

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TAIWAN SEMICONDUCTOR MANUFACTURING CO. LTD.,
Petitioner

v.

ADVANCED INTEGRATED CIRCUIT PROCESS LLC,
Patent Owner

Case IPR2025-01211
U.S. Patent 7,439,623

PATENT OWNER'S UNOPPOSED MOTION TO EXPUNGE

I. INTRODUCTION

Pursuant to the Director’s Notice of Decisions on Institution on November 20, 2025, Patent Owner, Advanced Integrated Circuit Process LLC (“AICP”), submits this Motion to Expunge to request that Patent Owner’s Unredacted Reply Brief in Support of Discretionary Denial (Paper 16), Petitioner’s Unredacted Sur-Reply in Support of Its Opposition to Patent Owner’s Discretionary Denial Request (Paper 20), and Exhibit 1064, and Exhibit 2026, which have been filed under seal in this proceeding, be removed from the record. Petitioner, Taiwan Semiconductor Manufacturing Co. Ltd. (“TSMC”), does not oppose this motion.

Institution of the Petition was denied in this case on discretionary denial grounds. Paper 23 at 2. Therefore, the timing of this motion is appropriate.

II. APPLICABLE STANDARDS

37 CFR § 42.56 provides that following “denial of a petition to institute a trial or after final judgment in a trial, a party may file a motion to expunge confidential information from the record.” “The Board has held [that] th[e] rule controlling the expungement of confidential information is subject to the same ‘good cause’ standard for granting a motion to seal under 37 C.F.R. § 42.54.” *Corning Optical Commc’ns RF, LLC v. PPC Broadband, Inc.*, IPR2013-00346, Paper 94 at 3 (Oct. 2, 2018) (internal citations omitted). Accordingly, the Board generally grants requests to expunge previously sealed confidential information that it did not rely

upon. *See, e.g., FireKing Security Prods., LLC v. Ellenby Techs., Inc.*, IPR2021-00531, Paper 24 at 4 (Feb. 17, 2022).

III. GOOD CAUSE EXISTS TO EXPUNGE THE SEALED EXHIBITS

A. The Information In Papers 16 and 20 and Exhibits 1064 and 2026 Is Highly Confidential

Exhibit 2026 consists of a Patent Purchase Agreement between AICP and its predecessor-in-interest in and to the patent at issue in this proceeding, Nuvoton Technology Corporation Japan. The terms of this Agreement are confidential to both AICP and third-party Nuvoton Technology Corporation Japan. The Agreement has been designated “Attorneys Eyes Only – Highly Confidential” under the Protective Order in related co-pending litigation (*see* EX2009). The terms of the Agreement filed as Exhibit 2026 are commercially sensitive information to both AICP and third-party Nuvoton Technology Corporation Japan.

Exhibit 1064 is Patent Owner’s Response and Objections to Petitioner’s First Request for Production of Documents. The request for production was based on a confidential document referenced in Exhibit 2026. The parties have marked Exhibit 1064 as Highly Confidential – Attorney’s Eyes Only pursuant to the Protective Order (*see* Paper 11) for the same reasons it marked Exhibit 2026 as highly confidential.

Unredacted Papers 16 and 20 discuss some of the highly confidential information contained in Exhibits 1064 and 2026. Thus, Unredacted Papers 16 and 20 are highly confidential for the same reasons as Exhibits 1064 and 2026. The

parties have filed versions of Papers 16 and 20 with extremely limited redactions pertaining to the confidential information in Exhibit 1064 and 2026.

B. Exhibits 1064 and 2026 and the Unredacted Portions of Papers 16 and 20 Played a Minimal Role In This Proceeding

More than 100 exhibits were utilized in this proceeding, and Exhibits 1064 and 2026 were among the least-cited exhibits. Exhibit 2026 was cited only once in Patent Owner's Discretionary Denial Brief (Paper 10), twice in Petitioner's Opposition to Patent Owner's Discretionary Denial Request (Paper 15), once in Patent Owner's Reply Brief in Support of Discretionary Denial (Paper 16), and once in Petitioner's Sur-Reply in Support of Its Opposition to Patent Owner's Discretionary Denial Request (Paper 20). Similarly, Exhibit 1064 was only cited once in Petitioner's Opposition to Patent Owner's Discretionary Denial Request (Paper 15) and once in Petitioner's Sur-Reply in Support of its Opposition to Patent Owner's Discretionary Denial Request (Paper 20).

Further, the redacted portions of Papers 16 and 20 are minimal. Paper 18, the public redacted version of Paper 16, includes less than four lines of redacted text. Paper 22, the public redacted version of Paper 20, includes less than four lines of redacted text.

Finally, it is unlikely that Exhibits 1064 and 2026 and the Unredacted Portions of Papers 16 and 20 played a role in the discretionary denial decision. The Notice of Decisions on Institution (Paper 23) does not elaborate on the Director's reasoning

for granting discretionary denial in this proceeding. However, since the parties' briefing on these exhibits was minimal, it is unlikely that these exhibits played a large (if any) role in the Director's reasoning for granting for discretionary denial. Instead, the fact that the patent at issue (U.S. Patent No. 7,439,623) is expired probably was a key factor in the Director's decision. *See* Paper 10 at 4.

C. Any Public Interest in Exhibits 1064 and 2026 and the Unredacted Portions of Papers 16 and 20 Is Minimal

Because of the minimal role played by the Exhibits 1064 and 2026 and the Unredacted Portions of Papers 16 and 20 in this proceeding, *see* § II.B above, and because those documents relate solely to contracts between private parties, there is minimal, if any, public interest in these documents. Expunging the Exhibits 1064 and 2026 and Papers 16 and 20 would not prejudice the ability of the public to understand the reasons discretionary denial was granted in this proceeding. Further, this would have no effect on the Petition or any of the exhibits cited in the Petition. Thus, the Public has little to no interest in Exhibits 1064 and 2026 and the Unredacted Portions of Papers 16 and 20.

IV. CONCLUSION

For the above reasons, AICP respectfully requests that the Board expunge Exhibits 1064 and 2026 and Papers 16 and 20 from the record of this proceeding.

Dated: January 2, 2026

Respectfully submitted,

By: Russell A. Chorush
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CERTIFICATE OF SERVICE

The undersigned certifies that a true copy of the foregoing PATENT OWNER'S UNOPPOSED MOTION TO EXPUNGE was served on January 2, 2026 to the following counsel of record for Petitioners addressed as follows:

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