

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE OFFICE OF THE UNDER SECRETARY OF COMMERCE
FOR INTELLECTUAL PROPERTY AND DIRECTOR OF THE
UNITED STATES PATENT AND TRADEMARK OFFICE

TAIWAN SEMICONDUCTOR MANUFACTURING COMPANY LTD.,
Petitioner,

v.

ADVANCED INTEGRATED CIRCUIT PROCESS LLC,
Patent Owner.

IPR2025-00682 (Patent 8,198,686 B2)
IPR2025-00683 (Patent 8,907,425 B2)

Before COKE MORGAN STEWART, *Acting Under Secretary of
Commerce for Intellectual Property and Acting Director of the United States
Patent and Trademark Office.*

DECISION
Denying Institution of *Inter Partes* Review

IPR2025-00682 (Patent 8,198,686 B2)

IPR2025-00683 (Patent 8,907,425 B2)

Advanced Integrated Circuit Process LLC (“Patent Owner”) filed a request for discretionary denial (Paper 6, “DD Req.”) in the above-captioned cases, and Taiwan Semiconductor Manufacturing Company Limited (“Petitioner”) filed an opposition (Paper 10, “DD Opp.”).¹ With authorization, Patent Owner filed a Reply (Paper 14), and Petitioner filed a Sur-reply (Paper 15).

After considering the parties’ arguments and the record, and in view of all relevant considerations, discretionary denial of institution is appropriate in these proceedings. This determination is based on the totality of the evidence and arguments the parties have presented.

In particular, the projected final written decision due date in these Board proceedings is October 18, 2026. DD Req. 9–10. The district court’s scheduled trial date is June 22, 2026, and the time-to-trial statistics suggest trial will begin between May 2026 and January 2027. *Id.* at 22; DD Opp. 17–23. As such, it is unlikely that a final written decision in these proceedings will issue before district court trial occurs, resulting in significant duplication of effort, additional expense for the parties, and a risk of inconsistent decisions.

Furthermore, the challenged patents have been in force for thirteen and eleven years, respectively, creating strong settled expectations for Patent Owner, and Petitioner does not provide persuasive reasoning why an *inter partes* review is an appropriate use of Board resources. *Dabico Airport Sols. Inc. v. AXA Power ApS*, IPR2025-00408, Paper 21 at 2–3 (Director June 18, 2025). Petitioner’s argument that Patent Owner does not have settled

¹ Citations are to papers in IPR2025-00682. The parties filed similar papers in IPR2025-00683.

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expectations because Patent Owner did not previously assert the challenged patent against Petitioner does not defeat Patent Owner's settled expectations. DD Opp. 38. Accordingly, in the absence of sufficient explanation, Patent Owner's strong settled expectations tip the balance in favor of discretionary denial.

Although certain arguments are highlighted above, the determination to exercise discretion to deny institution is based on a holistic assessment of all of the evidence and arguments presented. Accordingly, the Petitions are denied under 35 U.S.C. § 314(a).

In consideration of the foregoing, it is:

ORDERED that Patent Owner's request for discretionary denial is *granted*; and

FURTHER ORDERED that the Petitions are *denied*, and no trial is instituted.

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