
From: Trials <Trials@USPTO.GOV>
Sent: Thursday, October 3, 2024 9:22 AM
To: Cook, Brian; Trials
Cc: Browand, Nathaniel; Gaspar, Christopher; Fink, Tim; Haber, Ben; Whilt, Nicholas; Yagura, Ryan K.; Hogan, Caitlin P.; Pensabene, Marc J.; Gore, Laura B.
Subject: RE: IPR2024-00896, IPR2024-00897 -- Request for leave to file Sotera stipulation and for a Preliminary Reply

[EXTERNAL MESSAGE]

Counsel,

In view of Petitioner's request on October 1, 2024, the panel provides the following response:

1. IPR2024-00896 and IPR2024-00897: Stipulations

The panel grants Petitioner's unopposed request to file a copy of the stipulation it filed in related district court Case No. 2:23-cv-000427-JRG in the Eastern District of Texas and provided to the Board on October 1, 2024 by email. The panel grants this request in both IPR2024-00896 and IPR2024-00897.

2. IPR2024-00896: Preliminary Reply

The panel grants in part Petitioner's request to file a Preliminary Reply in IPR2024-00896 limited to the issue of the claim construction of "idle power consumption." This Preliminary Reply shall be limited to three pages and filed within one week from the date of this email.

We deny Petitioner's request to file a reply on Patent Owner's argument regarding the timing of the filing of stipulation. That issue is moot in view of our granting Petitioner's request to file the stipulation in IPR2024-00896.

We grant Patent Owner a 3-page Preliminary Sur-Reply to respond to Petitioner's Preliminary Reply and to be filed within two weeks from the date of this email.

If Petitioner chooses to file a Preliminary Reply pursuant to this authorization, Petitioner should enter a copy of this email as an exhibit and reference it in the Preliminary Reply.

Best regards,
Eric W. Hawthorne
Supervisory Paralegal Specialist
Patent Trial and Appeal Board

From: Cook, Brian <bcook@omm.com>
Sent: Tuesday, October 1, 2024 4:30 PM
To: Trials <Trials@USPTO.GOV>
Cc: Browand, Nathaniel <NBrowand@milbank.com>; Gaspar, Christopher <CGaspar@milbank.com>; Fink, Tim <tfink@omm.com>; Haber, Ben <bhaber@omm.com>; Whilt, Nicholas <nwhilt@omm.com>; Yagura, Ryan K. <ryagura@omm.com>; Hogan, Caitlin P. <chogan@omm.com>; Pensabene, Marc J. <mpensabene@omm.com>; Gore,

Laura B. <lgore@omm.com>

Subject: IPR2024-00896, IPR2024-00897 -- Request for leave to file Sotera stipulation and for a Preliminary Reply

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Dear Honorable Board,

Petitioner Samsung respectfully seeks authorization to file, in each of IPR2024-00896 and IPR2024-00897, a copy of the attached *Sotera*-type prior art stipulation it recently filed in related district court Case No. 2:23-cv-000427-JRG in the Eastern District of Texas. The stipulation specifies that for each of the above petitions, if the PTAB institutes review, Samsung will not pursue in district court any ground of invalidity raised or that could have been reasonably raised in the corresponding IPR. See *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 at 16-19 (PTAB Dec. 1, 2020). Filing a copy of this stipulation in each of the above IPRs is warranted because Patent Owner has argued, at least in its first POPR, that the petition should be discretionarily denied under *Fintiv*.

Patent Owner does not oppose Petitioner's proposed filing of a *Sotera* stipulation.

Secondly, Petitioner Samsung respectfully requests authorization to file a 5-page Preliminary Reply in IPR2024-00896 to address the following two issues: (1) Patent Owner's implicit construction of the term "idle power consumption," and (2) Patent Owner's assertion that Samsung cannot offer a *Sotera* prior art stipulation after Patent Owner has filed its POPR. Petitioner would not oppose a similar length sur-reply by Patent Owner.

Patent Owner opposes Petitioner's request to file a preliminary reply because Patent Owner's preliminary response does not offer any construction of the term "idle power consumption" either explicitly or implicitly, Petitioner already stated that "[t]o resolve this Petition, Petitioner does not believe that any term requires construction," Pet. at 9, and Petitioner "cannot raise new claim construction issues that were not previously raised in its petition," CPTG at 45. Patent Owner's non-opposition to Petitioner's request to file a *Sotera* stipulation moots Petitioner's second issue. If Petitioner is granted leave to file a preliminary reply, Patent Owner requests leave to file a similar length preliminary sur-reply.

Counsel for Patent Owner is copied on this request.

Best regards,
Brian Cook
Counsel for Petitioner Samsung

O'Melveny

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