

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INFINEON TECHNOLOGIES AMERICAS CORP.
Petitioner,

v.

MOSAID TECHNOLOGIES INC.,
Patent Owner.

Inter Partes Review No. IPR2025-01711
Patent No. 7,051,306

PATENT OWNER'S DISCRETIONARY DENIAL BRIEF

~~CONTAINS CONFIDENTIAL AND
CONFIDENTIAL ATTORNEYS' EYES ONLY MATERIAL~~

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PATENT OWNER'S EXHIBIT LIST

Exhibit	Description
2001	Reserved
2002	Reserved
2003	Reserved
2004	March 10, 2025 WDTX Complaint for Patent Infringement (1:25-cv-358) [Complaint]
2005	November 3, 2017 Notice Letter to Cypress Semiconductor Corporation [11/03/17 Letter] (CONFIDENTIAL)
2006	Scheduling Order in <i>MOSAID Technologies Inc. v. Infineon Technologies AG, et al.</i> , No. 1:25-cv-00358 (W.D. Tex.), Dkt. 30 (July 25, 2025) [Scheduling Order]
2007-2011	Reserved
2012	Declaration of Boris Teksler [Teksler-Decl.] (CONFIDENTIAL – ATTORNEYS' EYES ONLY)
2013	Press Release, Infineon Technologies AG completes acquisition of Cypress Semiconductor Corporation (Apr. 16, 2020) [Press-Release-Cypress]
2014	Letter from Cypress (May 5, 2019) [05/05/19 Letter] (CONFIDENTIAL)
2015	Response Presentation (April 2018) [04/18 Presentation] (CONFIDENTIAL)
2016	Claim Chart (April 2018) [04/18 PSoC Claim Chart] (CONFIDENTIAL)
2017	Response Presentation (Sept. 26, 2018) [09/26/18 Conversant Presentation] (CONFIDENTIAL)

Exhibit	Description
2018	Response Presentation (June 21, 2019) [06/21/19 Conversant Response Presentation] (CONFIDENTIAL)
2019	Response Presentation (Dec. 4, 2019) [12/04/19 Conversant Presentation] (CONFIDENTIAL)
2020	Response Presentation (July 14, 2020) [07/14/20 Conversant Response] (CONFIDENTIAL)
2021	Response to Cypress' September 9, 2020 Comments US 7,051,306 (March 11, 2021) [03/11/21 Conversant Presentation] [CONFIDENTIAL]
2022	MOSAID – Infineon/Cypress Presentation (February 28, 2023) [02/28/23 MOSAID-Infineon/Cypress Presentation] (CONFIDENTIAL)
2023	Excerpts of File History for U.S. Patent No. 7,899,145 ['145-FH]
2024	Excerpts of File History for U.S. Patent No. 8,290,109 ['109-FH]
2025	Infineon's Preliminary Invalidity Contentions in <i>MOSAID Technologies Inc. v. Infineon Technologies AG, et al.</i> , No. 1:25-cv-00358 (W.D. Tex.) (served Aug. 15, 2025) [Invalidity Contentions]
2026	Letter from Cypress (August 1, 2018) [08/01/18 Letter] (CONFIDENTIAL)

I. INTRODUCTION

Under the Director’s decisions, the Petition should clearly be denied due to the Patent Owner’s overwhelmingly strong settled expectations and under *Fintiv*.

Settled expectations. The Director has consistently found that patents that issued six or more years ago give rise to strong settled expectations warranting a denial of institution. *See* Section III.A (citing decisions). Here, the ’306 patent issued ***19 years ago and expired over a year ago***. Additionally, the ’306 patent was (i) licensed [REDACTED], (ii) licensed by [REDACTED] [REDACTED] technological space, and (iii) asserted against semiconductor companies in seven separate district court litigations prior to the present litigation with Infineon. The ’306 patent was, moreover, the subject of extensive, detailed negotiations between Patent Owner and Petitioner’s predecessor between November 2017 and August 2024 during which Patent Owner repeatedly made clear that Petitioner’s PSoC 6 products infringed, *inter alia*, claim 16—the same claim/product identified in Patent Owner’s complaint. *See* Ex. 2004 [Complaint] ¶¶ 128–154. Despite all of this knowledge, Petitioner did not challenge the ’306 patent’s validity until 2025.

Fintiv. *Fintiv* additionally favors denial. No stay has been sought and no stay is likely. The parties have exchanged infringement and invalidity contentions and by the institution decision deadline will have completed claim construction and discovery will be ongoing. By the time of the Final Written Decision (“FWD”)

discovery will have completed, the final pretrial conference will have occurred, dispositive motions and *Daubert* motions will have been briefed, and trial will soon commence. Further, the FWD associated with the recently filed IPR against another patent-in-suit (the '448 patent) would not be due until after the trial date.

II. FACTUAL BACKGROUND

The '306 patent issued on May 23, 2006 and expired in May 2024. Ex. 2009 ['306 Patent]. It is asserted in *MOSAID Technologies Inc. v. Infineon Technologies AG, et al.*, No. 1:25-cv-00358 (W.D. Tex.) ("District Court Action") along with two other patents, U.S. Patent Nos. 7,111,179 and 7,394,448. While Petitioner filed the present petition on June 20, 2025, Petitioner waited over two months to file IPR2025-01489 challenging the '448 patent and still has not filed an IPR challenging the '179 patent. As discussed below, the '306 patent has been extensively licensed (including by Infineon) and litigated and has been the subject of lengthy negotiations between Patent Owner and Petitioner dating back to 2017.

A. The '306 Patent Has Been Licensed To [REDACTED] [REDACTED] In The Semiconductor Space.

The '306 patent has been broadly licensed. [REDACTED]

[REDACTED]
[REDACTED] Ex. 2012 [Teksler-Decl.] ¶¶ 8–10. The '306 has also been licensed to [REDACTED]
[REDACTED] semiconductor and processor companies, including [REDACTED]
[REDACTED]

██████████. *Id.*, ¶¶ 9–10. Indeed, “██████████
██████████.” *Id.*, ¶ 11.

B. The '306 Patent Was Asserted In Seven District Court Actions Between 2011–2024 Prior To Its Assertion Against Infineon.

The '306 patent was asserted in seven district court actions. *MOSAID Techs. Inc. v. Freescale Semiconductor, Inc., et al.*, No. 6:11-cv-00173 (E.D. Tex.) (filed Apr. 7, 2011); *ARM Ltd., et al., v. MOSAID Techs. Inc.*, No. 3:11-cv-03869 (N.D. Cal.) (filed Aug. 5, 2011), transferred to E.D. Tex. (No. 6:12-cv-00008); *MOSAID Techs. Inc. v. ST-Ericsson, Inc.*, No. 6:12-cv-00845 (E.D. Tex.) (filed Nov. 5, 2012); *MOSAID Techs. Inc. v. NXP Semiconductors USA, Inc.*, No. 6:12-cv-00846 (filed Nov. 5, 2012); *MOSAID Techs. Inc. v. Xilinx, Inc.*, No. 6:12-cv-00847 (E.D. Tex.) (filed Nov. 5, 2012); *Conversant Intell. Prop. Mgmt. Inc. v. STMicroelecs., Inc.*, No. 6:12-cv-00848 (E.D. Tex.) (filed Nov. 5, 2012); *MOSAID Techs. Inc. v. MediaTek Inc., et al.*, No. 2:23-cv-00129 (E.D. Tex.) (filed Mar. 28, 2023). MediaTek challenged the '306 in IPR2024-00598 ("MediaTek IPR") which settled.

C. Patent Owner's Predecessor-In-Interest Had Actual Knowledge Of At Least The '306 Patent's Application By 2010.

In addition to Infineon’s actual license, Petitioner’s predecessor-in-interest, Cypress Semiconductor Corporation,¹ also had actual knowledge of at least the ’306 patent’s Application Publication No. 2004/0268278 (the “Hoberman Publication”) dating back to 2010–2011, when the reference was the basis for multiple rejections during prosecution of Cypress’s own patents. Ex. 2023 [’145-FH] 116–137 (in 2010, multiple claims anticipated or obvious in view of Hoberman Publication); *id.*, 105–114 (cancelling and amending claims); Ex. 2024 [’109-FH] 206–216 (in 2011, multiple claims anticipated or obvious in view of Hoberman Publication); *id.*, 188–196 (amending claims in response). Thus, Cypress was certainly aware of the ’306 patent’s application by at least 2010–2011.

D. Petitioner And Patent Owner Have Engaged In Extensive, Detailed Discussions Concerning The ’306 Patent Dating Back To 2017.

Patent Owner and Petitioner (including Cypress) had detailed discussions concerning Petitioner’s infringement between 2017 and 2024. On November 3, 2017—nearly eight years ago—Patent Owner (previously named Conversant Intellectual Property Management before changing its name back to MOSAID in

¹ Petitioner and/or its German parent acquired Cypress Semiconductor Corporation, along with its portfolio of microcontrollers and other semiconductor products, in April 2020. Ex. 2013 [Press-Release-Cypress].

2021), sent Cypress a notice letter stating that “[REDACTED]
[REDACTED]
[REDACTED]” Ex. 2005 [11/03/17 Letter] 1. [REDACTED]
[REDACTED], the same products-at-issue in the District Court
Action. *See id.*, 2; Ex. 2004 [Complaint] ¶¶ 128–154. In April 2018,
Conversant/MOSAID [REDACTED]
[REDACTED]—the same claim identified in the Complaint. Ex. 2015 [04/18 Presentation]
11 (“[REDACTED]
[REDACTED]”); *see also, id.*, 2–10; Ex. 2016 [04/18
PSoC Claim Chart]. The parties exchanged [REDACTED]
[REDACTED]
[REDACTED]. *See, e.g.*, Ex. 2017 [09/26/18 Conversant Presentation] 2–15; Ex. 2018
[06/21/19 Conversant Response Presentation] 2–15; Ex. 2019 [12/4/19 Conversant
Presentation] 2–15; Ex. 2020 [07/14/20 Conversant Response] 1–9; Ex. 2021
[03/11/21 Conversant Presentation] 1–7; Ex. 2022 [02/28/23 MOSAID-
Infineon/Cypress Presentation] 7. In each of these presentations, Patent Owner made
clear its contention that [REDACTED]
[REDACTED].

E. The District Court Action.

The District Court Action is far along. Patent Owner served its infringement contentions months ago on June 20, 2025, and Petitioner served its invalidity contentions on August 15, 2025. Ex. 2006 [Scheduling Order] 1–2. Claim construction is in progress, the *Markman* hearing is scheduled for December 4, 2025, and claim construction is expected to conclude weeks before the January 8, 2026 institution deadline. *Id.*, 2–3. By the time of the institution decision, the parties will have exchanged initial disclosures and fact discovery will be underway. *Id.*, 3. By the January 8, 2027 FWD, the parties will have exchanged final contentions, completed discovery, conducted dispositive motion briefing, and concluded the final pretrial conference. *Id.*, 4–5. Trial is set for January 25, 2027. *Id.*, 5.

III. ARGUMENT

Institution should be denied as a consequence of Patent Owner’s strong settled expectations (Section III.A) and under *Fintiv* (Section III.B).

A. Settled Expectations Overwhelmingly Favor Denial.

Patent Owner’s strong settled expectations overwhelmingly favor denying institution. Here, the ’306 patent issued in 2006—over 19 years ago—and expired over a year ago. What is more, the ’306 patent was licensed to [REDACTED] [REDACTED] in Petitioner’s technological space (the semiconductor industry), was asserted in seven other district court litigations (prior to the present District

Court Action), and was the subject of extensive discussions between the parties dating back to 2017. *See* Section II.A-D. These facts present a clear case for denial.

The Director has made clear that “settled expectations” generally bar institution as to a patent that issued six or more years ago. *See, e.g., Yangtze Memory Techs. Co., Ltd. v. Micron Tech., Inc.*, IPR2025-00500, Paper 10, 2 (Aug. 14, 2025) (strong settled expectations for patent issued in November 2019); *Kahoot! AS v. Interstellar Inc.*, IPR2025-00696, Paper 12, 2 (July 31, 2025) (“the challenged patent has been in force for over six years, creating strong settled expectations”); *Amgen Inc. v. Bristol-Myers Squibb Co.*, IPR2025-00602, Paper 9, 3 (July 24, 2025) (similar); *Samsung Elecs. Co., Ltd. v. GenghisComm Holdings*, IPR2025-00781, Paper 11, 2 (Aug. 14, 2025) (similar); *Intel Corp. v. Advanced Cluster Sys., Inc.*, IPR2025-00794, Paper 13, 2 (Aug. 14, 2025) (similar). Here, the ’306 patent issued **19 years ago** and has now expired; Patent Owner has a far stronger case for settled expectations than was present in dozens of cases in which institution was denied.

Notably, strong settled expectations alone can outweigh other factors that might favor institution (*e.g.*, because the underlying district court litigation was stayed). *See Kahoot!*, IPR2025-00696, Paper 12, 2; *Sandisk Techs. Inc. v. Polaris PowerLED Techs., LLC*, IPR2025-00515, Paper 15, 2 (July 16, 2025); *Amazon.com, Inc. v. VirtaMove, Corp.*, IPR2025-00563, Paper 10, 2 (July 11, 2025); *see also Intel Corp. v. Proxense LLC*, IPR2025-00327, Paper 12, 2–3 (June 26, 2025) (settled

expectations outweighed lack of trial date). Here, the underlying litigation is not stayed and there is a trial date within weeks of the FWD deadline.

The Director has found that settled expectations may not bar institution where a patent has not been “‘commercialized, asserted, marked, licensed, or otherwise applied’ in Petitioner’s ‘particular technology space.’” *Shenzen Tuozhu Tech. Co., v. Stratasys, Inc.*, IPR2025-00531, Paper 10, 3 (June 17, 2025). This potential exception does not apply here. The ’306 patent was asserted in seven separate district court litigations prior to the District Court Action. *See* Section II.B. It was licensed by [REDACTED], including large semiconductor companies. *See* Section II.A; *see also* Ex. 2012 [Teksler-Decl.] ¶¶ 8–10. [REDACTED] to the ’306 patent alone should be dispositive:

Petitioner was aware of the challenged patent, having taken a license to it from 2011 to 2018. ... ***Absent exceptional circumstances, it is not an efficient use of Board resources where a party licensed the challenged patent, and then, as is the case here, now advocates for the unpatentability of that same patent.***

Microsoft Corp. v. TS-Optics Corp., IPR2025-00767, Paper 13, 2 (Aug. 14, 2025).

No such exceptional circumstances are present here.

Petitioner had deep knowledge of the ’306 patent. In addition to [REDACTED], the Hoberman Publication was the basis for multiple rejections in Cypress’s prosecution of its own patents. *See* Section II.C. And, during an extensive seven-

year back-and-forth between Patent Owner and Cypress/Infineon, [REDACTED]

[REDACTED]. See Section II.D; see also Exs. 2005, 2015-2022.

These exchanges included detailed claim analysis and intensive technical discussions between the parties concerning infringement and validity. Thus, Petitioner was not only aware of the '306 patent, [REDACTED]

[REDACTED], the very same infringement allegation set forth in the Complaint. See Ex. 2004, ¶¶ 128–154.

As the Director has consistently found, such pre-suit awareness or discussion of the patent favors denial, even as to a patent that issued only two years ago because “Petitioner had actual notice of the challenged patents” but “fail[ed] to seek early review of the patents.” *NVIDIA Corp. v. Neural AI, LLC*, IPR2025-00608, Paper 18, 2–3 (July 31, 2025); see also *iRhythm Techs., Inc. v. Welch Allyn, Inc.*, IPR2025-00363, Paper 10, 3 (June 6, 2025) (“Petitioner’s awareness of Patent Owner’s applications and failure to seek early review of the patents favors denial ...”); *Murata Mfg. Co. v. Georgia Tech. Research Corp.*, IPR2025-00383, Paper 14, 2–3 (July 29, 2025) (denying institution where parties discussed “technology space involving the challenged patent” and thus “Petitioner was aware that Patent Owner was involved in the same technology space for a significant amount of time before filing its Petition challenging Patent Owner’s patent.”). Here, the magnitude of the parties’

discussions and the Petitioner's knowledge of the '306 patent far exceed the facts found to favor denial in *Neural AI*, *iRhythm*, or *Murata*.

That Petitioner did not agree with Patent Owner's infringement contentions does not overcome Patent Owner's strong settled expectations:

Petitioner argues that it had settled expectations that the challenged patents would not be asserted against it because the previous patent owner never asserted the challenged patents. Petitioner, however, acknowledges that it has been aware of Patent Owner's patent portfolio in general since at least 2022, and the challenged patents specifically since 2023, after Patent Owner sent a series of letters to Petitioner identifying the challenged patents. In a letter dated December 1, 2023, Petitioner stated that it did "not believe it requires a license to any of the Identified Arkose Patents." Ex. 1015, 2. Therefore, Petitioner had apparently evaluated the challenged patents as of that date but does not provide a sufficient explanation as to why that amounts to settled expectations. For example, a concession of non-infringement by a patent owner may constitute settled expectations for a petitioner. However, a *petitioner's reliance on its own assessment of patents presents a different consideration*. Under these circumstances, Petitioner's assertions of settled expectations do not overcome Patent Owner's strong settled expectations.

See Datadrome S.A. v. Arkose Labs Holdings, Inc., IPR2025-00693, Paper 13, 2–3 (Aug. 14, 2025).

Petitioner's failure to challenge the patent is particularly difficult to justify here given its failure to join the MediaTek IPR, which was instituted in late 2024. By then, Petitioner had been aware of Patent Owner's allegations for many years and was acutely aware of the possibility of litigation and yet, still failed to act. Here, there is no reason to disturb Patent's Owner's strong settled expectations as to a 19-year-old, expired patent, which has been extensively licensed ([REDACTED]) and asserted and was the subject of extensive discussions between the parties from 2017–2024.

B. Each Of The *Fintiv* Factors Favors Denial.

1. Factor 1: There is no likelihood the case will be stayed.

Here, there is no likelihood that Judge Albright will stay the underlying case. Petitioner has neither sought a stay nor indicated it would seek a stay. Any such attempt would be unlikely to succeed, where, as here, Petitioner has challenged only two of the three asserted patents in IPR. Even if this IPR were instituted the District Court Action would not be simplified. *Multimedia Content Mgmt. LLC v. DISH Network LLC*, No. 6:18-cv-00207-ADA, 2019 WL 11706231, *5 (W.D. Tex. May 30, 2019) (Albright, J.) (“most important factor” in granting stay is whether IPR “will result in simplification of issues before the Court.”); *mCom IP, LLC v. Bank of Am. Corp.*, No. 6:22-cv-00256-ADA, 2022 WL 22896963, *3 (W.D. Tex. Oct. 20, 2022) (Albright, J.) (unless defendant “show[s] that the PTAB is likely to invalidate

all asserted claims . . . a stay will likely not simplify the issues.”) (emphasis in original, cleaned up). Here, Petitioner has challenged two of three patents; it cannot demonstrate the Board will likely invalidate “all asserted claims.”

2. Factor 2: The District Court trial date is within weeks of the FWD and the FWD against the ’448 patent would occur after the trial.

Factor 2 favors denial because the trial date will occur within 2–3 weeks of any FWD and will occur months before the FWD in IPR2025-01489 (challenging the ’448 patent) which will be due over a month after the trial date. As the Director has found, “it will be inefficient to maintain two parallel proceedings when the district court scheduled trial date and the projected final written decision due date are in close proximity.” *Shenzen Tuozhu Tech. Co., Ltd. v. Stratasy, Inc.*, IPR2025-00354, Paper 11, 2 (June 12, 2025); *Adv. Micro Devices v. Concurrent Ventures, LLC* (“*Concurrent*”), IPR2025-00223, Paper 9, 2 (June 12, 2025) (“Even though a district court trial date that occurs after a projected final written decision date reduces the possibility of conflicting decisions, that benefit does not outweigh the efficiencies gained by avoiding parallel proceedings in this instance because of the parties’ meaningful investment in the district court proceeding discussed above.”).

Here, by the time of the institution decision, the parties will have exchanged infringement and invalidity contentions and completed the *Markman* process. *See* Ex. 2006 [Scheduling Order] 1–3. The Director has consistently found that

completing such activities qualifies as a meaningful investment. *NXP USA, Inc. v. Redstone Logics LLC*, IPR2025-00485, Paper 11, 2 (July 10, 2025) (finding “meaningful investment” where “the district court has held a *Markman* hearing”). That “meaningful investment” will expand significantly by the time of the final written decision deadline, by which point the parties will have completed fact and expert discovery, exchanged final contentions, completed dispositive briefing, and completed the final pre-trial hearing. *See* Ex. 2006 [Scheduling Order] 4–5.

3. Factor 3: The parties have exchanged contentions and will complete claim construction by the institution decision deadline.

Factor 3—“investment in the parallel proceeding by the court and the parties”—strongly favors denial. Here, the District Court Action has progressed significantly. The parties have exchanged infringement and invalidity contentions and by the Institution Decision deadline (January 8, 2026), the claim construction process will have concluded and the parties will be actively engaged in fact discovery. Ex. 2006 [Scheduling Order] 1–3. This investment by the parties and the Court exceeds that found by the Director to “strongly favor[] discretionary denial.” *Motorola Sols., Inc. v. Stellar, LLC*, IPR2024-01205, Paper 19, 3 (Mar. 28, 2025) (factor 3 “strongly favor[ed] discretionary denial” where parties “served extensive infringement and invalidity contentions,” “filed claim construction briefs,” and district court “construed the disputed claim terms.”); *Concurrent*, 2 (favoring denial

where “parties have exchanged infringement and invalidity contentions” and “a *Markman* hearing is scheduled to occur before the due date for an institution decision”).

4. Factor 4: Petitioner’s stipulation promises two bites at the apple and does not outweigh the advanced stage of the case.

Factor 4 favors denial. Here, Petitioner’s indicates it will not raise any ground it raised or reasonably could have raised in this IPR, any ground based on the combination of system prior art and the IPR references, or any ground “on the basis of system art corresponding to the references that form the basis of any ground raised in” the IPR. *See* Ex. 1033 [Stipulation] 1. Petitioner’s carefully worded stipulation confirms it seeks two bites at the apple.

The stipulation does not prevent Petitioner from propounding its repeated invalidity theories in the District Court Action. Petitioner’s stipulation does not forswear all reliance on system art. Instead, its invalidity contentions identify four prior art systems, including the PSOC 1 system. *See* Ex. 2025 [Invalidity Contentions] 12. This is the [REDACTED]
[REDACTED]. *See* Ex. 2026 [08/01/18 Letter] 5 ([REDACTED]
[REDACTED]
[REDACTED]
[REDACTED]); Ex. 2014 [05/05/19 Letter] 3 (similar). Petitioner’s

stipulation leaves it wide open to assert the invalidity theory [REDACTED]

[REDACTED].

The stipulation does not prevent Petitioner from propounding substantially similar system art in the District Court Action. In addition, Petitioner’s stipulation does not prevent the formulation of unpatentability grounds based on substantially similar or even materially identical prior art systems. The stipulation does not preclude Petitioner from, *e.g.*, presenting different versions of the Nowka IBM PowerPC that are materially identical but allegedly do not “correspond[] to the references that form the basis of any ground raised.” Ex. 1033; *see SAP Am., Inc. v. Cyandia, Inc.*, IPR2024-01496, Paper 13, 8–9 (Apr. 7, 2025) (stipulations have “limited practical effect in reducing overlapping efforts” when IPR prior art does not reduce prior art systems offered in district court). These intentional backdoors limit any possible efficiency gained by this proceeding.

The stipulation does not prevent Petitioner from relying on the same references to show the “state of the art.” Petitioner does not forswear using the IPR references for any purpose leaving open the possibility that Petitioner will try to leverage the references in district court under the guise that they show the “state of the art” or the knowledge of a POSITA. *See, e.g., Maxell, Ltd. v. Apple Inc.*, No. 5:19-cv-00036-RWS, 2021 WL 3021253, *16 (E.D. Tex. Feb. 26, 2021) (“Indeed, courts in the Eastern District have permitted defendants to rely on references that

were not included in their invalidity contentions when the references were not proposed as invalidating prior art, but were directed to other purposes, such as showing the state of the art at the time of the invention or rebutting the patentee’s secondary consideration evidence.”) (cleaned up).

Petitioner’s stipulation does not outweigh the advanced stage of this case. It is error to “giv[e] too much weight” even to “enhanced” stipulations where, as here, the parallel district court proceeding is at an “advanced state” and the district court has “not granted a stay.” *Green Revolution Cooling, Inc. v. Midas Green Tech., LLC*, IPR2025-00196, Paper 15, 2 (July 25, 2025).² Thus, Petitioner’s “enhanced” stipulation should similarly be given little weight, particularly here where the stipulation allows Petitioner to argue its repeated validity theory in the district court. Petitioner’s stipulation therefore increases the probability of inconsistent results.

5. Factor 5: The Petitioner and the Defendant in the parallel proceeding are the same party.

Factor 5 strongly favors denial because the Petitioner is the defendant in the District Court Action.

² In *Green Revolution*, the district court trial was four months before the FWD.

Here too, the trial date would long precede any FWD directed towards any IPRs brought against the other patents-at-issue.

6. Factor 6: Other circumstances enhance the case for denial.

Factor 6 strongly favors denial. The other circumstances supporting denial include Patent Owner's strong settled expectations; Petitioner's improper roadmapping based upon the prior MediaTek IPR, which Infineon failed to join and which should not have been instituted; and the fact that it would be a waste of the Office's limited resources to provide a redundant adjudication of an expired patent.

Settled expectations. Patent Owner's strong settled expectations alone are a sufficient basis to deny institution. *See* Section III.A (incorporated by reference). Again, the '306 patent issued 19 years ago, expired over a year ago, has been heavily litigated and licensed—[REDACTED]—and has been the topic of [REDACTED]. And yet, Petitioner did not challenge the '306 patent until 2025, even failing to join the MediaTek IPR. Patent Owner's settled expectations strengthen the case for denial under *Fintiv*.

Improper roadmapping based upon prior IPRs and Patent Owner's arguments, when Petitioner could and should have joined those IPRs. And, rather than join the MediaTek IPR, Petitioner used the prior MediaTek IPRs (against the '306 and other MOSAID patents), and Patent Owner's responses, to improperly roadmap the present Petition. In assessing whether to deny institution, "when different petitioners challenge the same patent" it is appropriate to consider "any relationship between those petitioners when weighing the *General Plastic* factors,"

Valve Corp. v. Elec. Scripting Prods., Inc., IPR2019-00062, Paper 11, 2 (Apr. 2, 2019) (precedential). A “significant relationship” is created when an IPR petitioner uses “prior petitions as a roadmap for its own petition.” *Ericsson Inc. v. Uniloc 2017, LLC*, IPR2019-01550, Paper 8, 12 (Mar. 17, 2020).

That is exactly what has happened here: Infineon used the same expert and largely the same arguments as MediaTek, who brought IPR petitions against the ’306 patent and related patents over a year ago. Using the “prior petitioners’ work as a menu and picking and choosing from their work product,” *id.*, and leveraging Patent Owner’s responses in an attempt to bolster the arguments made in MediaTek’s earlier petitions, Petitioner now seeks to revive, in modified form, patent challenges that its expert previously articulated differently.

More specifically, MediaTek’s IPR2024-00598 petition against the ’306 patent advanced seven grounds of invalidity—three involving Nowka and four involving Nicol—all of which are repeated here. *Compare, e.g.*, IPR2024-00598, Paper 2, i–v (Petition) (filed Mar. 6, 2024) *with* Pet., i–v (same). Petitioner, however, has not simply repeated MediaTek’s prior grounds, it has modified them in view of Patent Owner’s preliminary responses in IPR2024-00598, -00718 (denied institution), and -00719, in response to Patent Owner’s argument that Nowka disclosed only a single power island (*see, e.g.*, IPR2024-00718, Paper 8, 23–27 (POPR) (filed July 11, 2024)), Petitioner now argues that it has identified, if not new

additional alleged “power islands” in Nowka, at least elements that “[a] POSITA would have understood and found obvious . . . [to be] *capable of being controlled as power islands*” in Nowka. Pet., 9–10. Similarly, the Petition advances a new Nowka/Bertin combination, which Petitioner offers “if Patent Owner attempts to rebut Ground 1A by arguing that Nowka does not determine an explicitly prescribed target power level.” Pet., 47–48. With this combination, Petitioner attempts to address Patent Owner’s argument that Nowka did not teach “determining a target power level” in the sense of the ’306 patent. *See, e.g.*, IPR2024-00598, Paper 10, 29–34 (POPR) (filed July 1, 2024). Petitioner should not benefit from its delay in challenging the ’306.

The MediaTek petition should not have been instituted, and regardless, MediaTek’s IPR does not militate against denying institution of this Petition.

Under the current discretionary denial framework, there is no chance that MediaTek’s challenge—against an 18 year old, heavily licensed and litigated patent, being litigated in the Western District of Texas—would have been instituted. Additionally, the Board rejected the universally agreed upon—by both parties and two district courts—construction. *See* Ex. 1032 [IPR2024-00598 Inst. Dec.] 11–12. And, given the likelihood that the Court will adopt the same claim construction that has been agreed upon by multiple parties and adopted by multiple district courts (*see*

Exs. 1011, 48; 1012, 9; and 1013, 26), the Board’s previous institution raises concerns about inconsistent results.

Nor does *ARM Ltd. v. Daedalus Prime LLC*, IPR2025-00207, Paper 14, 2–3 (Aug. 6, 2025) (“*Daedalus*”) suggest otherwise. There, the Director vacated a *Fintiv* denial principally because the underlying district court action did not involve the petitioner and was dismissed within one week of the denial. *Id.*, 2. Additionally, the Director noted the IPR-at-issue concerned a challenge to claims that were “substantially identical” to claims in a related patent determined to be unpatentable based upon a single reference, one that was the basis for the prior rejection. *Id.*, 2–3. *Daedalus* is readily distinguishable because (1) the litigation here involves Petitioner, (2) the litigation has not settled, (3) there are strong settled expectations here; while “settled expectations” was not argued there (IPR2025-00207, Papers 7 & 13), (4) the MediaTek IPR was merely instituted, no claims were found unpatentable, and (5) the grounds here are different from those previously presented due to Petitioner’s roadmapping, as described above.

IV. CONCLUSION

For the foregoing reasons, Patent Owner respectfully requests that the Director deny institution.

Dated: September 8, 2025

Respectfully submitted,

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. §42.6(e), I hereby certify that on September 8, 2025, I electronically filed the foregoing document and served a copy of the same on counsel for Petitioner at the following e-mail address, as authorized in the Petition:

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Dated: September 8, 2025

/s/ Colette Woo
Colette Woo