IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF TEXAS
SHERMAN DIVISION

CHIEN-MIN SUNG,

Plaintiff,

v.

SAMSUNG ELECTRONICS CO., LTD., SAMSUNG ELECTRONICS AMERICA, INC., SAMSUNG SEMICONDUCTOR, INC., and SAMSUNG AUSTIN SEMICONDUCTOR LLC,

Defendants.

Case No. 4:23-cv-752
JURY TRIAL DEMANDED

DEFENDANTS' NOTICE OF INTENT TO FILE A MOTION TO STAY PENDING *INTER PARTES REVIEW*

Defendants Samsung Electronics Co., Ltd., Samsung Electronics America, Inc., Samsung Semiconductor, Inc., and Samsung Austin Semiconductor LLC (collectively, "Defendants") respectfully submit this notice of Defendants' intent to move for a stay of this case until conclusion of, including exhaustion of all appeals from the U.S. Patent and Trademark Office Trial and Appeal Board ("PTAB"), the *Inter Partes* Review ("IPR") proceedings of U.S. Patent Nos. 8,974,270, 9,138,862, and 9,724,802.

On February 29, 2024, Defendants filed IPR petitions challenging each and every claim of the patents asserted in this litigation by Plaintiff Chien-Min Sung. *Samsung Elecs. Co. Ltd. v. Sung*, No. IPR2024-00533 (P.T.A.B. Feb. 29, 2024) (challenging every claim of U.S. Patent No. 8,974,270); *Samsung Elecs. Co. Ltd. v. Sung*, No. IPR2024-00534 (P.T.A.B. Feb. 29, 2024) (challenging every claim of U.S. Patent No. 9,138,862); *Samsung Elecs. Co. Ltd. v. Sung*, No. IPR2024-00535 (P.T.A.B. Feb. 29, 2024) (challenging every claim of U.S. Patent No. 9,724,802).

On March 28, 2024, the PTAB of the U.S. Patent and Trademark Office issued notices of filing dates accorded for each of the above-identified IPR proceedings, attached as Exhibits 1-3. Accordingly, the PTAB will issue decisions to institute the IPR trials by September 28, 2024.

In light of the Eastern District of Texas's precedent—and this Court's prior ruling in *AR Design Innovations LLC v. Ashley Furniture Indus., Inc.*, No. 4:20-CV-392, 2021 WL 6496714 (E.D. Tex. Jan. 11, 2021)—denying as premature motions to stay patent cases prior to institution, and in order to preserve their right to move to stay once the IPRs are instituted, Defendants hereby notify the Court and Plaintiff of their intention to file a motion to stay this Action if and when the PTAB institutes the Defendants' IPRs.

Dated: March 29, 2024

By: *<u>/s/ Cosmin Maier (with permission of Collin Maloney)</u>*

Otis Carroll
Collin Maloney
Mandy Nelson
CARROLL MALONEY
HENRY & NELSON PPLC
1327 Dominion Plaza Ste. 100
Tyler, TX 75703
Tel: (903) 561-1600
otis@cmhnlaw.com
collin@cmhnlaw.com
mandy@cmhnlaw.com

John Desmarais (Admitted Pro Hac Vice)
Paul Bondor (Admitted Pro Hac Vice)
Cosmin Maier (Admitted Pro Hac Vice)
Yung-Hoon Ha (Admitted Pro Hac Vice)
Taeg Sang Cho (Admitted Pro Hac Vice)
DESMARAIS LLP
230 Park Avenue
New York, New York 10169
Tel: (212) 351-3400
Fax: (212) 351-3401
jdesmarais@desmaraisllp.com
pbondor@desmaraisllp.com
cmaier@desmaraisllp.com
yha@desmaraisllp.com
tcho@desmaraisllp.com

David Cho (Admitted Pro Hac Vice)
Paxton Lewis (Admitted Pro Hac Vice)
DESMARAIS LLP
1899 Pennsylvania Avenue, NW, Suite 400
Washington, DC 200069
Tel: (202) 451-4900
Fax: (202) 451-4901
dcho@desmaraisllp.com
plewis@desmaraisllp.com

Attorneys for Defendants Samsung Electronics Co. Ltd., Samsung Electronics America, Inc., Samsung Semiconductor, Inc., and Samsung Austin Semiconductor LLC

EXHIBIT 1

Trials@uspto.gov
571-272-7822

Paper No. 8

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO. LTD.,
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SAMSUNG AUSTIN SEMICONDUCTOR, LLC,
Petitioner,

v.

CHIEN-MIN SUNG,
Patent Owner.

IPR2024-00533
Patent 8,974,270

Mailed: March 28, 2024

Before STEVEN M. AMITRANI, *Trial Paralegal*

NOTICE OF FILING DATE ACCORDED TO PETITION
AND
TIME FOR FILING PATENT OWNER PRELIMINARY RESPONSE

The petition for *inter partes* review filed in the above proceeding has been accorded the filing date of February 29, 2024.

Patent Owner may file a preliminary response to the petition no later than three months from the date of this notice. The preliminary response is

limited to setting forth the reasons why the requested review should not be instituted. Patent Owner may also file an election to waive the preliminary response to expedite the proceeding. For more information, please consult the Office Patent Trial Practice Guide, 77 Fed. Reg. 48756 (Aug. 14, 2012), which is available on the Board Web site at http://www.uspto.gov/PTAB.

Patent Owner is advised of the requirement to submit mandatory notice information under 37 C.F.R. § 42.8(a)(2) within 21 days of service of the petition. Mandatory notices include identifying any other judicial or administrative matter that would affect, or be affected by, a decision in the proceeding. 37 C.F.R. § 42.8(b)(2). Such administrative matters include requests for certificates of correction.

The parties are encouraged to use the heading on the first page of this Notice for all future filings in the proceeding.

The parties are advised that under 37 C.F.R. § 42.10(c), recognition of counsel *pro hac vice* requires a showing of good cause. The parties are authorized to file motions for *pro hac vice* admission under 37 C.F.R. § 42.10(c). Such motions shall be filed in accordance with the "Order -- Authorizing Motion *for Pro Hac Vice* Admission" in Case IPR2013-00639, Paper 7, a copy of which is available on the Board Web site under "Representative Orders, Decisions, and Notices."

The parties are reminded that unless otherwise permitted by 37 C.F.R. § 42.6(b)(2), all filings in this proceeding must be made electronically in the Patent Trial and Appeal Board End to End (PTAB E2E), accessible from the Board Web site at http://www.uspto.gov/PTAB. To file documents, users must first obtain a user ID and password by registering with PTAB E2E. Information regarding how to register with and use PTAB E2E is available at the Board Web site.

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If there are any questions pertaining to this notice, please contact Steven Amitrani at 469-295-9294 or the Patent Trial and Appeal Board at 571-272-7822.

IPR2024-00533
Patent 8,974,270

PETITIONER:

Yung-Hoon Ha
Laura Avena
Taeg Sang
DESMARAIS LLP
yha@desmaraisllp.com
lavena@desmaraisllp.com
tcho@desmaraisllp.com

PATENT OWNER:

Alex Chan
Joel Glazer
DEVLIN LAW FIRM
achan@devlinlawfirm.com
jglazer@devlinlawfirm.com

NOTICE CONCERNING ALTERNATIVE DISPUTE RESOLUTION (ADR)

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Many non-profit organizations, both inside and outside the intellectual property field, offer alternative dispute resolution services. Listed below are the names and addresses of several such organizations. The listings are provided for the convenience of parties involved in cases before the PTAB; the PTAB does not sponsor or endorse any particular organization's alternative dispute resolution services. In addition, consideration may be given to utilizing independent alternative dispute resolution firms. Such firms may be located through a standard keyword Internet search.

CPR INSTITUTE FOR DISPUTE RESOLUTION	AMERICAN INTELLECTUAL PROPERTY LAW ASSOCIATION (AIPLA)	AMERICAN ARBITRATION ASSOCIATION (AAA)	WORLD INTELLECTUAL PROPERTY ORGANIZATION (WIPO)	AMERICAN BAR ASSOCIATION (ABA)
Telephone: (212) 949-6490	Telephone: (703) 415-0780	Telephone: (212) 484-3266	Telephone: 41 22 338 9111	Telephone : (202) 662-1000
Fax: (212) 949-8859	Fax: (703) 415-0786	Fax: (212) 307-4387	Fax: 41 22 733 5428	N/A
575 Lexington Ave	241 18th Street, South, Suite 700	140 West 51st Street	34, chemin des Colombettes	1050 Connecticut Ave, NW
New York, NY 10022	Arlington, VA 22202	New York, NY 10020	CH-1211 Geneva 20, Switzerland	Washington D.C. 20036
www.cpradr.org	www.aipla.org	www.adr.org	www.wipo.int	www.americanbar.org

If parties to an AIA trial proceeding consider using alternative dispute resolution, the PTAB would like to know whether the parties ultimately decided to engage in alternative dispute resolution and the reasons why or why not. If the parties actually engage in alternative dispute resolution, the PTAB would be interested to learn what mechanism (e.g., arbitration, mediation, etc.) was used and the general result. Such a statement from the

parties is not required but would be helpful to the PTAB in assessing the value of alternative dispute resolution to parties involved in AIA trial proceedings. To report an experience with ADR, please forward a summary of the particulars to the following email address: PTAB_ADR_Comments@uspto.gov

EXHIBIT 2

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IPR2024-00534
Patent 9,138,862

Mailed: March 28, 2024

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IPR2024-00534
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yha@desmaraisllp.com
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tcho@desmaraisllp.com

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CERTIFICATE OF SERVICE

I hereby certify that on March 29, 2024, I electronically filed the foregoing with the Clerk of the Court using the CM/ECF system, which will send notification of such filing to all counsel of record.

/s/ DRAFT