

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.

IPR2025-00478

U.S. Patent No. 8,924,596

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

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EXHIBIT LIST

Exhibit No.	Description
1001	U.S. Patent No. 8,924,596 to Beeson, et al. (“the ’596 patent”)
1002	Certified Prosecution File History for the ’596 patent (“Prosecution History”)
1003	Declaration of Dr. Samuel Russ (“Russ Declaration”)
1004	European Prosecution History for 14867963 (“European Prosecution History”)
1005	U.S. Patent No. 8,559,439 to Dongare, et al. (“Dongare”)
1006	U.S. Patent No. 8,051,227 to Gewirtz, et al. (“Gewirtz”)
1007	U.S. Patent No. 6,810,462 to Matsunami, et al. (“Matsunami”)
1008	U.S. Patent No. 7,398,528 to Khawand, et al. (“Khawand”)
1009	U.S. Patent No. 5,805,930 to Rosenthal, et al. (“Rosenthal”)
1010	U.S. Patent No. 8,028,284 to Ohkawa (“Ohkawa”)
1011	U.S. Patent No. 5,204,954 to Hammer, et al. (“Hammer”)
1012	N. Wirth, “On Multiprogramming, Machine Coding, and Computer Organization,” <i>Communications of the ACM</i> , Vol. 12, No. 9, Sept. 1969, pp. 489-498
1013	U.S. Patent No. 5,276,886 to Dror (“Dror”)
1014	J. Agron et al., “Run-Time Services for Hybrid CPU/FPGA Systems on Chip,” 2006 27th IEEE International Real-Time Systems Symposium (RTSS’06), Rio de Janeiro, Brazil, 2006, pp. 3-12
1015	John Goodacre, Andrew N. Sloss, “Parallelism and the ARM Instruction Set Architecture,” <i>Computer</i> , July 2005, pp. 42-50
1016	Shih-Hao Ou, Tay-Jyi Lin, Xiang Sheng Deng, Zhi Hong Zhuo and Chih Wei Liu, “Multithreaded coprocessor interface for multi-core multimedia SoC,” 2008 Asia and South Pacific Design Automation Conference, Seoul, Korea (South), 2008, pp. 115-116
1017	Excerpts from Plaintiffs’ Supplemental Claim Chart for the ’596 Patent
1018	<i>Concurrent Ventures LLC et al. v. Advanced Micro Devices, Inc. et al.</i> , Case No: 1:24-cv-00335-ADA, Docket No. 1 – Complaint for Patent Infringement
1019	Excerpts from “The Art of Electronics” by Paul Horowitz and Winfield Hill, cover, inside cover, copyright page, table of contents, 512

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1023	Excerpts from “Comprehensive Dictionary of Electrical Engineering”
1024	Excerpts from “Electrical Engineering Dictionary”
1025	Atmel 8-bit Microcontroller Datasheet
1026	U.S. Patent No. 5,907,485 to Van Loo, et al. (“Van Loo”)
1027	U.S. Patent No. 5,717,954 to Grieff, et al. (“Grieff”)
1028	U.S. Patent No. 8,463,958 to Mannava, et al. (“Mannava”)
1029	Plaintiffs’ Proposed Preliminary Claim Constructions served on January 23, 2025, in <i>Concurrent Ventures LLC et al. v. Advanced Micro Devices, Inc. et al.</i> , Case No: 1:24-cv-00335-ADA
1030	AMD’s Proposed Preliminary Claim Constructions served on January 23, 2025, in <i>Concurrent Ventures LLC et al. v. Advanced Micro Devices, Inc. et al.</i> , Case No: 1:24-cv-00335-ADA
1031	“Applied Micro ARM servers all over Open Compute Project” by Timothy Morgan, available at https://www.theregister.com/2013/01/17/applied_micro_x_gen_e_open_compute , published on January 17, 2013.
1032	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) (as of July 3, 2025)
1033	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)
1034	Judge Albright’s Standing Order Governing Proceedings (OGP)—Patent Cases, March 5, 2025
1035	Email to Judge Albright’s Law Clerks dated May 28, 2025
1036	Docket Navigator, Motion to Stay Pending Inter Partes Review success rate data for California Northern District (printed May 5,

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1038	Docket Navigator, Motion to Stay Pending Inter Partes Review success rate data for Judge Albright (printed May 6, 2025)
1039	Lex Machina, time-to-trial data for Western District Texas (printed May 19, 2025)
1040	Judge Albright's May Calendar Printout (printed May 1, 2025)
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1042	Scheduling Order (Dkt. 11) in <i>Irons v. Paccar, Inc.</i> , No. 1:24-cv-01553-ADA (W.D. Tex. 2024)
1043	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)
1044	Case Docket for <i>Parus Holdings, Inc. v. Google LLC</i> , No. 22-cv-07830-VC (N.D. Cal. filed June 4, 2021)
1045	Sotera Stipulation (Dkt. 78) in <i>Concurrent Ventures, LLC v. Advanced Micro Devices, Inc.</i> , No. 1:24-cv-00335 (W.D. Tex. 2024)
1046	Judge Albright's June, 5 to July 5, 2025 Calendar Printout (printed June 5, 2025)
1047	Order Cancelling Markman Hearing Via Zoom (Dkt. 88) dated June 24, 2025 issued in <i>Concurrent Ventures, LLC v. Advanced Micro Devices, Inc.</i> ; No. 1:24-cv-00335-ADA (W.D. Tex.)
1048	Order Vacating Report and Recommendation of U.S. Magistrate Judge Mark Lane and Order for Venue Discovery (Dkt. 89) dated June 24, 2025 issued in <i>Concurrent Ventures, LLC v. Advanced Micro Devices, Inc.</i> ; No. 1:24-cv-00335-ADA (W.D. Tex.)
1049	Docket Navigator, Statistics for Case Filing of '596 Patent (printed July 11, 2025)
1050	Docket Navigator, Statistics for Case Filing by Concurrent Ventures and XstreamEdge (printed July 11, 2025)

I. INTRODUCTION

Patent Owners emphasize the district court schedule¹ that had, at one time, scheduled a trial date before the FWD, but this is no longer the case. Not only has the scheduled Markman hearing been canceled (Ex-1047 (Dkt. 88)), Judge Albright has also stayed all deadlines in the case until after the parties complete venue discovery, followed by further briefing of the motion to transfer. Ex-1048 (Dkt. 89). Based on these facts, the Acting Director has denied Patent Owners' request for discretionary denial in a related proceeding involving another patent asserted in the same district court litigation. *Advanced Micro Devices Inc. v. Concurrent Ventures, LLC*, IPR2025-00479, Paper 10 (PTAB July 10, 2025) ("the 479 IPR Decision"). The same outcome is warranted here.

There is no deadline for when Judge Albright will rule on the motion to transfer. Ex-1048. At the earliest, the motion to transfer will not be addressed until at least several weeks after full venue briefing, meaning at least several weeks past October 1, 2025. As a result of this stay, any trial will take place at least nearly four months later than the previously scheduled date of June 29, 2026—meaning trial will occur at the earliest, around the Board's October 15, 2026 FWD

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

deadline. It would be speculative² to estimate a trial date—discretionary denial based on a speculative trial date would be fundamentally unfair. If there is one thing that is certain, it is that the trial date will be delayed. And a transfer would further 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 is unwarranted under the *Motorola*³ Director Review Decision, the *Memo*,⁴ and other recent PTAB decisions because the parties’ investment has been minimal and the district court case remains in its early stages. In contrast to *Motorola*, no depositions have been taken, the Markman hearing was canceled and expert reports are not planned until January 2026. Additionally, a *Sotera* stipulation has been filed in district court, mitigating the concern of duplicative efforts between the district court and the Board.

² Patent Owners’ reliance on the previously projected schedule date, in spite of the pending transfer motion, has been proven speculative and ultimately incorrect.

³ *Motorola Sols. Inc. v. Stellar, LLC*, IPR2024-01205, Paper 19 (PTAB Mar. 28, 2025).

⁴ The Memorandum on Interim Processes for PTAB Workload Management, dated March 26, 2025 (“the *Memo*”).

In short, the *Fintiv*⁵ analysis and other discretionary factors favor institution regardless of whether the case is ultimately transferred or not. Should the district court transfer the case following venue discovery, the balance tips overwhelmingly against discretionary denial.

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-1032, 8 (Dkt. 33 in Case Docket). Patent Owners were granted a prolonged briefing schedule, which ended September 26, 2024. *Id.*, 10 (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-1032, 11 (Dkt. 53). Judge Pitman denied, stating that “the Court 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

⁵ *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (precedential) (“*Fintiv*”).

Recommendation finding “[a]ll of the disputed factors favor transfer” and recommending that the motion to transfer be granted. Ex-1032, 11 (Dkt. 58); Ex-1033, 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. *Id.*

Three days later, the case was re-assigned to Judge Albright, who recently moved from Waco to Austin. Ex-1032, 12 (Dkt. 61). Judge Albright extended deadlines for claim construction briefing by a month (*id.*, 13 (Dkt. 73, Dkt. 75)) and reset the *Markman* hearing to June 25, 2025 (Ex-2002 (First Amended Scheduling Order) (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-1034, 6 (Judge Albright’s OGP, March 5, 2025).

On June 24, 2025, Judge Albright cancelled the *Markman* hearing with no new scheduled date. Ex-1047; Ex-1032, 14 (Dkt. 88). Judge Albright vacated the magistrate judge’s transfer recommendation, and stayed all deadlines in the case

until after the completion of venue discovery and briefing of the motion to transfer.

Ex-1048; Ex-1032, 14 (Dkt. 89).

III. PATENT OWNERS' ARGUMENTS ARE PREDICATED ON A SPECULATIVE TRIAL DATE

Patent Owners refuse to consider the likelihood of transfer⁶ and based their arguments for discretionary denial entirely on a schedule which is now outdated.

Events have overtaken the Patent Owners' original arguments.

In the district court, Judge Albright has canceled the Markman hearing without re-scheduling it and has stayed all case deadlines. Even though the Court has elected to conduct a *de novo* review⁷ rather than directly adopt the Recommendation, the Magistrate Judge's analysis and conclusions remain persuasive. *See supra* § II. Furthermore, the review of a non-dispositive issue such as transfer is under the abuse of discretion standard, making adoption likely.

In contrast to the facts here, where transfer had been recommended by Magistrate Judge Lane, Patent Owners' arguments and caselaw regarding the

⁶ Patent Owners discuss, only in a footnote, that the Court was considering the Recommendation. Br. 2.

⁷ Patent Owners filed objections to the Recommendation within fourteen days of service. Ex-1045, 11 (Dkt. 62). It is Petitioners' position that the Court incorrectly stated that *de novo* review should be applied.

transfer issue address the situation where motions remained pending without a recommendation for transfer, or for which a magistrate has recommended denial.

Moreover, in the case of a likely transfer, the district court case would be put 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. 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).

As another example, for *Fintiv* factor 2, Patent Owners point to the previously projected trial date which was June 29, 2026 and four months before the October 15, 2026 statutory deadline for a FWD. Br. 8. As the district court case stands, the trial schedule is already subject to a delay of nearly four months. This puts the trial date close to or after the statutory deadline for the FWD, with potential for further delay.

If transferred to NDCA, the case will likely experience additional delays, putting the trial date squarely 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-1033, 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 previously scheduled *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 October 15, 2025. Br. 11. Judge Albright has cancelled the *Markman* hearing without setting a new date. Any conjecture as to when the Court might eventually rule on claim construction would be purely speculative. What is certain is that the Court will not hear the parties’ arguments, nor rule on claim construction until after the motion to transfer is resolved.

In their brief, Patent Owners attempt to justify their complete lack of consideration of transfer relying on the discretionary denial decision issued a month ago in a related proceeding, IPR2025-00223 (the 223 IPR); Br. 2, fn. 1 (citing *Advanced Micro Devices Inc. v. Concurrent Ventures, LLC*, IPR2025-00223, Paper 9 (PTAB June 12, 2025) (“the 223 IPR Decision”).) Although the decision found, at that time, the likelihood of the district court granting motion to transfer speculative, it nonetheless qualifies the ruling by allowing Petitioners to

file a request for rehearing or Director Review “[i]f the district court does grant Petitioner’s motion to transfer within 30 days of this Decision.” The 223 IPR Decision at 3. Petitioners have timely requested rehearing, outlining the above-mentioned updates in the district court case. *Advanced Micro Devices Inc. v. Concurrent Ventures, LLC*, IPR2025-00223, Paper 10 (PTAB July 3, 2025). As noted in the rehearing request, although Judge Albright has not granted the motion to transfer, the significance of such updates warrants a different ruling in the 223 IPR. *Id.* 1-2.

Indeed, most recently, the significance of these district court updates was acknowledged by the Acting Director when deciding to not discretionarily deny the related 479 IPR. The 479 IPR Decision, Paper 10 at 2 (“On balance, these circumstances do not warrant discretionary denial.”). The current proceeding, the 223 IPR, and the 479 IPR all concern the invalidity of patents asserted by Patent Owners against Petitioners in the same district court proceeding. Across the related IPRs, the same facts and procedural history are present. The underlying logic of the Acting Director’s decision in the 479 IPR applies to the other IPRs. Therefore, Petitioners reasonably expect the Acting Director to vacate the decision to discretionarily deny the 223 IPR. There are five patents asserted in the district court proceeding and four are challenged in the IPRs. Once an IPR has been referred to the Board, the same logic should apply for the Acting Director to also

refer the remaining IPRs.⁸ Such an outcome is further compelled by the efficiency gains of addressing the remaining IPRs before the Board, as discussed below.

Infra §IV.F.

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

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 against discretionary denial. Factor 1 evaluates whether a stay would be granted pending resolution of the PTAB trial. *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 6 (PTAB Mar. 20, 2020) (precedential). Judge Albright’s venue discovery order stayed all deadlines in the district court case and ensures the case will remain stayed for over three months. Ex-1048; Ex-1032, 14 (Dkt. 89).

⁸ The fourth IPR is IPR2025-00486 (“the 486 IPR”). On July 7, Petitioners filed an Opposition to Patent Owners’ Request for Discretionary Denial in the 486 IPR. *Advanced Micro Devices Inc. v. Concurrent Ventures, LLC*, IPR2025-00486, Paper 8 (PTAB July 7, 2025).

Patent Owners misleadingly refer to the Court’s previous denial of a stay request of a different type. Br. 5 (citing Ex-2001). Indeed, Petitioners’ previous motion requested a stay pending resolution of the transfer motion. Ex-1037 (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 the recommendation to transfer the case to NDCA, rendering the requested stay moot. Ex-1033.

The *10x Genomics*⁹ and *Samsung*¹⁰ 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.

⁹ *10x Genomics, Inc. v. President & Fellows of Harvard Coll.*, IPR2023-01299, Paper 15 at 16 (PTAB Mar. 7, 2024).

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

Further, the Board should set aside Patent Owners’ analysis of whether Judge Albright will deny a stay pending IPR. A stay pending IPR is plausible. Judge Albright regularly grants stays pending instituted IPRs. In 2024, Judge Albright granted nine motions to stay pending IPR and denied three. Ex-1038 (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).

Additionally, Petitioners expect to move to stay the case pending IPRs once the district court case is 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.

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 because the district court trial date is now likely to be around or after the Board’s projected statutory deadline for a FWD. If the trial date is on or after the projected statutory deadline, the Board should look at factors 3 and 4 instead. *Fintiv* at 9. (“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*¹¹ at 17-18 (noting *Fintiv* analysis turns on other factors when trial date might “fall around the same time as the Board’s ... statutory deadline”). Recently, in *Amazon*,¹² the Director denied the Patent Owner’s request for discretionary denial even when the scheduled trial date was *before* the projected FWD date.

All district court case deadlines have been stayed and will not occur until sometime after the parties complete venue briefing by October 1, 2025 (over three months, and nearly four months later), and the court subsequently resolves Petitioners’ motion to transfer. As a result, the earliest possible trial date will be weeks after October 1, 2026—close to or likely past the projected FWD date for this IPR of October 15, 2026. Hence, factor 2 weighs against discretionary denial. *Liberty Energy* at 10-12 (instituting the proceeding when trial date falls “*around the same time* as the projected statutory [FWD] deadline”); *Amazon* at 2 (finding discretionary denial inappropriate where the scheduled trial date was nine days before the projected FWD deadline).

¹¹ *Liberty Energy, Inc. v. U.S. Well Servs., LLC*, IPR2025-00031, Paper 9 (PTAB Apr. 29, 2025).

¹² *Amazon.com, Inc. v. NL Giken Inc.*, IPR2025-00250, Paper 14 (PTAB May 16, 2025).

Further trial delay is also likely, even if the court denies transfer after the parties complete venue discovery and briefing. Judge Albright schedules multiple trials on the same date, and frequently moves trial dates when the conflicting trial dates have not been resolved. The practice of scheduling multiple trials also creates a likely scenario of the FWD issuing before a trial where a small gap exists between the deadline for the FWD and the current trial date.¹³

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-1041 (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-1033, 16 (Magistrate Judge Lane's Recommendation); Ex-1040 (Judge Albright's May Calendar Printout on May 1, 2025); Ex-1046 (Judge Albright's June 5 to July 5, 2025 Calendar Printout). With the significantly

¹³ Indeed, even as to the trial date in this case, June 29, 2026, there is already another trial scheduled for the same day. Ex-1055, 3 (Scheduling Order in *Irons v. Paccar, Inc.*, No. 1:24-cv-01553-ADA, Dkt. 11 (W.D. Tex. 2024)).

increased caseload, the likelihood is even greater than previously that the trial date may be pushed off at least a few weeks or more.

If the case transfers to NDCA, even greater delays are likely, as the trial date will likely be reset according to NDCA's slower scheduling practices. *See supra* § II. In *LED Wafer Sols. LLC v. Samsung Elecs. Co.*,¹⁴ the case was originally in WDTX before Judge Albright, who set a trial date of February 16, 2023 by third amended scheduling order. Ex-1043, 7 (Dkt. 57 in Case Docket). After transfer to NDCA and reassignment to Judge Chhabria on August 22, 2022, the trial date was reset to October 7, 2024—over 1.5 years later. Ex-1043, 11-12, 14 (Dkt. Nos. 94, 116, 133). Moreover, NDCA's liberal policy in favor of granting motions to stay pending IPR is illustrated in *Parus Holdings, Inc. v. Google LLC*,¹⁵ where after transfer from WDTX on December 12, 2022, the NDCA granted a stay pending IPR a month later, and the case remains stayed. Ex-1044, 11, 13, 15 (Dkt. Nos. 79, 94, 109 in Case Docket).

In each of the PTAB decisions cited by Patent Owners, although the trial date and the statutory FWD deadline were two to three months apart, a primary factor that prompted the Board to find factor 2 slightly favorable to denial was the

¹⁴ No. 3-22-cv-04809 (N.D. Cal. filed Mar. 25, 2021).

¹⁵ No. 3-22-cv-07830-VC (N.D. Cal. filed June 4, 2021).

relative certainty surrounding the scheduled trial date. *Cisco*¹⁶ at 12 (finding “no indication of similar uncertainty for the scheduled trial date in the Cisco litigation”); *Fintiv II*¹⁷ at 13 (seeing no reason why the jointly agreed-upon trial date “which already has been postponed by several months” would be postponed again); *Next Caller*¹⁸ at 14-15 (noting district court proceeding was in advanced stage and progressing “reportedly [] on track”). None of these cases apply here, as well as *Cipla*¹⁹ because the trial date is not “before [the] final written decision is due.” Br. 8.

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

¹⁶ *Cisco Sys., Inc. v. Portsmouth Network Corp.*, IPR2024-00503, Paper 7 (PTAB Aug. 6, 2024).

¹⁷ *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 15 (PTAB May 13, 2020) (informative) (“*Fintiv II*”).

¹⁸ *Next Caller Inc. v. TrustID, Inc.*, IPR2019-00961, Paper 10 (PTAB Oct. 16, 2019).

¹⁹ *Cipla Ltd. v. Gilead Sciences, Inc.*, IPR2025-00033, Paper 22 (PTAB May 15, 2025).

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*,²⁰ where factor 3 favored discretionary denial due to extensive investment in the case (including exchanged contentions, expert reports, and multiple depositions) (*Motorola* at 3), here *zero* depositions have been taken, *zero* expert reports have been exchanged, no claim construction hearing has occurred or is even scheduled, and all case deadlines have been stayed. Judge Albright will not hold a claim construction hearing or issue a claim construction order before the October 15, 2025 institution deadline. *Compare* Ex-1048 (Dkt. 89) , *with*, Br. 11. As reflected in Judge Albright’s OGP, Judge Albright will rule on any transfer motion before having a *Markman* hearing, or otherwise postpone

²⁰ *Motorola Sols. Inc. v. Stellar, LLC*, IPR2024-01205, Paper 19 (PTAB Mar. 28, 2025).

the hearing. *See supra* § II (discussing Ex-1034, 6 (Judge Albright’s OGP, March 5, 2025)). This approach was confirmed here when Judge Albright canceled the *Markman* hearing that had been scheduled for June 25, 2025.

Petitioners also did not delay filing of the IPR. Here, the Petition was filed within 3 months of receiving infringement contentions from the Patent Owners, which allowed Petitioners to identify what claims are relevant to the litigation. Faced with similar facts, the Panel in *Liberty Energy* held that the Petitioner was reasonably diligent in filing the petition. *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.

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. 12. 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-1032, 7-8, 10 (Dkt. Nos. 27, 29, 34, 54 in Case Docket). As noted above, the level of investment of resource in this case has been limited as the case rests in its early stages.

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 Petitioners have filed a *Sotera* stipulation. Ex-1045 (*Sotera* Stipulation). *Fintiv* at 12; *Sotera*²¹ at 17.

Patent Owners admit that a *Sotera* stipulation is in place. Br. 14. Rather, Patent Owners complain that the *Sotera* stipulation would not make this

²¹ *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 (PTAB Dec. 1, 2020) (precedential).

proceeding a “true alternative” to the district court case. *Id.* Patent Owners’ such concern is unwarranted.

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”).

Patent Owners cite *Motorola* as support, but it is 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 '753 patent, that do not overlap with the three prior-art patents used in this IPR. Ex-2005, 75.

Previously, Patent Owners cited *SAP*²² in their discretionary denial requests against related IPRs.²³ Patent Owners have not raised SAP here, silently acknowledging the fact that the references are not related to the system art raised in district court.

Lastly, Patent Owners acknowledge the fact that Petitioners “assert other alleged prior art—including three system prior art references” in district court (Br. 1), but incorrectly apply this fact to its factor 4 analysis (Br. 14). *Fintiv* factor 4 addresses “the concerns of inefficiency and possibility of conflicting decisions” when the Board is presented with prior art arguments substantially identical to those in the parallel proceeding. *Fintiv* at 12-13. As a result, *Fintiv* guides the Board to weigh the *overlap* between proceedings in claims, grounds, arguments, and evidence. *Id.* System art cannot be raised in the IPR. 35 U.S.C. § 311(b). The fact that three system art references are alleged as prior art in the district court

²² *SAP America, Inc. v. Cyandia, Inc.*, IPR2024-01432, Paper 14 (PTAB Apr. 7, 2025).

²³ IPR2025-00223, IPR2025-00479, IPR2025-00486.

is a testament that the overlap is insignificant. Therefore, factor 4 weighs against discretionary denial.

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*,²⁴ 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 very compelling case for institution.

The ’596 patent relates to “dividing and synchronizing a processing task across multiple processing elements/processors.” Ex-1001, Title. The patent attempts to address purported shortcomings of prior art software techniques, such

²⁴ *CommScope Techs. LLC v. Dali Wireless, Inc.*, IPR2022-01242, Paper 23 at 6 (PTAB Feb. 27, 2023) (precedential).

as semaphores and mutexes, to coordinate access to queues. Ex-1001, 1:22-27. As a solution, the '596 patent purports to invent a “reservation register” that “store[s] a value indicative of available space” in the input queue. Ex-1001, 1:45-46. However, such reservation registers were well-known in the prior art. For example, during prosecution of a European counterpart application, the EPO identified two references including Gerwitz which is relied upon in the petition here. Pet. 6. The European counterpart was eventually abandoned. *Id.*

The current petition demonstrates the well-known nature of the alleged invention of the '596 patent with not one, but multiple grounds. For Grounds 1 and 2, Dongare teaches an embedded processor that manages input queues (Pet. 10-11; Ex-1005, Abstract, 1:21-22, Fig. 4), while Gerwitz teaches a reservation register that tracks available space (Pet. 11-12; Ex-1006, 1:12-64, 2:59-62, 4:51-58). Pet. 19-24; Ex-1005, 10:50-11:30; Ex-1006, 4:51-5:6. Gerwitz's reservation register “holds the dynamic state of the queue, including ... queue occupancy, and/or number of free writeable entries for flow control purposes.” Ex-1006, 2:59-64, 3:55-59, 4:5-15; Pet. 19.

For Grounds 3, 4, and 5, Khawand teaches a multiprocessor architecture where service applications are delegated between the processors using queues; an inter-processor manager implements flow control between the processors. Pet. 45; Ex-1008, 3:65-4:27. Rosenthal teaches “a flow control register” that “stores a

value which indicates the amount of space available in the FIFO buffer[.]” Pet. 46; Ex-1009, 2:21-28. The Khawand-Rosenthal combination satisfies both of Petitioner’s and Patent Owners’ competing claim constructions in district court for the term “register” (Pet. 56-57) that is part of the alleged point of novelty—the “reservation register.”

As noted above, the Director has declined to discretionarily deny the related 479 IPR (*supra* §III), which likewise presented compelling merits (IPR2025-00479, Paper 8). Now that the merits are before the Board, it is likely that there will be an institution. Across the four patents challenged by IPRs, a variety of technologies are at issue. In contrast to this IPR, which touches on processor architecture, the 479 IPR involves technology related to geographical location and bandwidth management; the 223 IPR is related to FPGAs; and the 486 IPR concerns network addressing technology. Here, the number and scope of the patents asserted in the district court litigation further tip the balance against discretionary denial, “as the Board is better suited to review a large number of patents involving diverse subject matter.” *Tesla*,²⁵ at 3. It would be more efficient

²⁵ *Tesla, Inc. v. Intellectual Ventures II LLC*, IPR2025-00217, IPR2025-00219, IPR2025-00220, IPR2025-00221, IPR2025-00222, IPR2025-00339, Paper 9 (PTAB June 13, 2025).

for the Board to address all the IPRs than to present a disparate range of technical issues to a jury.

1. No Settled Expectation Exists

There are no settled expectations here. The facts surrounding the '596 patent do not resemble those in *iRhythm Technologies* to which Patent Owners cite. In *iRhythm Technologies*, one of the petitioner's patent applications cited the then-pending application of a challenged patent in an Information Disclosure Statement. *iRhythm Technologies, Inc. v. Welch Allyn, Inc.*, IPR2025-00363, Paper 10 at 3 (June 6, 2025). That is not the case here. Petitioners have not cited the '596 patent in any of its patent applications, because Petitioners never had reason to believe the '596 patent was relevant to Petitioners' products or technology. The mere fact that Patent Owners' agent briefly engaged AMD in business discussions in 2014—without identifying any patents—does not create “legitimate, settled expectations” regarding their patent portfolio. Br. 17.

That Petitioners have not previously challenged the '596 patent since its issuance does not, by itself, create any settled expectation of the patent's validity. Petitioners were unaware of the '596 patent until 2023 just shortly before the lawsuit. Until that time, Petitioners could not have anticipated that Patent Owners would attempt to stretch the patent far beyond the scope of its claims. Therefore, Petitioners had no reason to consider challenging this patent. The meeting that

Patent Owners point to was a meeting “in 2014 between Petitioner AMD and Patent Owner Concurrent Ventures’ agent,” HellaStorm, Inc.²⁶ Br. 3. However, the ’596 had not even issued at that time – the meeting was in June 2014 and the patent issued in December 2014. More importantly, the accused products and technology belong to Pensando, which did not even exist at the time of the meeting; it was separately and independently founded in 2019 and was not acquired by AMD until 2022.

Furthermore, “[t]here may be persuasive reasons why the Board should review challenged claims several years after their issuance date.” *Proxense*,²⁷ at 2. One such reasons is “a patent may have been in force for years but may not have been commercialized, asserted, marked, licensed, or otherwise applied in a petitioner’s particular technology space, if at all.” *Id.* 2-3. To the best of Petitioners’ knowledge, Patent Owners Concurrent Ventures, LLC and XtreamEdge, Inc. have not commercialized, marked, licensed, or otherwise applied the ’596 patent in Petitioners’ particular technology space. Concurrent Ventures’ alleged commercialization agent, HellaStorm, Inc., similarly has not

²⁶ Ex-1018, ¶30.

²⁷ *Intel Corp. v. Proxense LLC*, IPR2025-00327, IPR2025-00328, IPR2025-00329, Paper 12 (PTAB June 26, 2025).

commercialized, marked, licensed, or otherwise applied the '596 patent in Petitioners' particular technology space. The parallel district court proceeding marks the first—and remains the only—instance in which the '596 patent has been asserted. Ex-1049 (Docket Navigator statistics). In fact, it is the only patent-related proceeding in which Concurrent Ventures or XstreamEdge has ever been a party. Ex-1050 (Docket Navigator statistics). HellaStorm has never been a party to any patent related lawsuits. Accordingly, Petitioners could not have formed any settled expectation with regard to the validity of the '596 patent.

In short, the Petition presented a strong showing on the merits, which are not affected by Patent Owners' dubious arguments, and thus 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 '596 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 '596 patent, as discussed above. For all these reasons, discretionary denial is inappropriate here.

VI. CONCLUSION

Given the recent development in the district court proceeding, including cancellation of the Markman hearing and the staying of all court deadline, discretionary denial is inappropriate here. Petitioners respectfully request that the Director decline to exercise discretion to deny institution 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 5,676 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 July 15, 2025, a true and correct copy of the Petitioners' Opposition Brief to Patent Owners' Request for Discretionary Denial of Institution of Inter Partes Review and Exhibits 1032-1050 was served in entirety via email to all parties to this proceeding at the addresses indicated:

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