

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**BEFORE THE PATENT TRIAL AND APPEAL BOARD**

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TESLA, INC.,  
Petitioner,

v.

INTELLECTUAL VENTURES II LLC,  
Patent Owner.

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IPR2025-00638  
U.S. Patent No. 8,898,395

**JOINT MOTION TO DISMISS PETITION AND  
TERMINATE IPR PROCEEDING**

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**I. Introduction**

Petitioner Tesla, Inc. and Patent Owner Intellectual Ventures II, LLC (collectively, the “Parties”) jointly submit this motion to dismiss the Petition and terminate IPR2025-00638 under 37 C.F.R. §§ 42.71(a) and 42.72. In a June 5, 2025 email, the Board authorized the parties to file this motion.

The Board has discretion to “grant, deny, or dismiss any petition or motion.” 37 C.F.R. § 42.71(a). The Parties respectfully request that the Board dismiss the Petition (Paper 2) and terminate the proceeding for the good cause shown herein. The Parties have fully and permanently resolved their dispute with regard to U.S. Patent No. 8,898,395, the patent at issue in this IPR proceeding. Specifically, all claims related to the ’395 patent in the parallel proceeding have been dismissed *with prejudice*.

This IPR proceeding is at an early stage. Patent Owner has not filed any briefing in this IPR proceeding, and the Board has not yet determined whether to institute review of the claims challenged in this IPR proceeding. Furthermore, neither party wishes to expend further resources on this matter.

Termination will achieve a just, speedy, and inexpensive resolution of the dispute. 37 C.F.R. § 42.1(b). Patent Owner has not filed any briefing in this IPR proceeding, and the Board has yet to consider or issue any institution decision or final written decision. As such, preservation of resources would be real and

substantial for both the Board and the Parties. Withdrawal is also in the interest of justice, as the Parties have no other disputes involving the '395 patent, and dismissal will resolve all matters involving the '395 patent between the Parties.

## II. Argument

Good cause exists to dismiss the Petition and to terminate this IPR proceeding. The Parties' dispute with respect to the '395 patent has been fully and permanently resolved.

The '395 patent was at issue between the Parties in *Intellectual Ventures II LLC v. Telsa, Inc.*, No. 1:24-cv-00884-ADA in the U.S. District Court for the Western District of Texas ("the parallel proceeding"). On May 6, 2025, Patent Owner and Petitioner jointly moved to dismiss *with prejudice* (1) all of Patent Owner's claims relating to the '395 patent against Petitioner in the parallel proceeding, and (2) all of Petitioner's counterclaims relating to the '395 patent in the parallel proceeding. Ex.1028, 1. On May 16, 2025, the presiding judge in the parallel proceeding ordered that (1) all of Patent Owner's claims relating to the '395 patent against Petitioner are dismissed *with prejudice*, and (2) all of Petitioner's counterclaims relating to the '395 patent are dismissed *with prejudice*. Ex.1029, 1. Therefore, there is no longer any dispute—and will never be—between the Parties with respect to the '395 patent. Good cause thus exists to dismiss the Petition and to terminate this IPR proceeding.

The Board has broad authority to dismiss a petition under 37 C.F.R. §§ 42.71(a) and 42.5(a). *See Facebook, Inc. v. EveryMD.com*, IPR2018-00050, Paper 19 at 4 (PTAB Oct. 9, 2018) (noting that “the regulations expressly provide the Board with broad authority to dismiss a petition where appropriate” and dismissing since, among other reasons, it was an “inefficient use of the Board’s resources,” and the proceedings were “at a relatively early stage”); *see also Samsung Elecs. Co. v. NVIDIA Corp.*, IPR2015-01270, Paper 11 at 3–4 (PTAB Dec. 9, 2015) (dismissing because the case was “at [an] early juncture” and “to promote efficiency and minimize unnecessary costs”). As with the Board’s prior decisions, the facts here warrant dismissal, at least to reduce the Parties’ expenses, conserve Board resources, and promote efficiency.

The Parties are not aware of any example wherein the Board found that it could not—or would not—terminate a proceeding under the present circumstances. In the few cases where the Board has denied a request for termination, the Board has repeatedly attributed the advanced stage of the proceeding as weighing against termination. *See, e.g., Blackberry Corp. et al. v. MobileMedia Ideas LLC*, IPR2013-00016, Paper 31 at 3 (PTAB Dec. 11, 2013) (denying motion to terminate due to the advanced stage of the proceeding where “issues had been fully briefed at the time the parties moved to terminate the proceeding”). That is not the case here. Patent Owner has not filed any briefing in this IPR proceeding, and the Board has not

determined whether to institute review of the claims challenged in this IPR proceeding. Accordingly, the Parties' joint request for dismissal of the Petition and termination of the IPR proceeding is early, voluntary, and consistent with the Board's practices.

The Parties further confirm that, beyond their joint agreement to file this motion and move in the parallel proceeding to dismiss *with prejudice* the Parties' claims with respect to the '395 patent, there are no other agreements between the Parties, written or oral, between the Parties made in connection with, or in contemplation of, the dismissal of the Petition and termination of this proceeding. Specifically, there is no settlement agreement or collateral agreement between the Parties with respect to the '395 patent.

The Board should dismiss the Petition and terminate this IPR proceeding. Termination would save the Board and the Parties the time and resources when there is no longer a dispute between the Parties with respect to the '395 patent.

### **III. Conclusion**

The Board should order the dismissal of the Petition and terminate IPR2025-00638.

Joint Motion to Dismiss Petition and Terminate IPR Proceeding  
IPR2025-00638 (U.S. Patent 8,898,395)

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Respectfully submitted,

Date: June 5, 2025

/Jonathan R. Bowser/  
Jonathan R. Bowser  
Lead Counsel for Petitioner  
Registration No. 54,574

/Brandon R. Theiss/  
Brandon R. Theiss  
Lead Counsel for Patent Owner  
Registration No. 70,507

**PETITIONER’S EXHIBIT LIST**

Ex.1001	U.S. Pat. No. 8,898,395 to G. J. Rozas (“the ’395 patent”)
Ex.1002	Prosecution History of U.S. Application No. 12/121,531 (issued as the ’395 patent) (“’395 FH”)
Ex.1003	Declaration of Dr. Robert Colwell under 37 C.F.R. §1.68
Ex.1004	<i>Curriculum Vitae</i> of Dr. Robert Colwell
Ex.1005	U.S. Pat. No. 7,206,903 to Moir et al. (“Moir”)
Ex.1006	“Speculative synchronization: programmability and performance for parallel codes.” J. F. Martínez et al. IEEE Micro, December 2003 (“Martínez”)
Ex.1007	Prosecution History of U.S. Application No. 11/102,127 (issued as US 7,376,798) (“’798 FH”)
Ex.1008	Declaration of Gordon MacPherson
Ex.1009	Landing Page, IEEE Micro Vol. 23, No. 6, Internet Archive Capture, Feb. 1, 2004, <a href="https://web.archive.org/web/20040201212609/http://www.computer.org/micro/">https://web.archive.org/web/20040201212609/http://www.computer.org/micro/</a>
Ex.1010	Table of Contents, IEEE Micro Vol. 23, No. 6, Internet Archive Capture, Feb. 14, 2004, <a href="https://web.archive.org/web/20040214122853/http://csdl.computer.org/comp/mags/mi/2003/06/m6toc.htm">https://web.archive.org/web/20040214122853/http://csdl.computer.org/comp/mags/mi/2003/06/m6toc.htm</a>
Ex.1011	U.S. Pat. Pub. No. 2002/0199066 to S. Chaudhry et al.
Ex.1012	“Transactional Memory: Architectural Support for Lock-Free Data Structures,” M. Herlihy and J. E. B. Moss, ISCA '93: Proceedings of the 20th Annual International Symposium on Computer Architecture, pp. 289-300, May 1993 (“Herlihy and Moss Paper”)
Ex.1013	U.S. Pat. No. 5,428,761 to Herlihy and Moss. (“Herlihy and Moss Patent”)
Ex.1014	IV’s Complaint, <i>Intellectual Ventures II, LLC v. Tesla, Inc.</i> , No. 6:24-cv-188-ADA (WDTX)

Joint Motion to Dismiss Petition and Terminate IPR Proceeding  
IPR2025-00638 (U.S. Patent 8,898,395)

Ex.1015	Proposed Scheduling Order, <i>Intellectual Ventures II, LLC v. Tesla, Inc.</i> , No. 6:24-cv-188-ADA (WDTX)
Ex.1016	Statistics on District Court Timing
Ex.1017	<i>Reserved</i>
Ex.1018	IV's Preliminary Infringement Contentions, <i>Intellectual Ventures II, LLC v. Tesla, Inc.</i> , No. 6:24-cv-188-ADA (WDTX)
Ex.1019	Shen & Lipasti, <i>Modern Processor Design</i> , McGraw Hill, 2005
Ex.1020	<i>Concise Encyclopedia of Computer Science</i> , Wiley, 2004
Ex.1021	<i>The Cache Memory Book</i> , Jim Handy, 2nd ed., Academic Press, 1998
Ex.1022	Hennessy & Patterson <i>Computer Architecture: A Quantitative Approach</i> 3rd ed., Morgan Kaufmann, 2002
Ex.1023	IEEE Authoritative Dictionary of IEEE Standards Terms, 7th edition, 2000 (excerpts)
Ex.1024	Microsoft Computer Dictionary, Fifth Edition, 2002 (excerpts)
Ex.1025	Tesla's Opening Claim Construction Brief, <i>Intellectual Ventures II, LLC v. Tesla, Inc.</i> , No. 6:24-cv-188-ADA (WDTX)
Ex.1026	IV's Responsive Claim Construction Brief, <i>Intellectual Ventures II, LLC v. Tesla, Inc.</i> , No. 6:24-cv-188-ADA (WDTX)
Ex.1027	<i>The SPARC Architecture Manual</i> , Version 9, Prentice-Hall, 2000
Ex.1028 <b>(New)</b>	Joint Motion to Dismiss with Prejudice Pursuant to Federal Rule of Civil Procedure 41(a)(2), <i>Intellectual Ventures II, LLC v. Tesla, Inc.</i> , No. 1:24-cv-00884-ADA (WDTX), ECF No. 54 (May 6, 2025)
Ex.1029 <b>(New)</b>	Order Granting Joint Motion to Dismiss Pursuant to Rule 41(a)(2), No. 55, <i>Intellectual Ventures II, LLC v. Tesla, Inc.</i> , No. 1:24-cv-00884-ADA (WDTX), ECF No. 55 (May 16, 2025)

**CERTIFICATE OF SERVICE**

The undersigned certifies, under 37 C.F.R. § 42.6, that service was made on the Patent Owner as detailed below.

*Date of service* June 5, 2025

*Manner of service* Electronic Email: [BTheiss@vklaw.com](mailto:BTheiss@vklaw.com);  
[DGolub@vklaw.com](mailto:DGolub@vklaw.com); [RODonnell@vklaw.com](mailto:RODonnell@vklaw.com);  
[RLeonard@vklaw.com](mailto:RLeonard@vklaw.com); [rrigby@intven.com](mailto:rrigby@intven.com)

*Documents served* Joint Motion to Dismiss Petition and Terminate IPR Proceeding; Exhibits 1028-1029

*Persons served* Brandon R. Theiss  
Daniel H. Golub  
Ryan W. O'Donnell  
Robert D. Leonard  
VOLPE KOENIG  
30 S. 17th Street, Suite 1800  
Philadelphia PA 19103

Russell J. Rigby  
Intellectual Ventures II LLC  
3150 139th Avenue Southeast Building 4  
Bellevue, WA 98005

/Jonathan R. Bowser/  
Jonathan R. Bowser  
Lead Counsel for Petitioner  
Registration No. 54,574