

**From:** [Director Discretionary Decision](#)  
**To:** [Kyle Friesen](#); [Long, J. Preston](#); [Director Discretionary Decision](#)  
**Cc:** [Rodkey, Kevin](#); [Russ Chorush](#); [Chris Limbacher](#); [Lily Glick](#); [Michael Heim](#); [AICP PL Lit](#); [Esper, William](#)  
**Subject:** RE: Case Nos. IPR2025-00682 & IPR2025-00683  
**Date:** Thursday, July 24, 2025 11:58:06 AM  
**Attachments:** [image001.png](#)

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There is not sufficient time to accommodate the parties' proposed briefing schedule. Patent Owner, however, is authorized to file a 5-page reply in IPR2025-00682 and IPR2025-00683, due no later than Monday, July 28, 2025, limited to addressing the arguments raised below, and Petitioner is authorized to file a 5-page sur-reply reply, due no later than Thursday July 31, 2025.

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**From:** Kyle Friesen <kfriesen@hpcllp.com>  
**Sent:** Thursday, July 24, 2025 8:35 AM  
**To:** Long, J. Preston <J.Preston.Long@finnegan.com>; [Director\\_Discretionary\\_Decision](#) <[Director\\_Discretionary\\_Decision@uspto.gov](#)>  
**Cc:** Rodkey, Kevin <Kevin.Rodkey@finnegan.com>; Russ Chorush <rchorush@hpcllp.com>; Chris Limbacher <climbacher@hpcllp.com>; Lily Glick <lglick@hpcllp.com>; Michael Heim <mheim@hpcllp.com>; AICP PL Lit <[AICPPLLit@hpcllp.com](#)>; Esper, William <William.Esper@finnegan.com>  
**Subject:** RE: Case Nos. IPR2025-00682 & IPR2025-00683

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Dear Honorable Director:

Petitioner's proposed alternative schedule is acceptable to Patent Owner.

If necessary, counsel for Patent Owner is available for a teleconference today (**Thursday, July 24**) between **4:00-5:00 pm ET**, or tomorrow (**Friday, July 25**) between **9:00 am-2:00 pm ET**.

Respectfully,  
Kyle Friesen

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**From:** Long, J. Preston <[J.Preston.Long@finnegan.com](#)>  
**Sent:** Thursday, July 24, 2025 6:40 AM  
**To:** [Director\\_Discretionary\\_Decision@uspto.gov](#)  
**Cc:** Rodkey, Kevin <[Kevin.Rodkey@finnegan.com](#)>; Russ Chorush <[rchorush@hpcllp.com](#)>; Chris Limbacher <[climbacher@hpcllp.com](#)>; Lily Glick <[lglick@hpcllp.com](#)>; Michael Heim <[mheim@hpcllp.com](#)>; AICP PL Lit <[AICPPLLit@hpcllp.com](#)>; Kyle Friesen <[kfriesen@hpcllp.com](#)>; Esper, William <[William.Esper@finnegan.com](#)>

**Subject:** RE: Case Nos. IPR2025-00682 & IPR2025-00683

\*\*\*This message originated outside of Heim, Payne & Chorush\*\*\*

Dear Honorable Director:

Further to the below, Petitioner can agree to Patent Owner's requested scope and page limits for a reply and sur-reply in exchange for the briefing schedule being set to six (6) business days (due July 31) for Patent Owner's reply, and a further six (6) business days (due August 8) for Petitioner's sur-reply. This is due to unavailability of Petitioner's counsel during the week of July 28.

If necessary, counsel for Petitioner is available for a teleconference today (**Thursday, July 24**) between **4:00-5:00 p.m. ET**, or tomorrow (**Friday, July 25**) at any time **after 9:00 a.m. E.T.**

Respectfully,

**J. Preston Long, Ph.D.**

Partner

Finnegan, Henderson, Farabow, Garrett & Dunner, LLP  
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202.408.4347 | [jp.long@finnegan.com](mailto:jp.long@finnegan.com) | [www.finnegan.com](http://www.finnegan.com)

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**From:** Long, J. Preston

**Sent:** Wednesday, July 23, 2025 4:53 PM

**To:** [Director\\_Discretionary\\_Decision@uspto.gov](mailto:Director_Discretionary_Decision@uspto.gov)

**Cc:** Long, J. Preston <[J.Preston.Long@finnegan.com](mailto:J.Preston.Long@finnegan.com)>; Rodkey, Kevin <[Kevin.Rodkey@finnegan.com](mailto:Kevin.Rodkey@finnegan.com)>; Russ Chorush <[rchorush@hpcllp.com](mailto:rchorush@hpcllp.com)>; Chris Limbacher <[climbacher@hpcllp.com](mailto:climbacher@hpcllp.com)>; Lily Glick <[lglick@hpcllp.com](mailto:lglick@hpcllp.com)>; Michael Heim <[mheim@hpcllp.com](mailto:mheim@hpcllp.com)>; AICP PL Lit <[AICPPLLit@hpcllp.com](mailto:AICPPLLit@hpcllp.com)>; Kyle Friesen <[kfriesen@hpcllp.com](mailto:kfriesen@hpcllp.com)>; Esper, William <[William.Esper@finnegan.com](mailto:William.Esper@finnegan.com)>

**Subject:** RE: Case Nos. IPR2025-00682 & IPR2025-00683

Dear Honorable Director:

Counsel for Petitioner was not provided any of the topics identified below, or the proposed briefing schedule or page limit proposals, for the first time until 11:30 a.m. ET today.

Counsel for petitioner responded at 1:12 p.m. ET:

*As to item 1, TSMC's position is stated in footnote 1 of each opposition brief.*

*As to your remaining requests, we will need to confer with our client before we can provide a position.*

Counsel for Patent Owner replied as follows at 1:19 p.m. ET:

*Preston, do you anticipate providing a definitive response before 5ET today?*

Counsel for Petitioner then replied at 1:21 p.m. ET:

*Our client is in Taiwan, so we will be unable to respond before tomorrow.*

Patent Owner's request below followed.

As stated above, counsel for Petitioner intends to confer with Petitioner and provide its position tomorrow, as well as available times to meet and confer regarding Patent Owner's request.

Respectfully,

**J. Preston Long, Ph.D.**

Partner

Finnegan, Henderson, Farabow, Garrett & Dunner, LLP

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**FINNEGAN**

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**From:** Kyle Friesen <[kfriesen@hpcllp.com](mailto:kfriesen@hpcllp.com)>

**Sent:** Wednesday, July 23, 2025 4:23 PM

**To:** [Director\\_Discretionary\\_Decision@uspto.gov](mailto:Director_Discretionary_Decision@uspto.gov)

**Cc:** Long, J. Preston <[J.Preston.Long@finnegan.com](mailto:J.Preston.Long@finnegan.com)>; Rodkey, Kevin <[Kevin.Rodkey@finnegan.com](mailto:Kevin.Rodkey@finnegan.com)>;

Russ Chorush <[rchorush@hpcllp.com](mailto:rchorush@hpcllp.com)>; Chris Limbacher <[climbacher@hpcllp.com](mailto:climbacher@hpcllp.com)>; Lily Glick

<[lglick@hpcllp.com](mailto:lglick@hpcllp.com)>; Michael Heim <[mheim@hpcllp.com](mailto:mheim@hpcllp.com)>; AICP PL Lit <[AICPPLLit@hpcllp.com](mailto:AICPPLLit@hpcllp.com)>

**Subject:** Case Nos. IPR2025-00682 & IPR2025-00683

Dear Honorable Director:

Patent Owner respectfully requests authorization to file a 6-page Reply Brief to Petitioner's Opposition to Discretionary Denial in each of IPR2025-00682 and IPR2025-00683. The proposed Reply Briefs would be due four (4) business days from the date of this request, on Tuesday, July 29, 2025, would be limited to the following issues and their proper impact on the discretionary denial decision, and would be identical to one another, except as indicated for Issue No. 3 below:

1. The new stipulations, entered in the district court litigation by Petitioner and by UMC (petitioner in a separate set of IPRs involving the same patents);
2. Petitioner's new evidence regarding time-to-trial statistics and other predictors of trial timing;

3. Petitioner's new arguments (which are different in each of the two respective IPRs and will require non-identical Reply arguments) regarding the Examiner's alleged material error during prosecution (including Petitioner's new arguments that Patent Owner's statutory disclaimer reflect an admission in that regard);
4. Petitioner's new arguments about the importance of foreign third-party discovery, including Petitioner's omission of important facts regarding the foreign third-party discovery being sought in the district court that is relevant to the claims and Grounds at issue in these proceedings; and
5. Petitioner's new arguments that it and its customers have "settled expectations" that are threatened by the lawful enforcement in court of the challenged patents.
6. Petitioner's new arguments about national security interests, the supply chain, and the economy.

Good cause exists for additional briefing on all of the above-listed issues, at least because due process requires Patent Owner be given the opportunity to respond to any evidence or argument on which a decision may be based. Moreover, Petitioner's opposition briefing introduced 85 new exhibits, more than were included with either of the two original petitions (and almost as many as both original petitions combined).

First, the stipulations filed by Petitioner with its Oppositions are new developments since Patent Owner's Discretionary Denial Briefs. Petitioner also stated in each of its Opposition Briefs that it would not oppose a Reply Brief on the issue of these stipulations. (See IPR2025-00682, Paper 10, at 4 n.1; IPR2025-00683, Paper 10, at 4 n.1.) Second, Petitioner's presentation of new evidence on time-to-trial statistics was not foreseeable and is inapposite. Third, Petitioner's new related arguments regarding the significance of Patent Owner's statutory disclaimer are wrong both legally and factually and Petitioner's related arguments related to the purported errors made during prosecution of each of the respective patents could have and should have been included in the Petition; Patent Owner thus could not reasonably foresee their inclusion in the Oppositions and should be permitted to respond. Fourth, Petitioner's new arguments regarding foreign third-party discovery in the district court are wrong and omit important facts that should be made of-record. Fifth, Petitioner raises novel theories regarding its own alleged "settled expectations" and Patent Owner's alleged lack thereof; this argument was not reasonably foreseeable, and Patent Owner should be afforded an opportunity to address it. And sixth, Petitioner's novel theories regarding its own significance to national security interests, the supply chain, and the economy were similarly not reasonably foreseeable, and Patent Owner should be given a chance to respond to that argument.

Patent Owner requests the deadline for filing the Reply Brief be four (4) business days from

today (July 29, 2025), and further requests a 6-page limit for the brief. Petitioner would then have four (4) business days from the filing of the Reply Brief in which to file a Sur-reply (if any) with the same page limit as the Reply.

Counsel for Patent Owner contacted Petitioner's counsel yesterday morning to apprise them of Patent Owner's intent to request a Reply Brief and to follow up with a list of issues and other details by this morning. In that first correspondence, Patent Owner's counsel signaled their intent to send the request to the Board by 5 pm ET today. Counsel for Petitioner did not respond to that correspondence or otherwise indicate that it would need more time. When Patent Owner's counsel sent the follow-up correspondence this morning with additional details of the request, Petitioner's counsel indicated for the first time that it would need an additional day to consult with their client, except as to Issue No. 1. For Issue No. 1, Petitioner's counsel confirmed their non-opposition to the requested Reply, as expressed in the Opposition briefs. Patent Owner was therefore unable to ascertain whether Petitioner agrees to the foregoing request in its entirety or only in part.

Counsel for Petitioner are copied on this correspondence ([jp.long@finnegan.com](mailto:jp.long@finnegan.com) and [kevin.rodkey@finnegan.com](mailto:kevin.rodkey@finnegan.com)).

Respectfully,

**Kyle Friesen**

Heim, Payne & Chorush, L.L.P.

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