

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

REDSTONE LOGICS LLC,
Patent Owner.

Patent No. 8,549,339

Inter Partes Review No. IPR2025-01532

**PETITIONER'S OPPOSITION TO PATENT OWNER'S REQUEST FOR
DISCRETIONARY DENIAL OF INSTITUTION**

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Patent Owner's Exhibit List

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I. INTRODUCTION

Discretionary denial is not appropriate for multiple reasons. First, the *Fintiv* factors weigh in favor of institution and against discretionary denial in this proceeding. The Board recently considered the time-to-trial statistics for Judge Albright and the Western District of Texas; and found discretionary denial of an IPR petition to be “not appropriate” where Judge Albright had scheduled trial for six months before the Final Written Decision deadline. (*ClearCorrect Operating, LLC v. Align Tech., Inc.*, IPR2025-00814, Paper 14, 2 (PTAB Aug. 29, 2025).) Here, in the parallel litigation before Judge Albright, the scheduled trial date leads the Final Written Decision by only about one month, far less than in *ClearCorrect*; and Judge Albright’s time-to-trial statistics (including a median time to trial of 43 months for patent cases in 2025) demonstrate that the current trial date is speculative and unlikely to hold. When these statistics are considered, the Final Written Decision is likely to lead the trial date by approximately *one year* or more.

Moreover, the litigation is in its early stages and has seen only limited investment by the parties; notably, the court recently vacated the deadlines for claim construction briefing and the *Markman* hearing, at the parties’ joint request, obviating the need for the parties and the court to invest time and effort into claim construction proceedings. Further, Petitioner’s commitment to a stipulation that

goes above and beyond that in *Sotera Wireless* minimizes concerns of overlapping issues between the district court and the present IPR proceeding.

Additionally, the petition presents prior art and arguments that have never been considered on the merits by the Office or by any validity proceeding, and instituting the petition would be an appropriate use of Board resources. Patent Owner has engaged in a serial litigation campaign, asserting the invalid '339 patent against unrelated defendants in multiple litigation matters that span multiple federal district courts—none of which adjudicated the patent's validity before settlement was reached. The Board, not a series of district court juries, is in the best and most efficient position to evaluate the validity of the '339 patent.

II. ARGUMENT

A. The *Fintiv* Factors Favor Institution

1. Factor 1: The Likelihood of a Stay Is Neutral

Patent Owner claims that a stay of the district court litigation before Judge Albright is “unlikely.” (Paper 7, 3.) But the Board has previously “decline[d] to speculate on the likelihood of Judge Albright entering a stay after institution,” finding this factor neutral. (*See W. Digit. Corp. v. Kuster*, IPR2020-01391, Paper 10, 8-9 (PTAB Feb. 16, 2021); *see also Apple v. Allani*, IPR2025-00856, Paper 10, 2 (PTAB Sept. 4, 2025).) Accordingly, this factor is neutral.

2. Factor 2: The Parallel Trial Date Weighs Against Discretionary Denial

This factor weighs against discretionary denial because the trial date in the parallel district court litigation before Judge Albright in the Western District of Texas is likely to occur after the Board would issue the Final Written Decision in the present IPR proceeding. Under the current schedule in the district court, trial is scheduled to begin on February 22, 2027—approximately one month before the Board would issue its Final Written Decision on March 30, 2027. (EX2001, 5.) But the most recent and relevant time-to-trial statistics for Judge Albright, particularly in view of his increasing caseload, demonstrate that the trial date in the district court proceeding will likely be months *after* the Board issues the Final Written Decision.

For the year ending June 2025, the median time-to-trial in the Western District of Texas is 32.8 months, having increased from 22.4 months in 2020. (EX2006.) If this district-wide median applied to the parallel litigation, the trial would be pushed to February 2027 to January 2028—ten months after the Final Written Decision in March 2027. However, Judge Albright’s median time-to-trial in patent cases *exceeds* that of the Western District of Texas more broadly: for patent cases occurring in 2024 and 2025, Judge Albright’s median time-to-trial is 35 months. (EX1038, 1.) Based on this data, trial in the parallel district court

litigation would likely be pushed to at least March 2028—nearly one year after the expected Final Written Decision.

Moreover, Judge Albright’s median time-to-trial data shows a sharp and recent increase: from 23 months in 2022, to 27 months in 2023, 33 months in 2024, and 43 months in 2025. (EX1038, 2-5.) This trend reflects the increasing time-to-trial in the Western District of Texas more broadly—from 22.4 months in 2020 to 32.8 months in 2025. (EX2006.) It also reflects a specific recent expansion of Judge Albright’s case load: in January 2025, the Chief Judge of the Western District of Texas assigned Judge Albright 40% of the Austin Division docket, in addition to his previous assignment of 100% of the Waco Division cases. (EX1039, 3.) Even before the influx of new Austin Division cases, Judge Albright’s heavy caseload often resulted in delayed proceedings because of trial conflicts. (*See Motion Offense, LLC v. Google LLC*, No. 6:21-cv-514-ADA, Dkt. 68 (W.D. Tex. June 10, 2022); *IOENGINE, LLC v. Roku Inc.*, No. 6:21-cv-1296-ADA, Dkt. 306 (W.D. Tex. Sept. 19, 2023).) These delays can be expected to increase with Judge Albright’s case load, consistent with the 30 percent increase in Judge Albright’s median time to trial from 2024 to 2025.

Patent Owner suggests a shorter expected time to trial of 23 months for Judge Albright; but it only arrives at that figure by lumping in older trial data, from as far back as 2018. (*See* EX2004 (statistics encompassing trial dates from

between Sept. 1, 2018 and Nov. 20, 2025).) This tactic obscures the recent increase in Judge Albright’s median time to trial, which ballooned to 43 months in 2025 (with the shortest time to trial in 2025 taking 39 months). It is these recent time-to-trial statistics, not outdated statistics from years prior, that most accurately illustrate Judge Albright’s case calendar in 2025.

Patent Owner speculates that this particular litigation may benefit from efficiencies (such as familiarity with the ’339 patent) that would discourage the trial date from slipping. But Judge Albright’s trials are frequently postponed due to scheduling conflicts with *other* cases on Judge Albright’s docket. (*See Motion Offense, LLC v. Google LLC*, No. 6:21-cv-514-ADA, Dkt. 68 (W.D. Tex. June 10, 2022) (“Due to a scheduling conflict with a trial, the Court hereby vacates the remaining scheduled deadlines in this case.”); *IOENGINE, LLC v. Roku Inc.*, No. 6:21-cv-1296-ADA, Dkt. 306 (W.D. Tex. Sept. 19, 2023) (notifying the parties that “due to the Court’s schedule, the trial will have to be reset to the coming spring.”).) Efficiencies in one case cannot be expected to prevent scheduling conflicts that arise from unrelated cases. Further, while Patent Owner suggests that focusing on “small” patent cases (having four or fewer “accusations”) presents a more accurate picture, the data shows that for more recent trials, Judge Albright’s small patent cases actually took two months *longer*, on average, to reach trial than

his patent cases overall. (EX1038, 1, 6.) Thus, it does not appear that the parties can expect a shorter time to trial based on a smaller number of accusations.

In August 2025, applying the framework set forth in the March 2025 PTAB Workload Management Memorandum, the Board considered a patent owner's discretionary denial request in view of parallel litigation before Judge Albright. Based on Judge Albright's time-to-trial data, the Board declined the discretionary denial request, finding it inappropriate where "the time-to-trial statistics suggest that the trial will not begin until" after the expected date of the Final Written Decision—including where Judge Albright had scheduled trial for a date six months before the Final Written Decision date. (*ClearCorrect*, IPR2025-00814, Paper 14, 2.) This case is even more persuasive: trial is currently set for only about one month before the expected date of the Final Written Decision, and, as described above, Judge Albright's time-to-trial statistics conservatively suggest that trial will occur nearly one year after the Final Written Decision.

Because only about one month separates the currently scheduled trial date and the anticipated Final Written Decision date, and because Judge Albright's caseload and time-to-trial statistics indicate that trial will likely be postponed by at least one year, this factor weighs against discretionary denial.

3. Factor 3: The Investment in Parallel Proceeding Weighs Against Discretionary Denial

Investment in the parallel proceeding weighs against discretionary denial because the parties have invested little in the district court litigation thus far. The district court litigation is in its early stages. Fact discovery has not yet begun. (EX2001, 3.) The court has vacated the *Markman* hearing and disposed of the claim construction briefing process. (EX2007.) The court has not yet been asked to consider any dispositive motions on the prior art for the '339 patent that would overlap with the *inter partes* review proceeding. The parties have only briefed one table-setting issue to date: whether Patent Owner's complaints should be dismissed for failure to state a claim. The district court has yet to reach a decision on the merits of this issue—Petitioner's first motion to dismiss was mooted by the filing of Patent Owner's amended complaint.

This factor weighs against exercising discretion to deny institution where “much more work remains [in the district court litigation], including, expert reports, expert discovery, expert depositions, and pretrial motions and disclosures.” (See *Bio-Rad Lab's, Inc. v. Cal. Inst. of Tech.*, IPR2024-01451, Paper 11, 10 (PTAB Mar. 27, 2025); see also *Sand Revolution II, LLC v. Cont'l Intermodal Grp. – Trucking LLC*, IPR2019-01393, Paper 24, 10-11 (PTAB June 16, 2020) (“[M]uch work remains in the district court case as it relates to invalidity: fact discovery is still ongoing, expert reports are not yet due, and substantive motion

practice is yet to come.”).) Because neither the parties nor the district court have expended significant resources litigating the parallel district court proceeding, this factor weighs against discretionary denial.

4. Factor 4: The Overlap Between the Petition and Parallel Proceeding Weighs Strongly Against Discretionary Denial Because Petitioner Agreed to a *Sotera*-plus Stipulation

This factor weighs strongly against discretionary denial. Petitioner went above and beyond a *Sotera* stipulation to limit the potential overlap between this proceeding and the parallel litigation. Under Petitioner’s stipulation, if and when the Board institutes *inter partes* review in this proceeding, “Petitioner...will not advance against the claims challenged in [this proceeding] in the co-pending district court proceeding: (i) the specific grounds raised in [this proceeding],” or “(ii) any other grounds that could have reasonably been raised” in this proceeding. (Paper 6, 1.) And Petitioner went further, by stipulating not to raise any ground based on a combination of system prior art and the references asserted as the basis of a ground in this proceeding. (Paper 6, 1.) This additional provision limits the role of those asserted references in the district court proceeding, even in combination with system prior art that by statute cannot be raised in an IPR proceeding.

A *Sotera* stipulation “weighs strongly in favor of not exercising discretion to deny institution” because it “mitigates any concerns of duplicative efforts between

the district court and the Board.” (*Sotera Wireless, Inc., v. Masimo Corp.*, IPR2020-01019, Paper 12 at 19 (PTAB Dec. 1, 2020).) Petitioner’s stipulation, which goes beyond the commitments of *Sotera Wireless* (provisions (i) and (ii) above), weighs even more strongly against discretionary denial, because it even further limits any potential overlap between the two proceedings.

Patent Owner argues that Petitioner’s stipulation does not resolve the overlap between the district court litigation and the *inter partes* review proceeding, because Petitioner might later rely on a hypothetical “system art version” of documentary references from the petition. (Paper 7, 10.) Patent Owner posits that it is “very likely” that Petitioner will raise “substantially the same issues” in the district court as in the IPR proceeding. (Paper 7, 10.) Patent Owner, similarly, imagines a slew of possible future proceedings that could challenge the ’339 patent. (Paper 7, 10-11.) But Patent Owner’s arguments are purely speculative—Patent Owner identifies no such “system art version” of Petitioner’s references, nor any basis for its claim that Petitioner is “very likely” to rely on such hypothetical systems. And Patent Owner’s imagined future proceedings, likewise, are purely hypothetical. Patent Owner’s speculations ignore Board precedent determining that this factor weighs strongly against discretionary denial because it “obviate[s] much, if not all, of any potential overlap between the issues in the proceeding and the district court proceeding.” (*Liberty Energy Servs. LLC v. U.S. Well Servs.*,

LLC, IPR2025-00139, Paper 14, 13-14 (PTAB June 11, 2025); *see also Stingray Grp. Inc. v. Hernandez-Mondragon*, IPR2025-00349, Paper 19, 7-8 (PTAB June 13, 2025) (finding this factor weighs against discretionary denial where Petitioner committed to a *Sotera* stipulation); *Kubota N. Am. Corp. v. Vermeer Mfg. Co.*, IPR2025-00170, Paper 15, 13 (PTAB June 10, 2025) (same).)

5. Factor 5: Whether the Parties Are the Same Is Neutral

The parties before the Board in this *inter partes* review proceeding and in the parallel district court litigation are the same. Where the parties are identical between two parallel proceedings, the Board has held that this factor is “neutral or, at most, weighing slightly in favor of exercising discretion to deny institution.” (*Snap, Inc. v. SRK Tech. LLC*, IPR2020-00820, Paper 15, 16 (PTAB Oct. 21, 2020); *see also Shenzhen Root Tech. Co., Ltd. v. Chiaro Tech. Ltd.*, IPR2024-01296, Paper 9, 19-20 (PTAB Feb. 25, 2025) (finding this factor neutral where parties are the same in both proceedings).) Even if this factor weighs in favor of discretionary denial, this factor is not dispositive, and it should not outweigh the other factors favoring institution. (*See, e.g., Cisco Sys., Inc. v. WSOU Invs.*, IPR2025-00188, Paper 10, 17, 23 (PTAB June 13, 2025) (instituting *inter partes* review even though the same parties were involved in the proceedings before the Board and the district court).)

6. Factor 6: Other Considerations, Including the Strength of the Petition, Weigh Against Discretionary Denial

Factor 6 weighs against discretionary denial because the Petition provides strong arguments on the merits of the '339 patent's validity. The Petition, supported by the expert testimony of Dr. Robert Horst, demonstrates the claims are obvious based on three grounds of invalidity. Meanwhile, Patent Owner's request for discretionary denial does not engage with the merits of the Petition at all, offering only unexplained attorney conclusions that the Petition's merits "suffer from significant weaknesses and gaps in proof," and that the supporting expert declaration is "unreliable." (Paper 7 at 10, 17.)

These grounds apply prior art references that were not presented to or considered by the Examiner during prosecution. Petitioner submits that if the Examiner had located and considered these references, the claims would not have been allowed. For example, the claims were allowed after a claim amendment to limit the clock signal inputs, to recite that the first and second clock signals are independent. (EX1005, 63, 74-86.). But, as explained by Dr. Horst, at least the Lee prior art reference meets this limitation, by teaching that multiple independent clock signals are provided as inputs to respective PLLs of each core in a multi-core processor. (EX1003, ¶¶103, 110.) Lee was not presented to the Examiner or considered during prosecution. As demonstrated by the Petition with Dr. Horst's

support, this limitation and all other limitations of the challenged claims were known in the prior art.

An inspection of the Examiner's search strategy reveals specific defects in his prior art search. For example, the prosecution history indicates that the Examiner conducted a prior art search on three occasions. (EX1005, 105-108, 65-67, 41-43.) However, in each of these three instances, the Examiner's search was limited to databases of U.S. patent data only (US-PGPUB, USPAT, UPAD). (EX1005, 105-108, 65-67, 41-43.) These searches were underinclusive because they omitted large swaths of prior art, such as academic publications and foreign filings, that are not found in the U.S. patent databases that were searched. Specifically, the search strategy demonstrates how the Examiner failed to locate the Lee reference that teaches the independent clock signal limitations: Lee, as an academic publication presented at a conference in Korea, would not have been in the patent databases searched by the Examiner.

Because the Examiner failed to properly search for and consider the prior art, including Lee and any other references disclosing the independent clock signal limitations that the Examiner believed to confer patentability, the Patent Office erred in allowing the '339 patent. Institution is appropriate here to review and correct this error. (*See Microsoft Corp. v. Partec Cluster Competence Ctr. GmbH*, IPR2025-00318, Paper 9, 3 (PTAB June 12, 2025) (finding that discretionary

denial is not appropriate where the examiner overlooked material prior art, and “it is an appropriate use of Office resources to review the potential error.”).)

Here, as described above, no *Fintiv* factor weighs against discretionary denial. All factors are neutral or point in favor of institution. Under these circumstances, discretionary denial is not appropriate. (*See CrowdStrike, Inc. v. Open Text Inc.*, IPR2023-00289, Paper 7, 17 (PTAB July 21, 2023) (declining to exercise discretion to deny the petition where “no *Fintiv* factor weighs in favor of exercising our discretion to deny institution, while two factors weigh against, and four factors are neutral”).)

B. The Board’s Workload Management Factors Weigh Against Discretionary Denial

While the ’339 patent has been in force since October 2013, persuasive reasons exist here for the Board to review its validity. (*See Dabico Airport Sols. Inc. v. AXA Power ApS*, IPR2025-00408, Paper 21, 3 (PTAB June 18, 2025) (“There may be persuasive reasons why the Office should review the challenged patent” and “disturb the settled expectations of Patent Owner”).) Here, the Patent Owner has elected to enforce the ’339 patent in serial fashion by suing unrelated defendants, including Petitioner, in multiple federal district courts over a span of several years. Patent Owner has reached settlement with many of these defendants, *see* Paper 7 at 18, such that no court or jury has yet made a determination of the validity of the ’339 patent. Instituting the Petition is an

appropriate use of Board resources because it is the Board, not a series of district court judges and juries, that is in the best position to adjudicate the patent's validity, and halt Patent Owner's ongoing litigation campaign that continues to consume judicial resources.

C. Patent Owner's Additional Arguments for Discretionary Denial are Unavailing

None of Patent Owner's additional arguments can support discretionary denial. Patent Owner claims that "many prior patentability challenges have been adjudicated"; and that the Petition "largely reraises art that has already been considered." (Paper 7 at 15, 19.) Not so—none of the validity arguments presented in the Petition have been considered on the merits. A prior IPR petition by MediaTek (IPR2025-00085) challenged the '339 patent and was denied institution, but that petition did not raise any of the prior art and arguments presented in the present Petition. And a prior IPR petition by NXP and Qualcomm (IPR2025-00485) was denied institution on discretionary grounds—not on the merits. The Petition demonstrates obviousness based on prior art combinations (White/Talwar/Lee; Elgebaly/Lee; Elgebaly/Lee/Vajda) and arguments, with expert support by Dr. Horst, that were not considered by the Office; not presented in any prior IPR petition; and not adjudicated by any other forum. And while Patent Owner references Petitioner's invalidity arguments in the parallel litigation,

Petitioner's *Sotera*-plus stipulation obviates concerns of overlap, as discussed above. These factors cut against discretionary denial.

Additionally, Patent Owner argues that the Petition should be denied based on the USPTO's Notice of Proposed Rulemaking ("NRPM"), which solicited public comment on proposed changes to 37 C.F.R. § 42.108. (*See* EX2010.) The comment period ended on December 2, 2025, with over 10,000 public comments submitted on the proposed rule changes. (EX1040.) None of the rule changes proposed in the NPRM have been implemented. Nevertheless, Patent Owner argues that the Petition should be denied because under the proposed rules, it is "likely" that the Petition "could not be maintained" if instituted. (Paper 7, 13.) But even if Patent Owner were correct, it would be premature and inappropriate to deny institution on the basis of *future* rules that are subject to revision; and that may or may not be implemented at all. This is particularly so for proposed rules that have only recently exited the notice-and-comment period, and that have attracted significant public commentary, indicating that the rulemaking process is ongoing. These proposed rules cannot support discretionary denial.

III. CONCLUSION

For the foregoing reasons, Petitioner respectfully requests that the Director decline to exercise discretion to deny institution and refer the Petition to a panel to decide whether to institute based on the merits.

Dated: December 30, 2025

By: /Alex S. Yap/

Alex S. Yap

Registration No. 60,609

MORRISON & FOERSTER LLP

707 Wilshire Boulevard, Suite 6000

Los Angeles, CA 90017

Tel: (213) 892-5688

Fax: (213) 892-5454

Email: AYap@mofo.com

Certificate of Service (37 C.F.R. § 42.6(e)(4))

I hereby certify that the attached PETITIONER'S OPPOSITION TO PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL OF INSTITUTION was served on the below date via e-mail (by agreement) to the following counsel of record for the Patent Owner:

Reza Mirzaie, Reg. No. 69,138
rmirzaie@raklaw.com

Neil A. Rubin, Reg. No. 67,030
nrubin@raklaw.com

Christian Conkle (PHV to be filed)
cconkle@raklaw.com

Joshua Scheufler (PHV to be filed)
jscheufler@raklaw.com

Qi (Peter) Tong, Reg. No. 74,292
ptong@raklaw.com

rak_redstone@raklaw.com

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By: /Bryan Blumenkopf/
Bryan Blumenkopf