UNITED STATES DISTRICT COURT
EASTERN DISTRICT OF TEXAS
MARSHALL DIVISION

EMPIRE TECHNOLOGY DEVELOPMENT LLC, *Plaintiff*, v. SAMSUNG ELECTRONICS CO., LTD. and SAMSUNG ELECTRONICS AMERICA, INC., *Defendants*.	Case No. 2:23-cv-00427-JRG **JURY TRIAL DEMANDED**

DEFENDANTS SAMSUNG ELECTRONICS CO., LTD. AND SAMSUNG ELECTRONICS AMERICA, INC.'S STIPULATION REGARDING INVALIDITY CHALLENGES

Defendants Samsung Electronics Co., Ltd. and Samsung Electronics America, Inc. (collectively "Samsung") hereby stipulate as follows.

WHEREAS, on June 12, 2024, Samsung filed a petition with the Patent Trial and Appeal Board ("PTAB") requesting inter partes review ("IPR") of claims 25-29 of U.S. Patent No. 8,798,120 (the "'120 Patent"), IPR2024-00896;

WHEREAS, on June 7, 2024, Samsung filed a petition with the Patent Trial and Appeal Board ("PTAB") requesting IPR of claims 1-8 of U.S. Patent No. 8,565,331 (the "'331 Patent"), IPR2024-00897;

WHEREAS, Plaintiff Empire Technology Development LLC ("Empire") has argued in Patent Owner Preliminary Responses in at least the IPR2024-00896 proceeding that the PTAB should exercise its discretion under 35 U.S.C. § 314 to deny institution of the requested IPRs, *see, e.g.*, IPR2024-00896, Paper 11 at 40-53.

THEREFORE, Samsung hereby stipulates as follows:

If the PTAB institutes the pending IPR in IPR2024-00896 challenging the patentability of claims 25-29 of the '120 Patent, then Samsung will not pursue as to the challenged claims any ground raised or that could have been reasonably raised in the IPR in the above-captioned district court Case 2:23-cv-00427-JRG-RSP. *See Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 at 16-19 (PTAB Dec. 1, 2020).

If the PTAB institutes the pending IPR in IPR2024-00897 challenging the patentability of claims 1-8 of the '331 Patent, then Samsung will not pursue as to the challenged claims any ground raised or that could have been reasonably raised in the IPR in the above-captioned district court Case 2:23-cv-00427-JRG-RSP. *See Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 at 16-19 (PTAB Dec. 1, 2020).

This stipulation is not intended, and should not be construed, to limit Samsung's ability to assert invalidity of the asserted claims of the '120 or '331 Patents on any other ground (e.g., invalidity under 35 U.S.C. §§ 102 and 103 not available in IPR and under 35 U.S.C. §§ 101 and 112), regardless of whether IPRs are instituted. Further, Samsung reserves the right to pursue invalidity grounds encompassed by this stipulation in the district court litigation if the PTAB declines institution of the requested IPRs.

Dated: September 30, 2024

Respectfully submitted,

/s/ Ryan Yagura

Ryan Yagura (TX #24075933)
ryagura@omm.com
Nicholas J. Whilt (*Pro Hac Vice*)
California State Bar No. 247738
nwhilt@omm.com
O'MELVENY & MYERS LLP
400 South Hope Street, 18th Floor
Los Angeles, CA 90071
Telephone: (213) 430-6000
Facsimile: (213) 430-6407

Marc J. Pensabene (*Pro Hac Vice*)
New York State Bar No. 2656361

mpensabene@omm.com
O'MELVENY & MYERS LLP
7 Times Square
New York, NY 10036
Telephone: 212-326-2000
Facsimile: 212-326-2061

Melissa Richard Smith (Tex. Bar No. 24001351)
melissa@gillamsmith.com
GILLAM & SMITH, LLP
303 South Washington Ave.
Marshall, TX 75670
Telephone: 903-934-8450
Facsimile: 903-934-9257

Counsel for Defendants Samsung Electronics Co., Ltd. and Samsung Electronics America, Inc.

CERTIFICATE OF SERVICE

I hereby certify that, on September 30, 2024, all counsel of record who have appeared in this case are being served with a copy of the foregoing via the Court's CM/ECF system.

Dated: September 30, 2024

/s/ Ryan K. Yagura
Ryan K. Yagura
O'Melveny & Myers LLP