UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Taiwan Semiconductor Manufacturing Company Ltd.,

Petitioner,

v.

Advanced Integrated Circuit Process LLC,

Patent Owner.

IPR2025-01211
IPR2025-01212

U.S. Patent No. 7,439,623

STATEMENT REGARDING MULTIPLE PETITIONS

Petitioner has filed herewith two petitions against U.S. Patent No. 7,439,623 ("the '623 patent), in IPR2025-01211 and IPR2025-01212 ("the '211 Petition" and "the '212 Petition," respectively). Pursuant to the Consolidated Trial Practice Guide ("CTPG"), Petitioner submits this Paper to (1) explain why two IPR petitions have been filed against the '623 patent, (2) identify the differences between the petitions, and (3) rank the petitions. CTPG, 59-60.

The Board should institute both petitions for at least three reasons. **First**, the '623 patent contains 48 claims, and Patent Owner has not stipulated to non-assertion of any of them. **Second**, the petitions are efficient and not duplicative. Each petition challenges different claims and, aside from the sole independent claim and four dependent claims, none of the other 43 claims are challenged on more than two separate grounds (with some as a 102/103 ground), while twelve claims are challenged on only one ground. **Third**, the second petition relies on the same art as the first petition, with only three added references to address four specific dependent claims.

I. REASONS WARRANTING ADDITIONAL PETITIONS

A. The Two Petitions Address the Large Number of Claims

The Consolidated Trial Practice Guide recognizes that "there may be circumstances in which more than one petition may be necessary." CTPG, 59. Here, two IPR petitions have been filed because the '623 patent contains a total of 48

claims—more than double the number of claims covered by the PTAB's standard filing fee. Significantly fewer claims have been found to justify two petitions. *E.g.*, *Visa Inc. v. Cortex MCP, Inc.*, IPR2024-00486, Paper 8, 42-43 (P.T.A.B. Aug. 2, 2024) (allowing two petitions for 33 claims).

Moreover, where a patent owner leaves open the possibility of alleging infringement of additional claims in the future, e.g., without stipulating to non-assertion of claims beyond those originally asserted, this supports challenging all claims of the patent. *See, e.g.*, *AliveCor, Inc. v. Apple Inc.*, IPR2023-00949, Paper 8, 26-27, 30 (P.T.A.B. Jan. 9, 2024) (finding it not unreasonable for petitioner to challenge all twenty claims of the asserted patent across two petitions despite initial infringement contentions identifying only two asserted claims); *Apple Inc. v. SEVEN Networks, LLC*, IPR2020-00157, Paper 10, 25 & n.14 (P.T.A.B. June 15, 2020) (noting that although only four claims were being "currently" asserted in litigation, patent owner's reservation of rights to assert additional claims and the lack of any clear stipulation otherwise supported challenging all claims in two petitions).

Here, Patent Owner has asserted the '623 patent against Petitioner in litigation.[1] While Patent Owner's preliminary infringement contentions list seven

[1] *Advanced Integrated Circuit Process LLC v. Taiwan Semiconductor Manufacturing Company Limited*, Case No. 2:25-cv-00324 (E.D. Tex.).

asserted claims from the ’623 patent (specifically, claims 1, 2, 3, 25, 28, 39, and 40), Patent Owner makes clear that these are only “preliminary” contentions, stating, *inter alia*, that:

> This disclosure, including Exhibits A through E, is based on the present state of AICP’s knowledge, without the benefit of any discovery. Because AICP’s investigation is ongoing and no *Markman* order has been entered in this action, AICP reserves all rights to supplement, amend, and/or otherwise modify its infringement contentions.

TSMC-1018, 2, 4. Nor has Patent Owner proffered any stipulation to limit the number of claims that may be asserted. *See* CTPG, 61.

Because Patent Owner has reserved its rights to assert additional claims from the ’623 patent and has not stipulated otherwise, Petitioner has challenged all claims of the ’623 patent. And because there are 48 total claims, Petitioner has filed two IPR petitions to do so.

B. The Two Petitions Are Materially Different from Each Other

The ’211 and ’212 Petitions challenge 21 and 27 claims, respectively, with no overlap in challenged claims between the two petitions. Thus, the two trials would involve mutually exclusive dependent claims. Only claim 1 of the ’623 patent is independent, which the ’212 Petition challenges on multiple grounds that serve as the starting point for other challenges to various sets of dependent claims.

For the 47 dependent claims, twelve are challenged on only one ground, 32 are challenged on two grounds, and only three claims are challenged on three

grounds. *See* ’212 Petition, at 1 (challenging 23 claims on two grounds, and only three claims on three grounds (including some that are a 102/103 ground); ’211 Petition, at 1 (challenging twelve claims on one ground, and nine claims on two grounds (including one that is a 102/103 ground)). To address dependent claims, the ’211 Petition includes arguments for claims 1, 2, and 45, but does not formally challenge such claims.[2]

Accordingly, the two petitions assert fewer than two grounds per dependent claim on average. In addition, both petitions largely rely on the same prior art references, with the ’211 Petition relying on the same references as the ’212 Petition, along with only three additional references (Nasu, Fujii, and Fukazawa) to capture four additional dependent claims. *See* ’211 Petition, 1. Because the petitions are being filed concurrently, the cases can track the same schedule and make efficient use of depositions, briefing, and oral argument, which further supports consideration of both petitions. *See, e.g.*, *Abbott Diabetes Care Inc. f/k/a TheraSense, Inc. v.*

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[2] The Board has found such an approach acceptable when dependent claims are challenged in a separate petition. *E.g.*, *Vivint, Inc., v. SB IP Holdings LLC*, IPR2022-01352, Paper 9, 10 (P.T.A.B. March 21, 2023) (noting that a second petition on the same patent having grounds directed only to dependent claims does not constitute a second challenge to the independent claim).

DexCom, Inc., IPR2024-00891, Paper 9, 4-5 (P.T.A.B. Dec. 16, 2024) (noting that "certain efficiencies may be gained between the two proceedings since the same patent and prior art are involved," allowing two petitions to challenge 40 claims).

II. RANKING OF PETITIONS

Petitioner requests institution on both petitions as both are meritorious and non-duplicative, and address claims not otherwise rendered irrelevant by Patent Owner. Nonetheless, Petitioner ranks the petitions in the following order:

Rank	Petition	Prior Art	Claims Challenged
1	IPR2025-01212 ("the '212 Petition")	Watanabe, Kurashima, Iizuka, Kamoshima, Hasunuma, Aoyagi, Kunikiyo	1-4, 7-9, 11-18, 21-22, 25-26, 28, 32, 39-40, 42, and 45-47
2	IPR2025-01211 ("the '211 Petition")	Watanabe, Iizuka, Kurashima, Nasu, Fujii, Kamoshima, Fukazawa, Hasunuma	5-6, 10, 19-20, 23-24, 27, 29-31, 33-38, 41, 43-44, and 48

Should the Board decide to institute on only one of the two petitions, Petitioner requests that preference be given to the '212 Petition.

Respectfully submitted,

Dated: July 25, 2025 By: /*Michael R. Houston*/

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that on July 25, 2025, true and correct copies of the foregoing document was served in its entirety on the Patent Owner at the following address of record listed on the USPTO's Patent Center via overnight service:

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