

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.

IPR2025-00486

U.S. Patent No. 10,873,753

PETITIONERS' OPPOSITION BRIEF TO MOTION TO TERMINATE

EXHIBIT LIST

Exhibit No.	Description
1001	U.S. Patent No. 10,873,753 (the '753 patent)
1002	Prosecution History of the '753 patent
1003	Declaration of Donald Alpert, Ph.D.
1004	U.S. Patent App. Pub. No. 2013/0346667A1 ("Stroud")
1005	U.S. Patent No. 9,148,389 ("DaSilva")
1006	Harvey G. Cragon, Memory Systems and Pipelined Processors ("Cragon")
1007	U.S. Patent App. Pub. No. 2002/0087821 ("Saulsbury")
1008	U.S. Patent No. 8,015,386 ("Kulkarni")
1009	<i>Reserved</i>
1010	Kuon et al., "FPGA Architecture: Survey and Challenges" ("Kuon")
1011	Trimberger, "Three Ages of FPGAs: A Retrospective on the First Thirty Years of FPGA Technology" ("Trimberger")
1012	<i>Reserved</i>
1013	<i>Reserved</i>
1014	Frey, "The IBM Data Center Family" ("Frey")
1015	Desai et al., "BladeCenter system overview" ("Desai")
1016	Hughes et al., "BladeCenter processor blades, I/O expansion adapters, and units" ("Hughes")
1017	Caldeira et al., "IBM Power Systems S814 and S824 Technical Overview and Introduction" ("Caldeira")
1018	Steffen, "Nallatech Software Tools on the Maxwell FPGA Parallel Computer" ("Steffen")
1019	Nallatech, "H100 Series FPGA Application Accelerators" ("Nallatech")
1020	<i>Reserved</i>
1021	Exhibit C to Concurrent Ventures' and XstreamEdge's Oct. 11, 2024 Preliminary Infringement Contentions
1022	Declaration of J. Munford re Cragon
1023	IETF, RFC 6146 "Stateful NAT64: Network Address and Protocol Translation from IPv6 Clients to IPv4 Servers"
1024	U.S. Patent No. RE45708 ("Frantz")
1025	U.S. Patent No. 9,270,592 ("Sites")
1026	U.S. Patent No. 5,155,833 ("Cullison")
1027	U.S. Patent No. 5,586,293 ("Baron")

Exhibit No.	Description
1028	U.S. Patent App. Pub. No. 2018/0088853A1 (“Kotra”)
1029	U.S. Patent No. 9,959,212 (“Takeda”)
1030	U.S. Patent App. Pub. No. 2013/0318196A1 (“Yamamoto”)
1031	U.S. Patent App. Pub. No. 2006/0277365A1 (“Pong”)
1032	U.S. Patent App. Pub. No. 2006/ 0294308A1 (“Bailey”)
1033	U.S. Patent No. 10,847,196 (“Ware”)
1034	U.S. Patent No. 6,029,224 (“Asthana”)
1035	Concurrent Ventures’ and XstreamEdge’s March 29, 2024 Complaint in WDTX 1:24-cv-335
1036	Concurrent Ventures’ and XstreamEdge’s Jan. 23, 2025 Preliminary Claim Construction Disclosures
1037	Declaration of R. Jones re Cragon
1038	Microsoft, Microsoft Computer Dictionary (5th Ed., 2002) (excerpts)
1039	Chambers Dictionary (13th Ed., 2014) (excerpts)
1040	U.S. Patent App. Pub. No. 2014/0115137A1 (“Keisam”)
1041	Exhibit C to Concurrent Ventures’ and XstreamEdge’s Dec. 20, 2024 Supplemented Infringement Contentions
1042	Concurrent Ventures’ and XstreamEdge’s July 22, 2024 Response to Defendant’s Motion to Dismiss
1043	U.S. Patent No. 7,356,047 (“Mahalawat”)
1044	Chu, ENG-46158 rev 1.8 “Serial-GMII Specification”
1045	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)
1046	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)
1047	Judge Albright’s Standing Order Governing Proceedings (OGP)—Patent Cases, March 5, 2025
1048	Email to Judge Albright’s Law Clerks dated May 28, 2025
1049	Docket Navigator, Motion to Stay Pending Inter Partes Review success rate data for California Northern District (printed May 5, 2025)
1050	Opposed Motion to Stay Case Pending Resolution of Motion to Transfer
1051	Docket Navigator, Motion to Stay Pending Inter Partes Review success rate data for Judge Albright (printed May 6, 2025)

Exhibit No.	Description
1052	Lex Machina, time-to-trial data for Western District Texas (printed May 19, 2025)
1053	Judge Albright's May Calendar Printout (printed May 1, 2025)
1054	Order Regarding DII Docket (Dkt. 61) in <i>Concurrent Ventures, LLC v. Advanced Micro Devices, Inc.</i> , No. 1:24-cv-00335 (W.D. Tex. 2024)
1055	Scheduling Order (Dkt. 11) in <i>Irons v. Paccar, Inc.</i> , No. 1:24-cv-01553-ADA (W.D. Tex. 2024)
1056	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)
1057	Case Docket for <i>Parus Holdings, Inc. v. Google LLC</i> , No. 22-cv-07830-VC (N.D. Cal. filed June 4, 2021)
1058	Sotera Stipulation (Dkt. 78) in <i>Concurrent Ventures, LLC v. Advanced Micro Devices, Inc.</i> , No. 1:24-cv-00335 (W.D. Tex. 2024)
1059	Judge Albright's June, 5 to July 5, 2025 Calendar Printout (printed June 5, 2025)
1060	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.)
1061	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 and XtreamEdge, Inc. v. Advanced Micro Devices, Inc. and Pensando Systems, Inc.</i> , No. 1:24-cv-00335-ADA (W.D. Tex. 2024)
1062	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 October 22, 2025)
1063	Court's October 20, 2025 Order Setting Hearing for Petitioners' Motion to Transfer to October 27, 2025 (Dkt. 116) for <i>Concurrent Ventures, LLC v. Advanced Micro Devices, Inc.</i> , No. 1:24-cv-00335 (W.D. Tex. filed March 29, 2024).
1064	Defendants' Stipulation Regarding Invalidity Contentions (Dkt. 182) in <i>Concurrent Ventures, LLC v. Advanced Micro Devices, Inc.</i> , No. 4:25-cv-09567 (N.D. Cal.).
1065	Emails regarding Request for Authorization to File Motion to Terminate Proceeding

Exhibit No.	Description
1066	Batts Declaration (Dkt. 190-1) in Concurrent Ventures, LLC v. Advanced Micro Devices, Inc, No. 4:25-cv-09567 (N.D. Cal.).
1067	Emails regarding Meet & Confer regarding Plaintiffs' Interrogatory Responses
1068	Motion Regarding Enforcement of <i>Sotera</i> Stipulation (Dkt. 190) in Concurrent Ventures, LLC v. Advanced Micro Devices, Inc, No. 4:25-cv-09567 (N.D. Cal.).
1069	Order Denying the Motion to Expedite (Dkt. 194) in Concurrent Ventures, LLC v. Advanced Micro Devices, Inc, No. 4:25-cv-09567 (N.D. Cal.).
1070	Corrected Brief for Intervenor-Acting Director of the US PTAB (Dkt. 35) in Carolyn W. Hafeman v. Google LLC, Microsoft Corporation, No. 24-1600 (CAFC).

I. Introduction

The PTAB instituted the present IPRs for good reason, because Petitioners have a reasonable likelihood of prevailing. Attempting to derail IPRs in which the parties have expended significant time and resources, Patent Owners concocted a purported *Sotera* violation—and rushed to obtain Director Review before even conducting a PTAB meet and confer as required by PTAB guidelines. There is no violation or any grounds for termination. Petitioners have diligently and repeatedly made clear, in writing and by stipulation that they will abide by their *Sotera* Stipulation. The PTAB has reiterated a concern for duplicative proceedings/inefficient use of resources, the very reason for *Sotera* stipulations. There is no risk of duplicative or overlapping proceedings here. There is no basis to terminate this IPR, as Petitioners have acted in good faith and consistent with their *Sotera* commitment while navigating the new de-institution phenomena and have shown a willingness to compromise to resolve any issues and ensure fairness.

II. Background

A. Procedural History

Patent Owners asserted the three challenged patents in the Western District of Texas in March 2024. Petitioners filed their IPR petitions between December 2024 and March 2025, and a *Sotera* Stipulation in the district court on April 22, 2025, stipulating that they will not pursue the specific grounds of the IPR, or any other ground for which the Board institutes, that was raised or could have been

reasonably raised in an IPR. *See, e.g.,* EX1058 at 3–4. All three IPRs were instituted. The district court case was transferred to the Northern District of California in November 2025.

During the pendency of the district court litigation, significant developments were taking place in PTAB practice. Since Acting Director Stewart took over in 2025 and continuing with Director Squires, the PTAB began de-instituting IPRs for a number of new reasons, including § 101 challenges in district court, inconsistent claim constructions, RPI issues, and overlapping invalidity adjudication. *See, e.g., Hulu, LLC v. Piranha Media Distribution, LLC*, IPR2024-01252, Paper 27 (Acting Dir. Apr. 17, 2025); *Revvo Techs., Inc. v. Cerebrum Sensor Techs., Inc.*, IPR2025-00632, Paper 20 (Dir. Nov. 3, 2025); *Yangtze Memory Techs. Co. v. Micron Tech., Inc.*, IPR2025-00098, IPR2025-00099, Paper 38 (Dir. Jan. 15, 2026); *Green Revolution Cooling, Inc. v. Midas Green Techs., LLC*, IPR2025-00196, Paper 15 (Acting Dir. July 25, 2025).

B. Petitioners’ Invalidity Contentions and Patent Owners’ Response

As a result of the transfer, the parties each updated their pleading and contentions to comply with the Northern District of California’s Local Patent Rules. Unlike Texas, the Northern District of California requires defendants to disclose “each item of prior art that allegedly anticipates each asserted claim or

renders it obvious.” Patent L.R. 3-3 (N.D. Cal.) (emphasis added).¹ Petitioners served invalidity contentions on February 13, 2026. Mindful of the emerging practice of IPR de-institution discussed above, Petitioners included the grounds asserted in the IPRs and other prior art references of which they were aware in order to comply with the Patent Local Rules and to reserve their rights in the event of de-institution. Petitioners even expressly labeled certain art as having been asserted in the IPRs. *See, e.g.*, EX3105 at 10 (referencing “prior art as explained by Defendants’ Petition for Inter Partes Review . . . incorporated herein by reference.”).

Shortly thereafter, among numerous other deficiency letters for the district court litigation, Patent Owners sent a letter with an extensive list of complaints regarding the invalidity contentions. EX2037. The letter made no reference to seeking any relief from the PTAB or requesting termination of the IPRs. While Petitioners were preparing a response, Patent Owners sent an email to the Board and Director on March 9, 2026 seeking to file a motion to vacate institution and alleging that Petitioners had violated the *Sotera* Stipulation. They did so before providing any notice to Petitioners of their plan to seek a motion to vacate, or conducting any meet and confer as required by the Scheduling Order in this

¹ As explained below, courts interpret this as requiring disclosure of all prior art regardless of whether the party intends to assert it. *See* Section IV.A.4.

proceeding and the PTAB Consolidated Practice Guide. *See Consolidated Practice Guide at 37; Paper 12 at 2.*

C. Petitioners’ Good-Faith Efforts to Resolve the Dispute

After Patent Owners’ e-mail to the Director, Petitioners immediately reached out to Patent Owners’ counsel to meet and confer and resolve the current disputes. Petitioners repeatedly made clear that they would continue to abide by their *Sotera* commitment, and would not pursue any covered invalidity grounds in the district court so long as the IPRs remain instituted. EX1065 at 6; EX2039 at 2. Not stopping there, and to avoid any ambiguity, Petitioners filed a second stipulation in the district court confirming that they continued to abide by the original *Sotera* Stipulation, which always remained in force. EX1064. The second stipulation further explained that because of the practice of “de-instituting” instituted IPRs, Petitioners included in their contentions the full set of disclosures of prior art required under the Local Rules, but also specifically identified the prior art grounds that could have been raised in the IPRs and reaffirmed that none of those grounds would be pursued in the district court litigation. *Id.*

The Director initiated review “to consider whether Petitioners have violated their *Sotera* stipulation” and stayed the current proceedings pending Director Review (Paper 30 at 2). At that time, the Director did not have the benefit of full information, including Petitioners’ new stipulation and repeated written and verbal

communications to Patent Owners that removed any possible confusion and confirmed none of the prior art at issue or potentially in the IPRs was being pursued in the district court litigation.

In subsequent meet-and-confers and correspondence, Petitioners further confirmed their commitment to continue abiding by the *Sotera* Stipulation and not to pursue any grounds covered by it, again explaining that the prior art references and IPR grounds were included in the contentions to preserve Petitioners' rights in the event of de-institution. EX1065 at 6–8; EX1066, ¶ 2.

Petitioners efforts did not end there. Petitioners asked Patent Owners: if Petitioners were to withdraw the prior art and grounds covered by the *Sotera* Stipulation from their invalidity contentions, would that resolve Patent Owners' concerns, and if not, what remaining concerns persisted after Petitioners' second stipulation? EX1065 at 6–8; EX1066, ¶ 2(iii). Patent Owners declined to answer either question and refused to identify what would resolve the dispute. *Id.* Notably, Patent Owners failed to identify any potential prejudice in light of Petitioners' reiterated commitment and second stipulation. Patent Owners stated that they would continue to pursue a motion to terminate the IPRs and further confirmed that they would proceed with the motion to strike in district court even if the IPRs were de-instituted. EX1067 at 1; EX1066, ¶ 2(iv).

D. Petitioners Promptly Filed a *Sotera* Determination Motion in District Court

During the meet-and-confer process, Petitioners explained to Patent Owners that the determination of whether a *Sotera* violation occurred would need to be decided by the district court, according to both the PTAB and established case law. To avoid any delay in the resolution of the motions to terminate, Petitioners expeditiously filed a motion in the district court on March 20, 2026 (the same day Patent Owners filed their brief here) seeking a judicial determination that no *Sotera* violation has occurred. EX1068. Petitioners simultaneously moved for expedited briefing on their motion, but Patent Owners opposed, and the district court denied the motion to expedite, stating that it will issue a ruling on the standard schedule, which may nevertheless assist the Director. EX1069.

III. The District Court is properly considering whether there was a *Sotera* violation, and should be permitted to reach a decision.

Petitioners do not contend that the Director lacks authority to conduct a Director Review of the IPR proceedings, as Patent Owners allege. Mot. at 14, 20. Instead, Patent Owners were wrong to ask the Patent Office to determine whether there was a *Sotera* violation because that question must be determined by the district court where the stipulation is in effect. Patent Owners conflate these two issues to create a misperception of Petitioners' positions and to sow doubt as to Petitioners' motives. But Petitioners are not afraid of a *Sotera* determination—it is

Patent Owners who refused to expedite briefing on the issue. EX1067 at 1.

Petitioners are following clear precedent and law. The USPTO has consistently and repeatedly declined to decide *Sotera* violation disputes and instead directed parties to the district courts. *See, e.g., Samsung Elecs. Co. v. Netlist, Inc.*, IPR2022-00639, -00711, -00996, -00999, Paper 26 at 2 (P.T.A.B. Jan. 18, 2023) (declining to find violation, “[a]ny dispute regarding the scope or alleged violation of [*Sotera*] stipulations proffered by a party should be addressed in the district court proceedings in which such stipulations are to have effect.”); *Lightspeed Com. Inc. v. CloudfChange, LLC*, Nos. IPR2022-00779, -00997, -01143, Paper 28 at 3 (P.T.A.B. July 25, 2023); *Apple Inc. v. Maxell, Ltd.*, IPR2020-00204, Paper 21 at 10 (P.T.A.B. Dec. 15, 2020). Recently, the USPTO Solicitor reconfirmed this position before the Federal Circuit. EX1070 at 2, 11 (contending that “any dispute regarding the scope or alleged violation of [*Sotera*] stipulations should be addressed in the district court proceedings in which such stipulations are to have effect.”).

Indeed, Petitioners are not aware of any proceeding where the USPTO has determined whether there was a *Sotera* violation. And this absence makes sense because disputes arising from a litigation stipulation should be adjudicated by the court in which it is in effect. A *Sotera* Stipulation governs party behavior exclusively in the district court. *See* EX1058 at 4 (concerning grounds

“Defendants will not pursue in this [district court] case . . .”). Whether a litigation stipulation has been breached is analyzed under contract law principles. *Kokkonen v. Guardian Life Ins. Co. of Am.*, 511 U.S. 375, 381 (1994); *Tex. Instruments Fed. Credit Union v. DelBonis*, 72 F.3d 921, 928 (1st Cir. 1995) (“Litigation stipulations can be understood as the analogue of terms binding parties to a contract.”); *Jeff D. v. Andrus*, 899 F.2d 753, 759 (9th Cir. 1989) (“We rely on basic contract principles to interpret the Stipulation.”). The adjudication of a *Sotera* Stipulation is a matter of private right rooted in the parties’ contractual duties. The power to adjudicate such questions belongs exclusively to Article III courts. *N. Pipeline Constr. Co. v. Marathon Pipe Line Co.*, 458 U.S. 50, 90 (1982).

Accordingly, district courts have been the forum where alleged *Sotera* violations have been adjudicated², and, as explained above, the USPTO has consistently respected this jurisdictional distinction, consistent with its institutional role as an agency with specialized expertise in patent validity—not stipulation disputes. *See* 35 U.S.C. §§ 2, 6.

² *See, e.g., Sonrai Memory Ltd. v. Micron Tech., Inc.*, No. 1:23-CV-01407-ADA, 2024 WL 5185359, at *1 (W.D. Tex. May 20, 2024); *Facet Techs., LLC v. LifeScan, Inc.*, No. 2:22-cv-01717-MCS (MARx), 2024 WL 308292, at *7 (C.D. Cal. Jan. 3, 2024); *Pictiva Displays Int’l Ltd. v. Samsung Elecs. Co.*, No. 2:23-CV-00495-JRG-RSP, 2025 WL 2982341, at *6 (E.D. Tex. Oct. 22, 2025).

Petitioners are confident that no *Sotera* violation has occurred and promptly filed a motion with the district court for such a determination. Patent Owners contradict themselves by stating that the district court is being asked to make an advisory opinion (Mot. at 14), while arguing that Petitioners violated the stipulation by serving the invalidity contentions, making the issue ripe for decision by the district court. EX1067 at 1; EX1066, ¶2(iv). As the IPRs are stayed, the Director can await the district court ruling before deciding the instant motions.

IV. Even without the District Court determination of no *Sotera* violation, the Director should deny the motions to terminate.

If the Director is inclined to make a decision without awaiting a determination by the district court of whether a *Sotera* violation occurred, the termination motions should still be denied. Petitioners acted in good faith and have not prejudiced Patent Owners.

A. Petitioners Have Acted Properly

1. Petitioners' Binding Commitments Foreclose Any Possibility of Violation or Prejudice to Patent Owners

Contrary to Patent Owners' mischaracterization, Petitioners did not "double down" on any violation (Mot. at 5)—Petitioners' repeated, binding commitments, including their second stipulation, did the opposite. A *Sotera* dispute arises where a defendant affirmatively seeks to pursue disputed grounds in the district court, such as in expert reports, at summary judgment, or at trial. *See, e.g., Hafeman v. LG Elecs., Inc.*, No. 6:21-CV-00696-ADA, 2023 WL 4362863, at *1 (W.D. Tex.

Apr. 14, 2023) (denying summary judgment based on estopped grounds). This case is the opposite: Petitioners provided conditional disclosure of prior art grounds for compliance with the Patent Local Rules while reaffirming, both verbally and in writing, that those grounds will not be pursued so long as the IPRs remain instituted—this encompasses discovery, expert reports, summary judgment and trial. *See supra* § II.C. Indeed, two stipulations are now in force in the district court: the original *Sotera* Stipulation, covering all asserted grounds and any other ground that was raised or could have been reasonably raised; and a second stipulation specifically addressing prior art grounds identified in the Patent Owners’ letter. It is clear: Petitioners have disclosed but are not pursuing grounds covered by their stipulations.³ EX1064. Thus while Patent Owners complain about dozens of invalidity grounds that will be adjudicated in district court (Mot. at 9), that would only happen should the IPRs be de-instituted.

2. There Are No Grounds Unaddressed by Petitioners’ Binding Commitments

Patent Owners incorrectly allege that Petitioners “fail[] to address many of the violative grounds” and “[r]emain in violation.” Mot. at 7. First, the second

³ Patent Owners’ attempt to assert prejudice (Mot. at 13) is disingenuous. They do not need to address the grounds covered by the stipulations, and provide no plausible basis for needing to do so.

stipulation makes absolutely clear that Petitioners “will not pursue in this case any ground that was raised or could have been reasonably raised in th[e] IPRs... which includes...” EX1064 at 1. Second, Patent Owners complaints merely invent nonexistent loopholes in Petitioners’ Stipulations. They allege Petitioners assert “anticipation” based on Gewirtz, Jana, and Schultz. *See* Mot. at 7, 4, 9, 12. Not so. The charts include boilerplate language, but the invalidity contentions only chart obviousness for each of these references, not anticipation. EX3105 at 7 (listing Gewirtz as “O” meaning obviousness grounds only), 59 (same for Jana), 75 (same for Schultz).⁴ And any overlapping obviousness grounds are expressly addressed and covered by Petitioners’ stipulations. EX1064 at 2 (listing all printed publication combinations based on Jana); 2–3 (same for Gewirtz). Further, each of the prior art items/grounds Patent Owners appear to flag as a violation (Mot. at 3–5) is also covered by both Stipulations. *See, id.*; EX1058 at 1–3.

Finally, Patent Owners allege Petitioners violated their duty of candor by committing a “*Revvo* violation”—by advancing inconsistent claim construction positions through indefiniteness challenges. Mot. at 13. No such inconsistency exists. Petitioners argued only that Patent Owners’ proposed constructions, if adopted, would render the claims indefinite. *See, e.g.*, Ex3105 at 122 (“For the

⁴ *See also id.* at 10, 60, and 78 (further explaining that anticipation was only asserted for references that were identified as anticipation (“A”) references).

claim terms . . . Plaintiffs’ claim interpretations and proposed constructions rendered these limitations indefinite under 35 U.S.C. § 112.”) (emphasis added), 128, 130. This is entirely consistent with Petitioners’ positions across both forums, where Petitioners proposed their own claim constructions. *See, e.g.*, -478, Paper 2, at 8–9.

3. There Is No Risk of Overlapping Determinations or Inconsistent Decisions Across the Proceedings

The Director has consistently noted a concern for duplicative proceedings or duplicative adjudications on invalidity issues, an issue *Sotera* stipulations are designed to address. The Director recently ordered de-institution where the ITC had recently adjudicated the validity of the challenged patent, noting that maintaining the IPR would be inefficient and a waste of Board resources. *Sinclair Pharma Ltd. v. Hydrafacial LLC*, IPR2025-00145, Paper 41 (Dir. Feb. 12, 2026). That concern does not exist here because there is and there will be, no overlap between the two forums: Petitioners have repeatedly confirmed and stipulated that they will not pursue written prior art grounds as long as the IPRs are instituted.

4. Precautionary Disclosure for Notice Purposes Does Not Violate the *Sotera* Stipulation

Petitioners’ disclosure of prior art references in their invalidity contentions was proper, and Petitioners are not pursuing those grounds. Invalidity contentions serve an early discovery function of identifying prior art, and district courts require

disclosure of all such prior art regardless of whether it will be pursued. *Catch a Wave Techs., Inc. v. Sirius XM Radio, Inc.*, No. C 12-05791 WHA, 2014 WL 186405, at *2 (N.D. Cal. Jan. 16, 2014). No duplication of effort or inconsistent rulings are triggered by such bare disclosure of prior art, especially when coupled with stipulations that the grounds are not being pursued in the litigation.

Despite Petitioners' faithful compliance with Local Rules and the repeated explanations that Petitioners are not pursuing the grounds covered by the *Sotera* Stipulation, Patent Owners' brief is replete with unfounded aspersions and accusations leveled against Petitioners, including allegations that Petitioners were somehow "caught" and that Petitioners "willfully violated" the *Sotera* Stipulation. Mot. at 5, 1. To the contrary, as explained, Petitioners complied with the district court's rules to provide early disclosure, not concealment, while repeatedly explaining their approach and position. Instead Patent Owners seek to trap Petitioners with a "Catch-22": simultaneously faulting Petitioners for not amending their contentions to remove the covered grounds, Mot. at 1 ("Still today, Petitioners have not amended their contentions to remove the violative assertions"); asserting that Petitioners cannot amend their invalidity contentions, EX2037 at 5 ("Defendants may not reserve the right to amend their invalidity contentions"); and at the same time contending that even amendment would not cure the alleged violation and would only confirm it. Mot. at 12–13 (alleging that if a *Sotera*

violation occurs, all covered grounds are irrevocably lost). Patent Owners reveal their true intentions—to take a swing at a “gotcha” that is not based on facts and to feign concern with duplicative proceedings despite no overlap existing.⁵

B. Petitioners’ Actions Were in Good Faith, Such that the Motions Should Be Denied

As explained, Petitioners have acted in good faith to address the new and evolving practice of de-institutions. To date, Petitioners are unaware of any prior litigation where the intersection between IPR de-institutions and *Sotera* Stipulations has been addressed. Petitioners have made clear, and continue to make clear, that they will abide by their *Sotera* commitments. Similarly, the PTAB has not yet had the opportunity to provide any guidance about *Sotera* Stipulations and de-institutions of IPRs. Without any guidance from the PTAB to date on how petitioners should approach their district court discovery disclosure obligations in light of a possible IPR de-institution, Petitioners took the reasonable

⁵ Patent Owners’ assertion that the purpose of a *Sotera* Stipulation is to “irrevocably surrender[] certain rights” (Mot. at 12), is contrary to case law and the reasoning of the Stipulations. The reasons for the stipulation (avoiding duplicative efforts and potentially conflicting decisions) disappear upon de-institution. And a condition precedent of the stipulation is institution of IPRs, which condition precedent is nullified by de-institution as if it never occurred.

approach of disclosing, but not pursuing grounds that are covered by the *Sotera* Stipulation.

Petitioners are mindful that the Director has repeatedly made clear that overlapping adjudications are an inefficient use of Board resources. But here, there would not be any overlap because the disputed grounds would not be pursued as long as the IPRs remain instituted. Furthermore, the parties have already invested substantial resources in the IPRs, and terminating them now compromises the intended purpose of the AIA to increase patent quality. To avoid these outcomes, at a minimum, the Director should give AMD the opportunity to resolve the issue. Petitioners remain willing to work with Patent Owners to reach a resolution on this issue and to address any concerns the Director might have with their approach to this developing practice. Petitioners welcome any guidance the Director might wish to provide in this regard.

V. Conclusion

Petitioners respectfully request the Director deny the motion to terminate.

Respectfully submitted,

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CERTIFICATE OF COMPLIANCE

This Petitioners' Opposition Brief complies with the fifteen-page limit authorized by the Director's Order Initiating Sua Sponte Director Review and Authorizing Motion to Vacate and Terminate the Proceedings. Petitioners are authorized to file a fifteen-page response no later than March 27, 2026. This brief comprises 15 pages, as counted using the Microsoft Word software that was used to prepare this paper.

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that on March 27, 2026, a true and correct copy of the Petitioners' Opposition Brief to Motion to Terminate was served in entirety via email to all parties to this proceeding at the addresses indicated:

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