

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

DELL TECHNOLOGIES INC.,
DELL INC.,
AND
CISCO SYSTEMS, INC.,

Petitioners,

v.

CORRIGENT CORPORATION,

Patent Owner.

IPR2023-00370

Patent No. 7,593,400

**PATENT OWNER'S RESPONSE TO
PETITIONERS' *SOTERA* STIPULATIONS**

I. Petitioners’ Stipulations Should Be Given No Weight

The Board should give Petitioners’ stipulations no weight when it considers the parties’ *Fintiv* arguments for several reasons.

First, Petitioners’ stipulations are replies to the POPR and are thus improper new evidence that could have been presented in the Petition. “Petitioner may not submit new evidence or argument in reply that it could have presented earlier” *Patent Trial and Appeal Board Consolidated Trial Practice Guide November 2019* at 73; *Intelligent Bio-Sys., Inc. v. Illumina Cambridge Ltd.*, 821 F.3d 1359, 1369 (Fed. Cir. 2016) (petitioners are obligated “to make their case in their petition to institute.”). Here, Petitioners deliberately decided to not offer full *Sotera* stipulations when they filed their Petition. Petition at 65. Instead, in their Petition, Petitioners addressed *Fintiv* Factor 4 (“Overlapping issues with the parallel proceeding”) and only submitted a *Sand Revolution*-style stipulation in support of their arguments. *Id.* Now, in reply to the POPR, Petitioners offer *Sotera* stipulations as new evidence to support new *Fintiv* arguments. EX1026; EX1027. This clearly goes against both the PTAB’s rules and Federal Circuit precedent.

Second, consideration of the new *Sotera* stipulations rewards gamesmanship and prejudices Patent Owner. It was not until after Patent Owner expended significant resources responding to the Petition’s *Fintiv* arguments that Petitioners sought to submit their *Sotera* stipulations. And, Petitioners have not offered any

explanation or justification as to why their stipulations were not offered with the Petition.¹ If the Board allows Petitioners to submit the *Sotera* stipulations in reply to the POPR and then uses them to reject Patent Owner's *Fintiv* arguments, the Board is inviting gamesmanship. Petitioners in every case will have no incentive to submit a *Sotera* stipulation with their petitions. They will be able to offer no, or a limited, stipulation (e.g., *Sand Revolution*-style) with their petition, knowing that patent owners will have to expend significant resources crafting *Fintiv* arguments that they can obviate with a later-filed *Sotera* stipulation. Such gamesmanship should not be tolerated nor rewarded with institution in this case.

II. Conclusion

Accordingly, for at least the two reasons above, the Board should not give Petitioners' stipulations any weight as it considers the parties' *Fintiv* arguments. Absent the *Sotera* stipulation, the *Fintiv* Factors strongly weigh in favor of denying institution. POPR at 14–23.

¹ Also, the Director's guidance on stipulations was issued approximately 6 months before the Petition was filed. *Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation* (dated June 21, 2022).

Date: June 27, 2023

Respectfully submitted,

/James R. Nuttall, Reg. No. 44,978/

James R. Nuttall, Reg. No. 44,978

STEPTOE & JOHNSON LLP

227 West Monroe, Suite 4700

Chicago, Illinois 60606

Tel: (312) 577-1260

Fax: (312) 577-1370

Katherine D. Cappaert, Reg. No. 71,639

Thomas Yebernetsky, Reg. No. 70,418

Christopher A. Suarez, Reg. No. 72,553

STEPTOE & JOHNSON LLP

1330 Connecticut Avenue, NW

Washington, DC 20036-1795

Tel: (202) 429-3000

Fax: (202) 429-3902

Counsel Corrigent Corporation

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing PATENT OWNER'S RESPONSE TO PETITIONERS' *SOTERA* STIPULATIONS was served on June 27, 2023 by filing this document through the P-TACTS platform as well as by delivering a copy via the delivery method indicated to the attorneys of record for the Petitioners as follows:

Via Email:

Stuart Rosenberg
SRosenberg@gibsondunn.com
Brian Rosenthal
BRosenthal@gibsondunn.com
Y. Audrey Yang
ayang@gibsondunn.com

Date: June 27, 2023

By: /James R. Nuttall, Reg. No. 44,978/

James R. Nuttall, Reg. No. 44,978
STEPTOE & JOHNSON LLP
227 West Monroe, Suite 4700
Chicago, Illinois 60606
Tel: (312) 577-1260
Fax: (312) 577-1370

Counsel for Corrigent Corporation