

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

ADVANCED INTEGRATED CIRCUIT
PROCESS LLC,

Plaintiff,

v.

UNITED MICROELECTRONICS
CORPORATION

Defendant.

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

JURY TRIAL DEMANDED

ADVANCED INTEGRATED CIRCUIT
PROCESS LLC,

Plaintiff,

v.

TAIWAN SEMICONDUCTOR
MANUFACTURING COMPANY LIMITED.

Defendant.

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

JURY TRIAL DEMANDED

**PLAINTIFF'S UNOPPOSED MOTION FOR LEAVE TO
AMEND INFRINGEMENT CONTENTIONS**

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Pursuant to Rule 3-6(b) of the Local Patent Rules, Plaintiff Advanced Integrated Circuit Process LLC (“AICP”) respectfully moves for leave to amend its Disclosure of Asserted Claims and Infringement Contentions Pursuant to Local Patent Rules 3-1 and 3-2 with the amendments served on TSMC on February 5, 2025. Defendant Taiwan Semiconductor Manufacturing Company Limited (“TSMC”) does not oppose AICP’s proposed amendments.

AICP seeks leave to amend for three reasons: (1) to correct a formatting error that led to the omission of a claim limitation in AICP’s Patent Rule 3-1(c) Disclosures regarding the Asserted Claims of U.S. Patent No. 8,907,425 (“’425 Patent”); (2) to provide additional detail in support of its charting of exemplary products, in response to TSMC’s complaints; and (3) to accuse the 28 nanometer High Performance Low Power (“28HPL”) process node variant of infringing U.S. Patent No. 7,579,227 (the “’227 Patent”), United States Patent No. 7,923,764 (the “’764 Patent”), United States Patent No. 8,198,686 (the “’686 Patent”), United States Patent No. 8,253,180 (the “’180 Patent”), United States Patent No. 8,587,076 (the “’076 Patent”), and United States Patent No. 8,796,779 (the “’779 Patent”).

BACKGROUND

On January 7, 2025, AICP timely served its Disclosure of Asserted Claims and Infringement Contentions Pursuant to Local Patent Rules 3-1 and 3-2 on TSMC. Two weeks later, on January 22, TSMC wrote to AICP, claiming that AICP’s infringement contentions were deficient. Among other things, TSMC stated that AICP’s charting of the ’425 Patent was missing a claim limitation. TSMC also disputed AICP’s reliance on exemplary products to accuse multiple process node variants and argued that differences across these nodes made AICP’s contentions deficient.

Following TSMC's letter, AICP took several steps to address the issues TSMC identified. AICP responded to TSMC by letter on January 28, four business days after receiving TSMC's letter, explaining that its infringement contentions properly identified the accused products with the requisite particularity and providing additional support for its contentions. AICP also informed TSMC that it would move to amend its infringement contentions to address the '425 Patent missing limitation and would consider other amendments in response to TSMC's complaints.

Within two weeks of receiving TSMC's letter and less than one month after first serving its infringement contentions, on February 5, 2025, AICP provided amended infringement contentions to TSMC. AICP asked whether TSMC would oppose AICP's seeking leave to amend, and TSMC stated the following: "TSMC agrees not to oppose this motion for leave, but reserves all rights to challenge the sufficiency of the amended contentions and/or their compliance with the Local Rules for at least the reasons outlined in the parties' correspondence to date."

ARGUMENT

Good cause exists to grant AICP's unopposed motion seeking leave to amend its Disclosure of Asserted Claims and Infringement Contentions Pursuant to Local Patent Rules 3-1 and 3-2. This Court considers four factors in evaluating good cause: "(1) the explanation for the failure to meet the deadline; (2) the importance of the thing that would be excluded if the proposed amendment is not allowed; (3) potential prejudice in allowing the thing that would be excluded; and (4) the availability of a continuance to cure such prejudice." *Packet Intelligence LLC v. NetScout Sys.*, No. 2:16-CV-230-JRG, 2017 WL 2531591, at *1 (E.D. Tex. Apr. 27, 2017) (citation omitted).

First, AICP timely served its infringement contentions and has been diligent in addressing issues in response to TSMC's complaints. TSMC's amended infringement contentions would add

an inadvertently omitted claim limitation, address TSMC's complaints, and accuse an additional process node variant—that AICP already alleged infringes the '425 Patent—of infringing the other patents-in-suit.

These additions do not change AICP's infringement theories. On the contrary, they provide additional support in light of TSMC's comments. This sort of supplementation is proper. Indeed, this Court has held that it is not necessary to supplement contentions to provide such information at all. *See KAIST IP US LLC v. Samsung Elecs. Co.*, No. 2:16-CV-01314-JRG-RSP, 2018 WL 1806765, at *3 (E.D. Tex. Apr. 17, 2018) (explaining that a plaintiff has no “*obligation* to supplement [its] contentions to include additional identifying information once known, so if [its] preliminary infringement contentions sufficiently identified the instrumentalities when served, they are sufficient now and the addition of more specific identifying information has no prejudicial effect.”) (emphasis in original); *see also Greenthread, LLC v. OmniVision Techs., Inc.*, No. 2:23-CV-00157-JRG, 2024 WL 1744069, at *3 (E.D. Tex. Apr. 23, 2024) (granting leave to amend where “[t]he amendments clarif[ied] what products [we]re accused” and “were made in direct response to the conversations between [the parties]”). AICP's identification of the 28HPL as an infringing product is made after additional research, conducted in response to TSMC's comments, resulted in the discovery of information that shows the 28HPL infringes the other patents.

Second, AICP's amendments are important. With respect to the addition of a missing claim limitation and the accusation of the 28HPL, these amendments are important because, without them, AICP would be limited in its ability to accuse products. *See CogniPower LLC v. Samsung Elecs. Co.*, No. 2:23-CV-00160-JRG, 2024 WL 128207, at *6 (E.D. Tex. Jan. 11, 2024) (granting leave to amend infringement contentions with the addition of new products because, otherwise, plaintiff “would be unable to accuse the additional products in this litigation”). AICP's other

amendments are similarly important because they “provide[] additional information about how the accused products work.” *Garmin Ltd. v. Tomtom, Inc.*, No. 2:06-cv-338-LED, 2007 WL 2903843, at *7 (E.D. Tex. Oct. 3, 2007); *Arigna Tech. Ltd. v. Volkswagen AG*, No. 221CV00054JRGRSP, 2022 WL 2761288, at *2 (E.D. Tex. Jan. 19, 2022) (agreeing that amendments providing greater detail of how plaintiff’s infringement theory applies are important).

Third, there is no prejudice to TSMC, which does not oppose amendment. This case is in its early stages, and discovery has not even begun, let alone completed. TSMC has yet to file invalidity contentions, and a *Markman* hearing is not scheduled for months. For the same reason, there is no need for a continuance.

For these reasons, AICP respectfully requests that the Court grant this unopposed motion for leave to amend its Disclosure of Asserted Claims and Infringement Contentions Pursuant to Local Patent Rules 3-1 and 3-2.

Dated: February 20, 2025

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that counsel for TSMC were served with these documents electronically on February 20, 2025.

/s/ Justin Nelson
Justin A. Nelson

CERTIFICATE OF CONFERENCE

The undersigned hereby certifies pursuant to Local Rule CV-7(h) that the parties met and conferred by email, and this motion is unopposed. Counsel for TSMC stated the following by email on February 14, 2025: “TSMC agrees not to oppose this motion for leave, but reserves all rights to challenge the sufficiency of the amended contentions and/or their compliance with the Local Rules for at least the reasons outlined in the parties’ correspondence to date.”

/s/ Justin Nelson
Justin A. Nelson