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Sent: Thursday, July 13, 2023 12:40 PM
To: Trials <Trials@USPTO.GOV>
Cc: Brian Eutermoser <BEutermoser@KSLAW.com>; Russell Blythe <RBlythe@KSLAW.com>; Mikaela Stone <Mikaela.Stone@KSLAW.com>
Subject: Request for Leave to File Reply to Patent Owner's Preliminary Response in IPR2023-00528

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To the Board,

Petitioner respectfully requests authorization in IPR2023-00528 for entry into evidence a stipulation by Petitioner consistent in scope with the stipulation offered in *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019 Paper 12 (PTAB Dec. 1, 2020) (precedential). Petitioner additionally offers in connection with this request up to 1 page of related briefing to provide context for the stipulation.

If Petitioner's request for entry of the stipulation and offer of related briefing is granted, Petitioner does not oppose Patent Owner's submission of briefing of equal length.

Petitioner respectfully submits that good cause for entry of this stipulation and related briefing exists because the stipulation and related briefing would aid the Board in deliberations on an issue potentially dispositive to institution: namely, discretionary denial of institution under *Fintiv*. If requested by the Board, Petitioner will provide further explanation of good cause. Although Petitioner believes substantive argument should be made on a call with the board rather by email, Petitioner offers the following response to Patent Owner's position as stated below: The Board already has rejected Patent Owner's argument concerning the presence of other defendants in the district court proceedings in IPR2022-01522 (Paper 16). Patent Owner is benefited--not prejudiced--by Petitioner filing a stipulation that is broader in scope rather than one narrower in scope. Petitioner is not aware of any rule or practice requiring the filing of a stipulation consistent with *Sotera* at any particular time, and Patent Owner identifies none.

Petitioner and Patent Owner have met and conferred. Patent Owner opposes this motion and provides the following position: Petitioner has not shown good cause for entry of its proposed stipulation and related briefing. In particular, Petitioner has not explained its failure to offer this new stipulation along with its petition, or at any point before Patent Owner submitted its preliminary response. Fairness dictates that Petitioner not be

allowed to change positions now, after Patent Owner invested resources in *Fintiv* arguments based on the narrower stipulation referenced in not only this petition, but also others filed by Petitioner and still awaiting institution decisions. Moreover, Petitioner has not shown that its proposed stipulation would aid the Board's *Fintiv*-related deliberations. To the contrary, this new proposed stipulation would not bar Petitioner's four co-defendants from litigating the same invalidity challenges in the district court, and thus would not mitigate concerns of duplicative proceedings.

Should the Board desire a call to discuss this request, the parties are available:

1. July 13, 1-2 ET
2. July 14, 3-5 ET

Thank you.

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