

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

UPI SEMICONDUCTOR CORPORATION,

Petitioner,

v.

FORCE MOS TECHNOLOGY CO. LTD.,

Patent Owner

Inter Partes Review No. IPR2025-00920
U.S. Patent No. 7,812,409

PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL

TABLE OF CONTENTS

I. INTRODUCTION1

II. FACTUAL BACKGROUND.....3

 A. U.S. Patent No. 7,812,409 (“the ’409 Patent”)3

 B. Procedural Background4

III. ARGUMENT.....7

 A. THIS IPR WAS FILED ON BEHALF OF ASUS— AN
 UNDISCLOSED REAL PARTY-IN-INTEREST.....7

 B. THIS IPR SHOULD BE DENIED AS AN IMPROPER FOLLOW-
 ON PETITION UNDER *GENERAL PLASTIC*14

 1. *General Plastic* Factor 1: whether the same petitioner
 previously filed a petition directed to the same claims of the
 same patent.....15

 2. *General Plastic* Factor 2: whether at the time of filing of the
 first petition the petitioner knew of the prior art asserted in
 the second petition or should have known of it15

 3. *General Plastic* Factor 3: whether at the time of filing of the
 second petition the petitioner already received the patent
 owner’s preliminary response to the first petition or received
 the Board’s decision on whether to institute review in the
 first petition17

 4. *General Plastic* Factor 4: the length of time that elapsed
 between the time the petitioner learned of the prior art
 asserted in the second petition and the filing of the second
 petition.....17

 5. *General Plastic* Factor 5: whether the petitioner provides
 adequate explanation for the time elapsed between the filings

TABLE OF CONTENTS (cont.)

of multiple petitions directed to the same claims of the same patent17

6. *General Plastic* Factor 6: the finite resources of the Board; and18

7. *General Plastic* Factor 7: the requirement under 35 U.S.C. § 316(a)(11) to issue a final determination not later than 1 year after the date on which the Director notices institution of review.....18

C. DISCRETIONARY DENIAL IS APPROPRIATE UNDER *FINTIV*18

1. *Fintiv* Factor 1: Likelihood of a District Court Stay.....19

2. *Fintiv* Factor 2: Proximity of Trial Date to the Projected Statutory Deadline.....19

3. *Fintiv* Factor 3: Investment in the Parallel Proceeding20

4. *Fintiv* Factor 4: Overlap of Issues.....20

5. *Fintiv* Factor 5: Whether Petitioner and the Defendant in the Parallel Proceeding are the Same Parties.....21

6. *Fintiv* Factor 6: Other Considerations, Including the Merits....22

D. DISCRETIONARY DENIAL IS APPROPRIATE BECAUSE THE VALIDITY OF THE '409 PATENT HAS BEEN PREVIOUSLY ADJUDICATED22

E. THE PETITION SHOULD BE DISCRETIONARILY DENIED FOR EXCESSIVE, AND REDUNDANT GROUNDS24

F. SETTLED EXPECTATIONS FAVOR DISCRETIONARY DENIAL24

IV. CONCLUSION.....26

TABLE OF AUTHORITIES

Cases

Adaptics Ltd. v. Perfect Co.,
IPR2018-01596 Paper 20 (March 6, 2019).....23

Apotex Inc., v. Alkermes Pharma Ireland Limited,
IPR2025-00514, Paper 10 (PTAB July 2, 2025)24

Apple Inc. v. Fintiv, Inc.,
IPR2020-00019, Paper 11 (PTAB March 20, 2020) 18, 19, 20, 21

Applications in Internet Time, LLC v. RPX Corp.,
897 F.3d 1336 (Fed. Cir. 2018) 7, 8, 13

Cisco Sys., Inc. v. Hewlett Packard Enter. Co.,
IPR2017-01933, Paper 9 (PTAB Mar. 16, 2018)8

CrowdStrike, Inc. v. GoSecure, Inc.,
IPR2025-00068, Paper 25 (PTAB June 25, 2025)23

General Plastic Industrial Co., Ltd. v. Canon Kabushiki Kaisha,
IPR2016-01357, Paper 19 (PTAB Sept. 6, 2017).....14

iRhythm Tech., Inc. v. Welch Allyn, Inc.,
IPR2025-00363, Paper 10 (PTAB June 6, 2025)24

Luminex International Co. v. Signify Holding BV,
IPR2024-00101, Paper 10 (PTAB May 9, 2024) 11, 13

Luminex International Co. v. Signify Holding BV,
IPR2024-00101, Paper 20 (PTAB Nov. 21, 2024).....12

Valve Corp. v. Electronic Scripting Prods., Inc.,
IPR2019-00062, Paper 11 (PTAB Apr. 2, 2019)..... 13, 14

Verizon Connect Inc. v. Omega Patents, LLC,
IPR2023-01162, Paper 37 (May 2, 2025).....23

Worlds Inc. v. Bungie, Inc.,
903 F.3d 1237 (Fed. Cir. 2018) 11, 13

Statutes

35 U.S.C. § 314(a)25
35 U.S.C. § 315(b)22
Uniform Commercial Code § 2-3129

Other Authorities

Interim Processes for PTAB Workload Management (Mar. 26, 2025), available at
<https://www.uspto.gov/sites/default/files/documents/InterimProcesses-PTABWorkloadMgmt-20250326.pdf>..... 1, 14, 17, 22

Office Patent Trial Practice Guide,
84 Fed. Reg. 64,280 (Nov. 21, 2019)7, 8

PATENT OWNER'S EXHIBIT LIST

Exhibit	Description
2001	Amended Complaint, as filed at ECF 13 in <i>Force MOS Tech., Co., Ltd. v. ASUSTeK Computer, Inc.</i> , No. 2:22-cv-460 (E.D. Tex. Mar. 7, 2023)
2002	ASUSTeK Computer, Inc., Consolidated Financial Statements (3rd Quarter 2019, September 30, 2019), (<i>available at</i> https://www.asus.com/event/investor/content/attachment_en/2019_q3_finacial_report.pdf)
2003	ASUSTeK Computer, Inc., Annual Report (2024), (<i>available at</i> https://www.asus.com/EVENT/Investor/Content/attachment_en/2024_Annual_Report.pdf)
2004	uPI Semi Corp., "Top 10 Shareholders", (<i>available at</i> https://www.upi-semi.com/investor/shareholder-services/top-10-shareholders/)
2005	Plaintiff's First Set of Requests for Production to ASUSTeK Computer, Inc., as served in <i>Force MOS Tech., Co., Ltd. v. ASUSTeK Computer, Inc.</i> , No. 2:22-cv-460 (E.D. Tex. Dec. 6, 2023)
2006	Plaintiff's First Set of Interrogatories to ASUSTeK Computer, Inc., as served in <i>Force MOS Tech., Co., Ltd. v. ASUSTeK Computer, Inc.</i> , No. 2:22-cv-460 (E.D. Tex. Dec. 6, 2023)
2007	Email from C. McMahon re: ASUSTeK (Force MOS) Summary of Pre-Trial Conference (Dec. 4, 2024), as filed in <i>Inergy Technology Inc., v. Force MOS Technology Co., Ltd.</i> , Case No. 2024-Min-Gong-Shang-Zih No. 2, Taiwan Intellectual Property and Commercial Court: Ping Judicial Section, as Exhibit 37 to Inergy Technology Inc.'s Civil Answer Brief No. III (April 11, 2025)

Exhibit	Description
2008	Email string including email from C. McMahon re: ASUSTeK Mediation and Trial Update (Mar. 27, 2025), as filed in <i>Inergy Technology Inc., v. Force MOS Technology Co., Ltd.</i> , Case No. 2024-Min-Gong-Shang-Zih No. 2, Taiwan Intellectual Property and Commercial Court: Ping Judicial Section, as Exhibit 38 to Inergy Technology Inc.'s Civil Answer Brief No. III (April 11, 2025)
2009	LinkedIn, entry for C. Tseng (<i>available at</i> https://www.linkedin.com/in/tseng-catherine-518b9556/)
2010	Amended Final Judgment, as filed at ECF 422 in <i>Force MOS Tech., Co., Ltd. v. ASUSTeK Computer, Inc.</i> , No. 2:22-cv-460 (E.D. Tex. June 13, 2025)
2011	Trial Transcript, Vol. 1 (Feb. 7, 2025), as filed at ECF 369 in <i>Force MOS Tech., Co., Ltd. v. ASUSTeK Computer, Inc.</i> , No. 2:22-cv-460 (E.D. Tex. Feb. 7, 2025)
2012	Defendant ASUSTeK Computer, Inc.'s Motion to Stay Pending Resolution of <i>Inter Partes</i> Reviews, as filed at ECF 30 in <i>Force MOS Tech., Co., Ltd. v. ASUSTeK Computer, Inc.</i> , No. 2:22-cv-460 (E.D. Tex. Nov. 30, 2023)
2013	Memorandum Opinion and Order Denying Defendant ASUSTeK Computer, Inc.'s Motion to Stay Pending Resolution of <i>Inter Partes</i> Reviews, as filed at ECF 74 in <i>Force MOS Tech., Co., Ltd. v. ASUSTeK Computer, Inc.</i> , No. 2:22-cv-460 (E.D. Tex. Apr. 11, 2024)
2014	Defendant ASUSTeK Computer, Inc.'s Patent Initial Disclosures (Invalidity Contentions), as served in <i>Force MOS Tech., Co., Ltd. v. ASUSTeK Computer, Inc.</i> , No. 2:22-cv-460 (E.D. Tex. July 18, 2023)
2015	IPR2024-00094, Petition, Paper No. 1 (Oct. 27, 2023)
2016	IPR2024-00094, Order Setting Oral Argument, Paper No. 31 (Jan. 21, 2025)

Exhibit	Description
2017	IPR2024-00094, Final Written Decision, Paper No. 37 (May 16, 2025)
2018	IPR2024-00094, Patent Owner's Request for Director Review of the Final Written Decision, Paper No. 38 (June 16, 2025)
2019	U.S. Patent Publication No. 2006/0273384 to Hshieh
2020	PTACTS Docket of IPR2024-00094 (accessed July 28, 2025)
2021	PACER Docket of Force Mos Technology Co., Ltd. v. ASUSTeK Computer, Inc., Case No. 2:22-cv-00460-JRG (E.D. Tex.) (accessed July 28, 2025)
2022	Trial Transcript (Redacted), Vol. 2 (Feb. 10, 2025), as filed at ECF 403-1 in <i>Force MOS Tech., Co., Ltd. v. ASUSTeK Computer, Inc.</i> , No. 2:22-cv-460 (E.D. Tex. Feb. 7, 2025)
2023	Jury Verdict as filed at ECF 358 in <i>Force MOS Tech., Co., Ltd. v. ASUSTeK Computer, Inc.</i> , No. 2:22-cv-460 (E.D. Tex. Feb. 7, 2025)
2024	Trial Transcript (Redacted), Vol. 3 (Feb. 11, 2025), as filed at ECF 403-2 in <i>Force MOS Tech., Co., Ltd. v. ASUSTeK Computer, Inc.</i> , No. 2:22-cv-460 (E.D. Tex. Feb. 7, 2025)
2025	uPI Company History, <i>available at</i> https://www.upi-semi.com/about-us/companyhistory/ (accessed July 28, 2025)
2026	Specification Sheet for UBIQ / uPI SEMI QM3016AM3 N-Channel 30V Fast Switching MOSFET
2027	Notice of Attorney Appearance by Charles M McMahon on behalf of ASUSTeK Computer, Inc., as filed at ECF 115 in <i>Force MOS Tech., Co., Ltd. v. ASUSTeK Computer, Inc.</i> , No. 2:22-cv-460 (E.D. Tex. Feb. 7, 2025)
2028	U.S. Patent No. 6,621,107
2029	U.S. Patent No. 7,345,342

PO's Request for Discretionary Denial
IPR2025-00920

Exhibit	Description
2030	U.S. Patent No. 7,446,374
2031	U.S. Patent No. 7,504,306

Pursuant to the Acting Director's Memorandum titled "Interim Processes for PTAB Workload Management" (Mar. 26, 2025) (the "Interim Process Memorandum"), Patent Owner Force MOS Technology Co. Ltd. ("Force MOS" or "Patent Owner") submits this brief requesting discretionary denial of the petition for *Inter Partes* Review of U.S. Patent No. 7,812,409 (the "'409 patent"), filed by uPI Semiconductor Corporation ("uPI" or "Petitioner").

I. INTRODUCTION

As shown below, this IPR has actually been filed on behalf of uPI's customer—undisclosed real party-in-interest ASUSTek Computer Inc. ("ASUS"). Force MOS first asserted the '409 Patent against ASUS, in an amended complaint filed over two years ago in the Eastern District of Texas. That case has already proceeded to judgment, after a jury found claim 1 of the '409 Patent valid and infringed by ASUS. The '409 Patent was also subject to IPR2024-00094, ostensibly filed by one of ASUS's other suppliers (Inergy Technologies), but which expressly identified ASUS as a real party-in-interest.

Petitioner and ASUS are more than merely supplier and customer. ASUS is Petitioner's second largest shareholder and was previously a majority shareholder; ASUS's officers, directors, and other employees hold positions of control at Petitioner. Petitioner's products were specifically identified as infringing in the EDTX litigation long before this Petition was filed. And, Petitioner actively

participated in the EDTX litigation, receiving detailed communications on its status from ASUS's litigation counsel. Indeed, the Petition is specifically calculated to challenge the sole claim found infringed by ASUS at the EDTX trial—claim 1—with *four* grounds challenging claim 1. As such, there is little question that ASUS is the intended beneficiary of the present petition and should be found to be a real party in interest, or in privity, with Petitioner.

As a result, there are many reasons that this proceeding should be discretionarily denied institution. ***First***, because this IPR was filed well after IPR2024-00094, discretionary denial is appropriate under *General Plastic*. By filing this IPR after briefing and the oral hearing in that earlier IPR had completed, Petitioner had the benefits of Patent Owner's arguments and was able to improperly adapt its arguments to address them—asserting new art and arguments in this IPR. There is no good reason to provide ASUS another opportunity to challenge this patent.

Second, because the co-pending district court litigation has already proceeded to trial and final judgment—finding the '409 Patent to be valid and infringed—discretionary denial is appropriate under *Fintiv*. Simply put, further resources should not be wasted by once again litigating the validity of this patent after ASUS had a full and fair opportunity to litigate that issue in District Court.

Third, the validity of the '409 Patent has already been fully litigated in the EDTX case and the prior *inter partes* review brought on behalf of ASUS. Thus, there is therefore no reason for the Board to waste resources on yet another challenge to the '409 Patent.

Fourth, this Petition presents excessive, redundant grounds without good reason. Thus, institution would risk unduly wasting the Office's resources and time.

Fifth, settled expectations of the parties justify discretionary denial of the Petition. The '409 Patent is nearly fifteen years old—far older than other patents which the Acting Director has previously found to have justified discretionary denial due to settled expectations.

Indeed, this is an unusual case where so many factors so clearly weigh against institution, that the Director should promptly deny institution to avoid further unnecessary labor and expense from the Office or the parties.

II. FACTUAL BACKGROUND

A. U.S. Patent No. 7,812,409 (“the '409 Patent”)

The '409 Patent teaches improved cell layouts for trench MOSFETs. Ex. 1001, Abstract. A MOSFET is a transistor which, like a switch, alters the flow of electric charge between two terminals (the source and the drain) in response to a change in potential of a third terminal (the gate). Trenched MOSFETs embed gate

material into trenches so that the channel—where charge flows in the “ON” state—is vertical. *See* Ex. 1001, Fig. 1C. This allows for increased density and lower on-resistance, improving efficiency. Cell layouts for prior trenched MOSFETs—which used square-shaped cells and contacts—experienced “parasitic bipolar NPN latch up.” *Id.*, Fig. 1A, 1:15-20. This undesired current flow was especially pronounced near the cells’ corners in prior art devices. *Id.*

During prosecution of the ’409 Patent, the examiner acknowledged that there were prior art MOSFETs with square cells having rounded corners, such as the Pfirsch reference. Ex. 1002 at 283-284, 322, 328, 356, 364. The examiner also acknowledged the existence of prior art MOSFETs with circular contacts. *Id.* at 323-326. However, the examiner ultimately accepted the patentee’s argument that the prior art did not teach the unique cell layout recited in the claims. *Id.*, 259-261, 273-277, 306-308.

B. Procedural Background

On March 7, 2023, Patent Owner filed an amended complaint in Case No. 2:22-cv-460-JRG in the Eastern District of Texas (“the EDTX case”) against ASUSTeK Computer, Inc. (“ASUS”), alleging, among other things, infringement of the ’409 Patent. Ex. 2001 at 23, 27. The EDTX case against ASUS ultimately proceeded to a jury trial on February 7-13, 2025. Ex. 2021 (ASUS Docket) at 45-46 (ECF Nos. 349-361). In that case, Force MOS demonstrated that certain

accused MOSFETs incorporated in ASUS products infringed claim 1 of the '409 Patent and U.S. Patent No. 7,629,634. In particular, the MOSFETs accused of infringing the '409 Patent included Petitioner uPI Semiconductor's QM3016AM MOSFET. Ex. 2022 at 345:20-346:17, 366:20-367:9, 389:21-391:18.¹ The jury issued a verdict on February 13, 2025, finding for Force MOS on all issues—including the validity of the '409 Patent—and awarding \$10.5 million in damages. Ex. 2023 at 6, 9. The District Court subsequently entered an amended judgment on June 13, 2025 in favor of Force MOS and against ASUS, confirming the validity of claim 1 of the '409 Patent. Ex. 2010 at 2.

On October 27, 2023, Inergy Technology, Inc.—an indirect supplier to ASUS of some of the MOSFETs accused of infringement—filed IPR2024-00094 challenging the '409 Patent. Ex. 2015 at 78; *see also* Ex. 2011 at 244:18-24; Ex. 2022 at 623:8-13. ASUS was expressly identified as an admitted real-party-in-interest in IPR2024-00094, as was ASUS's indirect supplier Panjit International, Inc. Ex. 2015 at 1. IPR2024-00094 was instituted and thereafter proceeded

¹ Some of the EDTX trial transcript and trial documents refer to “UBIQ” instead of “uPI.” UBIQ and uPI Semiconductor previously operated as two subsidiaries of uPI Group, but merged in 2019. Ex. 2011 at 203:18-204:4; Ex. 2025 at 3 (“2019 Year” “uPI & UBIQ Semiconductor Merged – The Era of One uPI”); Ex. 2026 at 1 (“Ubiq is now part of uPI EMI”).

through trial, briefing, depositions, and the oral hearing on February 21, 2025.

Exs. 2016, 2021. On May 16, 2025—after the EDTX case verdict but before the judgment—the Board issued a Final Written Decision in IPR2024-00094 finding claims 1, and 3-5 unpatentable, and finding claims 2 and 6 patentable. Ex. 2017.

On June 16, 2025, Patent Owner timely filed a Request for Director Review of the Final Written Decision in IPR2024-00094, which remains pending. Ex. 2018.

On April 24, 2025—after the EDTX jury verdict, and after the oral hearing in IPR2024-00094, Petitioner uPI Semiconductor, Inc. filed the present IPR Petition challenging claims 1-5 of the '409 Patent. Pet. at 21. Notably, the Petition only identifies uPI Semiconductor, Inc. as a real party-in-interest. Pet. at 88. Although the Petition notes the existence of IPR2024-00094 and the EDTX case (*id.*), it contains no substantive attempt to address *Fintiv* or *General Plastic*, other than merely contending that “Petitioner is a party to neither co-pending proceeding.” Pet. at 85. Notably, the Petition is entirely silent as to the relationship between Petitioner and ASUS (discussed in further detail below).

III. ARGUMENT

A. THIS IPR WAS FILED ON BEHALF OF ASUS— AN UNDISCLOSED REAL PARTY-IN-INTEREST

The Petition asserts that the sole real party-in-interest is “uPI Semiconductor Corporation.” Pet. at 88. However, it is clear that ASUSTeK Computer, Inc. (“ASUS”) is an undisclosed real party-in-interest and privy in this IPR.

The RPI and privy requirements “seek[] to protect patent owners from harassment via successive petitions by the same or related parties, to prevent parties from having a ‘second bite at the apple.’” Office Patent Trial Practice Guide, 84 Fed. Reg. 64,280 at 12 (Nov. 21, 2019) (“Trial Practice Guide”). Further, regarding privity, “[a] common consideration is whether the non-party exercised or could have exercised control over a party’s participation in a proceeding.” *Id.* at 16.

“Determining whether a non-party is [an RPI] demands a flexible approach that takes into account both equitable and practical considerations, with an eye toward determining whether the non-party is a clear beneficiary that has a preexisting, established relationship with the petitioner.” *Applications in Internet Time, LLC v. RPX Corp.*, 897 F.3d 1336, 1351 (Fed. Cir. 2018). Underlying the RPI inquiry includes “two questions lying at its heart [which] are whether a non-party ‘desires review of the patent’ and whether a petition has been filed at a

nonparty's 'behest.'" *Id.* (quoting Trial Practice Guide, 77 Fed. Reg. at 48,759).

The inquiry focuses on "who, from a "practical and equitable" standpoint, will benefit from the redress that the chosen tribunal might provide . . . and should extend to parties to transactions and other activities relating to the property in question.'" *RPX*, 897 F.3d at 1349. "[A] non-party may be a real party-in-interest even in the absence of control or an opportunity to control." *Cisco Sys., Inc. v. Hewlett Packard Enter. Co.*, IPR2017-01933, Paper 9 at 12 (PTAB Mar. 16, 2018).

In the present case, publicly available information confirms that ASUSTek Computer Inc.—the disclosed real party in interest in IPR2024-00094 and the defendant in the EDTX case—is a real party in interest or privy of Petitioner. As early as 2018, ASUS identified in its public financial reports that it then held a 50.99% ownership interest in Petitioner. Ex. 2002 (ASUS 2019 Q3 report) at 15. Further, ASUS's most recent Annual Report confirms ASUS's continued ownership, which (either directly or indirectly through directors, supervisors and managers) remains at 22.10%. Ex. 2003 at 87. Indeed, Petitioner is expressly identified as an "Affiliated Enterprise" of ASUS. *Id.* at 86. Petitioner's own website further identifies that ASUS is Petitioner's second largest shareholder. Ex. 2004 at 1. ASUS's substantial, and continuing, ownership in Petitioner, as well as ASUS's identification of Petitioner as an affiliated enterprise, demonstrate that

Petitioner is in privity with ASUS, the Defendant in the EDTX litigation.

Moreover, ASUS's officers, directors, and other employees hold positions of control at uPI. First, one of ASUS's directors, S. Y. Hsu, is the Chairman of Petitioner. Ex. 2003 at 4-5. Second, ASUS's Corporate Vice President, Albert Chang, is one of Petitioner's directors. Ex. 2003 at 15, 17. Third, ASUS's Chief Financial Officer, Nick Wu, is also one of Petitioner's directors. Ex. 2003 at 16, 17.

Still further, uPI's products have long been accused of infringing in the district court litigation against ASUS. For example, in Force MOS's Requests for Production served in the EDTX case on December 6, 2023, Force MOS identified in the list of accused ASUS products in the district court litigation as including products incorporating Petitioner's QM3016AM MOSFET. Ex. 2005 at 2; *see also* Ex. 2026. An identical list of accused products was included in Force MOS's interrogatories served the same day, also listing Petitioner's QM3016AM product. Ex. 2006 at 2. Moreover, Patent Owner demonstrated that such products infringe the '409 Patent at the EDTX trial. Ex. 2022 at 345:20-346:20, 389:21-391:18; Ex. 2010 at 2. As such, Petitioner's products have long been accused in the co-pending district court litigation against ASUS. And, as a supplier of components to ASUS, Petitioner certainly has some form of indemnification obligation to

ASUS for infringement caused by inclusion of uPI's MOSFETs. *See* U.C.C. § 2-312.

Indeed, emails that have been made publicly available in Taiwan proceedings which confirm uPI's participation in the EDTX litigation. In particular, ASUS's litigation counsel from Benesch Friedlander Coplan & Aronoff, Mr. Charles McMahon, sent detailed communications regarding the status of Force MOS's EDTX case against ASUS to Cathy Tseng (cathy_tseng@[upi-semi.com](mailto:cathy_tseng@upi-semi.com)). Ex. 2007; Ex. 2008;² Ex. 2027 (Mr. McMahon's entry of appearance). Ms. Tseng's LinkedIn profile further confirms that Ms. Tseng has held the position of manager at uPI for over fifteen years. Ex. 2009 (Tseng LinkedIn Profile). This confirms that uPI was actively involved in the co-pending district court litigation. Indeed, uPi actively assisted ASUS by providing information to ASUS's expert witness for use at that trial. Ex. 2024 at 829:23-831:2.

Moreover, the fact that this petition was filed on behalf of ASUS is further demonstrated by the specific challenged claims and grounds. In particular, Petitioner asserts *four* distinct grounds all against claim 1 of the '409 Patent. Pet. at 21. Half of those grounds *only* challenge claim 1. *Id.* And, notably, claim 1 of

² Ms. Tseng's full "upi-semi.com" email address appears in the email header later in the email chain, near the bottom of page 2 Ex. 2008.

the '409 Patent was the sole asserted patent in the trial against ASUS in the EDTX case, where the jury found the claim both valid and infringed. Ex. 2023 at 5-6; Ex. 2010 at 2. Thus, obviously ASUS would particularly benefit from claim 1 of the '409 Patent being held invalid. By contrast, if Petitioner were attempting to avoid its own, separate liability from infringing the '409 patent, it would have challenged all of the claims of the '409 Patent equally.

In a similar situation, the Board previously held that a retailer was RPI in an IPR filed by the supplier. *See Luminex International Co. v. Signify Holding BV*, IPR2024-00101, Paper 10 (PTAB May 9, 2024). The Board determined that the customer was RPI to the supplier. The Board noted that the “petitioner bears the burden of persuasion to demonstrate that § 315(b) does not bar institution based on a complaint served on a real party in interest or privy of the petitioner more than one year before petition filing.” *Id.* at 29 (citing *Worlds Inc. v. Bungie, Inc.*, 903 F.3d 1237, 1242 (Fed. Cir. 2018)). Specifically, the Board found that the supplier's indemnification obligations showed that the petition was filed at the customer's “behest,” making the customer RPI as to the supplier for purposes of the one-year bar. *Id.* at 37. The Board determined that the customer was therefore RPI of the supplier because it was “a clear beneficiary that has a preexisting, established relationship with the petitioner.” *Id.* at 42.

The prior Director reversed the Board's decision in *Luminex*, but on grounds that are readily distinguishable from the present case. The Director found that “a standard, non-exclusive, manufacturer-customer indemnification agreement relating to patent infringement can be sufficient to support a finding of real party in interest and trigger the one-year time bar.” *Luminex International Co. v. Signify Holding BV*, IPR2024-00101, Paper 20 at 11 (PTAB Nov. 21, 2024). Thus, the prior Director held that a mere supplier-customer relationship, with standard indemnification provisions, would not create RPI “without more.” *Id.*

However, as shown above, the relationship between Petitioner and ASUS involves *significantly* more in the present case. First, the Director expressed a concern that finding customers to be RPI of suppliers would encourage suits against customers “to escape the threat of potential IPR challenges by manufacturers, who become unwittingly time-barred.” *Id.* at 14. However, in the present case there is no such concern because Petitioner's products were identified as infringing at least as early as December 6, 2023, also more than one year before Petitioner's filing. Ex. 2005 at 2; Ex. 2006 at 2. Second, the customer/defendant in the litigation has a significantly closer relationship to Petitioner than in a pure arms-length supplier-purchaser relationship. As shown above, ASUS is Petitioner's second largest owner, and has indeed held an ownership interest

greater than 50% in the past. Ex. 2002 at 15; Ex. 2003 at 87; Ex. 2004. Further, ASUS's officers, directors, and other employees hold positions of control at uPI. Ex. 2003 at 4-5, 15-17. Third, Petitioner actively received information and communications from ASUS's litigation counsel regarding the ongoing status of the EDTX case, and helped support ASUS's defense by providing information directly to ASUS's expert. Exs. 2007-2008; Ex. 2024 at 829:23-831:2. As such, this case involves a substantially closer relationship between Petitioner and ASUS than the mere customer-supplier relationship at issue in *Luminex*. Thus, the Board should find that ASUS is RPI with Petitioner and is also in privity with Petitioner for these reasons.

In sum, because ASUS “is a clear beneficiary that has a preexisting, established relationship with the petitioner,” it is a RPI. *RPX*, 897 F.3d at 1351; *see also Worlds Inc. v. Bungie, Inc.*, 903 F.3d 1237 at 1242, 1246.³ Moreover,

³ Although denial under the time bar of 35 U.S.C. § 315(b) is non-discretionary—and thus will be fully addressed in Patent Owner's preliminary response rather than this paper—ASUS's status as a real-party-in-interest in this IPR also renders this IPR as prohibited because it was filed more than one year after the '409 Patent was asserted in a complaint against ASUS. 35 U.S.C. § 315(b). In particular, Force MOS filed and served an amended complaint for patent infringement asserting the '409 Patent against ASUS on March 7, 2023. Ex. 2001 at 1, 27. The time barred

even if ASUS's relationship with Petitioner did not rise to the level of privity or RPI, discretionary denial is still appropriate because all of the same facts demonstrate a "significant relationship" between Petitioner and ASUS sufficient for discretionary denial of institution. *See Valve Corp. v. Electronic Scripting Prods., Inc.*, IPR2019-00062, Paper 11 (PTAB Apr. 2, 2019).

B. THIS IPR SHOULD BE DENIED AS AN IMPROPER FOLLOW-ON PETITION UNDER *GENERAL PLASTIC*

Under the Interim Process Memorandum, the factors enumerated in the Board's precedential *General Plastics* decision form part of "all relevant considerations" regarding whether to grant a request for discretionary denial.

March 26, 2025 Interim Process Memorandum at 2.

Because, as shown above, this petition, like IPR2024-00094, was filed on behalf of ASUS, it should be discretionarily denied as an improper follow-on IPR under *General Plastics*. *See General Plastic Industrial Co., Ltd. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 (PTAB Sept. 6, 2017). Each of the factors demonstrate that discretionary denial is appropriate.

status of this petition is relevant to the Director's consideration of discretionary denial, including the lack of compelling merits under *Fintiv* Factor 6.

1. *General Plastic* Factor 1: whether the same petitioner previously filed a petition directed to the same claims of the same patent

This petition challenges claims 1-5, which were all also challenged in IPR2024-00094. Pet. at 21; Ex. 2015 at 3-4. Moreover, as shown above, this petition, like IPR2024-00094, was filed on behalf of ASUS. *Supra* III.A. Thus, although it does not include the same named Petitioner verbatim, this factor still weighs in favor of discretionary denial. *Valve Corp. v. Electronic Scripting Prods., Inc.*, IPR2019-00062, Paper 11 (PTAB Apr. 2, 2019) (factor 1 weighs toward discretionary denial where “significant relationship” between petitioners in the current and prior IPRs).

2. *General Plastic* Factor 2: whether at the time of filing of the first petition the petitioner knew of the prior art asserted in the second petition or should have known of it

This factor weighs against discretionary denial since ASUS and Petitioner knew or should have known of all of the prior art asserted in this IPR long ago. The Petition contains no representation as to when Petitioner or ASUS allegedly first learned of the asserted references. However, ASUS served its invalidity contentions for the '409 patent on July 18, 2023, nearly two years prior to this IPR. Thus, ASUS was obligated to search and disclose prior art at that time. E.D. Tex. P.R. 3-3, *available at* <https://www.txed.uscourts.gov/?q=patent-rules>.

Indeed, many of the references in this Petition were clearly known by ASUS. Uno was directly cited in ASUS's contentions. *Compare* Ex. 1007 with Ex. 2014 at 10. Bhalla was published as US 2006/0180855 (Ex. 1009.001, (65)) which was cited in ASUS's invalidity contentions (Ex. 2014 at 5, 7, 9, 11). And Hsieh 390 is a continuation of 11/147,075 (Ex. 1006.1, (63)), another continuation of which published as US2006/0273384 (Ex. 2019), which was cited in ASUS's invalidity contentions (Ex. 2014 at 5, 9).

Moreover, Bucella—the reference cited in each ground of this IPR—was a cited prior art reference in a number of patents identified in ASUS's invalidity contentions. Ex. 2014 at 11-12, (citing US6621107, US7345342, US7446374, and US7504306); Exs. 2028-2031 (citing US5072266 to Bulucea et al.). Similarly, the Huang reference was cited by some of those same patents from ASUS's invalidity contentions. Exs. 2029-2031 (citing US6037628 to Huang). Moreover, as discussed, Petitioner was actively involved in the ASUS litigation. Exs. 2007-2008; Ex. 2024 at 829:23-831:2. Thus, ASUS and Petitioner knew or should have known of all of the cited prior art references in this Petition no later than July 18, 2023.

3. ***General Plastic Factor 3: whether at the time of filing of the second petition the petitioner already received the patent owner's preliminary response to the first petition or received the Board's decision on whether to institute review in the first petition***

This factor weighs strongly towards discretionary denial. Indeed, not only did Petitioner wait until receiving Force MOS's preliminary response, it waited until after the institution, Patent Owner's response, Patent Owner's surreply, and the oral hearing. Ex. 2020 (IPR2024-00094 Docket).

4. ***General Plastic Factor 4: the length of time that elapsed between the time the petitioner learned of the prior art asserted in the second petition and the filing of the second petition***

This factor weighs strongly towards discretionary denial. As noted, Petitioner waited nearly two years after ASUS's invalidity contentions to file this IPR.

5. ***General Plastic Factor 5: whether the petitioner provides adequate explanation for the time elapsed between the filings of multiple petitions directed to the same claims of the same patent***

This factor weighs strongly towards discretionary denial. Petitioner provides no explanation whatsoever. Indeed, Petitioner makes no attempt to substantively address discretionary denial, and instead misleadingly asserts that it was not a party to the prior IPR (without disclosing its relationship to ASUS). Pet. at 88.

6. ***General Plastic* Factor 6: the finite resources of the Board; and**

This factor weighs strongly towards discretionary denial. The Board has already fully litigated an entire *inter partes* petition for ASUS once, as has a District Court. Institution of this IPR would require fully duplicating those efforts.

7. ***General Plastic* Factor 7: the requirement under 35 U.S.C. § 316(a)(11) to issue a final determination not later than 1 year after the date on which the Director notices institution of review.**

This factor weighs strongly towards discretionary denial. Since this Petition was filed shortly before the 1-year deadline for the final written decision in IPR2024-00094, there is no ability to consolidate or coordinate the proceedings.

C. DISCRETIONARY DENIAL IS APPROPRIATE UNDER *FINTIV*

Under the Interim Process Memorandum, the factors enumerated in the Board's precedential *Fintiv* decision form part of "all relevant considerations" that the Director and Board considers in determining whether to grant a request for discretionary denial. March 26, 2025 Interim Process Memorandum at 2.

Each of the *Fintiv* factors weigh in favor of discretionary denial. *See Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (PTAB March 20, 2020). In particular, in the co-pending EDTX case against ASUS, the District Court has already entered final judgment against real party-in-interest ASUS finding claim 1

of the '409 Patent to be valid and infringed. Ex. 2010 at 2. Taking account of the details of the pending District Court litigation, the progress of discovery, and the “other circumstances” enumerated above, a *Fintiv* analysis favors discretionary denial.

1. *Fintiv* Factor 1: Likelihood of a District Court Stay

In the co-pending District Court litigation, the District Court has already held a jury trial, which found the '409 Patent to be valid and infringed. Exs. 2010, 2023. Further, Petitioner's partial owner, ASUSTek Computer Inc. (“ASUS”) previously requested a stay of the pending litigation (Ex. 2012), which the district court denied. Ex. 2013. Thus, factor 1 weighs in favor of discretionary denial.

2. *Fintiv* Factor 2: Proximity of Trial Date to the Projected Statutory Deadline

In this instance, trial in the co-pending district court litigation has already occurred, with the Court finding the '409 Patent to be valid and infringed. Ex. 2010. In *Fintiv* the Board stated that the reason the respective trial date and statutory deadlines would be relevant is because the institution decision would implicate “the resources that have been invested in the parallel proceeding.”

Fintiv, Paper 11 at 9. Since validity of the '409 Patent has already been determined in the co-pending District Court litigation, there is significant overlap in resources that have already been invested in the parallel proceeding. Because

the co-pending district court litigation has already found the '409 Patent to be valid and infringed, factor 2 weighs in favor of discretionary denial.

3. *Fintiv* Factor 3: Investment in the Parallel Proceeding

If, at the time of the institution decision, the district court has issued substantive orders related to the challenged patent, such as a claim construction order, this fact weighs in favor of denial. *See Fintiv*, Paper 11 at 10. In this instance, nearly all investment in the District Court case has already occurred. Not only has Markman occurred, the trial in the EDTX case has already occurred, with the Court finding the '409 Patent to be valid and infringed. Ex. 2010; *see also* Ex. 2021. Because validity of the '409 Patent has already been determined in the co-pending District Court litigation, significant resources that have been invested in the parallel proceeding. As such, factor 3 weighs in favor of discretionary denial.

4. *Fintiv* Factor 4: Overlap of Issues

There is substantial overlap of issues in the present litigation and in the co-pending District Court litigation. *Fintiv* states, “if 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*, Paper 11 at 12. “Conversely, if the petition includes materially different grounds, arguments, and/or evidence than those presented in the district court, this fact has tended to weigh against exercising discretion to deny institution under *NHK*.” *Id.* at 12–13.

Here, the District Court's judgment that claim 1 is valid (Ex. 2010 at 2) is dispositive of all claims challenged in this IPR, which only challenges claim 1 and its dependent claims 2-5. Pet. at 21. And, as discussed above in *General Plastics* factor 2, in the EDTX case, real party-in-interest ASUS served invalidity contentions which listed some of the art asserted here and related art. *Supra* II.B.2.

Indeed, the validity of the '409 Patent has already been adjudicated and found to be valid in the co-pending District Court litigation. Ex. 2010. Thus, there is substantial overlap of issues in the present proceeding and the District Court litigation, which therefore weighs heavily in favor of discretionary denial.

5. *Fintiv* Factor 5: Whether Petitioner and the Defendant in the Parallel Proceeding are the Same Parties

“If a petitioner is unrelated to a defendant in an earlier court proceeding,” this may weigh against exercising discretion to deny institution.” *Fintiv*, Paper 11 at 13–14. As explained in detail above, ASUS is an undisclosed privy and real party-in-interest. *Supra* III.A. Petitioner supplies to ASUS certain MOSFETs which were accused of infringement in the EDTX case, where Patent Owner was the plaintiff. *Id.* Further, as explained above, Petitioner participated in the EDTX case, ASUS is one of Petitioner's largest owners, and ASUS's officers and directors also serve as officers and directors of Petitioner. *Id.* As such, given the

close relationship between ASUS and Petitioner, this factor should still weigh against exercising discretion to deny institution.

6. *Fintiv* Factor 6: Other Considerations, Including the Merits

As explained above and herein, other circumstances disfavor institution, including the prior adjudication of the '409 Patent's validity by the District Court and Board. *See Fintiv*, Paper 20 at 14. Moreover, this Petition plainly lacks compelling merits. Indeed, the motivation to combine arguments for each of the obviousness grounds are improperly conclusory, evidencing hindsight bias. *See Pet.* at 27-28 (arguing, without explanation, that a teaching of "deep body dopant region" would motivate a POSITA to incorporate a "Deep Body Trench Contact"). And, as discussed above, there are no compelling merits because this Petition is subject to non-discretionary denial due to the 1-year bar of 35 U.S.C. § 315(b) due to the filing of the amended complaint asserting the '409 Patent against real party-in-interest ASUS. *See Ex. 2001; supra III.A.*

D. DISCRETIONARY DENIAL IS APPROPRIATE BECAUSE THE VALIDITY OF THE '409 PATENT HAS BEEN PREVIOUSLY ADJUDICATED

The Acting Director's Interim Process Memorandum identifies another factor indicating that discretionary denial is not appropriate in the present proceeding because both "the PTAB [and] another forum has already adjudicated the validity or patentability of the challenged patent claims." March 26, 2025

Interim Process Memorandum at 2. In the present proceeding, the '409 Patent has already been subject to a challenge to validity in the District Court—which found claim 1 valid (Ex. 2010)—as well as in a prior inter partes review, which already found at least claims 2 and 6 of the '409 Patent to have not been shown to be unpatentable. Ex. 2017 at 50. The Director may also confirm the validity of the other claims of the '409 Patent, depending on the outcome of the Patent Owner's Director Review Petition of IPR2024-00094. *See* Ex. 2018. In any event, these prior challenges to the validity of the '409 Patent favor discretionary denial.

This factor echoes concerns expressed in the Acting Director's Review decision in a recent case involving two petitions against the same patent. *See CrowdStrike, Inc. v. GoSecure, Inc.*, IPR2025-00068, Paper 25 (PTAB June 25, 2025). There, the Acting Director stated that “the Board abused its discretion by instituting two proceedings against the same claims of the same patent.” *Id.* at 2. Similarly, the Board should not waste resources involving a challenge to the same patent found to be patentable and valid in a prior IPR decision and in a prior District Court litigation. *See also Verizon Connect Inc. v. Omega Patents, LLC*, IPR2023-01162, Paper 37 at 3-4 (May 2, 2025) (noting that IPR proceedings are not appropriate where patent has already been subject to prior district court and Patent Office proceedings); *id.* at Paper 40 at 2.

E. THE PETITION SHOULD BE DISCRETIONARILY DENIED FOR EXCESSIVE, AND REDUNDANT GROUNDS

The Petition contains four separate obviousness grounds—each of which challenge at least claim 1 of the '409 Patent over Bulucea and one other reference—a different secondary reference for each ground. Pet. at 21. In addition, Petitioner presents two distinct theories for Bulucea: “lithographical development” or “sacrificial oxidation.” Pet. at 45, 58, 67, 78.

The Petition contains no explanation for why so many different grounds or secondary references are needed. Under these circumstances, discretionary denial is appropriate. *See Adaptics Ltd. v. Perfect Co.*, IPR2018-01596 Paper 20 at 17-18 (March 6, 2019).

F. SETTLED EXPECTATIONS FAVOR DISCRETIONARY DENIAL

The Acting Director, in prior decisions, has recognized that settled expectations alone are sufficient to deny institution. The Interim Process Memorandum identifies that the “[s]ettled expectations of the parties, such as the length of time the claims have been in force” as a consideration relevant to the discretionary denial determination. Interim Process Memorandum, 2.

In the present case, the '409 Patent issued on October 12, 2010, nearly *fifteen years* ago. The Acting Director has found that settled expectations counsel for discretionary denial for patents that have issued far more recently than the '409

Patent. For example, in *iRhythm Tech., Inc. v. Welch Allyn, Inc.*, IPR2025-00363, Paper 10 (PTAB June 6, 2025), the Director granted discretionary denial of a petition directed towards a patent that had been “in force since as early as 2012,” or approximately thirteen years. Similarly, in *Apotex Inc., v. Alkermes Pharma Ireland Limited*, IPR2025-00514, Paper 10 (PTAB July 2, 2025), the Acting Director denied institution of a petition challenging a patent that had been in force for more than 14 years and specifically identified that this length of time created “strong settled expectations.” Because the '409 Patent issued more than fourteen years ago, the settled expectations in the present case indeed exceeds the settled expectations in all of those prior decisions.

Moreover, uPI's prior knowledge of the '409 Patent without challenging it further bolsters the settled expectations. Indeed, Force MOS has been awarded over 150 U.S. Patents, and the company is so proud of its patented innovations that it displays its patents on the walls of its conference room. Ex. 2011 at 180-182. Second, beyond being competitors in the same industry of trench MOSFETs, Petitioner would have specifically been aware of the '409 Patent in December 2023 when Force MOS identified Petitioner's MOSFET products in a list of accused ASUS products in discovery served in the co-pending district court litigation. Ex. 2005 at 2; *see also* Exs. 2007-2008 (uPI receiving updates regarding

EDTX case). As such, the settled expectations of the parties confirm that the '409 Patent is valid and enforceable.

IV. CONCLUSION

For the foregoing reasons, Patent Owner respectfully submits that the Director and the Board should exercise their discretion under 35 U.S.C. § 314(a) and deny institution of the Petition.

Dated: July 28, 2025

Respectfully submitted,

By: / Michael D. Saunders /
Michael D. Saunders (Reg. No. 77,739)
PRINCE LOBEL TYE LLP
500 W. 2nd St., Suite 1900
Austin, TX 78701
(512) 737-2419
msaunders@princelobel.com
Counsel for Patent Owner

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), I certify that on this 28th day of July, 2025, a true and correct copy of the foregoing **PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL** was served by electronic mail on Petitioner's counsel at the following email addresses:

Edward C, Kwok, Reg. No. 33,938
VLP Law Group LLP
19900 Price Ave
Cupertino, CA 95014
Tel: 408-620-5501
Fax: 650-374-1890
Email: IPR02985-004@vlplawgroup.com

Steven P. Chen, Reg. No. 64373
BROADVIEW IP LAW, PC
3200 El Camino Real, Suite 260, Irvine, CA 92602
Email: schen@broadviewlaw.com
Phone: 949-232-0721

/ Michael D. Saunders /

Michael D. Saunders (Reg. No. 77,739)
Counsel for Patent Owner

CERTIFICATE OF COMPLIANCE WITH TYPE-VOLUME LIMITATION

This Request complies with the type-volume limitation in 37 C.F.R. § 42.24, and the Director's March 2025 Memorandum on Interim Processes for PTAB Workload Management. The Request contains 5,575 words, excluding the parts of the Request exempted from the type-volume limitation, as measured by the word processing software used to prepare the document.

This Response complies with the general format requirements of 37 C.F.R. § 42.6(a) and has been prepared using Microsoft Word in 14-point Times New Roman.

Dated: July 28, 2025

/ Michael D. Saunders /

Michael D. Saunders (Reg. No. 77,739)
Counsel for Patent Owner