

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE OFFICE OF THE UNDER SECRETARY OF COMMERCE  
FOR INTELLECTUAL PROPERTY AND DIRECTOR OF THE  
UNITED STATES PATENT AND TRADEMARK OFFICE

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ADVANCED MICRO DEVICES, INC. and  
PENSANDO SYSTEMS, INC.,  
Petitioner,

v.

XTREAMEDGE, INC.,  
Patent Owner.

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IPR2025-00223 (Patent 10,985,943 B1)  
IPR2025-00478 (Patent 8,924,596 B1)  
IPR2025-00486 (Patent 10,873,753 B1)<sup>1</sup>

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Before JOHN A. SQUIRES, *Under Secretary of Commerce for Intellectual  
Property and Director of the United States Patent and Trademark Office.*

Decision  
Granting Patent Owner's Motion to Vacate and Terminate

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<sup>1</sup> This Decision applies to each of the above-listed cases. All citations are to IPR2025-00223. The parties filed similar papers and exhibits in all cases.

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## I. BACKGROUND

XtreamEdge, Inc. (“Patent Owner”) and Advanced Micro Devices, Inc. and Pensando Systems, Inc. (collectively, “Petitioner”) are engaged in a parallel district court litigation (“Parallel Litigation”) involving the same patents challenged in these *inter partes* reviews (“IPRs”). *Concurrent Ventures, LLC v. Advanced Micro Devices, Inc.*, No. 4:25-cv-09567-JST. On April 22, 2025, Petitioner filed “Defendants’ Stipulation Regarding Invalidity Contentions” (“Stipulation”) in the Parallel Litigation, and later filed the Stipulation as an exhibit with the Board. Ex. 1048. Petitioner agreed that “if the Board institutes [these IPRs],” then it “will not pursue in this case the specific grounds [asserted in its IPRs] . . . , or on any other grounds for which the Board institutes, that was raised or could have been reasonably raised in an IPR.” *Id.* at 3. Petitioner represented to the Board that the Stipulation mitigates “any concerns of duplicative efforts between the district court and the Board.” Paper 8, 2.

In October and November 2025, the Board instituted the IPRs. On February 13, 2026, Petitioner served invalidity contentions in the Parallel Litigation. Ex. 3103. Petitioner’s invalidity contentions asserted that the challenged patents are invalid based on the same prior art and arguments raised in these IPRs. *Id.* at 10, 60, 78. Specifically, the invalidity contentions expressly incorporated by reference each IPR Petition. *Id.*

I initiated *sua sponte* Director Review. Paper 25. With authorization, Patent Owner filed a Motion to Vacate the Institution Decisions and Terminate the Proceedings arguing that Petitioner violated its Stipulation.

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Paper 27 (“Motion”). Petitioner filed an opposition. Paper 28 (“Opposition”).

After reviewing the parties’ briefs, I grant Patent Owner’s motion to vacate and terminate these IPRs.

## II. ANALYSIS

Patent Owner contends that Petitioner violated its Stipulation by “expressly identify[ing] the specific IPR grounds in [its] contentions and assert[ing it is] relying on those very same grounds in the district court case.” Motion 8. I agree with Patent Owner.

Although Petitioner responds with several arguments why I should not vacate and terminate these IPRs, none persuade me to excuse Petitioner’s conduct.

First, Petitioner argues that the district court, and not the Office, should determine whether Petitioner has violated its Stipulation. Opposition 6–9. But Petitioner filed the Stipulation with the Office to avoid a discretionary denial of institution. In the Stipulation, Petitioner represented *to the Office* that, if institution was granted, Petitioner would not pursue in the district court the grounds asserted in the IPRs or any other ground “that was raised or could have been reasonably raised in an IPR.” Stipulation 3. Therefore, I am not persuaded by Petitioner’s contention that the Office should decline to take up the question of whether a petitioner has violated a stipulation.

Petitioner’s arguments that the Board consistently has declined to decide stipulation violations is inapposite. Opposition 7. Stipulations, as conditions of institution, would be meaningless if a party were free to simply

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ignore its representations to the Office after the Office institutes review. Nevertheless, non-precedential prior Board decisions do not bind my authority to determine whether a party has violated a stipulation.

Second, Petitioner argues that it did not violate the Stipulation because it did not raise the IPR grounds in an expert report, motion for summary judgment, or at trial in the Parallel Litigation. Opposition 9–10.<sup>2</sup> Similarly, Petitioner suggests that its invalidity contentions were “disclosing, but not pursuing, grounds that are covered by [its] Stipulation,” Opposition 14–15, and that it incorporated the IPR Petition grounds into the contentions as a “conditional disclosure of prior art grounds.” *Id.* at 10.

Petitioner’s action of incorporating the IPR grounds into its invalidity contentions violates the Stipulation it filed with the Office. Petitioner stipulated that it “will not *pursue*” its IPR grounds in the Parallel Litigation, and then served invalidity contentions that included those IPR grounds. Stipulation 3 (emphasis added); Ex. 3103, 10, 60, 78. Petitioner’s view of how a stipulation is triggered and operates would effectively allow petitioners to maintain duplicative grounds in district court until the eve of trial. Such a position is problematic, as it could force patent owners to expend significant resources substantively responding to such grounds in the

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<sup>2</sup> Petitioner also suggests that it was complying with the district court’s Patent Local Rules to disclose “all such prior art regardless of whether it will be pursued.” *Id.* at 12–13. Whether Petitioner was following the district court’s requirements is a matter for the district court to decide. Here, I find that Petitioner violated its Stipulation and representations to the Office by pursuing its IPR grounds by including those grounds in its invalidity contentions.

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district court. This does not ensure that the IPRs are a “true alternative” to parallel litigation. *See Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 at 19 (PTAB Dec. 1, 2020) (precedential as to § II.A).

There are circumstances where parties may legitimately dispute whether a petitioner’s asserted invalidity contentions in district court violate a *Sotera*-style stipulation. However, these IPRs do not present such circumstances. Petitioner expressly incorporated the *same* art and *same* arguments from its Petitions into its invalidity contentions *after* these IPRs were instituted. Ex. 3103. Such conduct undermines the purpose of the Stipulation, which is to “mitigate the concern of duplicative efforts between the district court and the Board,” Paper 8, 2, and jeopardizes the purpose of IPRs serving as an *alternative* to district court. Petitioner’s conduct, therefore, warrants reconsideration of the earlier decisions to institute under 35 U.S.C. § 314(a). Based on that conduct I determine that termination of the IPRs is appropriate.

Accordingly, it is:

ORDERED that Patent Owner’s Motion to Vacate and Terminate (Paper 27) is granted; and

FURTHER ORDERED that the IPRs are terminated.

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