

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 7,812,409

**PETITIONER'S OPPOSITION TO PATENT OWNER'S REQUEST
FOR DISCRETIONARY DENIAL**

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- Ex. 1010 Declaration of Catherine Tseng
- Ex. 1011 May 9, 2024 email message from ASUS informing uPI of Force MOS identification of QM3016AM as a trenched MOSFET that infringes the ‘409 Patent
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- Ex. 1013 uPI’s Letter of Indemnification to ASUSTek Computer Inc.
- Ex. 1014 Minute Order from the Markman Hearing held on April 15, 2024 in the EDTX litigation
- Ex. 1015 Docket Control Order in the EDTX litigation
- Ex. 1016 The *Sotera* stipulation in the Inergy IPR by Inergy on April 24, 2024

OPPOSITION BRIEF

Pursuant to the Acting Director’s Memorandum, *Interim Processes for PTAB Workload Management* (Mar. 26, 2025) (the “Interim Process Memorandum”), and in opposition to the Request for Discretionary Denial (“RDD”) filed on July 28, 2025 as paper 9 in this *Inter Partes* Review (IPR) of U.S. Patent 7,812,408 (“the ‘409 Patent”) by Force MOS Technology Co. Ltd. (“Force MOS” or “Patent Owner”), uPI Semiconductor Corporation (“uPI” or “Petitioner”) submits this opposition brief in this IPR.

I. INTRODUCTION

In its RDD, Patent Owner accuses uPI for filing this *Inter Partes Review* (“IPR”) on behalf of ASUSTek Computer Inc. (“ASUS”), against whom Patent Owner has obtained a judgment in a patent infringement action¹ (the “EDTX litigation”) in the U.S. District Court, Eastern District of Texas (EDTX). RDD, at 1. Patent Owner’s RDD requests that the Board exercise discretion under 35 U.S.C. 315(b) to deny institution of this IPR, based on Patent Owner’s allegations that (i) ASUS is an undisclosed real party-in-interest or a privy of Petitioner in this

¹ Force Mos Technology Co., Ltd. v. ASUSTeK Computer, Inc. (2:22-cv-00460)
I. U.S. District Court, E.D. Texas

IPR, and (ii) this IPR was filed more than one year after the filing of the EDTX litigation. RDD, at 2.

As will be apparent below from the evidence, including the Declaration of Catherine Tseng (Ex. 1010), uPI's Legal Manager of Legal & IP Department, Patent Owner's RDD is a house of cards built on merely an impermissible shallow analysis that is confined to unwarranted allegations of general benefit of this IPR to ASUS, and ASUS's relationship with the Petitioner as a minority shareholder of Petitioner.

Under closer examination, Patent Owner's RDD simply falls apart. The evidence hereinbelow shows that:

- (i) uPI's and ASUS's respective interests in this IPR are simply not aligned;
- (ii) any benefit that ASUS derives from this IPR is at best *de minimis*;
- (iii) ASUS and uPI operate independently of each other;
- (iv) ASUS purchases uPI parts from uPI's distributors in the same manner as any other uPI customer;
- (v) uPI's indemnification obligations to ASUS are exactly the same as uPI's indemnification obligations to any other of uPI's 300 or so end-user customers; and
- (vi) ASUS played no part whatsoever in funding, controlling and directing this IPR.

Thus, ASUS is unequivocally neither a real party-in-interest, nor a privy of uPI, in this IPR.

Based on its superficial and faulty analysis, Patent Owner also argues for discretionary denial based on (i) *General Plastic Factors*, as applied to IPR2024-00094 (“the Inergy IPR”); (ii) *Fintiv factors*, as they applied to the EDTX litigation; (iii) the judgment in the EDTX litigation; (iv) redundancy; and (v) settled expectation of the parties. RDD, at 2-3. As Patent Owner’s house of cards falls, Patent Owner’s RDD fails and should be denied, and this IPR should be instituted.

II. FACTUAL BACKGROUND

The ‘409 Patent relates to a trenched semiconductor power device (“trenched MOSFET”). Ex. 1001, at cols. 5-6.

On March 7, 2023, Patent Owner filed an amended complaint (“Complaint”) in the EDTX litigation, alleging infringement of three U.S. Patents, including the ‘409 Patent. Ex. 2001. In the Complaint, Patent Owner accused infringement of the ‘409 Patent by trenched MOSFETs PJX138 and 2N7002K, which are both supplied by Panjit International Inc. (“Panjit”). EX. 2001, at 23-26.

On October 27, 2023, Inergy Technology, Inc., another supplier of trenched MOSFETs, filed IPR2024-00094² (the “Inergy IPR”), challenging all claims of the ‘409 Patent. The Inergy IPR names ASUS as a real party-in-interest. Ex. 2015 at 1. Prior to May 9, 2024, uPI was aware of neither the EDTX litigation nor the Inergy IPR. Ex. 1010, ¶¶ 27, 35. A *Sotera* stipulation was filed in the U.S. Patent and Trademark Office by Inergy on April 17, 2024, waiving invalidity contentions against the ‘409 Patent in the EDTX litigation that overlap with those in the Inergy IPR. Ex. 1016. (See, *Inergy Technology, Inc. v. Force Mos Technology Co., Ltd.* IPR2024-0094, (U.S. Patent 7,812,409), Ex. 1019, filed on April 17, 2024.). uPI did not participate at any time in the funding, controlling, or directing of the preparation, filing or subsequent prosecution of the Inergy IPR. Ex. 1010, ¶ 36.

On May 8, 2024, Patent Owner’s First Amended Infringement Claim Chart for U.S. Patent No. 7,812,409 (Ex. 1012; “Infringement Contentions”) was believed served on ASUS, more than one year following Patent Owner’s filing of the EDTX litigation. Ex. 1010, ¶ 27. On May 9, 2024, ASUS informed uPI that the Infringement Contentions identified uPI’s QM3016AM trenched MOSFET as infringing the ‘409 Patent. Ex. 1011. It is only then that uPI learned for the first time of the EDTX litigation. Ex. 1010, at ¶¶ 27-28.

² *Inergy Technology, Inc. v. Force Mos Technology Co., Ltd.* IPR2024-0094, (U.S. Patent 7,812,409), filed on October 27, 2023.

On February 7, 2025, a jury trial began in the EDTX litigation, which resulted in a jury verdict against ASUS, finding in part that uPI's trenched MOSFET QM3016AM infringes the '409 Patent. Ex. 2023. During its infringement case in the jury trial, Patent Owner presented expert testimony against seven trenched MOSFETs, five of which – including uPI's QM3016AM – Patent Owner alleged to have infringed the '409 Patent. Ex. 2022, at 345:20-346:4, 363:8-11. A jury verdict was entered on February 13, 2025, in which the jury found infringement of the '409 Patent by uPI's QM3016AM trenched MOSFET. Ex. 2023. Following the jury verdict, an amended judgment was entered on June 13, 2025. Ex. 2010.

Throughout the EDTX litigation, Patent Owner named as defendant neither uPI nor any of ASUS's numerous other suppliers of trenched MOSFETs that Patent Owner accused of infringing the '409 Patent Ex. 1010, ¶ 41.

On April 24, 2025, this IPR was filed by uPI, within one year of May 8, 2024, the day on which Patent Owner served ASUS its Infringement Contentions. Ex. 1010, ¶ 45.

Several weeks later, on May 16, 2025, the Board issued a Final Written Decision in the Inergy IPR, finding Claims 1, and 3-5 of the '409 Patent unpatentable. Ex. 2017. On June 16, 2025, Patent Owner filed a Request for

Director Review of the Final Written Decision in the Inergy IPR, which remains pending. Ex. 2018.

III. ARGUMENT

(A) ASUS IS NEITHER A REAL PARTY-IN-INTEREST NOR A PRIVY OF UPI IN THIS IPR

(1) General Legal Principles regarding “real party-in-interest”

As explained in the *Consolidated Trial Practice Guide, November 2019* (“Practice Guide”), 77 Federal Register, No. 157, the Board determines under 35 U.S.C. § 315(b) a non-party to be a real party-in-interest, or to be a privity of the petitioner, on a case-by-case basis, taking into consideration how courts have viewed the terms “real party-in-interest” and “privity.” Practice Guide, at 13. The Practice Guide recognizes that courts invoke the terms “real party-in-interest” and “privity” to describe relationships and considerations sufficient to justify applying conventional principles of estoppel and preclusion. *Id.* In the context of IPR, the Practice Guide states:

[T]he spirit of that formulation ... means that, at a general level, the “real party-in-interest” is the party that desires review of the patent. Thus, the “real party-in-interest” may be the petitioner itself, and/or it may be the party or parties at whose behest the petition has been filed.

Practice Guide, at 14. The Practice Guide suggests that “a party that funds and directs and controls an IPR or PGR petition or proceeding constitutes a ‘real party-

in-interest,’ even if that party is not a ‘privy’ of the petitioner. Practice Guide at 17. The Practice Guide cautions, however, that whether something less than complete funding and control suffices to justify similarly treating the party requires consideration of the pertinent facts. *Id.*

In the case *Applications In Internet Time, LLC, v. RPX Corporation* (“*AIT*”), 897 F. 3d 1336 (Fed. Cir. 2018), after reviewing the statutory language, common law, and the legislative history, the U.S. Court of Appeal, Federal Circuit (CAFC) speaks approvingly of the Practice Guide for focusing the inquiry of whether a non-party is a “real party-in-interest” on two questions: (i) whether the non-party desires review of the patent, and (ii) whether the petition was filed at the non-party’s behests :

Determining whether a non-party is a "real party in interest" 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. Indeed, the Trial Practice Guide, on which the Board relied, suggests that the agency understands the “fact-dependent” nature of this inquiry, explaining that the *two questions lying at its heart are whether a non-party "desires review of the patent" and whether a petition has been filed at a nonparty's "behest."* Trial Practice Guide, 77 Fed. Reg. at 48,759. (Emphasis added). *AIT*, at 1351.

The CAFC faulted the Board for, while paying lip-service to these two questions in the Practice Guide, failing to apply them in its §315(b) analysis. *Id.* In *AIT*, the CAFC found the IPR petitioner, RPX, to be a for-profit company that “can and does file IPRs to serve its clients' financial interests, and that a key reason clients pay RPX is to benefit from this practice in the event they are sued []. *AIT*, at 1351-52. Thus, the CAFC faulted the Board for “being impermissibly shallow,” for failing to consider whether evidence on record showing RPX’s practices would benefit any given RPX client from having RPX file an IPR petition challenging patents that have been asserted against that client in district court. *Id.* In so doing, the CAFC emphasizes that, in determining the identity of a “real party-in-interest,” the Board must consider and must assess the entirety of the *evidentiary* record.

Indeed, the Practice Guide also warns that “because rarely will one fact, standing alone, be determinative of the inquiry, the Office cannot prejudge the impact of a particular fact on whether a party is a “real party-in-interest” or “privy” of the petitioner.” Practice Guide, at 18.

Thus, in *Unified Patents Inc. v. Realtime Adaptive Streaming LLC*, (“*Unified Patents*”) IPR2018-00883, (Patent 8,934,535 B2), paper 29, the Board emphasizes that the inquiry is not merely finding that a party benefits from the petitioner’s IPR filing and that it also has a relation with the petitioner. Additionally, the Board must carefully consider the full range of relationships between the parties:

The RPI analysis set out in *AIT* and the common law require more than simply confining the analysis to determining whether a party benefits generally from the filing of this Petition and also has a relationship with the Petitioner. While the court in *AIT* looked to the fact that RPX was a “for-profit company whose clients pay for its portfolio of 'patent risk solutions',” it did not end its analysis there. *AIT*, 897 F. 3d at 1351. Instead, it proceeded deeper to ascertain the nature of the relationship between Salesforce, RPX and the specific IPRs filed, and the nature of the benefit to Salesforce from RPX's IPRs. Finding extensive and specific ties between the two parties as they relate to the IPRs, the Federal Circuit was ultimately compelled to vacate the Board's decision and remand for further proceeding to consider “the full range of relationships under § 315(b) and the common law that could make Salesforce a real party in interest.” *AIT*, 897 F.3d at 1358.

Unified Patents, IPR2018-00883, at 14-15.

In *AIT*, on remand, the Board began its analysis by recognizing that the CAFC opinion requires the Board find more than just the petitioner has “a pre-existing relationship,” and that the non-party has an interest in and will benefit from an invalidation of the claims of the challenged patents. *RPX Corporation v. Applications In Internet Time, LLC*, IPR2015-01750 (Patent 8,484,111 B2), Paper 128; IPR2015-01751 (Patent 7,356,482 B2), Paper 128; and IPR2015-01752 (Patent 7,356,482 B2), Paper 126, October 2, 2020 (“*AIT IPRs*”), at 30-31. Ultimately, the Board found the non-party a “real party-in-interest” based on “the relationship between [non-party] Salesforce as a member of [petitioner] RPX and

the business model of [petitioner] RPX.” *Id.* at 35. In the *AIT IPRs*, the Board found that the petitioner RPX’s business model includes filing IPRs for its clients. *AIT IPRs*, at 15. The Board noted that petitioner RPX itself had no risk of liability for infringement of the patents at issue. *AIT IPRs*, at 15. The Board agreed with the CAFC’s finding that the evidence could “imply that RPX can and does file IPRs to serve its clients’ financial interests.” *AIT IPRs*, at 26. Ultimately, the Board found the non-party Salesforce a “real party-in-interest” based on “the relationship between Salesforce as a member of RPX and the business model of RPX.” *Id.* at 35. Thus, the determination of “real party-in-interest” must take into the totality of the relationships between the parties, including the business relationship, *as it relates to the IPR in question.*

(2) *General Legal Principles regarding “Privity”*

The Practice Guide notes that the notion of “privity” is more expansive, encompassing parties that do not necessarily need to be identified in the petition as a “real party-in-interest.” The Practice Guide, at 14. The Board evaluates what parties constitute “privies” in a manner consistent with the flexible and equitable considerations established under federal caselaw. *Id.* Ultimately, the Practice Guide states, federal case law analysis seeks to determine whether the relationship between the purported “privity” and the relevant other party is sufficiently close such that both should be bound by the trial outcome and related estoppels. *Id.*

The Practice Guide points out that Congress intends that “privity [to be] an equitable rule that takes into account the ‘practical situation,’ and should extend to parties to transactions and other activities relating to the property in question” (citation omitted). *Id.* One consideration, according to the Practice Guide, is “whether the non-party exercised or could have exercised control over a party’s participation in a proceeding” *Id.* The concept of control generally means, but not dispositive, that “it should be enough that the nonparty has the actual measure of control or opportunity to control that might reasonably be expected between two formal coparties.” (Citation omitted). *Id.* The Practice Guide emphasizes once again “*deeper consideration of the facts in the particular case is necessary*” (*emphasis added*). *Id.* Relevant factors include: the non-party’s relationship with the petitioner and with the petition itself, including the nature and/or degree of involvement in the filing; and the nature of the entity filing the petition. *Id.*

In *Uniloc 2017 LLC v. Facebook Inc., WhatsApp, Inc.*, (“*Uniloc 2017*”) 989 F.3d 1018 (Fed. Cir. 2021), the CAFC ruled on the issue of “privity,” holding that the inquiry must involve the dual-focus of “preventing an unwarranted second attack” and “ensuring that the petitioner is not unfairly limited in its ability to lodge its challenges”:

Privity is also a highly fact-based inquiry, similarly “focus[ing] on the relationship between the named IPR petitioner and the party in the *prior* lawsuit.” *WesternGeco LLC. V. Ion Geophysical Corp.*, 889 F3d.

1308, 1319. (Fed. Cir. 2018) (emphasis added). That is, whether a party is in privity with another depends on the nature of the relationship between the two; “it is important to determine whether the petitioner and the prior litigant's relationship—as it relates to the lawsuit—is sufficiently close that it can be fairly said that the petitioner [already] had a full and fair opportunity to litigate” the issues it now seeks to assert. *See id.* This inquiry is grounded in due process concerns for both the petitioner (here, LG) and the opposing party (here, Uniloc). *See id.* (citing *Taylor v. Sturgell* 553 U.S. 880, 128 S.Ct. 2161, 171 L.Ed2d 155 (2008)). In other words, the inquiry has a dual-focus on preventing the petitioner from now lodging a successive attack for which it already had a first bite, thus, protecting the defending party from an unwarranted second attack, while also ensuring that the petitioner is not unfairly limited in its ability to lodge its challenges if it has not had a full and fair opportunity to do so already.

Uniloc 2017, at 1028.

Thus, in the determination of whether a non-party is a privy of a petitioner, fairness and equity require the determination to take into account *both* the Patent Owner’s interest in being protected from a second attack, and the petitioner’s interest in avoiding being unfairly foreclosed from lodging its challenge in the IPR.

(3) *The Evidence shows that uPI and ASUS do not have a close pre-existing relationship as it relates to the EDTX litigation*

uPI is a public company, incorporated in Taiwan, ROC, whose stock is traded on the Taiwan Stock Exchange. Ex. 1010, ¶¶ 6-7. ASUS is a minority shareholder of about 20% of Petitioner’s common stock. Ex. 1010, ¶ 8. But uPI

and ASUS operate independently of each other. Ex. 1010, ¶ 10. Several members of Petitioner’s Board of Directors are also corporate officers of ASUS. Ex. 1010, ¶ 9. However, the ASUS-affiliated directors are not involved in uPI’s day-to-day operations. Ex. 1010, ¶ 11.

Patent Owner argues that these facts show that ASUS is a “real party-in-interest” and “privy” in this IPR. RDD, at 8-9. Quite the contrary, the facts merely show an investor-investee relationship between uPI and ASUS. For the question of whether ASUS is a “real party-in-interest,” the CAFC, the Practice Guide, and the Board all counsel that “deeper consideration” is necessary. Specifically, as the CAFC states in *Uniloc*, the pre-existing relationship must be scrutinized *as it relates to the lawsuit*. *Uniloc 2017*, at 1028.

To examine the pre-existing relationship between uPI and ASUS *as it relates to the EDTX litigation*, one should begin with how ASUS purchases, and how uPI supplies, the accused trenched MOSFET in the EDTX litigation.

uPI is a supplier of electronic circuits or components (“uPI Products”), including a type of power electronic devices that are referred to in the electronic industry as “trenched MOS field-effect transistors” (“trenched MOSFETs”). Ex. 1010, ¶ 12. uPI Products are typically components that are incorporated into circuit boards by end-users (“Customers”). Ex. 1010, ¶ 13. uPI Products are not

sold directly to Customers, but to distributors; Customers purchase uPI products from the distributors. Ex. 1010, ¶ 14.

ASUS is among more than 300 Customers who regularly purchase uPI Products -- including trenched MOSFETs -- from uPI's distributors. Ex. 1010, ¶ 15. Thus, like any other uPI Customer purchasing uPI Products through uPI's distributors, ASUS does not receive any preferential treatment over other uPI Customers. Ex. 1010, ¶ 16. In fact, Chao-Liang Hung, a director of engineering at ASUS, responsible for designing new laptop computers for ASUS, testified in the EDTX litigation that ASUS doesn't even know which ones and how many of their approved trenched MOSFET suppliers' products are used in ASUS's own products, as that decision is made by third-party vendors who supply various system level components to ASUS. Ex. 2011, at 262: 1-5, 262:12-266:3.

Under such a procurement system, uPI's relationship with ASUS is no different than uPI's relationship with every other Customer of uPI products. Ex. 1010, ¶ 16. It would be fair to say that ASUS and uPI does not have a direct supplier-customer relationship. This is clearly different from Patent Owner's prior relationship with ASUS – Mr. Raphael Chung, Patent Owner's Deputy General Manager and member of Patent Owner's board of directors, testified in the EDTX litigation that Patent Owner sold *directly* to ASUS. Ex. 2011, at 173:6-8, 186:13-

18. One may therefore even say that Patent Owner had actually a closer supplier-customer with ASUS than uPI's supplier-customer relationship with ASUS.

uPI was dragged into Patent Owner's lawsuit against ASUS through uPI's indemnification obligations to ASUS. It is therefore useful to examine how these indemnification obligations came about. uPI has agreements with its distributors to indemnify their Customers against specified injuries, including injuries arising from infringement by a uPI Product of a third-party patent. Ex. 1010, ¶ 17. As is customary practice, uPI's distributors in turn have agreements with their Customers to indemnify their Customers of substantially the same injuries covered by uPI's agreements with the distributors. Ex. 1010, ¶ 18. Thus, upon the request by a Customer who has purchased uPI Products from a distributor, uPI will issue the Customer a "Letter of Indemnification" to inform the Customer that uPI will step into the shoes of its distributors, and to set forth the terms, conditions and scope of uPI's indemnification. Ex. 1010, ¶ 19. The terms, conditions and scope set forth in uPI's Letter of Indemnification are believed to be standard and customary in the industry (i.e., believed to be not different in any material manner from those offered by uPI's competitors). Ex. 1010, ¶ 20. Following the events on May 9, 2024, to be discussed next, ASUS requested uPI's customary Letter of Indemnification and, on May 30, 2024, uPI issued ASUS the customary Letter of Indemnification. Ex. 1010, ¶ 29. uPI's Letter of Indemnification to ASUS is

attached hereto as Ex.1013. The Letter of Indemnification issued to ASUS is substantially the same as that uPI would issue to any other uPI Customer. Ex. 1010, ¶ 30.

Thus, ASUS and uPI does not have a special indemnification relationship – uPI’s indemnification relationship with ASUS is no different from uPI’s indemnification relationship with any other uPI Customer.

On May 9, 2024, Stanley Wu, a uPI sales representative, brought to Catherine Tseng’s attention of an email message (“ASUS Notification Email”) that was sent to Stanley earlier that day. Ex. 1010, ¶ 22. The ASUS notification email (Ex. 1011) was sent by Michelle Hsu, Director of Legal Affairs Center at ASUS, addressed to Stanley Wu and Ann Chang, another uPI sales representative. Ex. 1010, ¶ 23. In the ASUS Notification Email, Ms. Hsu provided ASUS’s “formal notice” to uPI that Force MOS Technology (“Force MOS”) identified two uPI trench MOSFETs (QM3016AM and QM3058M6) as infringing three Force MOS patents, including the ‘409 Patent. Ex. 1010, ¶ 24. Attached to the ASUS Notification Email is a document (Ex. 1012) entitled “Plaintiff’s First Amended Infringement Contention Claim Chart for U.S. Patent No. 7,812,409.” Ex. 1010, ¶ 25. On the same day (May 9, 2024), Stanley Wu introduced Ms. Tseng to Ms. Hsu. Ex. 1010, ¶ 26.

In subsequent email messages with Ms. Hsu on the same day, Ms. Tseng (and hence uPI) learned for the first time:

- a. the case *Force MOS Technology Co., Ltd. v. ASUSTeK Computer, Inc.*, Case No. 2:22-cv-00460-JRG (“EDTX litigation”), in the U.S. District Court, Eastern District of Texas;
- b. Ex. 1012 was served on ASUS on May 8, 2024, as part of Force MOS’s infringement contentions;
- c. Force MOS’s infringement contentions named 9 trenched MOSFETs, supplied by uPI and 6 other suppliers (collectively, “Supplier Group”); and
- d. ASUS notified members of the Supplier Group by email on May 9, 2024, believed individually and simultaneously, except two, whose products were identified in Force MOS’s Complaint filed at the beginning of the EDTX litigation.

Ex. 1010, ¶¶ 27-28.

In the EDTX litigation, the Supplier Group reimburses ASUS for all fees and costs expended in the EDTX litigation, pro-rated among members of the Supplier Group, based solely on the number of Patent Owner’s accused infringement counts on their respective products. Ex. 1010, ¶ 31. Since May 9, 2024, from time to

time, the Supplier Group receives updates regarding the EDTX litigation from ASUS's outside counsel. Ex. 1010, ¶ 32. In January, 2025, Patent Owner withdrew its infringement contentions against two members of the Supplier Group; subsequently, the reimbursement scheme is reset on the same previous basis among the remaining members of the Supplier Group. Ex. 1010, ¶ 33.

Thus, with respect to the EDTX litigation, uPI received no special treatment. uPI receives exactly the same treatment as any other members of the Supplier Group. Ex. 1010, ¶ 34.

Thus, the evidence is clear that uPI and ASUS do not have any close pre-existing relationship to speak of as it relates to the EDTX litigation. In the RDD, Patent Owner built the rest of its house of cards with attorney's arguments and speculations, which are not evidence. Unfortunately for Patent Owner, therefore, its house of cards does not stand up when a more than "impermissible shallow" analysis is applied.

In the RDD, Patent Owner seeks to distinguish the Director's decision in *In Luminex International Co. v. Signify Holding BV*, IPR2024-00101, Paper 20 (PTAB Nov. 21, 2024) ("*Luminex*"). RDD, at 12. In *Luminex*, the Board denied institution the IPR. *Luminex*, at 2. The Director reversed the Board, the Director framed the issue in *Luminex* as "whether a customer-indemnitee's request for indemnification by a manufacturer-indemnitor under a standard, non-exclusive,

manufacturer-customer indemnification agreement relating to patent infringement can be sufficient to support a finding a real party in interest and trigger the one-year time bar.” *Id.* at 11. The Director’s answer is “without more, it cannot.” *Id.*

Taking the Director’s statement out of the context, Patent Owner argues that “the relationship between Petitioner and ASUS involves *significantly* more in the present case.” RDD, at 12. In so arguing, Patent Owner treats the Director’s statement as if it is a convenient “sound bite,” completely ignoring what the Director had actually stated as to what the “more” needs to be. In other words, Patent Owner misrepresented the Director’s holding in *Luminex*.

The Director in *Luminex* held that the “more” that is needed is the answer to the Practice Guide’s second question (i.e., a showing of whether the petition was filed at the non-party’s behests). In the section entitled “Legal Standard for Real Party in Interest,” quoting *Uniloc 2017 LLC v. Facebook Inc.*, 989 F.3d 1018, 1028 (Fed. Cir. 2021) (“*Uniloc 2017*”), and relying on *AIT*, the Practice Guide, and another authority, the Director emphasizes that “the heart of the [real party in interest] inquiry [is] focused on ‘whether a petition has been filed at a []party’s behest.’” *Luminex*, at 8-9. The Director reversed the Board, stating:

Finding that the standard, non-exclusive, manufacturer-customer indemnification agreement here does not by itself give rise to a real party in interest relationship between the Petitioner and Menard, *I turn to whether*

there is sufficiently “more” evidence here to support a finding of a real party in interest relationship. I determine there is not.

I disagree with the Board’s findings that the evidence establishes that Petitioner filed the IPR at Menard’s behest. Dec. 35–39.

(emphasis added) *Luminex*, at 15-16.

Patent Owner alleges that uPI was involved early and actively in the EDTX litigation. RDD at 9-10. Patent Owner points to its own Requests for Production that was served on ASIS on December 6, 2023. *Id.* at 9. Patent Owner argues on policy ground that its Request for Production -- served prior in time to when uPI was notified of the EDTX litigation -- takes away the Director’s concern that finding ASUS to be a real party-in-interest in this IPR would encourage suits against customers “to escape the threat of potential IPR challenges by manufacturers, who become unwittingly time-barred.” RDD, at 12. Quite the contrary, the evidence shows precisely why the Director’s concern is justified: uPI was never aware of, let alone served, Patent Owner’s Request for Production of December 6, 2023. 1010, ¶ 38.

Patent Owner should not be allowed to unilaterally and self-servingly turn a discovery request into a notice of infringement contentions, knowing that the party it now proposes to bind would not be notified. Such a result is clearly inequitable and not in the interest of fairness. Discovery under Federal Rule of Civil Procedure – including Patent Owner’s Request for Production -- is not intended to

serve as communication of infringement contentions, but to allow “discovery regarding any nonprivileged matter that is relevant to any party's claim or defense and proportional to the needs of the case ... Information within this scope of discovery need not be admissible in evidence to be discoverable.” Fed. R. Civil Proc. §26(b)(1).

Patent Owner also points to email messages (Exs. 2007 and 2008) sent by ASUS’s counsel on December 4, 2024 and February 15, 2025 to a group that included Catherine Tseng, uPI’s Manager of Legal & IP Department. RDD at 13. Based on a trial transcript from the EDTX litigation, Patent Owner also alleges that uPI has provided information directly to ASUS’s expert to support ASUS defense. *Id.* Patent Owner alleges that these facts suggest a substantially closer relationship between Petitioner and ASUS than the mere customer-supplier relationship at issue in *Luminex*. *Id.*

The evidence, however, is that the email messages relied upon by the Patent Owner are merely updates provided by ASUS’s outside counsel to all members of the Supplier Group, sent after uPI first learned of the EDTX litigation. Ex. 1010, ¶ 32. It is clear from examining in Exs. 2007 and 2008 the recipient lists of these email messages and their content that uPI is merely one among numerous equals in the Supplier Group. Further, from the same sections in the trial transcripts that Patent Owner relies for its allegation of uPI providing information to ASUS expert

(i.e., Ex. 2024 at 829:23-831:2), ASUS's expert testified that it receives the same kind of information from uPI and another supplier, Excelliance, and could have received the same kind of information from Panjit and Inergy. Ex. 2024, 829:23-831:10). Therefore, rather than supporting Patent Owner's argument that these facts argue for a close relationship between ASUS and uPI, they support the exact opposite.

To summarize, uPI and ASUS have no meaningful pre-existing relationship, as it relates to the EDTX litigation.

(4) ASUS's and uPI's Respective Interests in this IPR are not aligned and ASUS did not fund, direct or control the preparation, filing and prosecution of this IPR

On February 7, 2025, a jury trial began in the EDTX litigation. Ex. 1010, ¶ 39. A jury verdict was entered on February 13, 2025 in the EDTX litigation, in which the jury found infringement of the '409 Patent by uPI's QM3016AM trenched MOSFET. Ex. 2023. Ex. 1010, ¶ 40.

Since the jury verdict, many uPI Customers have requested for Letters of Indemnification for the trenched MOSFETs involved in the EDTX litigation. Ex. 1010, ¶ 42. uPI has more than 300 Customers who regularly purchase trenched MOSFETs from uPI through its distributors. Ex. 1010, ¶ 15. Ms. Tseng is concerned that, even with uPI's Letters of Indemnification in hand, many uPI Customers, including ASUS, may prefer trenched MOSFETs from other suppliers

not involved in the EDTX litigation over uPI's trenched MOSFETs. 1010, ¶ 43.

That is, uPI would suffer independent commercial harm on account that its 300 Customers, as purchasers of uPI's trenched MOSFETs, have over their heads Patent Owner's Sword of Damocles in the form of the '409 patent. For that reason, in March 2025, Ms. Tseng engaged separate outside counsels to prepare and to file an *inter partes review* (IPR) on the '409 Patent. 1010, ¶ 44. And under Ms. Tseng's sole direction, and without funding, direction, or control whatsoever from ASUS or from any other members of the Supplier Group, uPI's separate outside counsels filed this IPR (IPR2025-00920) on April 24, 2025 on behalf of uPI alone. Ex. 1010, ¶ 45.

Due to indemnification, ASUS is believed to a large extent held harmless in the EDTX litigation. Ex. 1010, ¶¶ 31, 33. Furthermore, in the EDTX litigation Patent Owner presented in its infringement case expert testimony against seven trenched MOSFETs, including five it accuses for infringing the '409 patent, one of which being uPI's QM3016AM. Ex. 2022, at 345:20-346:4, 363:8-13. However, prior to the trial on January 23, 2025, Patent Owner withdrew its infringement contentions on two trenched MOSFETs from two members of the Supplier Group. Ex. 1010, ¶ 33. Thus, ASUS and other Customers are now free to choose these withdrawn trenched MOSFETs over uPI's trenched MOSFETs, knowing that Patent Owner will be estopped from later asserting the same patents in the EDTX

litigation against them. See, e.g., *A.C. Aukerman Co. v. R.L. Chaides Construction Co.*, 960 F.2d 1020, 1041-43 (1992) (“*Aukerman*”). Thus, because it is substantially shielded from losses by its indemnification from suppliers, and having non-infringing choices from numerous suppliers, including from those two suppliers excused just before trial, any benefit that ASUS derives from this IPR is at best *de minimis*.

In the RDD, Patent Owner asserts that this IPR was filed on behalf of ASUS is further demonstrated by (i) the petition in this IPR asserting four distinct grounds all against claim 1 of the '409 Patent, (ii) half of those grounds *only* challenge claim 1, and (iii) claim 1 of the '409 Patent was the sole asserted patent in the trial against ASUS in the EDTX case, and thus “obviously ASUS would particularly benefit from claim 1 of the '409 Patent being held invalid.” RDD, 10-11. Patent Owner further argues that “if [uPI] 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.” *Id.* Patent Owner’s arguments are simply ludicrous.

There are many reasons not to bring a patent claim into an IPR. Among these reasons, first, is that it is unnecessary. In this case, the only claim of the '409 Patent that is not in this IPR is Claim 6. Patent Owner could have asserted -- but chose not to assert -- Claim 6 against uPI’s trenched MOSFETs that exist during the EDTX litigation. Patent Owner is likely estopped from asserting Claim 6

against uPI's trenched MOSFETs that it did not accuse in the EDTX litigation. See, e.g., *Aukerman, supra*. Furthermore, another reason for not bringing Claim 6 into this IPR is the word limit on a petition under 37 C.F.R. § 42.24(a)(1). Bringing Claim 6 into this IPR may require uPI to seek the Board's waiver of the word limit. For a claim that is unnecessary to invalidate, it simply increases the cost of preparing the petition and expends legal resources for no good reason.

Thus, uPI's and ASUS's respective interests in this IPR are simply not aligned. As ASUS played no part whatsoever in the planning, preparation and filing of this IPR, the evidence has clearly shown that this IPR is not filed at the behest of ASUS.

(5) *uPI did not have a meaningful chance to prepare and present non-infringement and invalidity arguments in the EDTX litigation*

Not only did uPI not have a pre-existing, preferential relationship with ASUS, by the time uPI was informed by ASUS of the EDTX litigation, Markman Hearing was already held in the EDTX litigation on April 11, 2024, the *Sotera* stipulation (Ex. 1016) was already filed in the Inergy IPR on April 17, 2024, and close of fact discovery was set less than 2 weeks on May 20, 2024. Ex. 1014 is a copy of the Minute Order from the Markman Hearing held on April 11, 2024 in the EDTX litigation. Ex. 1015 is a copy of the Docket Control Order in the EDTX litigation, ordering a close of fact discovery on May 20, 2024. Ms. Tseng is

justified to feel that uPI -- as merely one of 7 suppliers of the Supplier Group -- did not have a meaningful chance of preparing and presenting non-infringement and invalidity defenses in the EDTX litigation. Ex. 1010, ¶ 37.

It was after May 9, 2024 that Ms. Tseng became aware of the Inergy IPR, which was filed on October 27, 2023 by Inergy Technology, Inc. Ex. 1010, ¶ 35. uPI did not participate at any time in the funding, directing or controlling of the preparation, filing of the petition, nor any subsequent proceedings in the Inergy IPR. Ex. 1010, ¶ 36.

Therefore, the evidence is clear that uPI did not have a meaningful chance of preparing and presenting non-infringement and invalidity defenses in the EDTX litigation.

(6) The factors relied by the Director in Luminex to reverse the Board's decision not to institute IPR argues even stronger for finding ASUS neither a real party-in-interest nor a privy of uPI in this IPR

In *Luminex*, the Director makes clear the evidentiary support for her decision to reverse the Board's decision that finds a non-party indemnitee a real party-in-interest or a privy of the petitioner in an IPR:

Specifically, I find that: (A) there is no evidence on this record of control, funding, or substantial coordination between Petitioner and Menard to file the Petition; (B) the fact that Menard desires to be free from infringement liability does not establish that the Petition was filed at Menard's behest; (C) Petitioner's filing of the Petition after Menard's

requests for indemnification likewise does not establish that the Petition was filed at Menard's behest; (D) Petitioner and Menard understood the Agreement to, at most, create obligations to indemnify and defend in the district court litigation (without mention of any proceedings before the Office); and (E) the overlap of asserted challenges in the IPR and the joint invalidity contentions in district court do not show that Menard desires review of the '336 patent.

Id. at 15-16.

The evidence for uPI is even stronger for instituting this IPR. Specifically, (A) this IPR was not filed at ASUS's behest, as ASUS did not control, fund or substantially coordinate with uPI to file this IPR. Ex. 1010, ¶ 45; (B) as demonstrated above, ASUS is substantially free from infringement liability due to indemnification by suppliers and is free to choose among many non-infringement options, due to Patent Owner's own actions; (C) uPI has compelling motivation for filing this IPR subsequent to the jury verdict in the EDTX litigation; (D) uPI's Letter of Indemnification does not obligate uPI to file an IPR in the U.S. Patent and Trademark Office (Ex. 1013; Ex 1010, ¶ 21); and (E) there is no overlap of asserted challenges in this IPR and the invalidity contentions in the EDTX litigation.

(7) *Conclusion*

The evidence shows that:

- (i) uPI and ASUS did not have any meaningful pre-existing relationship, as it relates to the EDTX litigation,
- (ii) the benefit of this IPR to uPI is at best *de minimis*,
- (iii) ASUS's and uPI's respective interests in this IPR is not aligned;
- (iv) ASUS did not fund, control or direct in any respect the preparation, filing and subsequent prosecution of the IPR, and hence this IPR is not filed at ASUS's behest;
- (v) uPI did not have a meaningful chance to prepare and present a meaningful defense in the EDTX litigation; and
- (vi) the Director's evidentiary consideration in *Luminex* favors not finding ASUS a non-party real party-in-interest or a privy of uPI.

Therefore, based on the legal principles set forth in sections (1) and (2) above, the evidence compels the equitable and practical result of not finding ASUS a real party-in-interest or a privy of uPI in this IPR.

(B) THIS IPR SHOULD BE INSTITUTED UPON APPLICATION OF THE *GENERAL PLASTIC FACTORS*

The factors enumerated in the Board's precedential *General Plastics* decision ("*General Plastic*"; See *General Plastic Industrial Co., Ltd. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 (PTAB Sept. 6, 2017)) favor denying

Patent Owner's RDD. uPI did not fund, control or direct the Inergy IPR and, in fact, did not become aware of the Inergy IPR until May 9, 2024, 12 days before the Board granted institution of the Inergy IPR. Ex. 1010, ¶¶ 35-36. As ASUS is not a real party-in-interest or a privy of uPI in this IPR, equitable and practical considerations, and the interest of fairness, compel a finding that this IPR is not a follow-on petition of the Inergy IPR. Application of the *General Plastic Factors* in the following demonstrates that this IPR should be instituted.

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

This IPR was filed by uPI. The Inergy IPR was filed by Inergy, Inc., without any participation by uPI. Ex. 1010, ¶ 36. As this IPR is filed without any participation whatsoever by Inergy or by any of the real parties-in-interest in the Inergy IPR (Ex. 1010, ¶ 45), this IPR is not a follow-on petition of the Inergy IPR. Therefore, *General Plastic Factor 1* favors institution of this IPR.

(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*

uPI had no participation in the filing of the Inergy IPR and, in fact, did not become aware of it until after May 9, 2024, 12 days before the Board instituted the Inergy IPR. Ex. 1010, ¶¶ 35-36. At the time of filing of the Inergy IPR, uPI did not know the prior art asserted against the claims of the '409 Patent in this IPR.

Ex. 1010, ¶ 46. Indeed, uPI had no reason to know of them, as it became aware of EDTX litigation and the Inergy IPR only after May 9, 2024. Ex. 1010, ¶¶ 27, 35. uPI has no knowledge as to whether any of the real parties-in-interest in the Inergy IPR knew of the prior art asserted in this IPR. Ex. 1010, ¶ 48. Therefore, *General Plastic Factor 2* favors institution of this IPR.

- (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*

At the time of filing of this IPR, while uPI was aware of Patent Owner's Preliminary Response and the Board's decision to institute the Inergy IPR, there is no overlap between the prior art asserted in the Inergy IPR and the prior art asserted in this IPR. At the time of institution of the Inergy IPR, the EDTX litigation was in a pre-trial stage, while the EDTX litigation had proceeded to a jury verdict by the time this IPR was filed. Thus, neither Patent Owner's Preliminary Response in the Inergy IPR nor the Board's decision on institution of the Inergy IPR has any significance on uPI's petition in this IPR. Therefore, *General Plastic Factor 3* favors institution of this IPR.

- (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*

It was after May 9, 2024 that uPI became aware of the EDTX litigation and the Inergy IPR. Ex. 1010, ¶¶ 27, 35. This IPR was filed on April 24, 2025, less than one year from May 9, 2024. uPI learned of the prior art asserted in this IPR only after it engaged its separate outside counsels for preparing the filing of this IPR in March 2025, and only shortly before the filing of this IPR. Ex. 1010, ¶ 46. There is simply no meaningful elapsed time to speak of. Therefore, *General Factor 4* favors institution of 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*

As this IPR is not a follow-on petition of the Inergy IPR, this IPR being the only IPR uPI filed against the claims of the '409 Patent, there is no time elapsed relevant to *General Plastic Factor 5*. Therefore, *General Plastic Factor 5* favors institution of this IPR.

(6) *General Plastic Factor 6: the finite resources of the Board*

As this IPR is not a follow-on petition of the Inergy IPR, and the asserted prior art in this IPR has no overlap with the asserted prior art in the Inergy IPR, there is no concern that the Board would unfairly expend in this IPR resources that the Board had already expended in the Inergy IPR. Therefore, *General Plastic Factor 6* favors institution of this IPR.

(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 IPR is not a follow-on IPR, as ASUS is neither a real party-in-interest nor a privy of uPI. Thus, this IPR is no different from any initial IPR filed by any person. Thus, uPI believes 35 U.S.C. § 316(a)(11) has no significance on this IPR. Therefore, *General Plastic Factor 7* favors institution of this IPR.

(8) Conclusion

As all *General Plastic Factors* favor institution of this IPR, Patent Owner's RDD should be denied and this IPR should be instituted.

(C) THIS IPR SHOULD BE INSTITUTED UPON APPLICATION OF THE *FINTIV FACTORS*

The Board's precedential decision in *Apple Inc. v. Fintiv, Inc.* ("*Fintiv*"), IPR2020-00019 (Patent 8,843,125 B2), Paper 11 (PTAB March 20, 2020) concerns the inter-play between the Board's institution decision in an IPR and the status of a parallel district court litigation. *Fintiv*, at 2. In *Fintiv*, the Board listed 6 factors ("*Fintiv factors*") that the Board weighs to determine "whether efficiency, fairness, and the merits support the exercise of authority to deny institution in view of an earlier trial date in the parallel proceeding." *Id.* at 6. As applied below, the evidence shows that the *Fintiv factors* all support institution of the IPR.

(1) Fintiv Factor 1: whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted

Under this fact, the Board is concerned about “inefficiency and duplication of efforts.” *Fintiv*, at 6. However, because of the *Sotera* Stipulation (Ex. 1016) in the Inergy IPR, invalidity issues raised in the Inergy IPR were not presented at trial in the EDTX litigation. Further, the invalidity issues raised in this IPR do not overlap those raised in the Inergy IPR, nor those raised at trial in the EDTX litigation. At this time, the EDTX litigation has already entered a final judgment. Ex, 2010. There is thus no concern regarding inefficiency and duplication of efforts. Therefore, *Fintiv Factor 1* favors institution of this IPR.

(2) *Fintiv Factor 2: Proximity of the court’s trial date to the Board’s projected statutory deadline for a final written decision*

For substantially the same reasons as set forth above concerning *Fintiv Factor 1*, the trial date in the EDTX litigation – which has already occurred -- is irrelevant to the projected statutory deadline for a final written decision in this IPR. Therefore, *Fintiv Factor 2* favors institution of this IPR.

(3) *Fintiv Factor 3. Investment in the parallel proceeding by the court and the parties*

Again, for substantially the same reasons set forth above with respect to *Fintiv Factor 1*, neither the court nor the parties made investment in the EDTX litigation on the issues raised in this IPR because the invalidity issues raised in this IPR, in the Inergy IPR and during trial in the EDTX litigation do not overlap. Therefore, *Fintiv Factor 3* favors institution of this IPR.

(4) *Fintiv Factor 4: Overlap between issues raised in the petition and in the parallel proceeding*

Again, as mentioned above, the invalidity issues raised in this IPR, in the Energy IPR and during trial in the EDTX litigation do not overlap. There is no concern for conflicting decisions. Therefore, *Fintiv Factor 4* favors institution of this IPR.

(5) *Fintiv Factor 5: Whether the petitioner and the defendant in the parallel proceeding are the same party*

The evidence herein shows that ASUS is neither a real party-in-interest, nor a privy of uPI, in this IPR. uPI is not a party in the EDTX litigation. Thus, *Fintiv Factor 5* favors institution of this IPR.

(6) *Fintiv Factor 6: Other circumstances that impact the Board's exercise of discretion, including the merits*

uPI believes its asserted prior art and the strength of the unpatentability challenge to be compelling, thus uPI has unequivocally demonstrated the challenged claims of the '408 Patent to be invalid. As mentioned above, uPI has compelling independent reasons that motivate filing of this IPR. For example, uPI has more than 300 Customers of the trenched MOSFETs that Patent Owner accused of infringement. Ex. 1010, ¶ 15. Furthermore, uPI did not have a meaningful chance to present its defenses in the EDTX litigation. Ex. 1010, ¶ 37. In the interest of fairness and equity, *Fintiv Factor 6* favors institution of this IPR.

(7) *Conclusion*

As all *Fintiv Factors* favor institution of this IPR, Patent Owner's RDD should be denied and this IPR should be instituted.

(D) EQUITY AND FAIRNESS REQUIRE THAT THIS IPR BE INSTITUTED, AS ASUS IS NEITHER A REAL PARTY-IN-INTEREST, NOR A PRIVY OF UPI, IN THIS IPR, AND BECAUSE UPI DID NOT HAVE A MEANINGFUL CHANCE TO PRESENT ITS DEFENSES, INCLUDING SHOWING INVALIDITY OF THE '409 PATENT

The Acting Director's Interim Process Memorandum suggests that the Board weighs in its institution decision whether the PTAB or another forum has adjudicated the validity or patentability of the claims in this IPR. *Interim Processes Memorandum*, at 2.

In filing its RDD, Patent Owner attempts to take unfair advantage in this IPR of the EDTX litigation. As a supplier of trenched MOSFETs, Patent Owner is thoroughly familiar with the businesses of trenched MOSFETs suppliers and their customers. As Mr. Raphael Chung testified in the EDTX litigation, trenched MOSFETs are incorporated into system components (e.g., battery packs), which are eventually incorporated into finished electronic devices. Ex 2011, at 191:17-23, 201:20-202:6. Mr. Chung testified that ASUS has many suppliers including some major players. Ex. 2011, at 186:25-187:5. Mr. Chung even considers uPI a

major player. *Id.* When Patent Owner sued ASUS in the U.S., Patent Owner accused trenched MOSFETs from only one ASUS supplier, reserving 6 others, such as uPI, until May 8, 2024. Ex. 2001, at 23-26; Ex. 1010, ¶ 27. May 8, 2024 was merely 12 days from close of discovery, and after significant substantive proceedings (e.g., Markman Hearing) had already occurred. *Id.*, Ex. 1014, Ex. 1015, at 3.

By its own admission, uPI was in Patent Owner's gunsight as early as December 6, 2023, when it served ASUS its Request for Production (Ex. 2005). RDD, at 9. Patent Owner could have identified uPI earlier in the EDTX litigation, but it did not do so, or chose not to do so. Throughout the EDTX litigation, Patent Owner could have named uPI as a defendant, but did not do so, or chose not to do so. Ex. 1010, ¶ 41. (In that regard, Patent Owner did not name as defendant any member of the Supplier Group, all but one Patent Owner identified as supplying accused trenched MOSFET on May 8, 2024.)

Thus, through no fault of its own, uPI (i) did not participate in any fashion in the filing of the Inergy IPR, and (ii) did not become aware of the EDTX litigation until May 9, 2024. Ex. 1010, ¶¶ 27, 37. Consequently, uPI did not have a chance to present meaningful defenses in either the EDTX litigation or the Inergy IPR.

As noted above, the CAFC in *Uniloc 2017* held that the inquiry regarding exercising discretionary denial must have the dual-focus on "preventing an

unwarranted second attack” on Patent Owner and on “ensuring that the petitioner is not unfairly limited in its ability to lodge its challenges if it has not had a full and fair opportunity to do so already.” *Uniloc 2017*, at 1028. The examinations of *General Plastic* and *Fintiv* factors provide many safeguards to ensure Patent Owner is free from an “unwarranted second attack.” In the interest of equity and fairness, the Board must now ensure that uPI “is not unfairly limited in its ability to lodge its challenges.” The Board must institute this IPR.

To support its contention that this IR should not be instituted because of adjudications in the EDTX litigation and in the Inergy IPR, Patent Owner took out of context the Acting Director’s conclusion in *CrowdStrike, Inc. v. GoSecure, Inc.*, IPR2025-00068, Paper 25 (PTAB June 25, 2025) (“*CrowdStrike*”): “the Board abused its discretion by instituting two proceedings against the same claims of the same patent.” *CrowdStrike* at 2. Patent Owner argues: “*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.” (*emphasis added*). RDD, at 23. *CrowdStrike* has no similarity with this IPR.

In *CrowdStrike*, the reason for the Director’s conclusion is that the two IPRs was filed by the *same petitioner* based on *two different claim constructions*:

Allowing Petitioner more than one petition to challenge the same claims under two different claim constructions effectively expands the permitted word count and places “a substantial and unnecessary burden on

the Board and the patent owner and could raise fairness, timing, and efficiency concerns.” *See* CTPG 59 (citing 35 U.S.C. § 316(b)).

Under these circumstances where two different claim constructions were advanced in two petitions, the Board should have construed the claim term and instituted review of, at most, one of the petitions.

CrowdStrike, at 3.

uPI did not file two IPRs based on conflicting claim constructions.

Patent Owner also cites *Verizon Connect Inc. v. Omega Patents, LLC*, IPR2023-01162, paper 37, at 3-4 (May 2, 2025), and paper 40, at 2 (June 3, 2025), (“*Verizon*”), for “noting that IPR proceedings are not appropriate where patent has already been subject to prior district court and Patent Office proceedings.” RDD, at 23. However, in neither paper 37 nor paper 40 in *Verizon* could uPI find such a note from the Acting Director. Rather, the Acting Director, in reviewing a final written decision in *Verizon*, terminated the proceeding rather than remanding the proceeding back to the PTAB for further consideration of objective evidence of non-obviousness in view of seven prior challenges to the patent claims.

The circumstances are different for uPI’s petition in this IPR, where the Acting director is determining whether to institute the IPR, *not reviewing a final written decision*.

Therefore, in the interest of equity and fairness, the Director should institute this IPR.

**(E) THE GROUNDS OF INVALIDITY PRESENTED IN THIS IPR
ARE NEITHER EXCESSIVE NOR REDUNDANT**

In the petition of this IPR (“Petition”), uPI presented four grounds on invalidity, based on four references each individually combined with the main reference, Bulucea. Petition, at 21. Patent Owner incorrectly alleges that uPI “presents two distinct theories for Bulucea: “lithographical development” or “sacrificial oxidation.” Pet. at 45, 58, 67, 78.” RDD, at 24. A fair reading of the Petition will show that they are not “distinct theories,” but specific teachings in Bulucea that motivate a person of ordinary skill in the art to combine its teachings with one or more specific teachings in each of the secondary references. Grasping for straws, Patent Owner likens the grounds in this IPR to the grounds in *Adaptics Ltd. v. Perfect Co.*, IPR2018-01596 Paper 20 at 17-18 (March 6, 2019).

(“*Adaptics*”)

In *Adaptics*, the petitioner there used the conjunction “and/or” in its combination of references, such that more than a hundred combinations of references result. The Board states:

In this case, ... the Petition suffers from a lack of particularity that results in voluminous and excessive grounds. ... Petitioner’s reliance on up to ten references connected by the conjunction “and/or” results in a multiplicity of grounds, none of which is presented with sufficient particularity. Even if we were to disregard the order of references and consider only the two-reference combinations encompassed by Petitioner’s

asserted ground, Petitioner’s contention encompasses nine combinations with Bendel and another eight distinct combinations with Sartorius, for a total of seventeen possible combinations. . . . Petitioner’s use of “and/or,” however, expands the ground to include combinations of three, four, or more references, yielding hundreds of possible combinations.

Adaptics, at 18-19.

uPI’s Petition commits no such abuse and thus is clearly distinguishable from that in *Adaptics*. Patent Owner’s allegation is completely meritless.

(F) THERE IS NO CONCERN REGARDING UPSETTING SETTLED EXPECTATION IN INSTITUTING THIS IPR

Patent Owner claims that “[t]he Acting Director, in prior decisions, has recognized that settled expectations *alone* are sufficient to deny institution.” (*emphasis added*). RDD, at 24. To support this outrageous claim, Patent owner cites *iRhythm Tech., Inc. v. Welch Allyn, Inc.*, IPR2025-00363, Paper 10 (PTAB June 6, 2025) (“*iRhythm*”) and *Apotex Inc., v. Alkermes Pharma Ireland Limited*, IPR2025-00514, Paper 10 (PTAB July 2, 2025) (“*Apotex*”). RDD, at 25. Neither case supports Patent Owner’s claim. In *iRhythm*, the Director recognizes as one factor not merely the age of the challenged patent, but that the petitioner has knowledge of the challenged patent for 12 of its 13 years of existence:

... one of the patents has been in force since as early as 2012 and Petitioner was aware of it as early as 2013 ... settled expectations favor

denial of institution. ... Petitioner's awareness of Patent Owner's applications and failure to seek early review of the patents favors denial and outweighs the above-discussed considerations.

iRhythm, at 3. Thus, the Acting Director's decision does not merely rest on the age of the challenged patent alone. Furthermore, the Acting Director cautions that no single consideration is alone dispositive:

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.*

(*emphasis added*) *Id.*

Similarly, in *Apotex*, the Acting Director's decision rests also on a co-pending *ex parte reexamination* with substantially overlapping art and identical issues:

Furthermore, *ex parte reexamination* has been ordered on the challenged patent. The reexamination includes substantially overlapping art and nearly identical issues as Petitioner seeks to raise in this *inter partes* review. [citation omitted]. It is not an appropriate use of Office resources to review a patent in two separate, concurrent Office proceedings, especially when the issues and evidence in those proceedings has substantial overlap.

Apotex, at 2. For good measure, the Acting Director gave the same caution of "holistic assessment of all of the evidence" as that given in *iRhythm*. *Id.*

Patent Owner also states:

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 trenched 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.

RDD, at 25-26.

Here, Patent Owner appears to be arguing that the decorations on the walls of its private conference room serve as some constructive notice of the '409 Patent. This argument is beyond ludicrous. In any event, the evidence shows that uPI did not become aware of the '409 Patent until May 9, 2024 and this IPR was filed within one year of that awareness. Ex. 1010, ¶¶ 27, 35, 45.

IV. CONCLUSION

To summarize, ASUS is neither a real party-in-interest, nor a privy of uPI in this IPR. Furthermore, the evidence, the *General Plastic Factors*, the *Fintiv Factors*, equity, fairness and practical considerations weigh compellingly for institution of this IPR.

Dated: August 24, 2025

Respectfully submitted,

 /Edward C. Kwok/

Lead Counsel for Petitioner

 /Steven P. Chen/

Back-up Counsel for Petitioner

IPR2025-00920

CERTIFICATION UNDER 37 C.F.R. § 42.24

Under the provisions of 37 C.F.R. § 42.24(d), the undersigned hereby certifies that the word count for the foregoing Opposition To Patent Owner's Request For Discretionary Denial totals 9,901 words, which is less than the 14,000 provided in the Interim Process Memorandum.

Dated: August 24, 2025

Respectfully submitted,

/Edward C. Kwok/

Lead Counsel for Petitioner

IPR2025-00920

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. §§ 42.6(e)(4)(i) *et seq.* and 42.105(b), the undersigned certifies that on August 25, 2025, a complete and entire copy of this Opposition To Patent Owner’s Request For Discretionary Denial, and all supporting exhibits, were provided via email to the Patent Owner by serving the Patent Owner’s Lead and Backup Counsels at their respective email addresses:

Lead Counsel: Michael D. Saunders, Esq. at msaunders@princetonobel.com

Backup Counsel: Bryan D. Atkinson, Esq. at batkinson@princetonobel.com

Dated: August 25, 2025

Respectfully submitted,

 /Edward C. Kwok/

Lead Counsel for Petitioner

IPR2025-00920