Subject: RE: Sotera Stipulations for IPRs IPR2024-00329, -00330, -00331, -00332, -00333, -00334 and -00507
Date: Monday, April 29, 2024 at 1:08:05 PM Central Daylight Time
From: Trials
To: O'Brien, David, Trials
CC: Richard Kamprath, George T. Fishback, Jr., Ehmke, Andrew S., Lyle, Kelly Gehrke, Shi, Hong
Attachments: image001.jpg

Counsel,

From the Board –

For IPRs IPR2024-00329, -00330, -00331, -00332, -00333, -00334 and -00507, the stipulations described in the April 22, 2024, email from Petitioner's counsel may simplify the issues at this stage of these proceedings. The Board authorizes Petitioner to file the stipulations in these proceedings.

Regards,

Esther Goldschlager
Supervisory Paralegal Specialist
Patent Trial & Appeal Board
U.S. Patent & Trademark Office

From: O'Brien, David <David.OBrien@haynesboone.com>
Sent: Monday, April 22, 2024 4:51 PM
To: Trials <Trials@USPTO.GOV>
Cc: Richard Kamprath <rkamprath@McKoolSmith.com>; George T. Fishback, Jr. <gfishback@McKoolSmith.com>; Ehmke, Andrew S. <Andy.Ehmke@haynesboone.com>; Lyle, Kelly Gehrke <Kelly.Lyle@haynesboone.com>; Shi, Hong <Hong.Shi@haynesboone.com>
Subject: Sotera Stipulations for IPRs IPR2024-00329, -00330, -00331, -00332, -00333, -00334 and -00507

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Dear Honorable Board,

Apple requests authorization to file, as an exhibit in each of the above-identified proceedings, its stipulation of April 17, 2024. The stipulations follow denial, on March 19, 2024, of Apple's petition for writ of *mandamus* to direct U.S. District Court for the Western District of Texas to transfer Patent Owner's infringement case against Apple to the U.S. District Court for the Northern District of California.

Apple's signed stipulations, which were communicated to Patent Owner counsel on April 17, 2024, stipulate that if the Board institutes the *inter partes* review, Apple will not pursue in the parallel district court litigation ***the same grounds as in the petition or any grounds that could have***

reasonably been raised in the petition before the Board. The stipulations are consistent with the Director's Guidance Memorandum (Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation, dated June 21, 2022) and are intended in each proceeding to be dispositive of any *Fintiv* question.

Patent Owner states its position as follows: "Patent Owner opposes Petitioner's stipulations. In the correspondence leading up to this Petitioner's request, Petitioner would not confirm that it would not raise the prior art in the Petitions in the district court litigation if the Petitions are instituted and the district court litigation is not stayed. Without that confirmation, it is unclear what the new stipulations would accomplish."

The parties have met and conferred and are available should the Board wish to schedule a conference call Thursday or Friday (April 25 or 26) after 3pm ET or otherwise at the convenience of the Board.

HAYNES BOONE

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