

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ADVANCED MICRO DEVICES, INC. AND PENSANDO SYSTEMS, INC.,

Petitioners,

v.

CONCURRENT VENTURES, LLC AND XTREAMEDGE, INC.,

Patent Owners.

IPR2025-00223

U.S. Patent No. 10,985,943

**PETITIONERS' OPPOSITION BRIEF TO PATENT OWNERS' REQUEST
FOR DISCRETIONARY DENIAL OF INSTITUTION OF INTER PARTES
REVIEW**

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EXHIBIT LIST

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1001	U.S. Patent No. 10,985,943 (“’943 patent”)
1002	Prosecution History of the ’943 patent
1003	Declaration of Donald Alpert, Ph.D.
1004	U.S. Patent No. 10,776,142 (“Seshadri”)
1005	U.S. Patent App. Pub. No. 2018/0191642A1 (“Biederman”)
1006	U.S. Patent App. Pub. No. 2019/0095113A1 (“Atsatt-113”)
1007	Tarafdar et al., “Enabling Flexible Network FPGA Clusters in a Heterogeneous Cloud Data Center” (“Tarafdar”)
1008	U.S. Patent No. 8,015,386 (“Kulkarni”)
1009	U.S. Patent App. Pub. No. 2019/0041923A1 (“Atsatt-923”)
1010	Kuon et al., “FPGA Architecture: Survey and Challenges” (“Kuon”)
1011	Trimberger, “Three Ages of FPGAs: A Retrospective on the First Thirty Years of FPGA Technology” (“Trimberger”)
1012	Teubner & Woods, “Data Processing on FPGAs” (“Teubner”)
1013	Kean, “Secure Configuration of Field Programmable Gate Arrays” (“Kean”)
1014	Frey, “The IBM Data Center Family” (“Frey”)
1015	Desai et al., “BladeCenter system overview” (“Desai”)
1016	Hughes et al., “BladeCenter processor blades, I/O expansion adapters, and units” (“Hughes”)
1017	Caldeira et al., “IBM Power Systems S814 and S824 Technical Overview and Introduction” (Caldeira)
1018	Steffen, “Nallatech Software Tools on the Maxwell FPGA Parallel Computer” (“Steffen”)
1019	Nallatech, “H100 Series FPGA Application Accelerators” (“Nallatech”)
1020	Bassiri & Shahhoseini, “Configuration Reusing in On-Line Task Scheduling for Reconfigurable Computing Systems” (“Bassiri”)
1021	Exhibit D to Concurrent Ventures’ and XstreamEdge’s Oct. 11, 2024 Preliminary Invalidity Contentions
1022	Declaration of S. Delman re Tarafdar
1023	Chen et al., “Enabling FPGAs in the Cloud” (“Chen”)
1024	Asiatici et al., “Virtualized Execution Runtime for FPGA Accelerators in the Cloud” (“Asiatici”)

1025	Vipin & Fahmy, “FPGA Dynamic and Partial Reconfiguration: A Survey of Architectures, Methods, and Applications” (“Vipin”)
1026	Fahmy et al., “Virtualized FPGA Accelerators for Efficient Cloud Computing” (“Fahmy”)
1027	RocketBoards, “PCIe Root Port with MSI”
1028	Aldec, “High Performance Computing – Solutions”
1029	JEDEC Dictionary of Terms for Solid-State Technology, 7th Ed.
1030	IEEE 1532-2002 (“Standard for In-System Configuration of Programmable Devices”)
1031	U.S. Patent App. Pub. No. 2016/0049941A1 (“How”)
1032	Cisco, “High Speed Serial Interface (HSSI) Design Specification”
1033	PCI-SIG, “PCI Express Base Specification Revision 1.0”
1034	U.S. Patent App. Pub. No. Ex-1034 2011/0090640A1 (“Samson”)
1035	Case Docket for <i>Concurrent Ventures, LLC v. Advanced Micro Devices, Inc.</i> , No. 1:24-cv-00335 (W.D. Tex. filed March 29, 2024)
1036	Report and Recommendation of Magistrate Judge Lane (Dkt. 58) in <i>Concurrent Ventures, LLC v. Advanced Micro Devices, Inc.</i> , No. 1:24-cv-00335 (W.D. Tex. 2024)
1037	Judge Albright’s Standing Order Governing Proceedings (OGP)—Patent Cases, March 5, 2025
1038	Docket Navigator, Motion to Stay Pending Inter Partes Review success rate data for California Northern District (printed May 5, 2025)
1039	Opposed Motion to Stay Case Pending Resolution of Motion to Transfer (Dkt. 53) in <i>Concurrent Ventures, LLC v. Advanced Micro Devices, Inc.</i> , No. 1:24-cv-00335 (W.D. Tex. 2024)
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1044	Lex Machina, time-to-trial data for Western District Texas (printed May 19, 2025)
1045	Case Docket for <i>Future Link Systems, LLC v. Broadcom Inc.</i> , No. 3:22-cv-02041 (N.D. Cal. filed Mar. 16, 2021)
1046	Case Docket for <i>LED Wafer Sols. LLC v. Samsung Elecs. Co.</i> , No. 3-22-cv-04809 (N.D. Cal. filed Mar. 25, 2021)
1047	Case Docket for <i>Parus Holdings, Inc. v. Google LLC</i> , No. 22-cv-07830-VC (N.D. Cal. filed June 4, 2021)
1048	Sotera Stipulation (Dkt. 78) in <i>Concurrent Ventures, LLC v. Advanced Micro Devices, Inc.</i> , No. 1:24-cv-00335 (W.D. Tex. 2024)

I. INTRODUCTION

Patent Owners emphasize the district court schedule¹ but fail to disclose that Magistrate Judge Lane has already issued a Report and Recommendation to transfer the case to the Northern District of California, which Judge Albright is expected to rule on by June 25, 2025. As the Director's decision on discretionary denial is expected by June 26, it would be fundamentally unfair to discretionarily deny institution on the eve of Judge Albright's ruling. A transfer, as recommended by Magistrate Judge Lane, would result in a new case schedule and almost certainly delay trial until well after the Board's Final Written Decision.

Even if transfer does not occur before institution, discretionary denial would still be unwarranted under the *Motorola*² Director Review Decision, the *Memo*,³ as well as other recent PTAB decisions because the district court case remains in its early stages. In contrast to *Motorola*, no depositions have been taken, and expert

¹ *Concurrent Ventures, LLC v. Advanced Micro Devices, Inc.*, No. 1:24-cv-00335 (W.D. Tex. filed March 29, 2024).

² *Motorola Sols. Inc. v. Stellar, LLC*, IPR2024-01205, Paper 19 (PTAB Mar. 28, 2025).

³ The Memorandum on Interim Processes for PTAB Workload Management, dated March 26, 2025 ("the *Memo*").

reports are not planned until January 2026. Additionally, a *Sotera* stipulation has been filed in district court, mitigating any concerns of duplicative efforts between the district court and the Board.

In short, the *Fintiv*⁴ analysis and other discretionary factors favor institution regardless of transfer. Should the district court follow the existing recommendation and transfer the case, the balance against discretionary denial becomes even more overwhelming.

II. PROCEDURAL BACKGROUND

The district court action was filed on March 29, 2024. On August 9, 2024, Petitioners filed a motion to transfer to the Northern District of California (“NDCA”) as a more convenient forum. Ex-1035, 5 (Dkt. 33 in Case Docket). Patent Owners were granted a prolonged briefing schedule, which ended September 26, 2024. *Id.*, 6 (Dkt. 47; Text order granting the further briefing request).

On November 22, 2024, Petitioners moved to stay the case in view of impending claim construction deadlines and the pending resolution of the motion to transfer. Ex-1035, 7 (Dkt. 53). Judge Pitman denied, stating that “the Court

⁴ *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (precedential).

expects to resolve Defendants’ motion to transfer well in advance of the scheduled *Markman* hearing[.]” *Id.*; Ex-2001 (December 17, 2024 Court Text Order). The following month, after the holidays, Magistrate Judge Lane submitted a Report and Recommendation finding “[a]ll of the disputed factors favor transfer” and recommending that the motion to transfer be granted. Ex-1035, 7 (Dkt. 58); Ex-1036, 18 (Magistrate Judge Lane’s Recommendation). Magistrate Judge Lane explained in detail the one-sided nature of the facts—Patent Owners have no ties to WDTX; the documents and witnesses are closer to NDCA; and the only tie to WDTX is that Pensando is one of AMD’s 75 subsidiaries—and concluded that both private and public interest factors strongly favor transfer. Ex-1036, 18.

Three days later, the case was re-assigned to Judge Albright, who recently moved from Waco to Austin. Ex-1035, 7 (Dkt. 61). Judge Albright extended deadlines for claim construction briefing by a month (*id.*, 8-9 (Dkt. 73, Dkt. 75)) and reset the *Markman* hearing to June 25, 2025. Ex-2002 (Dkt. 77). Judge Albright’s Order Governing Proceedings in patent cases (“OGP”) provides that “[i]f a motion to transfer remains pending, the Court will either promptly resolve the pending motion before the *Markman* hearing, or postpone the *Markman* hearing.” Ex-1037, 6 (Judge Albright’s OGP, March 5, 2025). Therefore, Judge Albright should rule on Judge Lane’s recommendation for transfer by the *Markman* on June 25, 2025, or postpone the hearing.

III. PATENT OWNERS OMITTED THE COURT'S RECOMMENDATION FOR TRANSFER

Despite totaling over 6,000 words, Patent Owners' Brief fails to mention Magistrate Judge Lane's Recommendation to transfer the case—a glaring omission and a lack of candor. This omission is critical because the Recommendation indicates that the Court will likely transfer the case. Additionally, Patent Owners' arguments and caselaw regarding the transfer issue are predicated on motions that are pending or a magistrate has recommended denial for, situations distinguishable from here where transfer has been recommended by Magistrate Judge Lane. Even if the Court were to conduct a *de novo* review⁵ rather than directly adopt the Recommendation, the Magistrate Judge's analysis and conclusions remain persuasive. *See supra* § II. Unsurprisingly, Judge Albright frequently adopts a Magistrate Judge's recommendation regarding motion to transfer venue after review *de novo*. *See, e.g., CloudfChange, LLC v. Clover Network, Inc.*, No. 6-22-cv-00634, Dkt. 97 (W.D. Tex. June 16, 2023) (adopting Magistrate Judge's recommendation to transfer case to NDCA for more convenient venue); *Arsus, LLC v. Tesla, Inc.*, No. 6-22-cv-00276, Dkt. 59 (W.D. Tex. June 2, 2023) (same).

⁵ Patent Owners filed objections to the Recommendation within fourteen days of service, thereby securing *de novo* review by the Court. Ex-1035, 8 (Dkt. 62).

While impact of the likely transfer would be significant to Patent Owners' discretionary denial analysis, Patent Owners nevertheless craft their argument for discretionary denial upon the flawed assumption that the district court case will stay in WDTX. As further addressed below, Patent Owners' argument for at least *Fintiv* factors 1, 2, and 3 hinges on the current WDTX schedule. *See infra* §§ IV.A-C. The transfer would put the district court case in front of a new judge in a new forum with a new case schedule that would, consistent with NDCA practice, move out deadlines, including the trial date.

For example, Patent Owners argue, for *Fintiv* factor 1, that a stay in the district court case is unlikely in view of "Judge Albright's well-known aversion to granting stays." Br. 8. Patent Owners' argument fails to consider that NDCA judges are overwhelmingly willing to grant motions to stay pending IPR. As Judge Albright recognized in a similar case where four IPRs have been filed, "if this case is transferred to NDCA, it will likely be stayed pending the IPRs, and the stay would delay the trial for this case for years." *Demaray LLC v. Samsung Elecs. Co.*, No. 6:20-CV-00636-ADA, 2021 WL 5316455, at *5 (W.D. Tex. July 29, 2021). So far this year, five motions to stay pending IPR have been filed, with four granted in NDCA. Ex-1038 (Docket Navigator statistics). In 2024, twenty were granted and five were denied. *Id.* Overall, the rate of motions to stay pending IPR being granted in NDCA has been around 80% in the past three years. *Id.* NDCA

courts have recognized a “liberal policy in favor of granting motions to stay” pending IPR. *Anderson Power Prods., Inc. v. Bizlink Tech, Inc.*, No. 23-cv-05436-AMO, 2025 WL 474906, at *1 (N.D. Cal. Feb. 12, 2025) (citing *Zomm, LLC v. Apple Inc.*, 391 F.Supp.3d 946, 956 (N.D. Cal. 2019)). Many NDCA judges are willing to grant stay upon institution of IPRs and some grant stays pending institution decision. *See, e.g., Topia Tech., Inc. v. Dropbox Inc.*, No. 23-CV-00062-JSC, 2023 WL 3437823, at *4-6 (N.D. Cal. May 12, 2023) (granting stay request before PTAB made IPR institution decision).

As another example, for *Fintiv* factor 2, Patent Owners point to the presently projected trial date which is June 29, 2026 and only “**two weeks before** the July 15, 2026 statutory deadline for a FWD.” Br. 11 (emphasis added). The district court case, if transferred to NDCA, will undoubtedly have delays of much more than two weeks, putting the trial date well beyond the FWD statutory deadline. Indeed, the difference between the average time to trial for patent cases in NDCA is 6 months longer than that in WDTX, as recognized by Patent Owners in their own opposition to the motion to transfer. Ex-1036, 15-16 (“Plaintiffs argue that ‘[o]ver the last five years, the average time to trial for patent cases was 27 months in WDTX and 33 months in NDCA.’”).

As yet another example, for *Fintiv* factor 3, Patent Owners’ argument centers on the projected *Markman* hearing date of June 25, 2025 and that Judge

Albright could possibly have issued claim construction rulings before the statutory institution decision deadline of July 15, 2025. Br. 13. The time between these dates is shorter than a month. After transfer, the claim construction deadline will be pushed off and likely require new briefing given the NDCA (and different judges) approach to handling claim construction briefing in contrast to Judge Albright. For example, NDCA judges will have differing approaches to claim construction, not limited to page numbers, timing of briefs, and how to deal with indefiniteness and means plus function arguments. Some will undoubtedly prefer to resolve Petitioners' motion to dismiss,⁶ including the § 101 motion to dismiss (which would eliminate a patent from the district court case), before proceeding to claim construction.

As further addressed below, the *Fintiv* factors, considered as a whole, weigh against discretionary denial—even absent transfer.

⁶ Magistrate Judge Lane recommended that the district judge dismiss without prejudice Petitioners' motion to dismiss to allow refile in the NDCA once the case is transferred. Ex-1036, 18. The motion to dismiss remains pending and ripe for resolution by an NDCA judge.

IV. EVEN WITHOUT TRANSFER, THE *FINTIV* FACTORS FAVOR INSTITUTION

A. Factor 1: Whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted

This factor weighs slightly in favor of not exercising discretion or at least is neutral because no motion to stay is pending in the district court case and the court has not ruled on a potential stay pending IPR. *SAP Am. Inc. v. Cyandia, Inc.*, IPR2024-01432, Paper 14 at 7 (PTAB Apr. 7, 2025); *Charter Comms., Inc. v. Adaptive Spectrum Signal Alignment, Inc.*, IPR2024-01379, Paper 16 at 8 (PTAB Apr. 17, 2025).

Petitioners expect to move to stay the case pending IPRs once the district court case is transferred to NDCA. Factor 1 evaluates whether a stay would be granted pending resolution of the PTAB trial—an issue that has never been before the Court. *Fintiv* at 6-7. Patent Owners misleadingly refer to the Court’s previous denial of a stay request of a different type. Br. 7 (citing Ex-2001). Indeed, Petitioners’ previous motion requested a stay pending resolution of the transfer motion. Ex-1039 (Opposed Motion to Stay Case Pending Resolution of Motion to Transfer). Judge Pitman denied because “the Court expects to resolve Defendants’ motion to transfer well in advance of the scheduled Markman hearing.” Ex-2001. Sure enough, on January 31, 2025, the Court issued a recommendation to transfer the case to NDCA, rendering the requested stay moot. Ex-1036.

The *10x Genomics*⁷ and *Samsung*⁸ PTAB decisions Patent Owners rely on are distinguishable. In *Samsung*, the Board found factor 1 favored denial because the district court had already denied a motion to stay pending IPR and was unlikely to grant a renewed motion. In *10x Genomics*, the Board found factor 1 favored denial in view of “the coordinated schedule with the related cases, the prior denial of a motion to stay, and the lack of intent by either party to file a motion to stay.” Two of these three factors are not present here.

Further, the Board should set aside Patent Owners’ analysis of whether Judge Albright will deny a stay pending IPR. Patent Owners’ analysis ignores that the district court case is likely to be transferred to NDCA. After the transfer, a stay pending the IPR is highly likely, because as already explained above, NDCA judges are overwhelmingly willing to grant motions to stay pending IPR. *See supra* § III. Indeed, even if the district court case remains in WDTX, a stay pending IPR is not unlikely. Judge Albright regularly grants stays pending instituted IPRs. In 2024, Judge Albright granted nine motions to stay pending IPR

⁷ *10x Genomics, Inc. v. President & Fellows of Harvard Coll.*, IPR2023-01299, Paper 15 at 16 (PTAB Mar. 7, 2024).

⁸ *Samsung Elecs. Co., Ltd. v. California Inst. of Tech.*, IPR2023-00133, Paper 10 at 14 (PTAB May 4, 2023).

and denied three. Ex-1040 (Docket Navigator statistics). In 2023, he granted fourteen and denied six. *Id.* Furthermore, the Board has declined to speculate on the likelihood of a stay, particularly when the prospect appears too remote. *Google LLC v. Cerence Operating Co.*, IPR2024-01465, Paper 5 at 7 (PTAB Apr. 23, 2025).

B. Factor 2: Proximity of the court’s trial date to the Board’s projected statutory deadline for a final written decision

This factor weighs against discretionary denial or is at most neutral because the district court trial date is likely to be well after the Board’s projected statutory deadline for a FWD. If the trial date is earlier than the projected statutory deadline, factor 2 favors denial. *Fintiv* at 9. Otherwise, the Board should look at factors 3 and 4 instead. *Id.* (“If the court’s trial date is at or around the same time as the projected statutory deadline or even significantly after the projected statutory deadline, the decision whether to institute will likely implicate other factors discussed herein, such as the resources that have been invested in the parallel proceeding.”); *see also Liberty Energy*⁹ at 17-18 (noting *Fintiv* analysis turns on other factors when trial date might “fall around the same time as the Board’s ...

⁹ *Liberty Energy, Inc. v. U.S. Well Servs., LLC*, IPR2025-00031, Paper 9 (PTAB Apr. 29, 2025).

statutory deadline”). Recently, in *Amazon*,¹⁰ the Director denied the Patent Owner’s request for discretionary denial when the scheduled trial date was 9 days before the projected FWD date.

Patent Owners argue the trial date is June 29, 2026—before the July 15, 2026 statutory deadline for a FWD. Not only do Patent Owners fail to take into account Judge Lane’s recommendation, but even if the case is not transferred, the current trial date is merely **sixteen days** before the deadline for the Final Written Decision. However, the Board frequently issues FWD two to three weeks before the projected statutory deadline, rendering this gap insignificant in that the FWD could issue before the currently scheduled trial date.

Furthermore, as is typical with many judges, Judge Albright schedules multiple trials on the same date, and frequently moves trial dates when the conflicting trial dates have not been resolved. For example, Judge Albright’s calendar for May 2025 shows he has seven jury trials scheduled on May 19, 2025 to begin at 9:00 AM. Ex-1041, 18 (Judge Albright’s Next 30 Days Calendar Printout). The same shows two trials are scheduled for May 21, 2025 at 10 AM and 10:30 AM and eight trials are scheduled for May 27, 2025 at 9AM. *Id.*, 26-27,

¹⁰ *Amazon.com, Inc. v. NL Giken Inc.*, IPR2025-00250, Paper 14 (PTAB May 16, 2025).

34-40. Notably, a patent infringement jury trial between VLSI Technology LLC and Intel Corporation is scheduled to begin May 27, 2025 at 9AM at the same time with 7 other trials. *Id.*, 36-40. Thus, the practice of scheduling multiple trials also creates a likely scenario of the FWD issuing before a trial where such a small gap exists between the deadline for the FWD and the current trial date.¹¹

Additionally, Patent Owners fail to mention that Judge Albright recently moved from Waco, Texas to Austin, Texas. On January 31, 2025, the Austin Division had civil and criminal cases on the DII Docket re-assigned so 40% of the docket (hundreds of cases) went to Judge Albright, including this parallel case. Ex-1042 (Order Regarding DII Docket). At the same time, Judge Albright, after moving to Austin, is still managing the Waco docket until his successor is appointed there. Ex-1036, 16 (Magistrate Judge Lane's Recommendation); Ex-1041 (Judge Albright's Next 30 Days Calendar Printout). With the significantly increased caseload, the likelihood is even greater than previously that the trial date may be pushed off at least a few weeks or more.

¹¹ Indeed, even as to the trial date in this case, June 29, 2026, there is already another trial scheduled for the same day. Ex-1043, 3 (Scheduling Order in *Irons v. Paccar, Inc.*, No. 1:24-cv-01553-ADA, Dkt. 11 (W.D. Tex. 2024)).

The fact pattern here stands in stark contrast to that in the recent Director Review Decision in *Motorola* and other PTAB decisions. In *Motorola*, the Director found that the district court trial date was “eleven months before the Board’s projected final written decision date” strongly favored discretionary denial. *Motorola* at 3 (emphasis added). Even in the PTAB decisions Patent Owners cite to support its factor 2 argument, the trial date and the statutory FWD deadline are months, at least eight weeks, apart. In *Liberty Energy*, a Panel instituted the proceeding, even if the trial date will fall “*around the same time* as the projected statutory [FWD] deadline.” *Liberty Energy* at 10-12.

Indeed, the fact pattern here resembles that in *Amazon*, where the scheduled trial date was nine days before the projected FWD deadline. *Amazon* at 2. The Director found discretionary denial inappropriate because the time-to-trial statistics suggest trial would not begin until six months later than the currently set trial date. *Id.* Here, the complaint was filed on March 29, 2024. The median time-to-trial in WDTX is 892 days (over 29 months). Ex-1044 (Lex Machina Statistics). This suggests the trial would not begin until September 2026, which is about two months after the projected FWD.

C. Factor 3: Investment in the parallel proceeding by the court and the parties

This factor weighs in favor of not exercising discretion because at the time of the institution decision, the district court case will still be at an early stage and

Petitioners promptly prepared and filed this IPR after understanding what claims are relevant to the litigation. *Fintiv* at 10-11.

In *Motorola*, the Director found factor 3 strongly favors discretionary denial because “by the time Patent Owner filed its Preliminary Response[], the parties had served extensive infringement and invalidity contentions, served opening and rebuttal expert reports, filed claim construction briefs, and conducted several depositions.” *Motorola* at 3. The case disposition here is highly distinguishable from that in *Motorola*.

In contrast to *Motorola*, the close of fact discovery will be 6 months out and no expert reports will have occurred. To date, neither party has conducted any depositions. Parties are still in the process of negotiating an ESI Order as well as a modified Protective Order. Fact discovery is set to close January 21, 2026 and expert discovery is set to close March 18, 2026. Ex-2002 (First Amended District Court Scheduling Order).

Contrary to Patent Owners’ assertion, the Court likely would not have held the claim construction hearing before the statutory institution deadline, let alone issuing any claim construction order. As currently scheduled, the *Markman* hearing is on June 25, 2025. Ex-2002. As set forth in the OGP, Judge Albright will rule on any transfer motion before having a *Markman* hearing, much less in a situation where a magistrate has already recommended transfer. *See supra* § III

(discussing Ex-1037 (Judge Albright’s OGP, March 5, 2025)). Otherwise, the *Markman* hearing will be postponed per the OGP. Ex-1037, 6 (“If a motion to transfer remains pending, the Court will either promptly resolve the pending motion before the Markman hearing, or postpone the Markman hearing.”). The case docket in *Future Link Systems, LLC v. Broadcom Inc.*,¹² is an example of such a situation, where Defendants filed motion to transfer venue (Ex-1045, 3 (Dkt. 28 in Case Docket)) and then engaged in claim construction briefing. *Id.* The *Markman* Hearing was set for January 12, 2021, moved to February 23, 2022, and again moved to April 1, 2022, and on March 31, 2022, the case was transferred to NDCA where all deadlines were stayed shortly after. *Id.*, 7 (Dkt. 62, Dkt. 65).

If the district court case is transferred to NDCA, a new schedule would even further push out deadlines. As widely recognized, NDCA embraces a less aggressive scheduling order for setting a trial date. *See supra* § III. Take the development in *LED Wafer Sols. LLC v. Samsung Elecs. Co.*¹³ as an example. Before transfer, the case was in WDTX and in front of Judge Albright. On February 11, 2022, Judge Albright issued a third amended scheduling order, setting the trial date to be February 16, 2023. Ex-1046, 7 (Dkt. 57 in Case Docket). The

¹² No. 3:22-cv-02041 (N.D. Cal. filed Mar. 16, 2021).

¹³ No. 3:22-cv-04809 (N.D. Cal. filed Mar. 25, 2021).

case was later transferred to NDCA on August 22, 2022 and assigned to Judge Vince Chhabria. *Id.*, 11-12 (Dkt. 94, Dkt. 116). On October 5, 2022, Judge Chhabria held an initial case management conference, and reset the trial date to October 7, 2024, moving the trial date by more than 1.5 years. *Id.*, 14 (Dkt. 133). Moreover, a stay will be highly likely after transfer, given NDCA’s “liberal policy in favor of granting motions to stay” pending IPR. *See supra* § III. *Parus Holdings, Inc. v. Google LLC*,¹⁴ is one of many cases that was stayed after transferred in NDCA. The case transferred to NDCA from WDTX on December 12, 2022. Ex-1047, 11 (Dkt. 79 in Case Docket). A month later, a motion to stay pending IPRs was filed. *Id.*, 13 (Dkt. 94). The court granted the motion to stay on February 7, 2023, and the case remains stayed till today. *Id.*, 15 (Dkt. 109).

Petitioners also did not delay filing of the IPR. In *Motorola*, the petition was filed 11 months after the filing of the district court case. Here, the Petition was filed within 9 months of the complaint and slightly over 2 months of receiving infringement contentions from the Patent Owners, which allowed Petitioners to identify what claims are relevant to the litigation. The Panel in *Liberty Energy* held that the Petitioner was reasonably diligent by filing the petition less than three months after receiving the Patent Owner’s infringement contentions in the district

¹⁴ No. 22-cv-07830-VC (N.D. Cal. filed June 4, 2021).

court litigation. *Liberty Energy* at 12-15. The Board noted that infringement contentions “inform Petitioner of the claims that are in fact at issue, as well as how Patent Owner views the scope of the claims, both of which are material considerations in preparing a petition.” *Id.*, 14-15. Here, Petitioners took even less time to file the petition after receiving the infringement contentions. The IPR was even filed before Petitioners served invalidity contentions.

Patent Owners unfairly accuse Petitioners of “exacerbat[ing] the district court and parties’ significant investment in resources due to their delay in filing this petition.” Br. 14. But even if it were considered a delay, Patent Owners contributed to it by requesting extensions and additional briefing in the district court and should not be allowed to profit from it. Patent Owners have requested and obtained at least three weeks of extension in the district court. Ex-1035, 3-4, 7 (Dkt. Nos. 27, 29, 34, 54 in Case Docket).

Patent Owners’ complaint that serving a Patent Owner Response and preparing fact discovery at the same time poses “significant hardship” rings hollow. Parties in litigation navigate the competing constraints of parallel proceedings all the time.

Patent Owners’ argument that its investment in the district court “is particularly significant” based off the difference in parties’ revenues is also misplaced. Any such difference has no bearing on the case schedule or on the

investment of the parties and the court. Factor 3 only requires consideration of “the amount and type of work already completed in the parallel litigation by the court and the parties.” *Fintiv* at 9.

D. Factor 4: Overlap between issues raised in the petition and in the parallel proceeding

This factor weighs in favor of not exercising discretion because Petitioner has filed a *Sotera* stipulation. Ex-1048 (*Sotera* Stipulation). *Fintiv* at 12; *Sotera*.¹⁵

Petitioners promptly filed the *Sotera* stipulation after the Director and the Board provided new direction as set forth in the *Memo*. Patent Owners are not prejudiced by the timing of Petitioners’ *Sotera* stipulation, as they have addressed a *Sotera* stipulation in their Brief.

The Board has long held a *Sotera* type stipulation “mitigates any concerns of duplicative efforts between the district court and the Board, as well as concerns of potentially conflicting decisions.” *Sotera* at 19. This is true even where “Petitioner’s invalidity arguments in the district court are more expansive and include combinations of the prior art asserted in these proceedings with unpublished system prior art.” *Motorola* at 4 (recognizing “Petitioner’s *Sotera* stipulation may mitigate some concern of duplication”).

¹⁵ *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 at 17 (PTAB Dec. 1, 2020) (precedential).

Patent Owners’ concern that a *Sotera* stipulation would not make this IPR a “true alternative” to the district court case is unwarranted. Patent Owners cite *Motorola* and *SAP* as support. Both cases are distinguishable.

Motorola merely confirms a *Sotera* stipulation alone does not outweigh *Fintiv* factors 1, 2, and 5. It does not stand for the proposition that any overlap categorically renders a *Sotera* stipulation moot. In *Motorola*, the Board noted the Petitioner’s invalidity expert report “repeats all of the assertions in th[e] Petition.” *Motorola* at 3. Here, no invalidity expert report has been prepared yet. Patent Owners point to Petitioners’ invalidity contentions. However, it is common for expert reports to further narrow the grounds submitted in invalidity contentions, especially after IPR is instituted, and consistent with a *Sotera* stipulation. In addition, Petitioners have raised different systems in the district court case, including anticipatory art to the ’943 patent, without any overlap with the primary art raised in this IPR.

In *SAP*, the Petitioner asserted the IBM WebSphere product as system art in district court. The Board noted that “Petitioner describes the primary references [in the IPR] as ‘books describing aspects of the same IBM system: WebSphere.’” *SAP* at 10. Here, *Seshadri* is not documentation for the system art raised in the district court. While *Seshadri*’s assignee is related to the operator of a prior art system, AWS EC2, that is where the relation ends. Moreover, *Seshadri* has no

relationship to the four other prior art systems Petitioners rely upon in the district court case.

E. Factor 5: Whether the petitioner and the defendant in the parallel proceeding are the same party

Petitioners are defendants in the co-pending litigation. This factor follows factor 2 and thus is at most neutral. *Nikon Corp. v. Optimum Imaging Techs., LLC*, IPR2024-01372, Paper 17 at 23-24 (PTAB Apr. 23, 2025) (citing an abundance of prior PTAB decisions) (“Prior Board decisions have found that factor 5 generally follows factor 2, such that ‘this factor favors denial if trial precedes the Board’s Final Written Decision and favors institution if the opposite is true.’”).

F. Factor 6: Other circumstances that impact the Board’s exercise of discretion, including the merits

Under *CommScope*, factor 6 is considered only when factors 1-5 favor a denial. As discussed above, that is not the case here. Nonetheless, the merits of the Petition make a compelling case for institution.

The ’943 patent is directed to a particular type of integrated circuit called a “programmable logic device” (referred to in the art as a “PLD”), which include circuits that users can alter. Pet. 6. The patent purports to invent a PLD with two regions. The first region includes functionality that is lockable to prevent user access, and unlockable to enable user access, to programmable electronic circuits in the second region. Ex-1001, Claim 1; Pet. 10-11.

But this configuration is taught by the prior art presented in the Petition.

The primary reference for Grounds 1-2, Seshadri, encapsulates a “client configurable circuit” inside a PLD (Ex-1004, 3:41-64) and checks “customer account permissions” to allow access for “configuring the customer logic” (Ex-1004, 9:48-10:15). The shell logic “isolate[s] a configuration access port” to lock access to the client configurable circuit when the user is not authorized. Ex-1004, 6:11-41. Likewise, the primary reference for Grounds 3-4, Atsatt-113, teaches two regions in a PLD: a region with “a number of discrete programmable logic sectors 48” (Ex-1006, ¶30) and a region with the “device controller 60” that “authenticate[s] the configuration data 224 with the configuration data authentication key 220 and the mask 226 with the mask authentication key 222” (Ex-1006, ¶62).

Seshadri

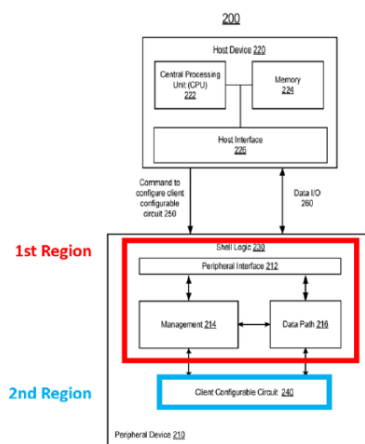
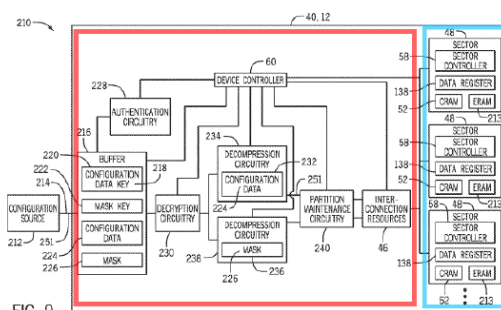


FIG. 2

Atsatt-113



Therefore, the Petition provides a compelling case for institution because the obviousness of the challenged claims is established by multiple, independent references that meet all limitations, including the purported point of novelty of the '943 patent. And Patent Owners' only criticisms are based on a claim construction that contradicts the patent, and mischaracterizations of the Petition and prior art.

First, Patent Owners rely on an implicit claim construction that alters the claim language. The claim simply requires a “router **with** a port ... wherein the port comprises: a bridge.” Patent Owners alter this language by changing the recited language “with” to mean “including.” Br. 19-20. The Patent Owners' Preliminary Response argues that “[i]ndependent Claims 1 and 10 thus require [] a router ... **includ[ing]** a port and bridge.” POPR, 9 (emphasis added).¹⁶

Patent Owners contradict the specification, ignoring the plain meaning of these words in the English language and excluding the only preferred embodiment depicted in the '943 patent. Figure 3, which Patent Owners rely upon to explain the '943 patent (POPR, 4-6), shows a bridge that is external to the router and port—and therefore not “included” in the router as required by Patent Owners:

¹⁶ Independent claim 10 recites a “router **having** a bridge **with** a port.” Patent Owners also alter “having” to mean “including.”

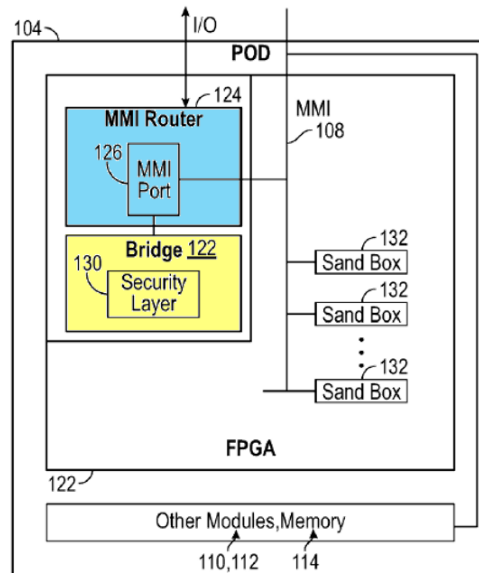


FIG. 3

Ex-1004, Fig. 3 (annotated: MMI router 124 in blue, Bridge 122 in yellow).

Nowhere in the specification is there ever disclosed the configuration that Patent Owners advocate for: a router including a port and a bridge. Instead, as explained in the Petition (Pet. 31 n.9), the specification discloses the inverse: a bridge with a router. Ex-1001, 3:8-12 (“An FPGA...has a bridge with an MMI router.”). Moreover, rather than disclosing a particular nested arrangement, as Patent Owners would require, the specification uses router, port, and bridge inconsistently. Figure 3 shows the **router** providing communication between internal and external modules and having an external port (I/O) and an MMI port. Ex-1001, Fig. 3. But elsewhere, the specification describes the **bridge** as having these features. Ex-1001, 4:52-59 (“The bridge 128 is thus a communication bridge between the outside of the server or system, and internal modules..., and has at

least two ports, I/O for external communication and MMI for internal (and possibly also external) communication”). Therefore, Patent Owners construe the claims to require a hierarchal arrangement that is inconsistent with the specification.

Second, for Grounds 1 and 2, Patent Owners resort to mischaracterizations. Patent Owners argue that, for the “bridge” recited in limitation [1d], the Petition only relied on Seshadri’s mailbox 588. Br. 18-19; POPR, 2, 9-10. But that is incorrect. The Petition explained how Seshadri’s “shell logic region includes functionality” that satisfies the port and router. Pet. 24-26 (emphasis added). The shell logic region includes the mailbox as one of its functions but also includes more. Pet. 24-25; *e.g.*, Ex-1004, 8:37-61. Likewise, for the bridge element, the Petition quoted Seshadri’s teaching that the “static shell [logic] may also include circuits...for bridging...” Pet. 28 (emphasis added).

Patent Owners should not be allowed to argue for a narrow hierarchal requirement for the claimed router, bridge, and port while pursuing a broad interpretation in district court. Notably, in their district court infringement contentions, Patent Owners argued that the claimed router, bridge do not have to be distinct nested components; instead, Patent Owner alleged that various IC components “separately and together” constitute the router and port. *See* Pet. 13 (discussing Patent Owners’ contentions (Ex-1021, 000020)). Indeed, Patent

Owners concede that “the ‘bridge’ ... [can be] coterminous with the claimed ‘port.’” POPR, 10. Patent Owners’ double standard should be rejected.

Third, Patent Owners draw a false dichotomy between Atsatt-113’s global resources and interconnection resources for Grounds 3-4. Br. 19-20. Patent Owners rearrange Atsatt-113 to suggest that it distinguishes between its global resources and interconnection resources. According to Patent Owners, Atsatt-113 describes the interconnection resources and then states “[t]he programmable fabric 100 *also* includes global resources.” Br. 20 (quoting Ex-1006, ¶39) (emphasis/alterations added by Patent Owners). However, the cited sentence does not follow a description of the interconnection resources; it comes after a lengthy discussion of user-programmable sectors over paragraphs 36-38, which are “also” in the programmable fabric of an FPGA. Ex-1006, ¶¶36-39.

Lastly, Patent Owners argue that the Petition relies on expert testimony because the expert declaration “largely parrots the petition.” Br. 20-21. Patent Owners miss the point. The *Memo* refers to case law and the Consolidated Trial Practice Guide to explain: “[e]xpert testimony, however, cannot take the place of a disclosure in a prior art reference.” *Consolidated Trial Practice Guide (CTPG)* (Nov. 2019), 36 (citations omitted); *see also FAQs for Interim Processes for PTAB Workload Management*, No. 21 (“[E]xtensive reliance on expert testimony and/or reasonable disputes between experts on dispositive issues may suggest that the

questions are better resolved in an Article III court. The statute and our reviewing court require that petitions be based on prior art patents and printed publications. ... The failure to provide focused expert testimony may weigh against institution.”). The fact that Petitioners adopted most of their expert’s explanation in the Petition is both proper and irrelevant for this issue.

What matters is that the Petition’s invalidity arguments are grounded in the teachings of the prior art references. Patent Owners do not allege that the Petition relied on expert testimony to provide for limitations that were not taught by the prior art. Indeed, the paragraph Patent Owners reproduce from the Petition shows the very opposite. It demonstrates that the Petition relied on the prior art reference Seshadri with direct quotes and cites, which was supported by the expert’s analysis of the same portions of Seshadri. Br. 21 (reproducing Pet. 24-25 and Ex-1003, ¶¶75, both quoting Ex-1004, 6:11-41, 8:37-61, 7:58-8:8). In short, the Petition presented a strong showing on the merits, based on multiple independent grounds, which weighs towards institution.

V. OTHER FACTORS WEIGH AGAINST DISCRETIONARY DENIAL

The *Memo* encourages parties to also address factors other than those analyzed above, including “[a]ny other considerations bearing on the Director’s discretion.” *Memo* at 2-3. Such considerations, as applicable to this case, also weigh against exercising discretion to deny institution. Discretionary denial is

inappropriate here because the validity or patentability of the '943 patent claims has not been adjudicated in another forum. As explained above, the Petition presents strong unpatentability challenges that are based on the disclosure of prior art patents and printed publications. The challenges do not rely extensively on expert testimony to stand in for prior art. The parties also have no settled expectations regarding the '943 patent. For all these reasons, discretionary denial is inappropriate here.

VI. THE PETITION IDENTIFIES GROUNDS 5-7 WITH PARTICULARITY

The Petition proposes four base combinations (Grounds 1-4), with one or two references each, to address the independent claims and the vast majority of dependent claims. For a handful of dependent claims, Grounds 5-7 each add, at most, one more reference to the base combinations, resulting in combinations of at most three references total.

The Board has regularly approved of this approach to dependent claims and instituted in similar circumstances. *See, e.g., IKEA Supply AG v. Everlight Electronics Co., Ltd.*, IPR2024-00972, Paper 6 (I.D.) at 8, 29 (instituting review where ground 5 combined “**each of Grounds 1, 2, or 4 in view of Bando** and/or the [ordinary level of skill in the art] OLSA”) (PTAB Dec. 10, 2024). Notably, the Board has rejected the same arguments that Patent Owners present here, as

explained below. *See Nat'l Beef Packing Co., LLC v. Inst. for Env. Health, Inc.*, IPR2024-00183, Paper 8 (I.D.) at 44-46 (PTAB Jan. 13, 2025).

Patent Owners do not dispute the particularity of the grounds for the independent claims (Grounds 1-4). Instead, they seek denial of the entire Petition based solely on three grounds related to dependent claims, which account for less than 20% of the Petition.¹⁷ Such a draconian measure would not only be unprecedented—Patent Owners cite no instance where denial was based solely on grounds addressing dependent claims—it would also rely on Patent Owners' blatant misrepresentations that attempt to confuse a straightforward presentation of three grounds for three dependent claim limitations.

A. The Petition presented Grounds 5-7 with particularity, following an approach the Board has previously blessed

Dependent claims 6, 7, and 8 recite three limitations that are repeated in claims 15, 16, and 17, respectively. Each claim introduces a standalone feature, and the Petition presents one prior art reference to address each standalone limitation.

- Tarafdar teaches a limitation of claims 6 and 15 for performing analytics;

¹⁷ The entirety of Grounds 5-7 are contained within 18 pages, starting on page 79 and ending on page 97 of the Petition, which is 99 pages in total.

- Kulkarni teaches a limitation of claims 7 and 16 for configurable port interfaces; and
- Atsatt-923 teaches a limitation of claims 8 and 17 for clock cycle regulation.

The Petition added each new reference to the base combinations for the underlying independent claims, **resulting in combinations of, at most, three references total**. For example, Tarafdar was added to each of Ground 1, Ground 2, Ground 3, and Ground 4. While this was clear in the claim analysis sections, which relied on the new reference to show the corresponding dependent limitation, and it was further explained in the motivation to combine sections. *See* Pet. 83-84 (“[T]he combination of Tarafdar with each of Grounds 1-4 would have been a simple combination of prior art elements according to known methods to yield predictable results.”), 89 (corresponding description for Kulkarni), 94-95 (corresponding description for Atsatt-923).

Contrary to Patent Owners’ representations, the Petition does not introduce every possible permutation of grounds. Rather, it addresses three dependent limitations by adding a standalone reference to the existing combinations that were explained earlier in the Petition (Grounds 1-4).

In *National Beef*, the Board faced a similar approach with three base grounds for the independent claims and additional references that were added to the base

combinations to address a handful of dependent claims. *Nat'l Beef*, IPR2024-00183, Paper 8 (I.D.) at 10-11, 45-46. The patent owner in *National Beef* asked for denial of institution because “[t]he petition fails to set forth the asserted grounds with particularity,” arguing the petition had too many “potential combinations” for those dependent claims, citing *Adaptics*¹⁸, as Patent Owners have done here. *Nat'l Beef*, Paper 6 (POPR) at 28-32. And like here, the patent owner misrepresented the number of combinations, far beyond what the petition actually proposed, in an effort to create an inflated number of permutations. *Id.*, 29-30 (“Neither the Board nor patentee have any meaningful opportunity to address even the simplest ground (ground 2) containing **over 700 potential combinations**, let alone the nearly 200,000 potential combinations under all grounds.”) (emphasis added).

The Board rejected the patent owner’s arguments, explaining that “the instant Petition uses four primary references in three clearly delineated Base Grounds (Grounds 1-3)” and “although Petitioner further challenges a subset of dependent claims under the remaining Grounds, **each of these are predicated on one of the three Base Grounds....**” *Nat'l Beef*, Paper 8 (I.D.) at 45-46 (emphasis added). Similarly, the Petition here follows this approach, providing clearly

¹⁸ *Adaptics Ltd. v. Perfect Co.*, IPR2018-01596, Paper 20 at 15-17 (PTAB Mar. 6, 2019) (designated informative).

delineated base grounds (Grounds 1-4), with additional grounds for dependent claims, each predicated on one of the base grounds. The Board further explained this approach was proper because “none of the Petitioner’s grounds employs the ‘and/or’ language” (*id.*, 45); the same is true here—no “and/or” language appears in the Petition’s grounds. Therefore, as the Board found in *National Beef*, the Petition does not “assert[] overly ‘voluminous and excessive grounds’ akin to those which led to the denial of institution in *Adaptics*.” *Id.*, 45.

Additionally, the Board explained that there was no confusion about which reference addressed which limitation, stating that “the grounds of the current Petition are sufficiently detailed to place Patent Owners on notice as to the arguments that are at issue.” *National Beef*, 45. The Board further observed that, “[n]ot surprisingly, Patent Owners have not pointed to any **specific arguments** for which it alleges there is confusion regarding the combination of references in play.” *Id.*, 45-46 (emphasis added). Likewise, in this case, Patent Owners have not identified any specific arguments of confusion as to which reference teaches which limitation. As the Board found in *National Beef*, the Petition’s approach fully complies with the particularity requirements of 35 U.S.C. § 312(a)(3). *Nat’l Beef*, Paper 8 at 45-46.

B. Patent Owners mischaracterize the Petition's grounds

Patent Owners argue that it is “wholly unclear (a) *what* references are being combined and (b) *how* they are being combined.” Br. 22 (emphasis in original).

According to Patent Owners, “Petitioners provide no explanation or guidance whatsoever regarding which of the above permutations to apply or even consider.” *Id.*, 24 (emphasis added). That is false.

As explained above, the Petition presents one prior art reference to address each standalone limitation in a handful of dependent claims, and each new reference is simply added to existing combinations. For example, the Petition explains that Tarafdar was combined with each of Grounds 1-4 to address a limitation of dependent claims 6 and 15. Pet. 79 (“Claims 6 and 15 are obvious based on each of Grounds 1-4 in view of Tarafdar”). Likewise, the Petition explains how Kulkarni is combined with each of Grounds 1-4 to address a limitation of dependent claims 7 and 16. *Id.*, 86 (“Claims 7 and 16 are obvious based on each of Grounds 1-4 in view of Kulkarni”). And the Petition explains how Atsatt-923 is combined with each of Grounds 1-4 to address a limitation of dependent claims 8 and 17. *Id.*, 92 (“Claims 8 and 17 are obvious based on each of Grounds 1-4 in view of Atsatt-923.”). This written explanation was reflected in the Petition’s chart of grounds.

Contrary to Patent Owners’ arguments, the Petition does not propose a catch-all combination or attempt to use every possible permutation of Grounds 1-4. Patent Owners speculate—without basis—that the Petition might combine grounds such as Ground 1 (Seshadri) with Ground 3 (Atsatt-113). Br. 23. Not so. The Petition never combined Grounds 1 and 3. Seshadri and Atsatt-113 serve as the primary references of their respective grounds and are never combined in the Petition. As previously explained, the Petition is clear: Grounds 5, 6, and 7 address three standalone limitations in specific dependent claims.

C. Patent Owners’ case law is inapposite

Patent Owners cite cases where petitions presented hundreds of permutations in catch-all grounds. This is not the situation with this IPR. Here, the Petition presents four specific grounds (Grounds 1-4) to challenge the vast majority of claims. No catch-all grounds were included. Patent Owners take issue with three grounds (Grounds 5, 6, and 7) that address a handful of dependent claims by adding one reference each to the base combinations of the independent claims—an approach found proper by the Board in numerous cases. Patent Owners cite no cases—and Petitioner is not aware of any—where a petition was denied for adding combinations to address dependent claims.

In *Adaptics*, the grounds included eight to ten references connected by “and/or,” yielding hundreds of possible combinations. *Adaptics* at 15-17. No such

permutations exist here. The Petition did not include any catch-all grounds or use “and/or.” Instead, the primary grounds (Grounds 1-4) present either a single reference by itself or a combination of two references. The grounds for dependent claims (Grounds 5-7) add one more reference, for combinations of, at most three references.

In *Invue*,¹⁹ the petition included a 17-page section (section IV) describing the teachings of 18 different prior art references, roughly grouped by claim feature, but without any claim-by-claim analysis or identification of specific combinations. *Invue*, Paper 1 (Petition) at 10-28. Invue’s claim analysis (section V) combined any of multiple references with the primary art reference, arguing that “a POSITA would have had reason **to use any of the known prior art fiber optic tethers** in place of the mechanical tether disclosed in the [primary prior art reference.]” *Id.*, 36 (emphasis added). Invue also provided a claim chart that vaguely referred back to the aforementioned sections IV (the prior art summaries) and V (the claim analysis). *Id.*, 37-69. This is nothing like the current Petition, which proposed four specific base combinations, with one or two references each, and added at most

¹⁹ *Invue Sec. Prods., Inc. v. Mobile Tech., Inc.*, IPR2019-00078, Paper 7 at 18 (PTAB May 1, 2019).

one more reference to address dependent claims, along with detailed motivations to combine explaining the combinations.

Nor are Petitioners requesting institution based solely on the grounds for dependent claims (Grounds 5-7), which was the scenario addressed in *Chevron*.²⁰ There, the Board refused a request to institute review because only the grounds for two dependent claims out of a total of 17 claims were presented with a reasonable likelihood of prevailing. Here, the Petition presented grounds for the independent claims with strong merits, and Grounds 5-7 exist solely to address three limitations in dependent claims, as explained above.

In *Paypal*,²¹ the petition contended that each of six limitations was simultaneously taught by two to three different teachings from one reference and also by two to three different teachings from another reference. Paypal's petition thus lacked particularity because it presented an unacceptable multiplicity of

²⁰ *Chevron Oronite Co. LLC, v. Infineum USA L.P.*, IPR2018-00923, Paper 9 at 10-11 (PTAB Nov. 7, 2018) (where the Board found petition had **not** demonstrated a reasonable likelihood that independent claim 1 and dependent claims 2 and 5-17 were invalid) (designated informative).

²¹ *PayPal, Inc. v. Ioengine, LLC*, IPR2019-00907, Paper 16 at 18-20 (PTAB Oct. 29, 2019).

permutations by not identifying the specific combinations and not explaining how a POSITA would have arrived at the claimed invention with those features. Paypal further failed to tie its motivation to combine analysis with any of these features, “only once [] cross-referenc[ing] its discussion of motivation to combine” in its claim mapping. *Paypal* at 23. Unlike in *Paypal*, the Petition here identifies specific teachings of specific references for each claim limitation, and Patent Owners have not pointed to any specific claim limitation where there is allegedly confusion regarding which prior art teaching satisfies that limitation. The Petition also articulates the rationale to combine the specific reference of each of Grounds 5-7 with the prior art references for each base combination.

Finally, Patent Owners cite *Henny Penny*,²² but that case dealt with the question of new theories on reply—an issue that is not germane to the pre-institution stage of this proceeding. In *Henny Penny*, the Federal Circuit commented on the particularity requirement to confirm the Board’s rejection of “‘an entirely new rationale’ for why a claim would have been obvious” that was raised for the first time in a petitioner’s reply, instead of the petition. *Id.*, 1330.

In summary, the Board’s prior cases have instituted for petitions that presented a similar approach to dependent claims, and the Board previously

²² *Henny Penny Corp. v. Frymaster LLC*, 938 F.3d 1324, 1330 (Fed. Cir. 2019)

rejected the arguments that Patent Owners have presented here. Patent Owners have not cited any case that is germane to the grounds of this Petition.

VII. CONCLUSION

For the foregoing reasons, Petitioners respectfully request that the Director decline to exercise discretionary denial and let the panel decide whether to institute based on the merits of the Petition.

Respectfully submitted,

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CERTIFICATE OF COMPLIANCE

This Petitioners' Opposition Brief to Patent Owners' Request for Discretionary Denial of Institution of Inter Partes Review complies with the type-volume limitation of 14,000 words, comprising 7,893 words, as counted using the Microsoft Word software that was used to prepare this paper, excluding the parts exempted by 37 C.F.R. § 42.24(a).

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that on May 27, 2025, a true and correct copy of the Petitioners' Opposition Brief to Patent Owners' Request for Discretionary Denial of Institution of Inter Partes Review was served in entirety via email to all parties to this proceeding at the addresses indicated:

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