UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ARM LTD, MEDIATEK INC.,

PETITIONERS

V.

DAEDALUS PRIME LLC,

PATENT OWNER

PATENT NO. 8,984,228
CASE NO. IPR2025-00207

PETITIONER ARM LTD'S REQUEST FOR DIRECTOR REVIEW

***Mail Stop* "*PATENT BOARD*"**
Patent Trial and Appeal Board
U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

TABLE OF EXHIBITS

Ex-1001	U.S. Patent No. 8,984,228 to Liu et al. ("the '228 patent").
Ex-1002	Patent Center Prosecution History of U.S. Patent No. 8,984,228.
Ex-1003	Declaration of Dr. Marwan Hassoun.
Ex-1004	Curriculum Vitae of Dr. Marwan Hassoun.
Ex-1005	U.S. Patent No. 7,805,575 to Agarwal et al. ("*Agarwal*").
Ex-1006	B. Sinharoy et al., "IBM POWER7 Multicore Server Processor," IBM Journal of Research and Development, vol. 5, no. 3, pp. 1:1-1:29 (2011) ("*Sinharoy*").
Ex-1007	U.S. Patent Appl. Pub. No. 2011/0219188 to Blumrich et al. ("*Blumrich*").
Ex-1008	U.S. Patent Appl. Publ. No. 2008/0126750 to Sistla ("*Sistla*").
Ex-1009	*Multicore Processors and Systems* (S.W. Keckler et al. eds., 2009) ("*Keckler*").
Ex-1010	U.S. Patent Appl. Pub. No. 2006/0041715 to Chrysos et al. ("*Chrysos*").
Ex-1011	G. Blake et al., "A Survey of Multicore Processors," IEEE Signal Processing Magazine, vol. 26, no. 6, pp. 26-37 (Nov. 2009) ("*Blake*").
Ex-1012	V. Getov et al., "Codesign for Systems and Applications: Charting the Path to Exascale Computing," Computer, vol. 44, no. 11, pp. 19-21 (Nov. 2011).
Ex-1013	T. Zhou, "Deriving Voltage Tolerance Specification for Processor Circuit Design," 2011 IEEE 20th Conference on Electrical Performance of Electronic Packaging and Systems, pp. 17-20 (Oct. 2011).
Ex-1014	Library of Congress Record: IBM Journal of Research and Development.

Ex-1015	MARC Record: IBM Journal of Research and Development.
Ex-1016	IBM Journal of Research and Development, vol. 5, no. 3 (2011).
Ex-1017	M.R. Marty, *Cache Coherence Techniques for Multicore Processors*, Ph.D. Dissertation, University of Wisconsin – Madison (2008) ("*Marty*").
Ex-1018	Docket Control Order
Ex-1019	Infringement Contentions Cover
Ex-1020	IPR2023-01344 Paper 10 05/28/2024 Patent Owner's Response
Ex-1021	IPR2023-01344 Paper 20 10/22/2024 Patent Owner's Sur-reply
Ex-1022	Median Time To Trial
Ex-1023	Declaration of Kelley Hayes Greenfield
Ex-1024	Daedalus LPR 4-2 Terms

Petitioner Arm Ltd ("Arm Petitioner") respectfully requests the Director vacate the Decision Granting Patent Owner's Request for Discretionary Denial and Denying Institution of *Inter Partes* Review (Paper 10, May 16, 2025) ("Decision") of U.S. Patent No. 8,984,228 ("the '228 Patent") and institute review on all grounds.

Vacatur of the Decision is warranted in view of the settlement of the related litigation which was the sole basis for discretionary denial of the Petition. Late on May 15, Patent Owner Daedalus Prime LLC and MediaTek filed a joint motion to stay the litigation pending settlement. *See* Motion to Stay, *Daedalus Prime LLC v Mediatek*, Case No 2:24-cv-00235-JRG Dkt. 70 (E.D. Tex, May 15, 2025). The Decision issued on May 16, 2025. *See* Paper 10. The Eastern District of Texas court granted the parties' motion to stay on May 20 and then dismissed the litigation with prejudice on May 22. *See* Order granting motion to stay, *Daedalus Prime LLC v Mediatek*, Case No 2:24-cv-00235-JRG Dkt. 71 (E.D. Tex, May 20, 2025); Order dismissing case, *Daedalus Prime LLC v Mediatek*, Case No 2:24-cv-00235-JRG Dkt. 73 (E.D. Tex, May 22, 2025).

As noted in the Petition (at 80), the Arm Petitioner is/was not a party to the litigation and has separate interests that were not vindicated by the dismissed district court proceedings. The stated basis for the Decision denying institution was the existence of the related litigation and the possibility of trial in the District Court. There is no pending litigation and thus there is no possibility of trial.

Further, as noted in the Petition and Petitioners' Response To Patent Owner's Request for Discretionary Denial (Paper 9, April 28, 2025), the Petition demonstrates compelling merits for multiple reasons including that the Board has already held substantially identical claims in the child patent to the challenged '228 patent. As noted in the Petition.

> The '895 patent's claim 1 includes all elements of the '228 patent's claim 1 largely verbatim. (Ex-1003 ¶¶46-48.) Thus, if IPR2023-01344 invalidates claim 1 of the '895 patent based on *Sinharoy*, the Board may institute on that basis alone.

Petition, at 1, n.1. Subsequently, the Board held all challenged claims of the child '895 patent as invalid over *Sinharoy*. IPR2023-01344, Final Written Decision ("FWD"), Paper 31 (January 24, 2025). Invalidity was so overwhelming in IPR2023-01344 that the Board issued the FWD six weeks before the statutory deadline. Thus, not only is there no district court litigation on which to base a discretionary denial, but also there is overwhelming compelling merits, and the PTAB is uniquely positioned to address the patentability of the '228 Patent based on the collateral estoppel effects of the final written decision for the related '895 Patent.

The Arm Petitioners thus respectfully request that the Decision be vacated and IPR be instituted on all grounds asserted in the litigation.

Respectfully submitted,

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Dated: June 11, 2025

CERTIFICATION OF WORD COUNT

Pursuant to 37 C.F.R. § 42.24(d), the undersigned certifies that this Request for Director Review complies with the 15-page limit exclusive of the parts exempted as provided in 37 C.F.R. § 42.24(a).

Respectfully Submitted,

BY: /Kevin P. Anderson/
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Counsel for Arm Petitioner

CERTIFICATION OF SERVICE ON PATENT OWNER

Pursuant to 37 C.F.R. §§ 42.6(e), 42.8(b)(4) and 42.105, the undersigned certifies that on the 11th of June, 2025, a complete and entire copy of this Request was served in its entirety by filing this document through the PTAB P-TACTS System, as well as by email to counsel of record for the Patent Owner. Concurrently, notification is being provided to the Director of the USPTO at Director_PTABDecision_Review@uspto.gov.

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