

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TAIWAN SEMICONDUCTOR
MANUFACTURING COMPANY LTD. and APPLE INC.
Petitioners

v.

MYW SEMITECH, LLC,
Patent Owner

U.S. Patent No. 11,538,763
Issue Date: December 27, 2022

Title: CHIP PACKAGE

Inter Partes Review No. IPR2026-00066

PATENT OWNER'S AUTHORIZED PRELIMINARY SUR-REPLY

TABLE OF CONTENTS

I. THE PETITION ADVANCES INCONSISTENT CONSTRUCTIONS1
II. THE PETITION ABUSES THE WORD COUNT2
III. THE PETITION FAILS TO COMPLY WITH 37 C.F.R §42.104(a).....3

TABLE OF AUTHORITIES

	Page(s)
Cases	
<i>Revvo Techs. Inc. v. Cerebrum Sensor Techs, Inc.</i> , IPR2025-00632, Paper 36 (PTAB Jan. 26, 2026)	1, 2
<i>Samsung Elecs. Co., Ltd. v. Wilus Inst. of Standards & Tech. Inc.</i> , IPR2025-01069, Paper 16 (PTAB Dec. 10, 2025)	2
<i>Tesla, Inc. v. Unicorn Energy GmbH</i> , IPR2022-00110, Paper 19 (PTAB Feb. 17, 2022).....	2, 3
Other Authorities	
37 C.F.R. §42.104	3, 4

I. THE PETITION ADVANCES INCONSISTENT CONSTRUCTIONS

Petitioners defend their inconsistent constructions of “semiconductor chip” by arguing that Patent Owner (“PO”) and Apple both “agree that the plain and ordinary (P&O) meaning should apply.” Prelim. Reply, 1 (citing Ex. 2015 at 4). But Petitioners hide behind the phrase “plain and ordinary meaning” without addressing the problem. The issue is that Petitioner Apple asserts in the district court litigation that “semiconductor chip” requires a specific, narrowing, meaning of “a semiconductor device comprising an IC (integrated circuit).” Ex. 2015. Apple proposed this construction (Ex. 2014); PO proposed no terms for construction and proposes no specific construction for “semiconductor chip” in response to Apple. Ex. 2015 at 4. In the IPR, however, Petitioners broadly propose that “claim construction is unnecessary.” And Petitioners provide no explanation for why a narrower construction is necessary in the litigation. *See Revvo Techs. Inc. v. Cerebrum Sensor Techs, Inc.*, IPR2025-00632, Paper 36 at 3 (PTAB Jan. 26, 2026) (“Simply put, you can’t have it both ways and certainly not without a sufficient explanation.”).

Petitioners argue that “Patent Owner does not dispute that the Petition’s prior art teaches the claimed ‘semiconductor chip’” under Apple’s construction. Prelim. Reply, 1. But simply because PO did not raise this issue in the POPR does not mean PO will not raise this issue if this IPR is instituted.

Petitioners' reliance on *Samsung Elecs. Co., Ltd. v. Wilus Inst. of Standards & Tech. Inc.*, IPR2025-01069, Paper 16 (PTAB Dec. 10, 2025) is misplaced. In *Samsung*, Petitioner originally argued in district court that claim terms were indefinite but withdrew those arguments prior to submitting its IPR brief and agreed no construction was necessary in the district court. Prelim. Reply, 2 (quoting *Samsung* at 7). Here, to the contrary, Apple is actively arguing that “semiconductor chip” requires a narrowing construction in district court while arguing no construction is necessary in this IPR. And, unlike *Samsung*, Apple continues to maintain its district court construction “may be relevant to lack of written description or enablement, and/or non-infringement.” Ex. 2015 at 4. Just as in *Revvo* and *Tesla*, the Petition should be denied because Petitioners are advancing different constructions in the two proceedings.

II. THE PETITION ABUSES THE WORD COUNT

Petitioners fail to address the issue PO raised with the word count. The issue is not that a few figures are annotated, or that there are a few abbreviations or deleted spaces, or that the Petition is a few words over the limit. Instead, the issue is that Petitioners' circumventions occur hundreds of times in the Petition, resulting in a word count that is—by a conservative count—at least a thousand words over the 14,000-word limit, resulting in an excessively long 131-page Petition. POPR, 8-11; Trial Practice Guide, § II.A.3. And the POPR did not even address many more

common shortcuts utilized hundreds of times in the Petition, like deleting spaces between “EX” and exhibit numbers, or “¶” and paragraph numbers.

Petitioners cite *Tesla, Inc. v. Unicorn Energy GmbH*, IPR2022-00110, Paper 19 at 11 (PTAB Feb. 17, 2022) in support. Prelim. Reply, 3. *Tesla* makes PO’s point. There, the PO identified approximately 500 extra words in a Petition that Petitioner certified as containing 13,561 words. *Id.*, 10-11. Accordingly, the Board held that “the excess number of words was small and was not used by Petitioner to significantly expand the argument in the Revised Petition.” *Id.*, 13. Here, the excess words conservatively exceed the limit by at least a thousand words and significantly expands the arguments.

Nor is it harmless. Collectively, Petitioners’ attempts to circumvent the word count results in a **131-page** Petition supported by a **309-page** expert declaration. Pet.; Ex. 1003 [Shanfield Decl.]. PO will have to request additional space in its POR to address Petitioners’ circumvention. It also causes compliance issues with numerous Petition requirements, including for example 37 C.F.R. § 42.24(a)(1)(i), 37 C.F.R. § 42.104(b)(4), 37 C.F.R. § 42.104(a) and incorporating expert testimony by reference. POPR, 10, 12-13. Accordingly, the Petition should be denied.

III. THE PETITION FAILS TO COMPLY WITH 37 C.F.R §42.104(a)

37 C.F.R. §42.104 discloses the “requirements [that] the petition must set forth.” The very first requirement is that “[t]he petitioner must certify that the patent

for which review is sought is available for *inter partes* review and that the petitioner is not barred or estopped from requesting an *inter partes* review challenging the patent claims on the grounds identified in the petition.” *Id.*, §42.104(a). The Petition does not comply with the requirements of §42.104(a); thus, it must be denied.

The Petition states “the ’763 Patent is eligible for IPR.” Pet., 1. Petitioners argue this “is an unambiguous certification that the ’763 Patent is available for IPR and that Petitioners are not barred or estopped from requesting this IPR.” Prelim. Reply, 4. This is not true. Even if “eligible” were incorrectly interpreted to mean “available”, whether a patent is “available” has nothing to do with whether *Petitioners* are estopped from requesting the IPR. A patent can be “available” for an IPR regardless of whether certain petitioners are barred or estopped.¹

Petitioners next argue that “[t]here is no requirement that the certification must repeat back Rule 42.104(a) verbatim.” Prelim. Reply, 4. Again, this is not true. § 42.104 expressly “require[s that] the petition must set forth” the certification in § 104(a). The language in § 104(a) is *required*, not *optional*. And even if the certification were not required to be “verbatim,” the Petition entirely lacks anything resembling the required certification. Thus, institution must be denied.

¹ A patent may not be “available for IPR,” for example, if it was granted less than 9 months before the Petition was filed, is undergoing PGR, or has expired.

Dated: March 19, 2026

Respectfully submitted,

By: / *Donald L. Jackson* / _____

Donald L. Jackson (USPTO Reg. No. 41,090)

Richard Juang (USPTO Reg. No. 71,478)*

Chandran B. Iyer (USPTO Reg. No. 48,434)

Ronald M Daignault*

Erin Hadi (USPTO Reg. No. 79,904)*

djackson@daignaultiyer.com

rjuang@daignaultiyer.com

cbiyer@daignaultiyer.com

rdaignault@daignaultiyer.com

ehadi@daignaultiyer.com

DAIGNAULT IYER LLP

8229 Boone Boulevard, Suite 450

Vienna, VA 22182

**Not admitted in Virginia*

Attorneys for MYW Semitech, LLC

CERTIFICATE OF SERVICE

The undersigned hereby certifies that the foregoing PATENT OWNER'S
AUTHORIZED PRELIMINARY SUR-REPLY was served electronically via email
on March 19, 2026, on the following counsel of record for Petitioners:

Jennifer C. Bailey
Paul R. Hart
Justin Grimes
ERISE IP, P.A.
jennifer.bailey@eriseip.com
paul.hart@eriseip.com
justin.grimes@eriseip.com
PTAB@eriseip.com

Dated: March 19, 2026

Respectfully Submitted,

By: / *Donald L. Jackson* / _____
Donald L. Jackson
USPTO Reg. No. 41,090