

From: [Director Discretionary Decision](#)
To: [Houston, Michael R.](#); [Russ Chorush](#); [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: Monday, November 3, 2025 8:15:58 AM

Patent Owner is authorized to file a 5-page reply in IPR2025-01210, -01211, -01212, -01302, and -01305 due no later than Wednesday, November 5, 2025, limited to addressing the arguments raised below. Petitioner is authorized to file a 3-page sur-reply due no later than Wednesday, November 12, 2025.

From: Houston, Michael R. <MHouston@foley.com>
Sent: Sunday, November 2, 2025 9:28 PM
To: Russ Chorush <rchorush@hpcllp.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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IPR2025-01210, -01211, -01212, -01302, and -01305

Dear Honorable Director,

Patent Owner sent the below request stating Petitioner's position without including any of Petitioner's reasoning that was explained to Patent Owner. Petitioner thus writes to clarify why it requests that any authorized sur-replies be due within 5 business days of the replies, and opposes the 3 business day period requested by Patent Owner.

First, Patent Owner has already had Petitioner's oppositions in the captioned proceedings for five days, and seeks an additional three business days to file its replies; this is in addition to the period of time it takes to receive a decision on Patent Owner's request. Petitioner should be afforded a reasonably similar amount of time to prepare and file any sur-replies.

Second, Petitioner is located in Taiwan, with a 13-hour time difference to the ET time zone. Petitioner's co-counsel in these five proceedings merely seek an adequate period to confer

with our overseas client and with each other ahead of any filings being submitted.

Accordingly, to the extent Patent Owner's request for replies in the above IPRs is granted, Petitioner respectfully requests authorization to file sur-replies, with a minimum of five business days to prepare and file any such authorized sur-replies.

Counsel for Patent Owner is copied here.

Sincerely,
Mike Houston
Counsel for Petitioner

Michael R. Houston
Partner

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From: Russ Chorush <rchorush@hpcllp.com>

Sent: Friday, October 31, 2025 2:33 PM

To: 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>; Houston, Michael R. <MHouston@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

***** EXTERNAL EMAIL MESSAGE *****

Dear Honorable Director:

Patent Owner writes to request permission to file 5-page reply discretionary denial briefs in IPR2025-01210, -01211, -01212, -01302, and -01305. To date, Petitioner has been afforded five pages more briefing space than Patent Owner. *See* IPR2025-01210, EX3102 at 1 (allowing Petitioner 25 pages for its opposition brief). When the Director's Office permitted Petitioner those additional five pages, it also permitted Patent Owner to submit a request for a reply brief "within 3 days of receiving the opposition." *See* IPR2025-01210, EX3102 at 1 (and below). This request is therefore timely.

Patent Owner now respectfully requests authorization to file a reply brief in each of the above-referenced proceedings of no more than 5 pages and would not oppose 3-page sur-reply briefs by Petitioners. Patent Owner believes it would be unfair for Petitioner to receive sur-reply briefs of the same length as Patent Owner's reply briefs given that Petitioner has already received five pages more briefing space than Patent Owner.

Under Patent Owner's proposal, the proposed reply briefs would be due three (3) business days from the Director's grant of this request and would be limited to the issues listed below and their proper impact on the discretionary denial decision. Good cause exists for additional briefing on all of the above-listed issues, at least because due process requires that Patent Owner be given the opportunity to respond to any evidence or argument on which a decision may be based.

Counsel for Petitioner has indicated that Petitioner is agreeable to Patent Owner's list of topics and has agreed to provide Patent Owner a greater number of pages for reply briefs than Petitioner receives for sur-reply briefs. However, Petitioner is opposed to a 3-page limit on sur-reply briefs and a 3 business day response period. Petitioner has proposed an alternative approach in which Patent Owner receives 8 pages for its reply briefs, Petitioner receives 5 pages for its sur-reply briefs, and Petitioner's sur-reply briefs are due 5 business days after Patent Owner's reply briefs are filed. Patent Owner does not oppose Petitioner's alternative approach if it is preferable to the Director.

Counsel for Petitioner are copied on this correspondence.

Best regards,

Russ Chorush
Counsel for Patent Owner

Proposed Reply Brief Topics

1. Petitioner's arguments regarding the expiration of the patents and Petitioner's challenges to claims in the patents that are not asserted in the litigation.
2. Petitioner's examiner error and merits arguments;
3. Petitioner's settled expectations arguments;
4. Petitioner's arguments regarding miscellaneous *Fintiv* factors including:
(a) the likelihood that the trial in the parallel litigation will not proceed on schedule (b) the foreign discovery relevant to whether certain of the Petitions' references qualify as prior art, and (c) the general technology area of the patents;
5. Petitioner's national security, economic and public interests arguments.

Russell A. Chorush, Ph.D., J.D.
Heim, Payne & Chorush, L.L.P.
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From: Director_Discretionary_Decision <Director_Discretionary_Decision@uspto.gov>

Sent: Thursday, October 16, 2025 3:27 PM

To: Russ Chorush <rchorush@hpcllp.com>; 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 <AICPPLit@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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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 <AICPPLit@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>

Cc: Russ Chorush <rchorush@hpcllp.com>; 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

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

Partner

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FOLEY & LARDNER LLP

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