IN THE UNITED STATES DISTRICT COURT
FOR THE WESTERN DISTRICT OF TEXAS
WACO DIVISION

EIGHT KHZ, LLC, *Plaintiff*, v. META PLATFORMS, INC.; META PLATFORMS TECHNOLOGIES, LLC; TWISTED PIXEL GAMES, LLC, *Defendants*.	Civil Action No. 6:22-cv-00575-ADA-DTG

DEFENDANTS META PLATFORMS, INC.'S, META PLATFORMS TECHNOLOGIES, LLC'S, AND TWISTED PIXEL GAMES, LLC'S
STIPULATION REGARDING INVALIDITY CHALLENGES

Defendants Meta Platforms, Inc., Meta Platforms Technologies, LLC, and Twisted Pixel Games, LLC (collectively, "Defendants" or "Meta"), by and through their undersigned counsel, hereby stipulate as follows.

WHEREAS, on June 8, 2023, Meta filed a petition with the Patent Trial and Appeal Board ("PTAB") requesting *inter partes* review ("IPR") of claims 1-20 of U.S. Patent No. 10,368,179 (the "'179 patent"), *see* IPR2023-01019, Paper 2;

WHEREAS, on June 8, 2023, Meta filed a petition with the PTAB requesting IPR of claims 1-20 of U.S. Patent No. 10,448,184 (the "'184 patent"), *see* IPR2023-01020, Paper 2;

WHEREAS, on June 8, 2023, Meta filed a petition with the PTAB requesting IPR of claims 8-17 of U.S. Patent No. 11,290,836 (the "'836 patent"), *see* IPR2023-01024, Paper 2;

WHEREAS, on June 9, 2023, Meta filed a petition with the PTAB requesting IPR of claims 1-20 of U.S. Patent No. 10,917,737 (the "'737 patent"), *see* IPR2023-01021, Paper 2;

WHEREAS, on June 9, 2023, Meta filed a petition with the PTAB requesting IPR of claims 1-20 of U.S. Patent No. 11,172,316 (the "'316 patent"), *see* IPR2023-01022, Paper 2;

WHEREAS, on June 9, 2023, Meta filed a petition with the PTAB requesting IPR of claims 1-14 and 17-20 of U.S. Patent No. 10,798,509 (the "'509 patent"), *see* IPR2023-01023, Paper 2;

WHEREAS, on June 9, 2023, Meta filed a petition with the PTAB requesting IPR of claims 1-3, 6, 8-10, 12, and 14-19 of U.S. Patent No. 9,226,090 (the "'090 patent"), *see* IPR2023-01003, Paper 1;

WHEREAS, on June 9, 2023, Meta filed a petition with the PTAB requesting IPR of claims 1, 4-6, 8-11, 14-15, and 17-19 of U.S. Patent No. 9,282,196 (the "'196 patent"), *see* IPR2023-01004, Paper 1; and

WHEREAS, on June 9, 2023, Meta filed a petition with the PTAB requesting IPR of claims 9-14 and 16-20 of U.S. Patent No. 9,674,628 (the "'628 patent"), *see* IPR2023-01005, Paper 1; and

WHEREAS, Plaintiff Eight kHz, LLC ("8K") has argued in Patent Owner Preliminary Responses in each of the above-listed IPR proceedings that the PTAB should exercise its discretion under 35 U.S.C. § 314 to deny institution of the requested IPRs, *see, e.g.*, IPR2023-01019, Paper 6 at 50-59.

THEREFORE, Meta hereby STIPULATES as follows:

If the PTAB institutes the pending IPR in IPR2023-01019 challenging the patentability of claims 1-20 of the '179 patent, then Meta will not pursue as to the challenged claims any ground raised or that could have been reasonably raised in the IPR in the above-captioned district court

litigation (No. 6:22-cv-00575-ADA). *See Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 at 16-19 (PTAB Dec. 1, 2020).

If the PTAB institutes the pending IPR in IPR2023-01020 challenging the patentability of claims 1-20 of the ’184 patent, then Meta will not pursue as to the challenged claims any ground raised or that could have been reasonably raised in the IPR in the above-captioned district court litigation (No. 6:22-cv-00575-ADA). *See Sotera*, IPR2020-01019, Paper 12 at 16-19.

If the PTAB institutes the pending IPR in IPR2023-01024 challenging the patentability of claims 8-17 of the ’836 patent, then Meta will not pursue as to the challenged claims any ground raised or that could have been reasonably raised in the IPR in the above-captioned district court litigation (No. 6:22-cv-00575-ADA). *See Sotera*, IPR2020-01019, Paper 12 at 16-19.

If the PTAB institutes the pending IPR in IPR2023-01021 challenging the patentability of claims 1-20 of the ’737 patent, then Meta will not pursue as to the challenged claims any ground raised or that could have been reasonably raised in the IPR in the above-captioned district court litigation (No. 6:22-cv-00575-ADA). *See Sotera*, IPR2020-01019, Paper 12 at 16-19.

If the PTAB institutes the pending IPR in IPR2023-01022 challenging the patentability of claims 1-20 of the ’316 patent, then Meta will not pursue as to the challenged claims any ground raised or that could have been reasonably raised in the IPR in the above-captioned district court litigation (No. 6:22-cv-00575-ADA). *See Sotera*, IPR2020-01019, Paper 12 at 16-19.

If the PTAB institutes the pending IPR in IPR2023-01023 challenging the patentability of claims 1-14 and 17-20 of the ’509 patent, then Meta will not pursue as to the challenged claims any ground raised or that could have been reasonably raised in the IPR in the above-captioned district court litigation (No. 6:22-cv-00575-ADA). *See Sotera*, IPR2020-01019, Paper 12 at 16-19.

If the PTAB institutes the pending IPR in IPR2023-01003 challenging the patentability of claims 1-3, 6, 8-10, 12, and 14-19 of the ’090 patent, then Meta will not pursue as to the challenged claims any ground raised or that could have been reasonably raised in the IPR in the above-captioned district court litigation (No. 6:22-cv-00575-ADA). *See Sotera*, IPR2020-01019, Paper 12 at 16-19.

If the PTAB institutes the pending IPR in IPR2023-01004 challenging the patentability of claims 1, 4-6, 8-11, 14-15, and 17-19 of the ’196 patent, then Meta will not pursue as to the challenged claims any ground raised or that could have been reasonably raised in the IPR in the above-captioned district court litigation (No. 6:22-cv-00575-ADA). *See Sotera*, IPR2020-01019, Paper 12 at 16-19.

If the PTAB institutes the pending IPR in IPR2023-01005 challenging the patentability of claims 9-14 and 16-20 of the ’628 patent, then Meta will not pursue as to the challenged claims any ground raised or that could have been reasonably raised in the IPR in the above-captioned district court litigation (No. 6:22-cv-00575-ADA). *See Sotera*, IPR2020-01019, Paper 12 at 16-19.

This stipulation is not intended, and should not be construed, to limit Meta’s ability to assert invalidity of the asserted claims of the ’179, ’184, ’836, ’737, ’316, ’509, ’090, ’196, and ’628 patents on any other ground (e.g., invalidity under 35 U.S.C. §§ 102 and 103 not available in IPR and under 35 U.S.C. §§ 101 and 112), regardless of whether IPRs are instituted. Further, Meta reserves the right to pursue invalidity grounds encompassed by this stipulation in the district court litigation if the PTAB declines institution of the requested IPRs.

Date: October 17, 2023

Respectfully submitted,

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Attorneys for Defendants Meta Platforms, Inc., Meta Platforms Technologies, LLC, and Twisted Pixel Games, LLC.

CERTIFICATE OF SERVICE

Pursuant to the Federal Rules of Civil Procedure and Local Rule CV-5, I hereby certify that, on October 17, 2023, all counsel of record who have appeared in this case are being served with a copy of the foregoing via the Court's CM/ECF system.

/s/ Paige Arnette Amstutz
Paige Arnette Amstutz