

From: [Director Discretionary Decision](#)
To: [Russ Chorush](#); [Houston, Michael R.](#); [Director Discretionary Decision](#)
Cc: [Michael Heim](#); [Chris Limbacher](#); [Lily Glick](#); [Kyle Friesen](#); [AICP PL Lit](#); [Agarwal, Pavan K.](#); [Gordon, Lori A](#); [tkonstantakopoulos@goodwinlaw.com](#); [Lagerwall, Nick](#); [Papadatos, Filippos](#); [Williams, Eliot D.](#); [Samir Bhavsar](#); [jeffrey.johnson@bakerbotts.com](#)
Subject: RE: TSMC v AICP, IPR2025-01210, -01211, -01212, -01302, -01305
Date: Thursday, October 16, 2025 4:26:58 PM

The request for an additional 5 pages is granted. Patent Owner can send a request for a reply if they determine one is necessary within 3 days of receiving the opposition.

From: Russ Chorush <rchorush@hpcllp.com>
Sent: Thursday, October 16, 2025 2:41 PM
To: Houston, Michael R. <MHouston@foley.com>; Director_Discretionary_Decision <Director_Discretionary_Decision@uspto.gov>
Cc: Michael Heim <mheim@hpcllp.com>; Chris Limbacher <climbacher@hpcllp.com>; Lily Glick <lglick@hpcllp.com>; Kyle Friesen <kfriesen@hpcllp.com>; AICP PL Lit <AICPPLLit@hpcllp.com>; Agarwal, Pavan K. <PAgarwal@foley.com>; Gordon, Lori A <lorigordon@goodwinlaw.com>; tkonstantakopoulos@goodwinlaw.com; Lagerwall, Nick <NLagerwall@foley.com>; Papadatos, Filippos <fpapadatos@goodwinlaw.com>; Williams, Eliot D. <eliot.williams@bakerbotts.com>; Samir Bhavsar <samir.bhavsar@bakerbotts.com>; jeffrey.johnson@bakerbotts.com
Subject: RE: TSMC v AICP, IPR2025-01210, -01211, -01212, -01302, -01305

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Dear Honorable Director,

Counsel for patent owner AICP in the above-referenced IPRs opposes petitioner TSMC's request for additional pages. If desired, AICP's counsel will be available at the Director's convenience for a conference call to explain the basis for AICP's opposition. In the event that the Director prefers a written response, below is a summary of AICP's position.

First, TSMC is yet again attempting to improperly shift the discretionary denial landscape **after** AICP files its discretionary denial brief. TSMC asserted examiner error in only **one** of the five above-referenced IPR petitions—namely, the petition in IPR2025-01302. The other four petitions do **not** include any assertion of examiner error, which in turn precluded AICP from addressing such theories in its opening brief. TSMC again seeks to “game the outcome of the discretionary denial process” by changing the playing field after AICP filed its discretionary denial briefing. See IPR2025-00682, Paper 14 (Reply Brief), at 2

(explaining how TSMC initially submitted a narrow, ineffective stipulation in its petition only to change course ***after*** AICP filed its discretionary denial brief).

Second, in each of TSMC's four above-referenced IPR petitions that do ***not*** assert examiner error, TSMC's petition relies wholly on art that was ***not*** the basis for any rejections during the prosecution of the relevant patent. Indeed, of the primary references relied on by those four IPR petitions, only one reference (i.e., the Kunikiyo reference) in one of the petitions (i.e., the petition in IPR2025-01212) was even of record during prosecution. Thus, with that one potential exception for those four petitions, any alleged error by the examiner in reviewing the prior art that was of record during prosecution will not be among the theories that the Board reviews if proceedings are instituted. TSMC does not need additional space to address untimely examiner error theories that will not, in any event, be considered by the Board in an IPR proceeding.

Third, TSMC's request for additional pages seems designed to present improper new merits theories. If TSMC believes it needs large or annotated figures in its discretionary denial briefing to advance its arguments, TSMC is welcome to cite the appropriate pages in the relevant petition showing those larger annotated figures. If, however, TSMC did not include those figures or annotations in its Petition, as appears to be the case, it should not now be allowed to develop new merits arguments that were not disclosed in its petitions.

Fourth, if TSMC's request is granted, it will open the floodgates to all petitioners. Every petitioner will seek additional pages to include newly annotated figures as a technique for advancing new merits arguments in its discretionary denial opposition brief, and the discretionary denial process will devolve into a dispute over the merits rather than what it is designed to do. Further, if this type of request is granted, it will often (if not always) entail reply briefing, because whatever new arguments the petitioner advances through its new figures will, by definition, not be something the patent owner could have addressed in its opening brief.

Fifth, nothing in TSMC's request precludes it from using some portion of the

extra five pages for text as opposed to figures. TSMC's request offers no assurances in this regard.

Best regards,

Russ Chorush

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From: Houston, Michael R. <MHouston@foley.com>

Sent: Thursday, October 16, 2025 11:14 AM

To: Director_Discretionary_Decision <Director_Discretionary_Decision@uspto.gov>

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Subject: RE: TSMC v AICP, IPR2025-01210, -01211, -01212, -01302, -01305

This message originated outside of Heim, Payne & Chorush

Dear Director,

Counsel for Petitioner in IPRs 2025-01210, -1211, -1212, -1302, & -1305 write to seek authorization to extend by five pages the oppositions to Patent Owner's discretionary denial requests. Petitioner believes good cause exists for this request because Petitioner wishes to include with each of its oppositions numerous annotated figures to assist the Director in better understanding the parties' arguments regarding Examiner error. Such figures will be similar to and consistent with the annotated figures in each Petition, but not identical due to their different focus. Accordingly Petitioner seeks authorization to request an extension of the page limit for its discretionary denial opposition briefs from 20 to 25 pages, the earliest of which are due September 28.

Counsel for Patent Owner, copied here, has indicated that Patent Owner opposes the request. If the Board would like to have a call, the parties will quickly confer and provide their availability. Petitioner can also file a motion on an expedited basis if the Board authorizes it and so desires.

Sincerely,

Mike Houston

Lead Counsel in IPR2025-01211 and -01212

On Behalf of Petitioner in PR2025-01210, -01211, -01212, -01302, -01305

Michael R. Houston

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