

**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: /s/ Cosmin Maier (with permission of Collin Maloney)

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*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.,
SAMSUNG ELECTRONICS AMERICA, INC.,
SAMSUNG SEMICONDUCTOR, INC., and
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

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Patent 8,974,270

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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Patent 8,974,270

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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:

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Taeg Sang
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PATENT OWNER:

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Joel Glazer
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IPR2024-00533
Patent 8,974,270

**NOTICE CONCERNING ALTERNATIVE DISPUTE RESOLUTION
(ADR)**

The Patent Trial and Appeal Board (PTAB) strongly encourages parties who are considering settlement to consider alternative dispute resolution as a means of settling the issues that may be raised in an AIA trial proceeding. Many AIA trials are settled prior to a Final Written Decision. Those considering settlement may wish to consider alternative dispute resolution techniques early in a proceeding to produce a quicker, mutually agreeable resolution of a dispute or to at least narrow the scope of matters in dispute. Alternative dispute resolution has the potential to save parties time and money.

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 New York, NY 10022	241 18th Street, South, Suite 700 Arlington, VA 22202	140 West 51st Street New York, NY 10020	34, chemin des Colombettes CH-1211 Geneva 20, Switzerland	1050 Connecticut Ave, NW 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

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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

Trials@uspto.gov
571-272-7822

Paper No. 8

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Petitioner,

v.

CHIEN-MIN SUNG,
Patent Owner.

IPR2024-00534
Patent 9,138,862

Mailed: March 28, 2024

Before STEVEN M. AMITRANI, *Trial Paralegal*

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AND
TIME FOR FILING PATENT OWNER PRELIMINARY RESPONSE

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PATENT OWNER:

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Joel Glazer
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Patent 9,724,802

Mailed: March 28, 2024

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PATENT OWNER:

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

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PTAB_ADR_Comments@uspto.gov

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