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.

---

Case No. IPR2025-00478
U.S. Patent No. 8,924,596

---

**PATENT OWNERS' MOTION TO VACATE THE INSTITUTION DECISION AND TERMINATE THIS *INTER PARTES* REVIEW**

**PATENT OWNERS' EXHIBIT LIST**

| Exhibit | Description |
|---|---|
| 2001 | Text Order Denying AMD/Pensando's Motion to Stay Case (Judge Robert Pitman) in *Concurrent Ventures, LLC and XtreamEdge, Inc. v. Advanced Micro Devices, Inc. and Pensando Systems, Inc.*, No. 1-24-cv-00335 (W.D. Tex. 2024) |
| 2002 | First Amended District Court Scheduling Order (Dkt. 77) in *Concurrent Ventures, LLC and XtreamEdge, Inc. v. Advanced Micro Devices, Inc. and Pensando Systems, Inc*., No. 1-24-cv-00335 (W.D. Tex. 2024) |
| 2003 | Webpage printouts of Docket Navigator Time to Trial regarding the District Court for the Western District of Texas and Judge Alan D. Albright |
| 2004 | Webpage printout of "AMD Reports Fourth Quarter and Full Year 2024 Financial Results" dated March 4, 2025 (https://ir.amd.com/news-events/press-releases/detail/1236/amd-reports-fourth-quarter-and-full-year-2024-financial-results) |
| 2005 | AMD/Pensando's Invalidity Contentions (Cover Pleading) in *Concurrent Ventures, LLC and XtreamEdge, Inc. v. Advanced Micro Devices, Inc. and Pensando Systems, Inc.*, No. 1-24-cv-00335 (W.D. Tex. 2024) |
| 2006 | AMD/Pensando's Opening Claim Construction Brief in *Concurrent Ventures, LLC and XtreamEdge, Inc. v. Advanced Micro Devices, Inc. and Pensando Systems, Inc.*, No. 1-24-cv-00335 (W.D. Tex. 2024) |
| 2007 | Declaration of Dr. R. Jacob Baker submitted by AMC/Pensando in support of AMD/Pensando's Opening Claim Construction Brief in *Concurrent Ventures, LLC and XtreamEdge, Inc. v. Advanced Micro Devices, Inc. and Pensando Systems, Inc.*, No. 1-24-cv-00335 (W.D. Tex. 2024) |
| 2008 | Declaration of Darrell Long submitted by AMC/Pensando in support of AMD/Pensando's Opening Claim Construction Brief in *Concurrent Ventures, LLC and XtreamEdge, Inc. v. Advanced Micro Devices, Inc. and Pensando Systems, Inc.*, No. 1-24-cv-00335 (W.D. Tex. 2024) |

| | |
|---|---|
| 2009 | Declaration of Bill Lin submitted by AMC/Pensando in support of AMD/Pensando's Opening Claim Construction Brief in *Concurrent Ventures, LLC and XtreamEdge, Inc. v. Advanced Micro Devices, Inc. and Pensando Systems, Inc.*, No. 1-24-cv-00335 (W.D. Tex. 2024) |
| 2010 | Declaration of Kevin Jeffay submitted by AMC/Pensando in support of AMD/Pensando's Opening Claim Construction Brief in *Concurrent Ventures, LLC and XtreamEdge, Inc. v. Advanced Micro Devices, Inc. and Pensando Systems, Inc.*, No. 1-24-cv-00335 (W.D. Tex. 2024) |
| 2011 | CV/XE's Responsive Claim Construction Brief in *Concurrent Ventures, LLC and XtreamEdge, Inc. v. Advanced Micro Devices, Inc. and Pensando Systems, Inc.*, No. 1-24-cv-00335 (W.D. Tex. 2024) |
| 2012 | Declaration of Dr. Paul Min submitted by CV/XE in support of CV/XE's Responsive Claim Construction Brief in *Concurrent Ventures, LLC and XtreamEdge, Inc. v. Advanced Micro Devices, Inc. and Pensando Systems, Inc.*, No. 1-24-cv-00335 (W.D. Tex. 2024) |
| 2013 | AMD/Pensando's Reply Claim Construction Brief in *Concurrent Ventures, LLC and XtreamEdge, Inc. v. Advanced Micro Devices, Inc. and Pensando Systems, Inc.*, No. 1-24-cv-00335 (W.D. Tex. 2024) |
| 2014 | CV/XE's Objection to the Report and Recommendation of the U.S. Magistrate Judge in *Concurrent Ventures, LLC and XtreamEdge, Inc. v. Advanced Micro Devices, Inc. and Pensando Systems, Inc.*, No. 1-24-cv-00335 (W.D. Tex. 2024) |
| 2015 | AMD/Pensando's Motion for Reconsideration of Venue Order in *Concurrent Ventures, LLC and XtreamEdge, Inc. v. Advanced Micro Devices, Inc. and Pensando Systems, Inc.*, No. 1-24-cv-00335 (W.D. Tex. 2024) |
| 2016 | Order denying AMD/Pensando's Motion for Reconsideration of Venue Order in *Concurrent Ventures, LLC and XtreamEdge, Inc. v. Advanced Micro Devices, Inc. and Pensando Systems, Inc.*, No. 1-24-cv-00335 (W.D. Tex. 2024) |
| 2017 | September 11, 2025 Scheduling Order in *Concurrent Ventures, LLC and XtreamEdge, Inc. v. Advanced Micro Devices, Inc. and Pensando Systems, Inc.*, No. 1-24-cv-00335 (W.D. Tex. 2024) |

| | |
|---|---|
| 2018 | Petitioners' Request For Rehearing Of Decision Denying Institution Of *Inter Partes* Review in IPR2025-00223, Paper 10. |
| 2019 | Declaration of Zachary L. Jacobs in Support of Motion for Admission *Pro Hac Vice* |
| 2020 | Declaration of Dr. Paul S. Min in Support of Patent Owners' Response |
| 2021 | Curriculum Vitae of Dr. Paul S. Min |
| 2022 | Deposition of Dr. Samuel Russ in IPR2025-00478, conducted December 19, 2025 |
| 2023 | July 31, 2025 Memorandum |
| 2024–2026 | RESERVED |
| 2027 | Invalidity Claim Chart (Dongare 439), Ex. 596-04 NDCA |
| 2028 | Invalidity Claim Chart (Gewirtz), Ex. 596-06 NDCA |
| 2029 | Invalidity Claim Chart (Khawand), Ex. 596-10 NDCA |
| 2030 | Invalidity Claim Chart (Rosenthal), Ex. 596-16 NDCA |
| 2031 | Invalidity Claim Chart (Matsunami), Ex. 596-13 NDCA |
| 2032 | Invalidity Claim Chart (Hammer), Ex. 596-08 NDCA |
| 2033 | Invalidity Claim Chart (Goyal), Ex. 596-07 NDCA |
| 2034 | Invalidity Claim Chart (Chavan), Ex. 596-03 NDCA |
| 2035 | Invalidity Claim Chart (Michaylov), Ex. 596-14 NDCA |
| 2036 | Invalidity Claim Chart (Van Loo), Ex. 596-17 NDCA |
| 2037 | 2026.02.20 Ltr. from Z. Jacobs to J. Liang re Invalidity Contention Deficiencies |
| 2038 | 2026.03.09 Email from H. Batts re Reporting *Sotera* Violation |

| | |
|---|---|
| 2039 | 2026.03.09 Defs. Ltr. Resp. to Pls. re Invalidity Contentions |
| 2040 | AMD/Pensando's Responsive Notice of New & Relevant Facts Re Mot. to Stay Pending Determination of IPR in *Concurrent Ventures, LLC and XtreamEdge, Inc. v. Advanced Micro Devices, Inc. and Pensando Systems, Inc.*, 4:25-cv-09567-JST, Dkt. 188 (Mar. 17, 2026) |
| 2041 | Invalidity Claim Chart (Stroud), Ex. 753-04 NDCA |
| 2042 | Invalidity Claim Chart (Da Silva), Ex. 753-07 NDCA |
| 2043 | Invalidity Claim Chart (Cragon), Ex. 753-08 NDCA |
| 2044 | Invalidity Claim Chart (Saulsbury), Ex. 753-10 NDCA |
| 2045 | Invalidity Claim Chart (Jana), Ex. 753-05 NDCA |
| 2046 | Invalidity Claim Chart (Schultz), Ex. 943-02 NDCA |

Patent Owners submit this authorized motion[1] to vacate institution and terminate this IPR because Petitioners willfully violated their *Sotera* stipulation.

Petitioners have done precisely what they represented to the Director and Patent Office they would ***not*** do post-institution: include in their district court invalidity contentions the very grounds raised in this IPR, as well as a multitude of other grounds based on patents and printed publications. After Patent Owners identified this violation to Petitioners, Petitioners first ignored the issue completely; next attacked Patent Owners for reporting the violation; then denied any violation occurred; and finally compounded their violation by unilaterally filing a new stipulation that purports to reserve rights Petitioners already surrendered. Now, only days before this filing, Petitioners have come forward with a new (though equally spurious) theory: the Director lacks authority to determine when to terminate an IPR.

There is no defense to the indefensible. Petitioners' repudiation of promises made to this agency not only violates their stipulation, it violates Petitioners' duty of candor and good faith and frustrates the fundamental purpose of pre-institution stipulations: ensuring that IPRs are a true alternative to the district court. Still today, Petitioners have not amended their contentions to remove the violative assertions.

[1] Petitioners' violation took place in each of IPR2025-00223, IPR2025-00478, and IPR2025-00486. Patent Owners thus submit the same brief in each proceeding.

Petitioners' conduct threatens the integrity of the discretionary system the Director and Office have carefully built, which hinges on Petitioners honoring their promises to surrender certain invalidity theories if an IPR is instituted. Without consequences, petitioners will be incentivized to renege on those promises: if they are not caught, they get away with the violation; if caught, they can simply correct it and be no worse off than before. Vacatur of the institution decision and termination of the IPR is necessary to protect both Patent Owners and the Office itself.

# I. RELEVANT FACTUAL BACKGROUND

## A. Petitioners Violated Their *Sotera* Stipulation

In order to avoid discretionary denial, Petitioners filed in each IPR proceeding and the parallel district court action a stipulation they titled "Defendants' Stipulation Regarding Invalidity Contentions." EX1048 in -478 and -223; EX1058 in -486 ("*Sotera* Stipulation"). In the *Sotera* Stipulation, Petitioners identify the invalidity grounds in the Petitions and agree that, if the Board institutes the IPRs, they will not pursue in the district court any invalidity grounds that were or could have been raised in the IPRs. For example:

> For the '596 patent, ***<u>if the Board institutes IPR2025-00478</u>***, then ***Defendants will not pursue in this case*** the specific grounds identified above in connection with the '596 patent and the challenged claims for that patent as originally issued, or on ***any other ground for which the Board institutes, that was raised or could have been reasonably raised in an IPR (i.e., any ground that could be raised under §§ 102 or 103 on the basis of prior art patents or***

***printed publications)***.

EX1048 in -478 at 3–4 (emphasis added) (providing same stipulation for ’753 and ’943 patents); *see also id.* at 2 (identifying IPR grounds).

Petitioners relied heavily on their *Sotera* Stipulation in opposing discretionary denial, arguing that it “mitigate[ed] the concern of duplicative efforts between the district court and the Board.” Paper 8 in -478 at 2; Paper 8 in -223 at 18; Paper 8 in -486 at 16. Consequently, the *Sotera* Stipulation was a material part of the Director’s “holistic assessment of all of the evidence and arguments presented” in determining not to discretionarily deny the Petitions. *See* Paper 10 in -478 at 3; Paper 9 in -223 at 3; Paper 9 in -486 at 2. Further, in referring one Petition, the Director noted the absence of “concern of inconsistent outcomes and duplication of efforts resulting from two proceedings operating in parallel.” *See* Paper 10 in -478 at 3.

The Board instituted the IPRs in October and November 2025. Paper 11 in -478; Paper 14 in -223; Paper 11 in -486. The instituted grounds are based on combinations of paper references; for example, in IPR2025-00478, Dongare, Gewirtz, Matsunami, Khawand, and Rosenthal. Paper 11 in -478 at 6. On February 13, 2026—months after the institutions and almost ten months after Petitioners stipulated they would not rely on any grounds based on paper references—Petitioners served invalidity contentions in the district court case. EX3014 in -478.

Petitioners’ contentions expressly assert every one of the paper grounds and

references Petitioners rely on in each of the IPRs. For IPR2025-00478 and IPR2025-00486, Petitioners provide claim charts for each IPR reference. *See, e.g.*, EX3104 in -478 at 6-8, 18-20, 22-24; EX2027 (Dongare); EX2028 (Gewirtz); EX2029 (Khawand); EX2030 (Rosenthal); EX2031 (Matsunami); EX2041 ("Stroud"); EX2042 ("Da Silva"); EX2043 ("Cragon"); EX2044 ("Saulsbury"). And Petitioners assert that each paper reference anticipates and alone renders obvious each patent—grounds that could have been raised in the IPR. *See e.g.*, EX2028 at 1–68 (contending the claims "are anticipated" by Gewirtz). Petitioners go further for IPR2025-00223—expressly relying on the Petition as their invalidity charts and thus inherently asserting the same grounds as in the IPR. *See* EX3103 in -478 at 77.

Petitioners also identify the specific invalidity grounds at issue in this IPR and repeatedly and expressly incorporate them by reference. *See, e.g.*, EX3104 in -478 at 10 ("[T]he '596 patent is anticipated and/or rendered obvious by prior art as explained by Defendants' Petition for Inter Partes Review (assigned Case No. IPR2025-00478), ***which is incorporated herein by reference***.") (including chart listing all IPR grounds), 60 (same for -486); 78 (same for -223); *see also, e.g.*, 18, 22–23 (identifying same obvious combinations used in IPR Grounds).

Petitioners also rely on a host of other prior art patents and publications expressly for anticipation, obviousness alone, and in combination with other paper references—despite their stipulation. For example, Petitioners assert that U.S. Patent

No. 5,204,954 ("Hammer") anticipates and by itself renders obvious the '596 patent and provide a claim chart spanning more than 100 pages mapping their anticipation arguments for each limitation. EX2032; *see also* EX2033 ("Goyal") (same); EX2034 ("Chavan") (same); EX2035 ("Michaylov") (same); EX2036 ("Van Loo") (same). Petitioners do the same for the '753 and '943 patents. *See, e.g.*, EX2045 ("Jana") (same for the '753 patent); EX2046 ("Schultz") (same for the '943 patent).

All told, Petitioners' invalidity contentions pertaining to the challenged patents contain no fewer than 340 invalidity grounds based purely on paper references, and over 2,000 pages of charts directed to paper references that are asserted for anticipation or obviousness, alone or with other paper references. *See, e.g.*, EX3104 in -478; EX2027–36, 2041–46. Overall, the majority of Petitioners' invalidity contentions consist of grounds that are covered by the *Sotera* Stipulation.[2]

### B. When Caught, Petitioners Doubled Down On Their Violation

On February 20, 2026, one week after Petitioners served their contentions, Patent Owners alerted Petitioners to their violation and requested a meet and confer the week of March 3 and a substantive response by March 6. EX2037. Petitioners' response was silence. Only when Patent Owners, having heard nothing from

[2] Petitioners unambiguously assert the cited paper references as anticipation and standalone obviousness grounds—not only in combination with system art.

Petitioners, raised the issue with the Director on March 9, did Petitioners respond. Rather than acknowledge the violation, take steps to amend their invalidity contentions, or request a time to discuss the violation, Petitioners tried to bury the issue: first by threatening sanctions against Patent Owners for reporting it (EX2038) and then by (unsuccessfully) asking the Director to ignore it (EX3103 in -478).

Petitioners next sent Patent Owners a letter that both implicitly acknowledged a violation occurred and denied any such violation—beginning a theme of contradiction that continues to today. On one hand, Petitioners (incorrectly) denied that they violated the *Sotera* Stipulation. EX2039. On the other hand, Petitioners admitted that their invalidity contentions included grounds covered by the Stipulation "to preserve Defendants' rights in the unlikely event that an IPR is de-instituted." *Id.* To support this purported "reservation of rights," Petitioners only cited examples of deinstitution decisions that occurred ***after*** they served their invalidity contentions, underscoring that their letter was nothing more than an after-the-fact attempt to justify departures from the binding *Sotera* Stipulation (which included no such "reservation of rights," *see* EX1045 in -478 at 2–4).

Petitioners doubled down on this position in a new, amended stipulation they unilaterally filed on March 10, 2026 in the district court case. EX1053 in -478 ("the Amended Stipulation"). In the Amended Stipulation, Petitioners asserted that their invalidity contentions "included some grounds merely as a reservation of rights" and

enumerated some of the invalidity grounds in their contentions that are in fact covered by the *Sotera* Stipulation. *Id.* Far from withdrawing those grounds, however, Petitioners did the opposite: they confirmed they ***are*** pursuing those grounds as a "reservation of rights" in case the IPR proceedings are deinstituted. *Id.*

Putting aside that Petitioners now improperly attempt to rewrite their original *Sotera* Stipulation, the Amended Stipulation fails to address many of the violative grounds. For example, Petitioners assert anticipation based on each of Gewirtz, Jana, and Schultz (among many others). *See* § I.A. The Amended Stipulation ignores these grounds completely and does not even claim they are only being asserted as a "reservation of rights." EX1053 in -478 at 2–3. Petitioners still assert these paper-art-only grounds wholesale, comprising hundreds of pages of contentions.

The Director authorized this motion in each IPR on March 13, stating that "Director Review of the [Institution] Decision is appropriate to consider whether Petitioners have violated their *Sotera* stipulation." Paper 28 in -478 at 2.

### C. Petitioners Remain In Violation

As of this filing, Petitioners have neither amended their invalidity contentions nor made any commitment to do so. Petitioners are still asserting in the district court case the very same invalidity grounds they are pursuing in the IPR—and others that they could have pursued—forcing Patent Owners to respond to identical challenges in both forums. Despite having been on notice of this issue for a month, Petitioners

remain in open violation, underscoring just how untenable their position is.

## II. ARGUMENT

### A. Petitioners' Willful Violation of their *Sotera* Stipulation Necessitates Vacatur and Termination

Vacating the institution decision and terminating the IPR is the only appropriate remedy for Petitioners' willful repudiation of their commitments to the Office. Petitioners unambiguously stipulated that they would not pursue in the district court invalidity grounds based only on references used in this IPR or other patents and printed publications—yet they have done precisely that. *See* § I.A. Indeed, Petitioners expressly identify the specific IPR grounds in their contentions and assert they are relying on those very same grounds in the district court case. *Id.* And this was not an isolated, limited, or inadvertent violation. Petitioners chose to add dozens upon dozens of grounds to their invalidity grounds, and hundreds of pages of invalidity charts, all violating the *Sotera* Stipulation. *Id.* Drafting hundreds of pages of contentions is a conscious choice.

Petitioners' improper Amended Stipulation is both an improper attempt to back out of a binding stipulation and further proves their violation. In the Amended Stipulation, Petitioners acknowledge that their invalidity contentions include no fewer than 340 grounds for the three patents that are covered by the stipulation and explain that they ***are*** pursuing those grounds, albeit now as a "reservation of rights" in case the IPR proceedings are deinstituted—a carve out that did not exist in the

original *Sotera* Stipulation. EX1053 in -478 at 1; *see* § II.B. Worse still, the Amended Stipulation does not address numerous other paper-reference grounds that Petitioners still assert in district court, such as anticipation based on each of Gewirtz, Jana, and Schultz. *See* § I.B. In sum, Petitioners' violation was—by Petitioners' own admission—knowing, premeditated, and comprehensive.

Such conduct plainly merits termination of this proceeding. Not only was the *Sotera* Stipulation a core part of the discretionary analysis that led to this IPR being instituted, Petitioners' violation undercuts the core purpose of IPR proceedings. As the Office has repeatedly explained, IPRs are designed to serve as a cost-effective alternative to district court determinations of invalidity. *See* 90 FR 48335 (Oct. 17, 2025) (hereafter "Proposed Rules") ("When IPR proceedings cover the same ground as district court litigation, they cease to be an 'alternative' and can substantially increase litigation costs. That is the opposite of what Congress intended."); *id.* at 48338 (petitioners must stipulate they will not pursue *any* challenges under §§ 102 or 103 in other forums as a prerequisite for institution); *Motorola Sols. Inc. v. Stellar LLC*, IPR2024-01205, Paper 19 at 3-4 (Acting Director Mar. 28, 2025) (the effectiveness of petitioner's stipulation turns on whether it "ensure[s] that these IPR proceedings would be a 'true alternative' to the district court proceeding").

Petitioners' ongoing violation ensures that this IPR is not a "true alternative." By maintaining the same invalidity grounds in district court, Petitioners force Patent

Owners to litigate those grounds in district court. Had Petitioners admitted that they were in fact going to include invalidity grounds based upon paper references in their invalidity contentions, this IPR never would have been instituted in the first place. Being forced to defend this IPR has prejudiced Patents Owners, both in terms of cost and time. Termination is thus the most appropriate remedy for Petitioners' violation.

This remedy is consistent with Office practice—the Director has repeatedly vacated institution decisions where petitioners have taken inconsistent positions before the Office and district court. *See, e.g.*, *Revvo Techs., Inc. v. Cerebrum Sensor Techs., Inc.*, IPR2025-00632, Paper 36 at 4 (Director Jan. 26, 2026); *Generac Power Sys., Inc. v. Champion Power Equip., Inc.*, IPR2025-00805, Paper 40 at 5 (Director Feb. 3, 2026).[3] Here, Petitioners' conduct is orders of magnitude worse than the inconsistencies the Director has already found sufficient to justify termination.

Termination is also appropriate given Petitioners' manifest lack of candor in this proceeding. All "[p]arties and individuals involved in [an IPR] have a duty of candor and good faith to the Office during the course of a proceeding." 37 C.F.R. § 42.11(a). That duty is implicated when, for example, parties offer different claim

[3] As discussed below, Petitioners also engage in the same conduct that led to vacatur in the above-cited decisions: pursuing indefiniteness in district court while arguing before the PTAB that the same claim terms are amenable to construction. *See* § II.B.

construction positions in multiple forums without disclosing it to the Board. *American Airlines, Inc. et al. v. Intellectual Ventures I LLC*, IPR2025-01055, Paper 11 at 13 (PTAB Nov. 21, 2025) ("We also remind Petitioner's counsel of their duty of candor and good faith to the Office during the course of a proceeding pursuant to 37 C.F.R. § 42.11. Patent Owner should not have been the first party to inform the Board as to Petitioner's different claim construction positions in the two forums."). The duty of candor was plainly violated here—there is simply no other way to characterize Petitioners' willful violation of the *Sotera* Stipulation, their failure to bring it to the Office's attention, and their subsequent refusal to fix their violation or admit wrongdoing as anything other than a lack of candor and good faith.

Petitioners' violation of their obligation of candor and good faith, if permitted, would gravely undermine the discretionary denial process and regulatory scheme the Office has constructed. Petitioner stipulations are the linchpin of the discretionary denial regime, and the Office's Proposed Rules would require broad stipulations as a condition for institution. If petitioner stipulations can be casually ignored or unilaterally modified, as Petitioners have done, then IPRs will once again tread the same ground as district court litigation—to the detriment of the patent system.

### B. Petitioners' Pattern of Misconduct Underscores That Vacatur and Termination Are Necessary

Petitioners' violation of the *Sotera* Stipulation is sufficient to justify vacatur and termination. But worse yet, Petitioners' conduct since Patents Owners raised this

issue further confirms the appropriate remedy. In short, Petitioners' new Amended Stipulation, even if operable, only worsens their violation. Petitioners now advance two irreconcilable positions: one, they claim they did not violate their *Sotera* Stipulation; but two, they acknowledge they asserted *Sotera*-barred prior art grounds as a "reservation of rights." Rather than conforming their conduct to the promise they already made—by amending their contentions to remove the violative grounds—Petitioners instead attempt to rewrite that promise to conform to their conduct. A party cannot fix a broken promise by redefining it after the fact.

In any event, Petitioners' Amended Stipulation does not cure the violation. First, the Amended Stipulation does not even address all of the *Sotera*-barred prior art grounds—not even with its "reservation of rights" carveout. Gewirtz is a prime example: Petitioners' invalidity contentions assert anticipation based on Gewirtz, yet the Amended Stipulation does not mention anticipation based on Gewirtz at all. *See* §§ I.A, I.B. This ground remains asserted in the district court despite the fact it could have been raised in the IPR. It is the same for many other grounds. *Id.*

Second, the Amended Stipulation's purported reservation of rights does not cure the violation. The purpose of the *Sotera* Stipulation is that Petitioner irrevocably surrenders certain rights upon institution of an IPR. Once institution occurred, Petitioner lost all rights as to the grounds covered by the *Sotera* Stipulation. Petitioners had no rights to reserve. Petitioners' attempt to claw back rights they

already expressly waived and to unilaterally add a condition to their previously unconditional *Sotera* Stipulation is an independent violation of the *Sotera* Stipulation and another act inconsistent with the duty of candor.

This attempted claw-back of rights, moreover, is highly prejudicial to Patent Owners. Although the Amended Stipulation states that the "previously submitted *Sotera* stipulations remain in effect" (EX1053 in -478 at 1), Petitioners' invalidity contentions still include the violative grounds and Petitioners purport to reserve the right to rely on them in the future. This places Patent Owners in an impossible position. Since the grounds are in Petitioners' contentions, Patent Owners cannot reasonably ignore them and instead must address them in interrogatories and with expert analysis in the district court—defeating the purpose of the *Sotera* Stipulation.

Petitioners' attempted justification for their Amended Stipulation involves yet more conduct inconsistent with the duty of candor. Petitioners justify their purported "reservation of rights" on the ground that "the PTAB has recently vacated institution for some IPR proceedings" and cite the Director's precedential decision in *Revvo Tech., Inc. v. Cerebrum Sensor Tech., Inc.*, IPR2025-00632, Paper 20 (Director Nov. 3, 2025). EX1053 in -478. But despite their assertion that they "do not see any reason for de-institution here," they have in fact committed a *Revvo* violation. Petitioners argue in district court that the claims of the challenged patent are indefinite, even as they tell the Office the claims are amenable to construction. *See* EX3104 in -478 at

122 (arguing indefiniteness and incorporating claim construction briefing). This simultaneous pursuit of different claim construction positions in different forums independently warrants termination. *See Revvo*, IPR2025-00632, Paper 20; *Carbyne, Inc. v. Tritech Software Sys.*, IPR2025-00959, Paper 20 at 4 (Director, Feb. 19, 2026); *Infineon Techs. Am. Corp.*, IPR2025-0117, Paper 27 at 2–4.

### C. Petitioners New Argument That the Director Lacks Jurisdiction To Enforce Promises Made to the Office is Baseless

Petitioners have now pivoted to a new argument—that "a dispute regarding any alleged violation of the *Sotera* Stipulation can only be properly resolved before [the district court], not the PTAB." EX2040. Remarkably, Petitioners contend that the Director cannot act in response to a violation of a promise Petitioners made to the Office and instead must wait until a district court issues an advisory opinion as to whether a violation occurred. *Id.* This argument lacks any support in law or logic.

It is beyond well-settled that: (1) the decision to institute an IPR is fully discretionary; (2) that discretion belongs entirely to the Director; and (3) the Director's decisions made pursuant to that statutory discretion are insulated from judicial review. *See In re Motorola Sols., Inc.*, 159 F.4th 30, 36 (Fed. Cir. 2025). It is equally well-settled that the Director has authority to reconsider or revoke any institution decision. *See In re Vivint, Inc.*, 14 F.4th 1342, 1351 (Fed. Cir. 2021).

These black letter legal principles foreclose Petitioners' theory. The Director has plenary authority to decide whether to institute an IPR, to decline to institute an

IPR, or to revoke a prior institution of an IPR. That discretionary authority, whether exercised based on a *Sotera* violation or any other reason, is not subject to judicial review or judicial direction—it is "the special province of the Executive Branch." *In Re Volkswagen Group of America, Inc.*, No. 2026-123, 2026 WL 776550, at *1 (Fed. Cir. 2026). No district court has authority to tell the Director that he can or cannot terminate these IPRs because of Petitioners' *Sotera* violation. Just as the Director can evaluate Petitioners' district court claim construction positions to determine if there is a *Revvo* violation, the Director can evaluate whether Petitioners' conduct here violates their commitments to the Office. Petitioners' theory that the Director must wait for the district court fails as a matter of law.

It also fails as a matter of logic and policy. Petitioners' *Sotera* Stipulation was a promise *to the Director and this Office*. These stipulations are essential to the Office's discretionary evaluation. Under Petitioners' theory, the Office would be powerless to act against parties that, like Petitioners here, openly flout the obligations they voluntarily assumed to induce the Office to act. That would be unworkable. Even aside from the Director's plenary institution authority, the Office has ample authority to ensure that parties act in good faith and do not renege on unambiguous commitments. *See* 37 C.F.R. § 42.11(a), (c); 37 C.F.R. § 11.18(c)(5).

For all of the foregoing reasons, Patent Owners request that the Director issue an order that vacates the Institution Decision and terminates this IPR.

Dated: March 20, 2026

By: /s/Michael Matulewicz-Crowley
Michael Matulewicz-Crowley
PTO Reg. No. 72,220

*Counsel for Patent Owners Concurrent Ventures, LLC and XtreamEdge, Inc.*

## CERTIFICATE OF SERVICE

The undersigned hereby certifies that pursuant to 37 C.F.R. §42.6(e)(1), a copy of the foregoing **PATENT OWNERS' MOTION TO VACATE THE INSTITUTION DECISION AND TERMINATE THIS *INTER PARTES* REVIEW** was served on March 20, 2026 by filing this document through the Patent Trial and Appeal Board's P-TACTS System as well as delivering a copy via electronic mail upon the following attorneys of record for Petitioners:

Harper Batts
hbatts@sheppardmullin.com
Chris Ponder
cponder@sheppardmullin.com
Jeffrey Liang
jliang@sheppardmullin.com

Dated: March 20, 2026

By: */s/Michael Matulewicz-Crowley*
Michael Matulewicz-Crowley
PTO Reg. No. 72,220

*Counsel for Patent Owners Concurrent Ventures, LLC and XtreamEdge, Inc.*