From:	Trials
To:	Heintz, James M.; Trials
Cc:	Pluta, Robert G.; Minutoli, Gianni; FW-CLIENT-Maxell-Samsung-Service
Subject:	RE: Request for Board Authorization to File Notice of Sotera Stipulations in IPR20204-00717, -00735, -00777, -00828 and -00867
Date:	Tuesday, September 10, 2024 11:51:14 AM
Attachments:	image001.png

Counsel,

From the Board –

Petitioner is authorized to file a stipulation related to pursuing in a parallel proceeding the same grounds and or any grounds that could have reasonably been raised before the PTAB. However, the Petitioner is directed to the "INTERIM PROCEDURE FOR DISCRETIONARY DENIALS IN AIA POST-GRANT PROCEEDINGS WITH PARALLEL DISTRICT COURT LITIGATION" from Director Vidal dated June 21, 2022 ("Director's Memo") which can be found here: https://www.uspto.gov/sites/default/files/documents/interim_proc_discretionary_denials_aia_parallel_district_court_litigation_memo_20220621_.pdf

The Board intends to carefully scrutinize the stipulation in view of the Director's Memo and the related case law especially any limitations placed on the scope of the stipulation. The Board advises Petitioner that any stipulation that varies from the precise language "stipulates not to pursue in a parallel district court proceeding the same grounds as in the petition or any grounds that could have reasonably been raised in the petition" puts the Petition at risk of being discretionarily denied.

Regards,

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

From: Heintz, James M. <Jim.Heintz@us.dlapiper.com>
Sent: Monday, September 9, 2024 12:16 PM
To: Trials <Trials@USPTO.GOV>
Cc: Pluta, Robert G. <RPluta@mayerbrown.com>; Minutoli, Gianni <gianni.minutoli@us.dlapiper.com>; FW-CLIENT-Maxell-Samsung-Service <Maxell-Samsung-Service@mayerbrown.com>
Subject: Request for Board Authorization to File Notice of Sotera Stipulations in IPR20204-00717, -00735, -00777, -00828 and -00867

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Dear Board:

Petitioner requests a conference call with the Board to discuss (1) Petitioner's request for authorization to file a

Notice of *Sotera* Stipulation in each of the above-referenced IPRs, and 2) Patent Owner's assertion that the stipulations for which Petitioner is seeking authorization to file, which are in the form "Petitioners agree that if IPR204-___ is instituted, Petitioners will not pursue **for the instituted claims** any ground that was raised or reasonably could have been raised in IPR2024-___ in the related district court proceeding" are not sufficient under *Sotera* due to the presence of language in bold, particularly as it relates to the multiple petitions filed against the same patent in IPR2024-00735 and -00777. Accordingly, Patent Owner has requested Petitioner to amend the language in each respective proceeding to read in the form "Petitioners agree that if IPR204-___ is instituted, Petitioners will not pursue any ground that was raised or reasonably could have been raised in IPR2024-___ in the related district court proceeding…"

Counsel for Petitioner is available 9/9 (any time before 5 pm ET), 9/11 (from 2-5pm ET), and 9/12 (from 11-1pm ET and from 2-5pm ET). Counsel for Patent Owner is available 9/10 (anytime before 5pm ET), 9/11 (from 2-5pm ET), 9/12 (from 11-1pm ET and from 2-5pm ET).

Sincerely,

James M. Heintz
Chair, Post Grant Review Practice

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