Scheduling Order requires that "[i]f a party proposes a construction of a term to be its 'plain and ordinary' meaning, the party must explain what that meaning is." EX1140, p. 6, n.1. Petitioner Apple complied and provided the P&O meaning. EX2015, p. 4. Conversely, Patent Owner refused to state what its P&O meaning is, simply

repeating back the exact claim language, i.e., the P&O for “semiconductor chip” is “semiconductor chip.” *Id.*

In the pre-institution briefing, Patent Owner argued, as it does now, that Petitioners presented inconsistent claim constructions. Paper 12, pp. 6-8. Petitioners, in their Reply, submitted that the same P&O meaning applies in the IPR. Paper 13, pp. 2-3. Patent Owner does not dispute that Petitioners’ IPR prior art teaches the “semiconductor chip” under this term’s P&O meaning.

B. Petitioners Take the Consistent Position in IPR and District Court That P&O Applies

Patent Owner continues to argue that Petitioners are presenting inconsistent constructions. But Patent Owner admits in its Request that Petitioners’ position is that the same P&O meaning applies in the Parallel Litigation, as in this IPR. Paper 20, p. 8 (stating Apple “suggest[s] vaguely in Paper 13 that ‘plain and ordinary meaning’ is sufficient”); *cf.* Paper 13, pp. 2-3 (within the context of discussing the IPR, Petitioner stating “The Parties also agree that ‘semiconductor chip’ should be given its P&O meaning.”). Petitioners also stated in their Reply to Patent Owner’s POPR that “the Parties in this IPR agree that no terms need to be construed.” Paper 13, pp. 2-3. That is, the P&O meaning applies. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312 (Fed. Cir. 20025) (“We have frequently stated that the words of a claim ‘are generally given their ordinary and customary meaning.’”) (internal citations

omitted). To comply with the District Court’s Scheduling Order, Petitioners presented the P&O meaning. EX2015, p. 4 (Joint Claim Construction Statement (“JCCS”); providing Petitioner Apple’s construction of “semiconductor chip” as “Plain and ordinary meaning: ‘a semiconductor device comprising an IC (integrated circuit)’”).

To avoid any doubt, Petitioners submit, and herein stipulate, that Petitioner Apple’s P&O meaning for the term “semiconductor chip” presented to the District Court, per the Court’s Scheduling Order, applies in this IPR (and any other proceeding before the Office involving Petitioners and the same claim term). This unequivocal position should put this issue to rest.

The facts here are very similar to those in *Caption Health v. The Univ. of British Columbia*, IPR2025-01422, Paper 15 at 3 (Director Dec. 18, 2025), where the Director declined to deny institution based on alleged inconsistent claim constructions. In *Caption Health*, petitioner “in the district court [] elaborated on its understanding [of] the plain and ordinary meaning of the term....” *Id.* The Director accepted petitioner’s stipulation and consent to apply the P&O meaning in the IPR, finding that it “resolve[d] any potential inconsistency in claim construction positions between forums and does not require further explanation under *Revvo*.” *Caption Health*, IPR2025-01422, Paper 15 at 3. As in *Caption Health*, Petitioners submit

their unequivocal stipulation “remove[s] any perceived discrepancy” otherwise manufactured by Patent Owner. *Id.*

To summarize: both Parties agreed that no claim terms needed express construction in the IPR, and both Parties agreed the P&O construction should apply in the Parallel Litigation. Given the same facts here, *Samsung*, which Petitioners cited pre-institution, controls. *See Samsung Elecs. Co., Ltd. v. Wilus Inst. of Standards & Tech. Inc.*, IPR2025-01069, Paper 16 at 7 (PTAB Dec. 10, 2025) (finding no inconsistent constructions where both parties agreed that no claim terms needed express construction in the IPR, while both parties also agreed the P&O construction should apply in the litigation).

C. Patent Owner’s “Hiding” or “Narrowing” Accusations Conflict with the Facts and Its Own Admissions

Patent Owner mistakenly claims that Petitioner Apple *hid* its position and offered no explanation of what it considered to be the P&O meaning of “semiconductor chip.” Paper 20, pp. 4, 5, 8. Patent Owner’s allegations are contrary to the facts and its own pre-institution briefing.

As explained in the preceding section, Petitioner Apple provided Patent Owner with its P&O meaning of this claim term as early as in the JCCS submitted to the District Court, which was before Patent Owner submitted its POPR, and well before the IPR Institution. And Patent Owner conceded in its POPR its knowledge

of Petitioner Apple’s proposed P&O meaning for the claim term “semiconductor chip.” Paper 10, p. 6 (noting that “Apple has asserted that ‘semiconductor chip’ should be construed to have its [P&O] meaning which is ‘a semiconductor device comprising an IC (integrated circuit)’”). In their Reply to Patent Owner’s POPR, Petitioners also cited the JCCS and stated that “[t]he Parties also agree that ‘semiconductor chip’ should be given its P&O meaning.” Paper 13, pp. 2-3. Patent Owner also acknowledges in its Request that Petitioner Apple’s responsive claim construction brief presented the same P&O meaning. Paper 20, p. 5, 8.

In short, it is absurd for Patent Owner to argue Petitioners hid their P&O meaning before institution. More egregiously, Patent Owner argues that Petitioner proposed a narrower meaning in the District Court. To the contrary, Petitioner’s P&O meaning for the term “semiconductor chip”—a semiconductor device comprising an IC (integrated circuit)—has never changed.

Patent Owner’s “hiding” and “narrowing” allegations are simply tactics in an attempt to avoid institution.

D. The Director Should Reject Patent Owner’s Gamesmanship and Deny Its Request

Gamesmanship is at issue in this IPR. Indeed, it is Patent Owner who has engaged in it, contrary to Patent Owner’s claim. The Director should reject Patent Owner’s gamesmanship and deny the request.

Patent Owner does not and cannot challenge that Petitioners' prior art teaches the "semiconductor chip" under this term's P&O meaning. *See generally* Paper 20. Patent Owner made no arguments against any of the prior art at all in either Patent Owner's POPR or sur-reply. And the Director has determined that Petitioners have demonstrated a reasonable likelihood of prevailing and instituted Petitioners' IPRs. Paper 18. That has backed Patent Owner into a corner, and it has responded by doubling down on its manufactured "inconsistent" argument. Patent Owner's Request does nothing more than reshuffle the same arguments it advanced pre-institution and that have already been rejected by the Director.

Even worse, Patent Owner makes false accusations that Petitioner hid its P&O meaning position and advanced a narrowing meaning. As explained above, Patent Owner's accusations are contrary to the facts and the admissions made in its own briefing.

Moreover, Patent Owner fabricates "inconsistent" arguments, taking advantage of Petitioner Apple's compliance with the Scheduling Order in the Parallel Litigation to provide a P&O meaning. But Patent Owner still has not complied with the Scheduling Order in the Parallel Litigation and has not provided its P&O meaning. *Supra* Section IIA. *See generally* Paper 20; EX2016, 1 ("Semitech...has refused to say what the [P&O] meaning is—despite the Court's Scheduling Order requiring an explanation").

III. PATENT OWNERS’S NEW § 112 ARGUMENTS ARE IRRELEVANT AND DO NOT SUPPORT DIRECTOR REVIEW

A. Apple Does Not Raise and Will Not Challenge Indefiniteness of Any Claim Term

Contrary to Patent Owner’s allegations, Petitioner Apple does not raise indefiniteness arguments of any claim term in the Parallel Litigation. *See* EX2017, pp. 54-65. Patent Owner relies solely on the generic, introductory sentence to Petitioner Apple’s Section 112 portion of its March 5, 2026, contentions, which states, “[t]he Asserted Claims of the Asserted Patents are invalid under 35 U.S.C. § 112 because (1) the claims are indefinite, (2) the claims lack adequate written description; *and/or* (3) the claims are not enabled.” Paper 20, p.9 (citing EX2017, p. 54) (emphasis added). But this is simply a boilerplate introduction to Section 112 and the three types of invalidity it covers. Indeed, Petitioner Apple did not present any indefiniteness argument of any claim term throughout the March 5, 2026 contentions. And courts have found that generic, introductory language alone does not preserve an indefiniteness defense. *See, e.g., Integra LifeSciences Corp. v. HyperBranch Med. Tech., Inc.*, 223 F. Supp. 3d 202, 204 (D. Del. 2016) (ordering defendant to supplement contentions “by identifying the limitations allegedly not meeting one or more portions of 35 U.S.C. § 112 (‘Section 112’) and further identifying the specific portion of Section 112 allegedly not met by each limitation”).

More importantly, Petitioner Apple’s March 5, 2026, contentions provide the specific Section 112 arguments—none of which is indefiniteness. *Id.* at 54-65. Nor did Petitioner Apple raise any indefiniteness arguments in the JCCS (EX2015) or in its corresponding briefing. Any indefiniteness arguments were typically presented in the JCCS before the then-presiding judge. Apple understood that it was not raising and would not raise any such indefiniteness arguments in the Parallel Litigation. *See, e.g., Belden Inc. v. Commscope, Inc.*, No. CV 22-783-RGA, 2026 WL 1091253, at *6-11 (D. Del. Apr. 22, 2026) (Andrews, J.) (addressing multiple indefiniteness arguments in *Markman* decision).² Thus, Petitioner Apple **does not and will not** raise indefiniteness arguments in the Parallel Litigation.

Patent Owner’s cited cases are distinguishable and inapplicable. In each case, the petitioner identified *specific* claim terms as indefinite in parallel litigation. *See Ford Motor Co. v. AutoConnect Holdings, LLC*, IPR2025-01342, Paper 27, at 2-3 (Director May 12, 2026) (Informative) (petitioner identified the terms “and/or” and “one or more” as indefinite “after institution was granted”); *Terumo BCT Inc. v. Haemonetics Corp.*, IPR2025-01374, Paper 20 (Director May 12, 2026) (Informative) (petitioner identified the term “controller” as indefinite “after

² The Parallel Litigation was subsequently reassigned to visiting Judge Barker (EDTX).

institution was granted”); *Tesla, Inc. v. Intellectual Ventures II LLC*, IPR2025-00340, Paper 18, at 4 (Director Nov. 5, 2025) (Informative) (petitioner identified a “generating limitation” as indefinite).³ Unlike the cases cited by Patent Owner here, Petitioner Apple does not raise any indefiniteness challenges.

B. Patent Owner’s New Written Description and Enablement Arguments Do Not Warrant Director Review

Patent Owner created new written description and enablement arguments, which have been waived (see below) to seek Director’s review. No law supports Patent Owner’s argument. Patent Owner argues that if a claim is “not enabled and is not supported by a sufficient description,” then “the plain and ordinary meaning of the claims cannot be ascertained.” Paper 20, p. 12. That makes no sense. “[D]efiniteness and enablement are analytically distinct requirements.” *Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1358 n.2 (Fed. Cir. 1999).

Unlike indefiniteness, whether a specification is sufficiently enabling does not involve “the clarity of the claim language preventing one skilled in the art from determining the scope of the claim.” *Id.* Rather, claim terms with plain meaning are

³ Similarly, Patent Owner’s citation to *Magnolia*’s principle that AIA reviews are intended to be an “alternative” to district court litigation is also inapposite given that Petitioner Apple has not raised any indefiniteness challenges.

not indefinite even if the claims themselves lack enabling written description. Applying plain meaning may involve “little more than the application of the widely accepted meaning of commonly understood words.” *Phillips*, 415 F.3d at 1314. Even Patent Owner’s cited case law confirms that claim scope may be ascertainable even where claims are invalid for lack of enablement or written description. *See Idenix Pharms. LLC v. Gilead Scis. Inc.*, 941 F.3d 1149, 1155 (Fed. Cir. 2019) (discussing what is required by the claims where “[n]either party challenges the district court’s claim constructions” and affirming lack of enablement); *Juno Therapeutics, Inc. v. Kite Pharma, Inc.*, 10 F.4th 1330, 1336 (Fed. Cir. 2021) (explaining that the claims’ scope “broadly cover[s]” an “expansive genus” of elements for which the patent lacked written description).

Petitioner Apple does not dispute in its contentions that a POSITA would have understood what each claim term (including a “polymer layer,” “solid layer,” or “compound of silicon and oxygen”) refers to. EX2017, p. 60. Nor does Patent Owner. Paper 20, pp. 12-13. So, those terms need not be construed to resolve written description and enablement. Consequently, Petitioner Apple’s litigation positions are consistent with its IPR positions and do not warrant Director Review.

C. Patent Owner’s § 112 Arguments Are Waived

Patent Owner waived its § 112 arguments, as it failed to raise any of them in its pre-institution briefing. *See* Director Review Process at 3(e) (“The Director will

not consider new evidence or new arguments not part of the official record.”), available at <https://www.uspto.gov/patents/ptab/decisions/director-review-process>; *see also Motorola Mobility LLC v. Ironworks Patents, LLC*, IPR2021-00421, Paper 21 at 10 (PTAB Oct. 7, 2021) (“[A] request for rehearing is not an opportunity to supplement Patent Owner’s Preliminary Response or Sur-reply, or to submit new evidence and new arguments that were not made of record.”). Patent Owner knew Apple’s §112 positions before its pre-institution briefings: Petitioner Apple served its invalidity contentions on March 5, 2026 (EX2017, p. 69)—11 days before Patent Owner’s Discretionary Denial Response brief (Paper 14), and two weeks before its Preliminary Sur-Reply (Paper 16). Also, Patent Owner was, or should have been, aware of the cases it cites, which predate its pre-institution briefings. But Patent Owner did not raise these arguments in any briefs before institution and thus has waived such arguments.

Patent Owner does not even attempt to excuse its failure to raise these arguments before institution or advance any arguments that the Board’s waiver rules should not apply here. Paper 20, pp. 9-11. Nor did any of the cases cited by Patent Owner, *id.*, p. 10, create new law sufficient to justify Director Review or permit Patent Owner to revive its waived arguments. As stated above in sections III.B, C, Patent Owner’s cited cases do not support its waived § 112 arguments that Patent Owner now fabricates in this request. Additionally, several cited cases—*Tesla*,

Idenix, and *Juno*—predate Patent Owner’s pre-institution briefing. So Patent Owner could have, and should have, raised these arguments then. Moreover, two of the cases cited by Patent Owner—*Ford* and *Terumo*—were decided *prior* to the Director’s institution of this IPR. In short, the law, facts, and circumstances present when the Director instituted this IPR have not changed. Patent Owner cannot reargue the waived arguments, and its request should be denied.

Respectfully submitted,

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CERTIFICATION OF COMPLIANCE

The undersigned certifies pursuant to 37 C.F.R. § 42.24 that foregoing Petitioners' Authorized Response to Patent Owner's Request for Director Review, excluding those portions excepted by 37 C.F.R. § 42.24(a)(1), complies with the fifteen-page limit specified by the Board.

Dated: May 28, 2026

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CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing Petitioners' Reply to *Petitioners' Authorized Response to Patent Owner's Request for Director Review* was served on May 28, 2026, by email on the following counsel of record for Patent Owner:

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