

From: Welsh, Margaret
Sent: Tuesday, September 24, 2024 2:59 PM
To: Jessica Rauh; DL BB Samsung Eyesmatch; Arner, Erika; Kestle, Sydney; Premraj, Angeline; Zhang, Xirui
Cc: EyesMatch_Team
Subject: RE: Samsung Electronics Co. Ltd. et al. v. EyesMatch Ltd., IPR2024-00810 – Preliminary Response and Exhibits 2004-2007

Counsel,

We write regarding the following two aspects related to IPR2024-00810.

First, Petitioners stipulate that, if the Patent Trial and Appeal Board institutes an IPR proceeding for U.S. Patent No. 8,982,110 on the grounds presented in the petition in IPR2024-00810, Petitioners will not pursue an invalidity defense in district court that the patent claims subject to the instituted IPR are invalid based on grounds that were raised or reasonably could have been raised in the IPR.

Second, pursuant to 37 C.F.R. §§ 42.23, 42.24(c), 42.108(c), and 42.208(c), Petitioners intend to request authorization from the Board to file a 6-page pre-institution reply in IPR2024-00810 to address the following issues. Good cause exists for this pre-institution briefing because factual circumstances before the district court concerning the *Fintiv* analysis have changed since the Petition's filing date, Petitioners intend to enter a Sotera stipulation, and Patent Owner presented statements that were unforeseeable and could not have been addressed in the Petition:

1. Discretionary denial under *Fintiv* (POPR 27-34);
2. Patent Owner's incorrect statements/characterizations of Petitioners' prior art references and combinations; and
3. Patent Owner's flawed motivation to combine analysis, including its misapplication of the motivation to combine standard.

Petitioners will not oppose a sur-reply by the Patent Owner of equal length, provided the Patent Owner does not oppose the requested reply.

Please let us know if Patent Owner opposes this pre-institution reply, and provide availability for a Board call, should the Board request one.

Thanks,
Maggie

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