

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NVIDIA CORPORATION,
Petitioner,

v.

ONESTA IP, LLC,
Patent Owner.

Case No. IPR2026-00011
U.S. Patent No. 11,841,803

**PATENT OWNER'S REQUEST FOR DISCRETIONARY
DENIAL OF INSTITUTION**

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I. Introduction

Discretionary denial of institution of the Petition is appropriate here under the totality of the circumstances, including that the parallel International Trade Commission (“ITC”) investigation regarding the challenged patent, wherein Petitioner has raised invalidity defenses based on the same prior art asserted in the Petition, will **conclude** prior to a final written decision in the requested IPR.

The final written decision (“FWD”) in this proceeding would be due, at the latest, by April 22, 2027, if the Board were to institute trial. *See* Paper 5 (Notice of Filing Date mailed on October 22, 2025). By contrast, in the parallel ITC Investigation, the Commission Target Date for **completion of the investigation** is November 30, 2026, roughly **five months before the FWD**. Further, the ALJ’s initial determination is expected to issue on July 30, 2026, roughly ten months before the FWD. And the Hearing before the ALJ is set for May 4-8, 2026, over eleven months before the FWD.

The ITC’s scheduling history of conduct and time-to-final decision statistics establish that there is no reasonable likelihood that the ITC will reschedule these deadlines to after the FWD. There is no reasonable likelihood that the ITC will stay the parallel Investigation if the PTAB were to institute this Petition—to the contrary, the ITC has never stayed an Investigation for a pending IPR.

II. Background

A. The Challenged '803 Patent and The Parties

The Patent Office issued challenged U.S. Patent No. 11,841,803 on December 12, 2023. The '803 Patent is titled “GPU Chiplets Using High Bandwidth Crosslinks,” and, consistent with that title, it discloses and claims innovative systems and methods of GPU chiplets. The '803 Patent issued to Advanced Micro Devices, Inc. (“AMD”), a leading computer chip development company.

B. The Relevant Petition and ITC Deadlines

Patent Owner Onesta LLC filed an ITC Complaint asserting the '803 Patent against Petitioner NVIDIA on April 18, 2025. *See Certain Integrated Circuits, Electronic Devices Containing The Same, and Components Thereof*, Inv. No. 337-TA-1450 (U.S.I.T.C.).¹ Nearly six months later, on October 15, 2025, NVIDIA filed the Petition in the instant proceeding. If the requested IPR were instituted, the deadline for the final written decision would be April 22, 2027.

But the parallel ITC Investigation against Petitioners will already be over by then. Indeed, the parties and the ITC have already expended a great deal of time and

¹ In addition to the '803 Patent, which is only asserted against NVIDIA, Onesta also asserts 5 other patents against NVIDIA and other Respondents: Qualcomm, OnePlus, and Nothing.

resources on this dispute, and will expend even more before any institution decision on the merits. For example, as of the filing of this request for discretionary denial:

- The parties have already engaged in over six months of intensive discovery, including serving and responding to 322 interrogatories and 513 document requests, producing over 35,000 documents, and producing and reviewing additional confidential materials on secure computers located throughout the United States;
- The parties have engaged in claim construction discovery and exchanged proposed claim constructions;
- Patent Owner has prepared and served its initial and supplemental infringement contentions;
- Petitioner NVIDIA has prepared and served its non-infringement contentions responding thereto;
- Petitioner NVIDIA has prepared and served its initial and supplemental invalidity contentions, asserting 30 prior art references (including all 3 references relied on in the Petition) against the '803 patent and including 13 claim charts for the '803 patent;²

² Patent Owner is not attaching Petitioners' ITC Invalidity Contentions as an exhibit because Petitioners marked the entire document as Confidential Business

- Patent Owner has prepared and served its validity contentions (Ex. 2112) responding to Petitioners' extraordinarily voluminous invalidity contentions; and
- The Technology Tutorial and *Markman* Hearing was held on December 10, 2025.

In addition, before the institution decision in this proceeding (scheduled for April 22, 2026):

- Patent Owner will have prepared and served its final infringement contentions and Petitioner will have prepared and served its final invalidity contentions (January 21, 2026);
- Patent Owner will have prepared and served its final validity contentions and Petitioner will have prepared and served its final non-infringement contentions (February 4, 2026);
- The parties will have exchanged initial and rebuttal expert reports, including on validity (February 16, 2026 for initial reports and March 9, 2026 for rebuttal reports);

Information – Subject to Protective Order. The ten claim charts that are not marked as Confidential are attached as Exhibits 2102-2111.

- Both Patent Owner and Petitioner will have filed pre-hearing statements and briefs, including on validity (April 3, 2026)
- The parties will have filed and responded to motions *in limine* and high priority objections statements (April 13, 2026 for initial motions and statements and April 20, 2026 for responses)
- The parties will have submitted proposed exhibits to the ALJ (April 22, 2026).

By the April 22, 2027, deadline for the final written decision, the parties and the ITC will have already completed the parallel ITC Investigation, including:

- The ITC hearing (May 4-8, 2026)
- The parties will have completed all post-hearing briefing (May 28, 2026 for initial briefs and June 12, 2026 for reply briefs)
- The ITC ALJ issuing the **Initial Determination** on all issues, including Petitioners' invalidity defenses (July 30, 2026); and
- The parties and the ITC **completing** the Investigation (November 30, 2026). EX2101 at 4.

III. The *Fintiv* Factors Compel Discretionary Denial Of The Petition

Based on the foregoing, instituting the requested IPR here would duplicate and waste resources, and the Petition should be denied on *Fintiv* grounds in light of the parallel ITC investigation. *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11

at 8 (PTAB Mar. 20, 2020) (precedential) (“[A]n earlier ITC trial date may favor exercising authority to deny institution under *NHK* if the ITC is going to decide the same or substantially similar issues to those presented in the petition.”); (citing *NHK Spring Co. v. Intri-Plex Techs., Inc.*, IPR2018-00752, Paper 8 (PTAB Sept. 12, 2018) (precedential, designated May 7, 2019)).

A. The Parallel ITC Investigation Is The Relevant Parallel Proceeding For The *Fintiv* Analysis

In addition to the ongoing parallel ITC Investigation, there is a pending district court action between the Patent Owner and Petitioner. But because those district court lawsuit is stayed, the ITC Investigation is the relevant proceeding for the *Fintiv* analysis: when a district court lawsuit is stayed due to an ongoing ITC investigation at a Petitioner’s request, then “the ITC investigation is now the relevant proceeding we must evaluate under the *Fintiv* factors.” *Intel Corp. v. Koninklijke Philips N.V.*, IPR2021-00328, Paper 9 at 9 (PTAB July 16, 2021).

Here, the pending district court lawsuit³ was filed on April 17, 2025. NVIDIA then moved to stay the case pending the ITC investigation. Ex. 2113. Patent Owner

³ Patent Owner and Petitioner are parties to an ongoing district court litigation in the Eastern District of Texas. *See Onesta IP, LLC v. NVIDIA Corp.*, Case No. 1:25-cv-586-ADA (W.D. Tex.).

did not oppose the motions, and the district court granted the motion to stay pending resolution of the ITC investigation. Ex. 2114.

Thus, the district court case is now stayed pending the completion of the ITC Investigation. Accordingly, “the ITC investigation is now the relevant proceeding we must evaluate under the *Fintiv* factors.” *Intel Corp. v. Koninklijke Philips N.V.*, IPR2021-00328, Paper 9 at 9 (PTAB July 16, 2021).

B. The *Fintiv* Factors Weigh Heavily For Discretionarily Denying The Petition

Pursuant to 35 U.S.C. § 314(a), the PTAB has discretion to deny a petition based on ITC proceedings related to the same patent. See Consolidated Trial Practice Guide 58 (Nov. 2019), available at <https://www.uspto.gov/sites/default/files/documents/tpgnov.pdf?MURL=TrialPracticeGuideConsolidated>. The PTAB enumerated six non-dispositive factors to determine whether efficiency, fairness, and the merits support exercising discretion to deny a petition based on a related proceeding:

Factor 1: Whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted;

Factor 2: Proximity of the court’s trial date to the Board’s projected statutory deadline for a final written decision;

Factor 3: Investment in the parallel proceeding by the court and the parties;

Factor 4: Overlap between issues raised in the petition and in the parallel proceeding;

Factor 5: Whether the petitioner and the defendant in the parallel proceeding are the same party; and

Factor 6: Other circumstances that impact the Board’s exercise of discretion, including the merits.

Apple Inc. v. Fintiv, Inc., IPR2020-00019, Paper 11 at 5-6.

A holistic assessment of these *Fintiv* factors in view of the parallel ITC Investigation heavily weighs for discretionarily denying the Petition.

1. Factor 1: There Is No Evidence That The ITC Will Stay The Parallel ITC Investigation If The Petition Were Instituted

This factor weighs heavily against institution because it is highly unlikely that the ITC will stay its parallel Investigation if the PTAB were to institute this Petition—indeed, the ITC has **never** stayed an Investigation for a pending IPR.

The ITC has not granted a stay, Petitioners have not requested a stay, and Petitioners have not represented that they would seek a stay if this Petition were instituted.⁴ And any such motion would be futile because the ITC has never granted

⁴ While the co-pending district court litigation has been stayed, the Board has made clear that when a district court litigation is stayed pending resolution of an ITC investigation “[t]he fact that the parallel district court litigation is stayed is, . . . not

a motion to stay an Investigation for a pending IPR. To date, the ITC has denied **every** motion to stay an investigation for a pending IPR.⁵ Ex. 2115.

The Petition identifies no reason why the ITC would depart from its clear precedent and grant a stay here. Indeed, the Petition does not even address this factor.

Thus, because there is no stay, and because the ITC is highly unlikely to grant a stay, this factor weighs heavily against institution.

the focus of this *Fintiv* factor.” See *Arashi Vision Inc. US d/b/a Insta360 v. GoPro, Inc.*, IPR2025-00017, Paper 11 at 9 (PTAB Apr. 28, 2025).

⁵ The ITC has granted one stay motion related to an IPR, but that stay motion was unopposed (which would not be the case if Petitioner were to move to stay the ITC case at issue here) and did not concern a pending IPR. Rather, that single stay was on an unopposed motion and concerned an already completed IPR upon appellate review: the parties agreed to stay the ITC Investigation pending appellate review of an IPR final written decision invalidating the patent-in-suit. See *Certain Integrated Circuits with Voltage Regulators and Products Containing the Same*, Inv. No. 337-TA-1024, Order No. 55 (Aug. 31, 2018).

2. Factor 2: The ITC Trial And Investigation Will Be Completed Before The Projected FWD Deadline

Factor 2 weighs heavily against institution because the ITC trial/hearing and Investigation will be completed before the projected final written decision date:

- All relevant deadlines and work in the parallel ITC Investigation are scheduled to conclude substantially before the projected final written decision date, including the ITC Trial/Hearing (**over eleven months before** the FWD), the ALJ’s Initial Determination, (roughly **ten months before** the FWD), and the Commission’s Target Date (roughly **five months before** the FWD); and
- The ITC’s relevant history of conduct and time-to-final decision statistics establish that there is no reasonable likelihood that the ITC will reschedule these deadlines to after the FWD.

The USPTO’s “Guidance on USPTO’s Recission of ‘Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation’” (the “Guidance Memo”)⁶ re-establishes that “the Board will apply the

⁶ Available at

https://www.uspto.gov/sites/default/files/documents/guidance_memo_on_interim_procedure_recission_20250324.pdf.

Fintiv factors when there is a parallel proceeding at the International Trade Commission.” Ex. 2116 at 2. Petitioners suggest that the PTO’s Guidance Memo be ignored because the “the ITC case, which is not dispositive of the invalidity issues in the WDTX case, will not resolve all issues concerning the ’803 patent.” Pet. at 4. But the Guidance Memo addresses this very issue, confirming that the ITC must be considered as a parallel proceeding because “as the *Fintiv* decision explains, although an ITC final invalidity determination does not have a preclusive effect, it is difficult as a practical matter to assert patent claims that are invalid.” Indeed, Petitioner’s argument that the ITC decision will not preclude a later district court decision belies its complaint that it has no options to invalidate the challenged claims—if the Petitioners fail to invalidate the claims at the ITC, they could have a second chance at doing so in the district court.

The Guidance Memo states that “instituting an IPR . . . where the ITC has set a target date for completing its investigation (i.e., the full Commission’s final determination) to occur earlier than the Board’s deadline to issue a final written decision in a challenge involving the same patent claims means that multiple tribunals may be adjudicating validity at the same time, which may increase duplication and expenses for the parties and the tribunals. Ex. 2116 at 2. That is the exact circumstance here. If the Board were to institute the Petition, the Final Written Decision deadline would be April 22, 2027, nearly five months after the ITC’s

November 30, 2026, Target Date for Completion of the Investigation. And it is highly unlikely that the ITC will reschedule this deadline so that the FWD precedes the completion of the ITC Investigation. Since 2022, the average time between the ITC instituting and completing a full Investigation is 17.7 months.⁷ Ex. 2117. Here, the April 22, 2027, deadline for a FWD would be over 23 months after the ITC instituted the parallel ITC Investigation. Ex. 2118. Thus, even if the ITC Investigation were to be extended, it will almost certainly be completed well before the FWD deadline.

Moreover, the 5-day ITC Hearing is currently scheduled for May 4-8, 2026, over eleven months before the projected FWD deadline. Therefore, over eleven months before any FWD, the parties and the ITC will already have completed nearly all of the work on the parties' disputes—including Petitioner's invalidity defenses—including all fact discovery, claim construction, expert reports, expert depositions, discovery, pre-trial submissions and motion practice, and the 5-day trial itself. The only work left will be (1) the ITC Administrative Law Judge ("ALJ") presiding over the Investigation issuing her written rulings and opinions on those disputes

⁷ 17.7 months is the average for ITC Investigations that are completed on the merits. The average time between institution and completion of all ITC Investigations since 2022 is 13.24 months. Ex. 21**.

(including invalidity) by the Initial Determination Date of July 30, 2026 (which is nearly ten months prior to the projected FWD deadline); and (2) the parties then potentially petitioning the ITC to review some of the ALJ's determinations, which the ITC will resolve to complete the Investigation by the November 30, 2026, Target Date.

Accordingly, Factor 2 weighs heavily in favor of denying institution. *See Samsung Electronics Co., Ltd. v. Sionyx, LLC*, IPR2024-01431, Paper 21 at 13-14 (PTAB Apr. 10, 2025).

3. Factor 3: The Parties And The ITC Will Have Investigated Significant Time And Resources In The Parallel ITC Investigation By The time Of The Institution Decision

Under *Fintiv* Factor 3, the Board considers “the amount and type of work already completed in the parallel litigation by the court and the parties at the time of the institution decision.” *Fintiv* at 9. The Board's Institution Decision is expected no later than November 15, 2025.

The Petition does not even address this factor, which weighs heavily against institution because the parties and the ITC have already expended a great deal of time and resources on this dispute, and will expend even more before an institution decision. For example, as of the filing of this request for discretionary denial:

- The parties have already engaged in over six months of intensive discovery, including serving and responding to 322 interrogatories and 513

document requests, producing over 35,000 documents, and producing and reviewing additional confidential materials on secure computers located throughout the United States;

- The parties have engaged in claim construction discovery and exchanged proposed claim constructions;
- Patent Owner has prepared and served its initial and supplemental infringement contentions;
- Petitioner NVIDIA has prepared and served its non-infringement contentions responding thereto;
- Petitioner NVIDIA has prepared and served its initial and supplemental invalidity contentions, asserting 30 prior art references against the '803 patent and including 13 claim charts for the '803 patent;
- Patent Owner has prepared and served its validity contentions (Ex. 2112) responding to Petitioners' extraordinarily voluminous invalidity contentions; and
- The Technology Tutorial and *Markman* Hearing was held on December 10, 2025.

In addition, before the scheduled April 22, 2026, decision on institution in this proceeding:

- Patent Owner will have prepared and served its final infringement contentions and Petitioner will have prepared and served its final invalidity contentions (January 21, 2026);
- Patent Owner will have prepared and served its final validity contentions and Petitioner will have prepared and served its final non-infringement contentions (February 4, 2026);
- The parties will have exchanged initial and rebuttal expert reports, including on validity (February 16, 2026 for initial reports and March 9, 2026 for rebuttal reports);
- Both Patent Owner and Petitioner will have filed pre-hearing statements and briefs, including on validity (April 3, 2026)
- The parties will have filed and responded to motions *in limine* and high priority objections statements (April 13, 2026 for initial motions and statements and April 20, 2026 for responses)
- The parties will have submitted proposed exhibits to the ALJ (April 22, 2026).

Therefore, because the parties and the ITC have invested and will continue to invest significant time and resources in the parallel ITC investigation, Factor 3 weighs heavily in favor of denying institution of the Petition.

4. Factor 4: There is Significant Overlap Between the Issues Raised in the Petition and the Parallel ITC Investigation

“[I]f the petition includes the same or substantially the same claims, grounds, arguments, and evidence as presented in the parallel proceeding, th[at] fact has favored denial.” *Fintiv*, IPR2020-00019, Paper 11 at 12. This factor weighs heavily against institution because Petitioners are presenting the substantially the same invalidity grounds and evidence in the ITC as they included in the Petition.

As in the Petition, Petitioners are asserting that claims of the '803 patent are invalid by prior art as obvious under § 103. Moreover, Petitioner is raising in the ITC all prior art references raised in the Petition. For example, in Petitioner's ITC Invalidity Contentions, it asserts the claims of the '803 Patent are invalid in light of the same exact art asserted in this Petition, namely U.S. Patent No. 7,598,958 (Kelleher), U.S. Patent No. 11,610,862 (Collins), U.S. Patent No. 10,909,652 (Koker), and U.S. Patent Appl. No. 2009/0037658 (Sistla). Exs. 2102 (Kelleher), 2105 (Koker), 2106 (Collins), 2111 (Sistla).

Third, there is almost complete overlap between the claims challenged in the ITC and those challenged in the Petition. The Petition challenges only a single dependent claim (dependent claim 4) that is not currently asserted in the ITC. See Ex. 21** (Keller claim chart) at 1. But claim 4 depends from claim 3, which in turn depends from independent claim 1. Both claims 1 and 3 **are** at issue and challenged

in the ITC. And so in arguing invalidity of claim 4 in this proceeding, Petitioner will be arguing invalidity of the claims asserted in the ITC. Moreover, dependent claim 4 adds only “a third GPU chiplet” including the same limitations as the first and second GPU chiplets recited in claims 1 and 3, which are at issue in the ITC. See Ex. 1001, claims 1, 3, 4.

'803 patent, claim 1	'803 patent, claim 3	'803 patent, claim 4
A system, comprising: a central processing unit (CPU) communicably coupled to a first graphics processing unit (GPU) chiplet of a GPU chiplet array, wherein the GPU chiplet array includes: the first GPU chiplet communicably coupled to the CPU via a bus; and a second GPU chiplet communicably coupled to the first GPU chiplet via a passive crosslink, wherein the passive crosslink is dedicated for inter-chiplet communications.	The system of claim 1, wherein the first GPU chiplet comprises a first PHY region including conductor structures for chiplet-to-chiplet communications, and further wherein the second GPU chiplet comprises a second PHY region including conductor structures for chiplet-to-chiplet communications.	The system of claim 3, further comprising: a third GPU chiplet communicably coupled to the first GPU chiplet via the passive crosslink, wherein the third GPU chiplet comprises a third PHY region including conductor structures for chiplet-to-chiplet communications.

As a result, all but one limitation of claim 4 (that the system includes “a third GPU chiplet”) is in fact already the subject of Respondents’ invalidity grounds,

arguments, and evidence in the ITC. Accordingly, the Petition does not argue (with support or otherwise) that this slight difference somehow means that the Petition does not include “substantially the same claims, grounds, arguments, and evidence as presented in the parallel [ITC] proceeding.” *Fintiv*, IPR2020-00019, Paper 11 at 12-13 (“[I]f a petition involves the same prior art challenges but challenges claims in addition to those that are challenged in the district court, it may still be inefficient to proceed because the district court may resolve validity of enough overlapping claims to resolve key issues in the petition.”). Instead, the Petition just ignores this almost total overlap.

For each of the foregoing reasons, Factor 4 weighs heavily in favor of denying institution.

5. Factor 5: Petitioners And Patent Owner Are Parties In The Parallel ITC Investigation

Factor 5 also weighs heavily in favor of discretionary denial because the parties to this proceeding are also parties in the parallel ITC investigation. *Fintiv*, at 15 (“Because the petitioner and the defendant in the parallel proceeding are the same party, this factor weighs in favor of discretionary denial.”).

Patent Owner Onesta is Complainant in the parallel ITC Investigation, and Petitioner NVIDIA is a Respondent in the ITC Investigation.

Therefore, Factor 5 weighs heavily in favor of denying institution.

6. Factor 6: No Other Circumstances Justify Institution

The final *Fintiv* factor considers whether there are other circumstances that impact the exercise of discretion, including the merits of the Petition. But no other circumstances weigh against the PTAB and the Director exercising their discretion to deny institution. To the contrary, this factor (like all of the others) weighs in favor of exercising discretion and denying the Petition—as Patent Owner will show in its upcoming Preliminary Response, the Petition not only fails to establish compelling merits, it fails to establish even the required likelihood of success.

The Petition does not argue, much less establish, that compelling merits exist here. Nor would such an (incorrect) argument matter here in light of the other *Fintiv* factors and the holistic assessment weighing against institution. As the PTO’s Guidance Memo states, “compelling merits alone is not dispositive in making the [balanced] assessment [of all the relevant circumstances in the case.]” (EX2107 at 3).

Rather than addressing the *Fintiv* factors or arguing that compelling merits are present here, Petitioner argues (without support) that IPR should be instituted because NVIDIA GPUs are “critical to the U.S.’s national interest” and “Onesta should not be permitted to use a plainly invalid patent to hold the U.S. economy hostage.” Pet. at 4. But this allegation is irrelevant—as the Patent Office and Department of Justice recently emphasized in a Joint Comment to the ITC, “the

general importance of an infringer's company or technology is not the same as the public interest." Ex. 2119 at 4. "[S]uch arguments are often private commercial interests masquerading as public concerns." *Id.* NVIDIA's attempt to frame its own commercial interests as a matter of public concern is precisely the sort of argument criticized in the Joint Comment. *See also id.* ("The Commission should reject attempts to convert the public interest factors into preliminary obstacles to enforcement.").

Moreover, Petitioner "does not explain in sufficient detail why review of the challenged patents is in the interest of... the economy." *Taiwan Semiconductor Mfg. Co. Ltd., et. al v. Marlin Semiconductor Ltd.*, IPR2025-00864, Paper 11 at 3. Like in IPR2025-00864, here, "Petitioner's arguments are not narrowly-tailored towards particular products or manufacturing methods, and Petitioner does not sufficiently explain how national security, economic, or public interests warrant review of the specific patents challenged in these proceedings." *Id.* And Petitioner can raise its invalidity arguments, as it currently is, before the ITC and presiding ALJ (who has considerable experience in both invalidity determinations and computer hardware patents), without needing to waste the PTAB's resources to challenge the same claims in a subsequent duplicative and inefficient parallel proceeding.

Thus, the Petition fails to identify any relevant circumstances that would impact the exercise of discretion here, much less any circumstances outweighing the

above factors and analysis, thereby compelling a discretionary denial here. Accordingly, Factor 6, like Factors 1-5, weighs in favor of denying institution.

For all of the above reasons, the Petition should be discretionarily denied.

IV. Conclusion

For at least the reasons discussed above, Patent Owner respectfully requests that the Director and the Board exercise their discretion and deny institution of the Petition.

Dated: December 22, 2025

/s/ William A. Meunier

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CERTIFICATE OF WORD COUNT

Pursuant to 37 C.F.R. §42.24(d), Patent Owner hereby certifies, in reliance on the word count of the word-processing system (Microsoft Office Word 2010) used to prepare this preliminary response, that the number of words in this paper is 4,168. This word count excludes the tables of contents, tables of authorities, certificate of word count, certificate of service, and table of exhibits.

Dated: December 22, 2025

/s/ William A. Meunier

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CERTIFICATE OF SERVICE

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