

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NXP USA, INC. and QUALCOMM INCORPORATED,

Petitioners

v.

REDSTONE LOGICS LLC,

Patent Owner

Case: IPR2025-00485
U.S. Patent No. 8,549,339

**CO-PETITIONER NXP USA, INC. AND PATENT OWNER REDSTONE
LOGICS LLC'S JOINT MOTION TO DISMISS NXP AS A PETITIONER**

TABLE OF EXHIBITS

Exhibit	Short Name	Description
EX1001	'339 Patent	U.S. Patent No. 8,549,339
EX1002	Annavaram Declaration	Declaration of Dr. Murali Annavaram
EX1003	Annavaram CV	<i>Curriculum Vitae</i> of Dr. Murali Annavaram
EX1004	Elgebaly	U.S. Patent App. Pub. No. 2007/0096775
EX1005	'339 Prosecution History	File History of U.S. Patent No. 8,549,339
EX1006	White	U.S. Patent No. 7,263,457
EX1007	Talwar	U.S. Patent App. Pub. No. 2009/0271646
EX1008	Williams	Williams et al., "Low Latency Clock Domain Transfer for Simultaneously Mesochronous, Plesiochronous and Heterochronous Interfaces," 13 th IEEE International Symposium on Asynchronous Circuits and Systems, 2007.
EX1009	RESERVED	RESERVED
EX1010	Cho	U.S. Patent App. Pub. No. 2010/0073068
EX1011	Vajda	U.S. Patent App. Pub. No. 2012/0060170
EX1012	RESERVED	RESERVED
EX1013	Ozer	U.S. Patent App. Pub. No. 2008/0209133
EX1014	NXP Complaint	Doc. No. 1, Complaint, <i>Redstone Logics LLC v. NXP Semiconductors N.V., et al.</i> , No. 7:24-cv-00028-DC-DTG (W.D. Tex.)
EX1015	Qualcomm Complaint	Doc. No. 1, Complaint, <i>Redstone Logics LLC v. Qualcomm Inc., et al.</i> , No. 7:24-cv-00231-ADA (W.D. Tex.)

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EX1016	MediaTek Complaint	Doc. No. 1, Complaint, <i>Redstone Logics LLC v. MediaTek, Inc., et al.</i> , No. 7:24-cv-00029-DC-DTG (W.D. Tex.)
EX1017	NXP Opening Claim Construction Brief	Doc. No. 39, Defendant NXP USA Inc.'s Opening Claim Construction Brief, <i>Redstone Logics LLC v. NXP USA, Inc.</i> , No. 7:24-cv-00028-DC-DTG (W.D. Tex.)
EX1018	Redstone Responsive Claim Construction Brief	Doc. No. 41, Plaintiff's Responsive Claim Construction Brief, <i>Redstone Logics LLC v. NXP USA, Inc.</i> , No. 7:24-cv-00028-DC-DTG (W.D. Tex.)
EX1019	Kaxiras Textbook	S. Kaxiras, Computer Architecture Techniques for Power-Efficiency, 2008.
EX1020	Fryman	U.S. Patent No. 8,312,225
EX1021	Capps	U.S. Patent No. 7,584,369
EX1022	Pelley	U.S. Patent No. 7,777,330
EX1023	Intel Multi-Core Processor White Paper	R. Ramanathan, Intel multi-core processors: Making the move to quad-core and beyond, Technology@Intel Magazine, December 2006.
EX1024	Panov Paper	Y. Panov, Design Considerations for 12-V/1.5-V, 50-A Voltage Regulator Modules, Power Electronics, IEEE Transactions on. 16. 10.1109/APEC.2000.826080.
EX1025	Flautner	U.S. Patent App. Pub. No. 2005/0034002
EX1026	Liptay 1968	J.S. Liptay, Structural aspects of the System/360 Model 85, II. The cache, IBM Systems Journal, Vol. 7, No. 1, 1968.
EX1027	Gold	U.S. Patent App. Pub. No. 2009/0063888
EX1028	Cesky	U.S. Patent No. 7,538,625

Exhibit	Short Name	Description
EX1029	Kim Paper	W. Kim, System Level Analysis of Fast, Per-Core DVFS using On-Chip Switching Regulators, 14 th International Symposium on High Performance Computer Architecture, February 2008.
EX1030	Stenstrom Paper	P. Senstrom, A Survey of Cache Coherence Schemes for Multiprocessors, Computer, Volume 23, Issue 6, June 1990.
EX1031	Campbell	U.S. Patent No. 10,482,952
EX1032	Crandall	U.S. Patent No. 4,873,703
EX1033	Kato	U.S. Patent App. Pub. No. 2004/0210738
EX1034	Redstone / NXP Infringement Chart	Doc. No. 1-2, Exhibit 2 to Redstone's Complaint, <i>Redstone Logics LLC v. NXP Semiconductors N.V., et al.</i> , No. 7:24-cv-00028-DC-DTG (W.D. Tex.)
EX1035	Redstone / Qualcomm Infringement Chart	Doc. No. 14-2, Exhibit 2 to Redstone's Second Amended Complaint, <i>Redstone Logics LLC v. Qualcomm Inc., et al.</i> , No. 7:24-cv-00231-ADA (W.D. Tex.)
EX1036	Ishimi	U.S. Patent No. 8,200,878
EX1037	Vajda PCT	WO 2010/138031
EX1038	Williams Paper IEEE Webpage	IEEE Webpage for Williams et al., "Low Latency Clock Domain Transfer for Simultaneously Mesochronous, Plesiochronous and Heterochronous Interfaces," 13 th IEEE International Symposium on Asynchronous Circuits and Systems, 2007. https://ieeexploreonorthbridge.ieee.org/document/4137045 (last accessed on January 17, 2025).
EX1039	Tran Level Shifter Paper	C. Tran et al., "Low-power high-speed level shifter design for block-level dynamic voltage scaling environment," International Conference on Integrated Circuit Design and Technology, 2005.

Exhibit	Short Name	Description
EX1040	Williams Paper PDF Metadata	Screenshot of EX1008's pdf metadata, generated by Dr. Annavaram on January 20, 2025.
EX1041	NXP Return of Summons	Doc. No. 7, Proof of Service, <i>Redstone Logics LLC v. NXP Semiconductors N.V., et al.</i> , No. 7:24-cv-00028-DC-DTG (W.D. Tex.)
EX1042	Motion to Stay NXP Litigation	Doc. No. 61, Joint Motion to Stay All Deadlines and Notice of Resolution, <i>Redstone Logics LLC v. NXP Semiconductors N.V., et al.</i> , No. 7:24-cv-00028-DC-DTG (W.D. Tex.)
EX1043	Order Granting Stay of NXP Litigation	Doc. No. 62, Order Staying All Deadlines, <i>Redstone Logics LLC v. NXP Semiconductors N.V., et al.</i> , No. 7:24-cv-00028-DC-DTG (W.D. Tex.)
EX1044	Motion to Dismiss NXP Litigation	Doc. No. 64, Joint Motion to Dismiss, <i>Redstone Logics LLC v. NXP Semiconductors N.V., et al.</i> , No. 7:24-cv-00028-DC-DTG (W.D. Tex.)
EX1045	Order Dismissing NXP Litigation	Doc. No. 65, Order of Dismissal With Prejudice, <i>Redstone Logics LLC v. NXP Semiconductors N.V., et al.</i> , No. 7:24-cv-00028-DC-DTG (W.D. Tex.)

Pursuant to 37 C.F.R. §§ 42.5(a) and 42.71(a), and the Board’s authorization received on May 30, 2025, Co-Petitioner NXP USA, Inc. (“NXP”) moves to dismiss NXP as a Co-Petitioner in this proceeding. Termination of the entire proceeding pursuant to 35 U.S.C. §317 and 37 C.F.R. §42.72 is not appropriate because trial has not yet been instituted and, in any event, Co-Petitioner Qualcomm Incorporated remains. NXP has reached an agreement in principle, and the NXP Litigation has been dismissed with prejudice. NXP thus will not be pursuing this IPR. NXP was served with the Complaint in the NXP Litigation more than one year ago, so is precluded by 35 U.S.C. §315 from pursuing a future petition against the ’339 Patent. Dismissal of NXP as Co-Petitioner in this proceeding will conclude the dispute between Patent Owner and NXP with respect to the ’339 Patent.

I. LEGAL STANDARD

“The Board may ... dismiss any petition.” 37 C.F.R. 42.71(a). While that Rule does not expressly address dismissal of a petitioner, when there are two petitioners, dismissal of one is merely a subset of the Board’s authority to dismiss an entire petition. *See* 37 C.F.R. 42.5(a). Indeed, it is well established that the Board may terminate a party as co-petitioner without terminating the entire proceeding. *See, e.g., BMW of North America, LLC v. Mich. Motor Techs. LLC*, IPR2023-01233, Paper 9 (PTAB Nov. 16, 2023).

A proceeding may also be terminated before institution—*i.e.*, during the *preliminary proceeding* phase.¹ *See, e.g., Samsung Elecs. Co. v. Telefonaktiebolaget LM Ericsson*, IPR2021-00446, Paper 7 at 5 (PTAB Aug. 3, 2021).

“Less clear is 37 C.F.R. § 42.74, which also addresses settlement.” *Samsung*, IPR2021-00446, Paper 7 at 3. Although 35 U.S.C. §317 requires a written settlement agreement to terminate an instituted proceeding, there is no such statutory requirement to dismiss a petition or petitioner *before* institution. *See id.* at 3 (“Section 317 does not apply to dismissal or termination of a proceeding prior to institution.”). Nor does 37 C.F.R. 42.74(a) clearly require it:

As such, even though § 42.74(b) uses “proceeding” in the first instance to require that settlement agreements be in written form even for proceedings in the preliminary, pre-institution stage, in contrast, the language requiring parties to file settlement agreements is tied to, and a prerequisite for, “termination of the trial.” The second requirement is consistent with § 317. Conversely, to read the language requiring parties to file settlement agreements to apply to all “proceedings” would read out the language “before termination of the trial” from the Rule.

Samsung, IPR2021-00446, Paper 7 at 5.

¹ “*Preliminary Proceeding* begins with the filing of a petition ... and ends with a written decision as to whether a trial will be instituted.” 37 C.F.R. §42.02.

After careful analysis of relevant statutes and rules, the enlarged panel of four judges in *Samsung* permitted termination without filing a settlement agreement. *See Samsung*, IPR2021-00446, Paper 7 at 2-5. That panel did so over a dissent of one of the four judges who focused on the breadth of the “proceeding” in the first clause of §42.74(b) and viewed the second clause’s “shall be filed with the Board before the termination of the trial” as merely a timing requirement. *See Samsung*, IPR2021-00446, Paper 7 at 10-11 (Quinn, J. dissenting). At least one other panel subsequently agreed with that dissent. *See Biofrontera Incorporated v. Dusa Pharm., Inc.*, IPR2022-00056, Paper 7 at 3 (PTAB Dec. 28, 2021) (denying, without prejudice, a motion to dismiss the petition: “We agree with Judge Quinn.”).

Despite the uncertainty, Rule 42.74(b) has not been clarified. Nor has either decision (or apparently any other on this issue) been designated as precedential or informative. Thus, neither approach is binding on the panel in this proceeding.

However, NXP notes that after the Board’s respective panels took these different approaches, the Supreme Court decided *Loper Bright Enterprises v. Raimondo*, 603 U.S. 369 (2024). There, the Court’s primary holding was to overturn the *Chevron* doctrine but, in doing so, the Court made clear that federal agencies must find support for any exercise of discretion in statutory text. *See, e.g., id.* at 391 (noting the APA was enacted specifically to limit the potential for agencies to stray beyond statutory authority and scope), 411 (noting that even “statutory ambiguity

... is not a reliable indicator of actual delegation of discretionary authority to agencies.”).

Ultimately, and subject to binding judicial precedent, USPTO rules permit the Board to “determine a proper course of conduct in a proceeding for any situation not specifically covered by this part and may enter non-final orders to administer the proceeding.” 37 C.F.R. §42.5(a). As explained below, the Board should grant this motion without requiring a written agreement because there is no statutory authorization for such a requirement in this context.

II. FACTUAL BACKGROUND

On January 26, 2024, Patent Owner sued NXP for alleged infringement of the ’339 Patent in *Redstone Logics LLC v. NXP Semiconductors N.V., NXP B.V., and NXP USA, Inc.*, Case No. 7:24-cv-00028 (W.D. Tex.) (the “NXP Litigation”). EX1014.

On January 31, 2024, NXP was served with the complaint. EX1041.

On January 22, 2025, NXP and Co-Petitioner Qualcomm Incorporated (“Qualcomm”) filed a Petition requesting *inter partes* review of the ’339 Patent. *See* Paper 1. The Board has not yet issued an institution decision.

Patent Owner and NXP (but not Qualcomm) have reached an agreement in principle to settle their dispute, including for NXP to seek withdrawal as co-petitioner in this proceeding.

On May 1, 2025, Patent Owner and NXP moved to stay the NXP Litigation in view of their agreement in principle (*see* EX 1042), which the court granted on May 5. *See* EX1043.

On May 23, 2025, Patent Owner moved to dismiss with prejudice its claims against NXP (*see* EX1044), which the Court has now granted. EX1045.

NXP and Patent Owner have not yet executed a written agreement as of the filing of this motion.

III. ARGUMENT

Dismissal of Co-Petitioner NXP from this proceeding is appropriate because NXP and Patent Owner have reached an agreement in principle to resolve their dispute and jointly seek dismissal of NXP. Moreover, Qualcomm Incorporated remains as a petitioner in this proceeding, and NXP is barred by 35 U.S.C. §315(b) from pursuing another petition against the '339 Patent, so dismissal of NXP will have no impact on the Board's workload now or in the future.

That a co-petitioner may be dismissed or terminated is well settled. *See, e.g., BMW*, IPR2023-01233, Paper 9. So too is the notion that a proceeding may be terminated before institution. *See, e.g., Samsung*, IPR2021-00446, Paper 7 at 5.

Whether a co-petitioner must submit a copy of a settlement agreement to be dismissed as a petitioner pre-institution is, as noted above, less clear. On that issue, however, NXP submits that *Loper Bright* counsels in favor of not imposing such a

requirement because there is no statutory authorization to do so. *See, e.g., Loper Bright*, 603 U.S. at 391 (noting the APA was enacted specifically to limit the potential for agencies to stray beyond statutory authority and scope). Conditioning termination of an instituted IPR on the filing of a settlement agreement is consistent with 35 U.S.C. §317. However, conditioning dismissal of a co-petitioner before institution undoubtedly goes beyond what Congress chose to require. As the Supreme Court noted in *Loper Bright*, even “statutory ambiguity ... is not a reliable indicator of actual delegation of discretionary authority to agencies.” 603 U.S. at 411. Regardless, Section 317 lacks any ambiguity that might open the door to imposing additional requirements.

More particularly, looking to the statutory text of the AIA, Section 317 explicitly addresses only “[a]n inter partes review ***instituted*** under this Chapter....” 35 U.S.C. §317(a). Section 317 was enacted in parallel with Section 311, which authorizes the filing of “a petition to institute an inter partes review,” and Section 314, which addresses the threshold requirements for institution. 35 U.S.C. §§311, 314(a). Thus, Congress plainly knew that petitions would be filed before an IPR is instituted and that not all such petitions would result in an instituted IPR. Yet Congress made the decision to impose the requirements of Section 317 on ***only*** instituted IPRs. The Board should therefore follow Congress’ direction and not impose an additional requirement pre-institution. This approach “is consistent with

§317” and can be squared with the text of 37 C.F.R. §42.74(b). *Samsung*, IPR2021-00446, Paper 7 at 4 (“[T]o read the language [of §42.74(b)] requiring parties to file settlement agreements to apply to all ‘proceedings’ would read out the language ‘before termination of the trial’ from the Rule.”).

Nor would this approach do any disservice to the anticompetitive concerns raised in the *Samsung* dissent. *See, e.g., Samsung*, IPR2021-00446, Paper 7 at 7-9. Pre-institution withdrawal does not implicate those concerns. Before institution, the proceeding has not yet reached a point at which the Board has even indicated a willingness to reach a final written decision that would invoke Section 315(e). Moreover, Qualcomm Incorporated remains as a petitioner, such that this proceeding will continue despite NXP’s withdrawal. Indeed, whatever Congress’ “impetus for requiring settlement agreements in 1962,” that impetus was also present when drafting Section 317. *See Samsung*, IPR2021-00446, Paper 7 at 8. As such, it would be inappropriate for the Board to impose a pre-institution requirement beyond Section 317 based on policy considerations that plainly did not motivate Congress to impose that same pre-institution requirement. *Id.*; *see also* 35 U.S.C. §317 (limited to instituted IPRs).

NXP further submits that a federal agency may not exercise authority “in a manner that is inconsistent with the administrative structure that Congress enacted into law.” *ETSI Pipeline Project v. Missouri*, 484 U.S. 495, 517 (1988). Even before

Loper Bright, the Supreme Court explained in *Whitman v. American Trucking Associations* that an administrative agency (there, the EPA) could not consider certain cost factors where Congress had “expressly granted” the authority to consider those same factors in other statutory provisions but not in the provision at issue. 531 U.S. 457, 467 (2001); *see also Gen. Motors Corp. v. United States*, 496 U.S. 530, 541 (1990) (“The fact that Congress explicitly enacted an enforcement bar similar to the one proposed by petitioner in one section of the statute, but failed to do so in the section at issue in this case reinforces our refusal to import such a bar here.”); *Russello v. United States*, 464 U.S. 16, 23 (1983) (“[W]here Congress includes particular language in one section of a statute but omits it in another section of the same Act, it is generally presumed that Congress acts intentionally and purposely in the disparate inclusion or exclusion.”). Applying that principle here, there is no statutory authority for the Board to require a written agreement to dismiss a co-petitioner pre-institution. In Section 317, Congress expressly required such written agreements only where an IPR has been “instituted.” 35 U.S.C. § 317(a). It would contravene that clearly-expressed Congressional intent for the Board to impose that same requirement in an un-instituted proceeding, particularly where, as here, dismissal of NXP would have no impact on whether the overall proceeding continues with respect to Qualcomm.

For the foregoing reasons, dismissal of NXP as a co-petitioner from this proceeding is appropriate, even in the absence of a filed settlement agreement.

IV. CONCLUSION

For the reasons discussed above, NXP and Patent Owner respectfully request that the Board grant this joint motion to dismiss NXP as a co-petitioner.

Dated: May 30, 2025

Respectfully submitted,

/Eagle H. Robinson/

Eagle H. Robinson (Reg. No. 61,361)
*Lead Counsel for Co-Petitioner NXP
USA, Inc.*

Dated: May 30, 2025

Respectfully submitted,

/Reza Mirzaie/

Reza Mirzaie (Reg. No. 69,138)
*Lead Counsel for Patent Owner
Redstone Logics LLC.*

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), the undersigned certifies that on May 30, 2025, copies of Co-Petitioner NXP USA, Inc. and Patent Owner Redstone Logics LLC's Joint Motion to Dismiss NXP as a Co-Petitioner, and EX1041-EX1045, were served on Patent Owner via email (by consent) to:

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