

**UNITED STATES DISTRICT COURT
EASTERN DISTRICT OF TEXAS
MARSHALL DIVISION**

ADVANCED INTEGRATED CIRCUIT
PROCESS LLC,

Plaintiff,

v.

UNITED MICROELECTRONICS
CORPORATION,

TAIWAN SEMICONDUCTOR
MANUFACTURING COMPANY LIMITED.

Defendants.

Civil Action No. 2:24-cv-00730-JRG
(Lead Case)

Civil Action No. 2:24-cv-00623-JRG
(Member Case)

JURY TRIAL DEMANDED

**AICP’S P.R. 3-1 DISCLOSURE OF ASSERTED CLAIMS AND INFRINGEMENT
CONTENTIONS AND P.R. 3-2 DOCUMENT PRODUCTION AGAINST TSMC**

Pursuant to Patent Rules 3-1 and 3-2 and the Court’s Order regarding scheduling (Dkt. No. 28), Plaintiff Advanced Integrated Circuit Process LLC (“AICP”) hereby provides its Disclosure of Asserted Claims and Infringement Contentions and its Document Production Accompanying Disclosure against Defendant Taiwan Semiconductor Manufacturing Company Limited (“TSMC”).

AICP presents these Infringement Contentions based on its analysis of the facts currently known based on its review of certain publicly available information. AICP reserves the right to amend or further supplement this disclosure—including to supplement its infringement contentions pursuant to P.R. 3-6—with additional information learned through discovery or further investigation concerning TSMC’s products or services.

I. AICP's P.R. 3-1 Disclosure

A. P.R. 3-1(a): Infringed Claims

Subject to ongoing discovery and investigation, and based on available information obtained to date, AICP asserts that TSMC infringes the following claims (collectively, the "Asserted TSMC Claims"):

- Claims 1, 2, 7, 8, and 14 of the '227 Patent;
- Claims 1, 2, 3, 4, 5, 6, 11, 12, 13, 14, 15, 16, 17, 18, and 19 of the '764 Patent;
- Claims 25, 26, 27, 28, 29, 31, 34, and 35 of the '686 Patent;
- Claims 1, 2, 3, 5, 6, 11, 13, 14, 16, 17, 18, 19, 21, and 22 of the '180 Patent;
- Claims 1, 2, 3, 6, 7, 8, 10, 11, 12, and 13 of the '076 Patent;
- Claims 1, 12, 13, 14, and 15 of the '779 Patent; and
- Claims 1, 3, 4, 5, 7, and 11 of the '425 Patent.

AICP reserves the right to supplement its asserted claims following further discovery and/or claim construction.

B. P.R. 3-1(b): Accused Products

Subject to ongoing discovery and investigation, and based on available information obtained to date, AICP contends that all semiconductor devices that TSMC manufactures at its 28 nanometer process node high-performance variants, including but not limited to its 28nm High Performance (28HP), 28nm High Performance Computing (28HPC), 28nm High Performance Compact Plus (28HPC+), and 28nm High Performance Mobile (28HPM) process nodes variants, infringe the asserted claims of the '227 Patent, '764 Patent, '686 Patent, '180 Patent, '076 Patent, and Claims 1, 12, 13, and 14 of the '779 Patent. An exemplary list of such products is included in Exhibits A, B, C, D, E, and G. AICP contends that all semiconductor devices that TSMC

manufactures at its 22nm and 28nm process node low power variants, including but not limited to its Ultra Low Leakage (22ULL), 22nm Ultra Low Power (22ULP), and 28nm Ultra Low Power (28ULP) process node variants, infringe the asserted claims of the '425 Patent. An exemplary list of such products is included in Exhibit H. AICP additionally contends that all semiconductor devices TSMC manufactures according to its FinFET process nodes, including all variants of its FinFET process nodes, infringe Claims 1, 12, 13, and 15 of the '779 Patent. An exemplary list of such products is included in Exhibit F. All of the semiconductor devices described in this section are collectively referred to as “Accused TSMC Products.”

TSMC both directly and indirectly infringes each of the Asserted TSMC Claims. TSMC directly infringes these claims by making, using, selling, offering to sell, and/or importing in or into the United States the Accused TSMC Products without a license.

TSMC also indirectly infringes the Asserted TSMC Claims by inducing infringement of the Asserted TSMC Claims by its customers and end-users. TSMC has actively encouraged and intentionally induced its customers to directly infringe the Asserted TSMC Claims by using, selling, offering for sale, and/or importing into the United States electronic devices and products containing the Accused TSMC Products. TSMC further induces infringement by collaborating with and instructing its customers on how to use and implement the technology claimed in the Asserted Patents, including, on information and belief, by implementing the claimed inventions in standard cell libraries that TSMC makes available to its customers for integrated chip design and customization.¹ TSMC intends to cause, and has taken affirmative steps to induce, infringement by customers and end-users by at least, *inter alia*, encouraging, promoting, instructing, and/or

¹ TSMC Annual Report 2023, available at https://investor.tsmc.com/sites/ir/annual-report/2023/2023%20Annual%20Report_E.pdf (last accessed Jan. 5, 2025).

directing the infringing use of the Accused TSMC Products.

TSMC further indirectly infringes the Asserted TSMC Claims by offering to sell and/or selling within in the United States services for manufacturing and designs for the Accused TSMC Products that practice the Asserted TSMC Claims. TSMC is aware that the Accused TSMC Products are semiconductor devices that constitute material and substantial parts of the inventions claimed by the Asserted TSMC Claims, that they are especially made or especially adapted for a use that is both patented and infringing, and that they are not staple articles of commerce capable of substantial non-infringing use.

AICP makes this disclosure, including Exhibits A through H, based on the present state of its knowledge, without the benefit of discovery. Further, AICP's investigation is ongoing, and no *Markman* order has been entered in this action. AICP reserves the right to supplement its position as to infringement following further discovery and/or claim construction.

C. P.R. 3-1(c): Preliminary Infringement Charts

Subject to ongoing discovery and investigation, and based on available information obtained to date, the attached infringement charts show AICP's preliminary contentions as to how each element of the Asserted TSMC Claims is found within the applicable Accused TSMC Products, Exhibits A through H. AICP's identification in the claim charts is exemplary and based upon public information currently available to AICP.

This disclosure, including Exhibits A through H, is based on the present state of AICP's knowledge, without the benefit of any discovery. Because AICP's investigation is ongoing and no *Markman* order has been entered in this action, AICP reserves all rights to supplement, amend, and/or otherwise modify its infringement contentions.

The parties have not exchanged claim terms or proposed claim constructions, TSMC has not served its preliminary invalidity contentions and accompanying production, and the *Markman*

hearing date is yet to be determined. AICP is not required to disclose claim construction positions at this time and does not do so here. This disclosure, inclusive of Exhibits A through H, should not be construed as setting forth AICP's claim construction positions. To the extent TSMC asserts that a particular claim construction position is implied by this disclosure, including Exhibits A through H, AICP denies and objects to any such assertion. AICP reserves all rights to modify its claim construction positions.

D. P.R. 3-1(d): Literal Infringement and Infringement Under Doctrine of Equivalents

Subject to ongoing discovery and investigation, and based on available information obtained to date, AICP further contends that each element of the Asserted TSMC Claims is literally present in the Accused TSMC Products, as specifically shown in Exhibits A through H. AICP asserts, in the alternative, that each element of each of the Asserted TSMC Claims is met by the Accused TSMC Products through the Doctrine of Equivalents because the Accused TSMC Products are insubstantially different than the patented devices and perform the same functions, in substantially the same ways, to achieve the same results as the patented devices.

As discussed above, discovery is necessary to further develop AICP's infringement positions—either literal or under the Doctrine of Equivalents—and the Court has yet to issue a claim construction order. Pursuant to P.R. 3-6, AICP expressly reserves the right to amend and supplement its position as to infringement under the Doctrine of Equivalents after further discovery from TSMC and/or pending this Court's claim construction order.

E. P.R. 3-1(e): Priority Dates

This initial disclosure is based on AICP's current knowledge. AICP's investigation is ongoing, and AICP reserves all rights to modify the positions taken in this initial disclosure.

The asserted claims of the '227, '764, '180, and '076 Patents claim priority to Japanese

Patent Application No. 2005-227457, which has a priority date of August 5, 2005. The asserted claims of the '686 Patent claim priority to Japanese Patent Application No. 2008-064435, which has a priority date of March 13, 2008. The asserted claims of the '779 Patent claim priority to Japanese Patent Application No. 2010-205599, which has a priority date of September 14, 2010. The asserted claims of the '425 Patent claim priority to Japanese Patent Application No. 2010-002225, which has a priority date of January 7, 2010.

F. P.R. 3-1(f) Disclosure: Right to Rely on Plaintiff's Own Instrumentality

AICP does not contend that it practices the claimed inventions.

II. AICP's P.R. 3-2 Document Production Accompanying Disclosure

These disclosures include an accompanying document production that contains copies of the file history for each of the Asserted Patents. The accompanying production is subject to, and does not waive any of, the objections and reservations set forth herein.

In producing the accompanying documents, AICP does not admit or concede the relevance, materiality, authenticity, or admissibility as evidence of any of these documents. All objections to the use, at trial or otherwise, of any document produced are hereby expressly reserved, and AICP objects to the production of any documents protected by the attorney-client privilege, the work-product doctrine, or any other immunities from discovery.

AICP makes this disclosure without the benefit of discovery, and AICP's investigation is ongoing. AICP produces these documents without prejudice to its right to produce additional documents after considering documents obtained and reviewed throughout discovery and further investigation.

A. Documents Responsive to P.R. 3-2(a)

AICP does not presently possess any relevant, non-privileged documents responsive to P.R. 3-2(a). AICP will supplement this response should any such relevant, non-privileged

documents be identified in the future.

B. Documents Responsive to P.R. 3-2(b)

AICP does not presently possess any relevant, non-privileged documents responsive to P.R. 3-2(b). AICP will supplement this response should any such relevant, non-privileged documents be identified in the future.

C. Documents Responsive to P.R. 3-2(c)

Pursuant to P.R. 3-2(c), copies of the file histories of the asserted patents have been produced at: AICP_00000001–AICP_00000253 ('227 Patent); AICP_00000254–AICP_00000431 ('764 Patent); AICP_00000432–AICP_00000788 ('686 Patent); AICP_00000789–AICP_00001118 ('180 Patent); AICP_00001119–AICP_00001321 ('076 Patent); AICP_00001322–AICP_00001660 ('779 Patent); and AICP_00001661–AICP_00002125 ('425 Patent).

Dated: January 7, 2025

Respectfully submitted,

/s/ Justin Nelson

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing was served via electronic mail to all counsel of record in this matter on January 7, 2025.

/s/ Justin Nelson
Justin A. Nelson