UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INTEL CORPORATION,
Petitioner

v.

PROFESSOR MASAHIRO IIDA,
Patent Owner

Case IPR2023-00864
U.S. Patent No. 6,812,737

PATENT OWNER'S AUTHORIZED SUR-REPLY TO PETITIONER'S REPLY TO PATENT OWNER'S PRELIMINARY RESPONSE

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Petitioner's counsel's letter (Exhibit 1045) falls short as an enforceable *Sotera* stipulation as Petitioner has not filed it as part of the record in the parallel proceeding pending in the Western District of Texas.

"A stipulation is 'an agreement, admission, or concession made in a judicial proceeding by the parties or their attorneys respecting some matter incident thereto.'" *Shepherd v. Ledford*, 962 S.W.2d 28, 33 (Tex. 1998) (quoting *Ortega-Carter v. Am. Int'l Adjustment Co.*, 834 S.W.2d 439, 441-42 (Tex. App. Dallas 1992)). It is "a binding contract between the parties and the court." *Houston Lighting & Power Co. v. City of Wharton*, 101 S.W.3d 633, 641 (Tex. App. Houston 2003).

It is a well-established principle that "once a stipulation is signed and submitted to the court, it acts as a binding contract between the parties." *Direct Lineal Descendants of Jack v. Sec'y of the Interior*, 2014 U.S. Dist. LEXIS 151148, *4 (D. Nev. October 24, 2014) (citing *Muller v. Dows*, 94 U.S. 277, 278 (1876) (stating that a stipulation between counsel cannot be withdrawn by one party without consent of the other, except by leave of the court)). A stipulation is not enforceable unless it is in writing, signed, and filed as part of the record, or unless it is made in open court and entered of record. Tex. R. Civ. P. 11 ("Rule 11"); *Owens v. Curry*, 2023 Tex. App. LEXIS 2557 (Tex. App. Fort Worth April 20, 2023); *Blum v. GE*, 536 F. Supp. 2d 720 (W.D. Tex. 2008).

Rule 11[1] provides that agreements between attorneys or parties with respect to pending suits will only be enforced if they are (1) written, signed, and filed as a part of the record, or (2) made in open court and as part of the record. Tex. R. Civ. P. 11; *Shepherd*, 962 S.W.2d at 33. If a purported stipulation "does not comply with the mandates of Rule 11, *it is without effect*." *Caprock Inv. Corp. v. FDIC*, 17 S.W.3d 707, 713 (Tex. App. Eastland 2000) (emphasis added); *Fidelity & Cas. Co. of N.Y. v. McCollum*, 656 S.W.2d 527, 529 (Tex. App. Dallas 1983) (stipulation that failed to comply with Rule 11 held unenforceable).

Here, Petitioner's counsel has circulated a letter purporting to express Petitioner's intent to enter into a stipulation. *See* Exhibit 1045. While the language in this letter is consistent with that of *Sotera*, the critical difference is that the petitioner in *Sotera* actually offered the Board an *enforceable* stipulation insofar as it had been filed as part of the record in the District Court. *See Sotera Wireless, Inc. v. Masimo Corporation*, IPR2020-01019, Paper 12 at 13. Filing is what elevated a

[1] This rule "has been followed and enforced in a multitude of Texas cases for many years." *Condit Chemical & Grain Co. v. Helena Chemical Corp.*, 789 F.2d 1101, 1102 (5th Cir. 1986) ("The rule is obviously akin to and is considered a part of a parol evidence rule. It is now well established in the law that the parol evidence rule, although called a rule of evidence, is actually a rule of substance.").

proposed undertaking to an enforceable stipulation. No such comparably enforceable stipulation has been offered by Petitioner in the present case. Simply put, Exhibit 1045 does not constitute an enforceable *Sotera* stipulation. It is "without effect." Accordingly, the Board should disregard Exhibit 1045 and undertake a *Fintiv* analysis.

All of the *Fintiv* factors weigh against institution. Petitioner has offered no evidence that a stay will be granted in this case. Current statistics show a median time-to-trial in the Western District of Texas of 26.4 months. Here, this would mean a trial slightly *before* it is presently scheduled in September 2024 – *two months prior* to when a final written decision would be due. When an institution decision is made, the parties will have already exchanged infringement and invalidity contentions, completed claim construction, exchanged and responded to discovery requests, and produced and reviewed substantial numbers of documents. And absent an enforceable *Sotera* stipulation, the District Court will adjudicate the validity of the '737 patent based on the same references relied upon in the Petition.

As to the merits, as explained in the Preliminary Response, Fujii fails to teach or suggest a programmable logic element constructed from a plurality of individual LUT units, or a configuration control circuit for controlling an internal configuration of a plurality of LUT units. As a result, the combinations of references cited in the Petition fail to teach or suggest the claimed invention.

Dated: September 19, 2023

Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify that on September 19, 2023, I caused a copy of the foregoing document to be served via electronic mail (as consented to by counsel) upon the following:

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