

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INFINERA CORPORATION,
Petitioner

v.

ALEXANDER SOTO AND WALTER SOTO,
Patent Owners.

IPR2023-00838
U.S. Patent No. 10,771,181

PETITIONER'S AUTHORIZED *SOTERA* STIPULATION

Petitioner Infinera Corporation has filed a *Sotera* stipulation in the co-pending district court case involving the '181 Patent. As the Board authorized during the call of Wednesday, November 15, 2023, Petitioner submits this *Sotera* stipulation in this IPR proceeding. The following **Attachment A** is a true and correct copy of the stipulation filed by Infinera Corporation in 2:22-cv-00307 in the Eastern District of Texas.

Respectfully submitted,

Dated: November 15, 2023
DUANE MORRIS, LLP
1201 North Market Street, Suite 501
Wilmington, DE 19801
Customer No. 39290

/Monté T. Squire/
Monté T. Squire
Lead Counsel for Petitioner
Registration No. 80,123

CERTIFICATE OF SERVICE

The undersigned certifies, in accordance with 37 C.F.R. § 42.6(e), that service was made on Patent Owner as detailed below.

Date of service November 15, 2023

Manner of service Electronic Service:
ptong@raklaw.com
rak_nextgen@raklaw.com
ilee@raklaw.com
bwang@raklaw.com
aweiss@raklaw.com
pkroeger@raklaw.com
rak_nextgen@raklaw.com

Documents served **Petitioner's Authorized Sotera Stipulation**

Persons served Qi (Peter) Tong
Reg. No. 74,292
Russ August & Kabat
4925 Greenville Avenue,
Suite 200
Dallas, TX 75206

Irene Y Lee (Reg. No. 54,259)
Benjamin T. Wang
Andrew D. Weiss
Paul A. Kroeger
Russ August & Kabat
12424 Wilshire Blvd., 12th Fl.
Los Angeles, CA 90025

Respectfully submitted,

/Monté T. Squire/
Monté T. Squire
Lead Counsel for Petitioner
Registration No. 80,123

ATTACHMENT A

**UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF TEXAS
MARSHALL DIVISION**

NEXTGEN INNOVATIONS, LLC,

Plaintiff,

v.

FUJITSU NETWORK
COMMUNICATIONS, INC., et al,

Defendants.

Case No. 2:22-cv-00307-JRG-RSP
(Lead Case)

NEXTGEN INNOVATIONS, LLC,

Plaintiff,

v.

INFINERA CORPORATION,

Defendant.

Case No. 2:22-cv-00306-JRG-RSP
(Member Case)

JURY TRIAL DEMANDED

**DEFENDANT INFINERA CORPORATION'S STIPULATION
REGARDING U.S. PATENT NO. 10,771,181**

On April 14, 2023, Defendant Infinera Corporation ("Infinera") filed petition no. IPR2023-00838 with the Patent Trial and Appeal Board ("PTAB"), requesting *inter partes* review of U.S. Patent No. 10,771,181 ("the '181 patent"). The IPR2023-00838 petition asserts two grounds of unpatentability: (1) claims 1-3, 5, 6, 8, 10, 12-17, 22, and 23 would have been obvious over U.S. Patent Application Publication No. 2003/0020986 to Pang et. al. ("Pang") in view of U.S. Patent Application Publication No. 2002/0167693 to Vrazel et al. ("Vrazel"); and (2) claim 11 would have been obvious over Pang in view of Vrazel and U.S. Patent No. 7,206,366 to Fujimori.

Infinera stipulates that if the PTAB institutes *inter partes* review on claims on the grounds presented in the petition, Infinera will not pursue against such claims in the co-pending district court litigation the specific grounds asserted in the petition, or any other ground that was raised or could have been reasonably raised in an *inter partes* review. *See Sotera Wireless, Inc. v. Masimo Corp.*, No. IPR2020-00109, Paper 12 at 18–19 (PTAB Dec. 1, 2020).

Notwithstanding this Stipulation, Infinera reserves the right to assert in this litigation any grounds or claims on which the Board declines to institute *inter partes* review. Infinera also reserves the right to assert grounds other than the grounds raised or could have been reasonably raised in the *inter partes* review for these claims.

Dated: November 8, 2023

Respectfully submitted,

/s/ Holly Engelmann

Holly Engelmann

Email: hengelmann@duanemorris.com

DUANE MORRIS LLP

Las Cimas IV

900 S. Capital of Texas Hwy., Suite 300

Austin, TX 78746-5435

Telephone: (512) 277-2300

Facsimile: (512) 277-2301

Melissa R. Smith

State Bar No. 24001351

Email: melissa@gillamsmithlaw.com

GILLAM & SMITH, LLP

303 South Washington Avenue

Marshall, TX 75670

Telephone: (903) 934-8450

Facsimile: (903) 934-9257

Matthew C. Gaudet

Email: mcaudet@duanemorris.com

Sajid Saleem

Email: ssaleem@duanemorris.com

Daniel D. Mitchell

Email: dmitchell@duanemorris.com

DUANE MORRIS LLP

1075 Peachtree NE, Suite 1700
Atlanta, GA 30309
Telephone: (404) 253-6900
Facsimile: (404) 253-6901

Monté T. Squire
Email: mtsquire@duanemorris.com
DUANE MORRIS LLP
1201 N. Market Street, Suite 501
Wilmington, DE 19801
Telephone: (302) 657-4918
Facsimile: (302) 397-2543

John M. Baird
Email: jmbaird@duanemorris.com
DUANE MORRIS LLP
901 New York Ave NW, Suite 700 East
Washington, DC 20001
Telephone: (202) 776-7819
Facsimile: (202) 379-9850

Brianna M. Vinci
Email: bvinci@duanemorris.com
DUANE MORRIS LLP
30 S. 17th Street
Philadelphia, PA 19103
Telephone: (215) 979-1198
Facsimile: (215) 754-4983

Jordana A. Garellek
jgarellek@duanemorris.com
DUANE MORRIS LLP
1540 Broadway
New York, NY 10036
Telephone: (212) 471-1829
Facsimile: (212) 214-0889

Counsel for Defendant Infinera Corporation

CERTIFICATE OF SERVICE

I hereby certify that on November 8, 2023, I electronically filed the foregoing with the Clerk of Court using the CM/ECF system, which will send notification of such filing to all counsel of record.

/s/ Holly Engelmann
Holly Engelmann