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To: [Sharifahmadian, Ali R.](#); [James Tsuei](#); [Peter Tong](#); [bwang@raklaw.com](#); [aweiss@raklaw.com](#); [rak_cerence@raklaw.com](#); [Reidy, Patrick C.](#); [Clark, Douglas](#); [Boardman, Albert](#); [Baxter, Jeff](#); [xSamsung Cerence AP](#); [bhaber@omm.com](#); [Zervos, Renia](#); [kbutler@omm.com](#)
Cc: [Trials](#)
Subject: RE: Samsung et al v. Cerence, IPR2024-00978, and -00979
Date: Monday, December 9, 2024 1:23:42 PM
Attachments: [image001.png](#)

Counsel,

Thank you for your email of December 6, 2024 regarding the *Samsung et al. v. Cerence* proceedings, IPR2024-00978 and -00979. Petitioners' unopposed request to file a copy of the letter noted in your email as an exhibit in each proceeding is granted. Petitioners' unopposed request to file a one-page preliminary reply, however, is denied because the Board is well-suited to determine whether the stipulation resolves any issues pertaining to discretionary denial based on *Fintiv* and, therefore, a preliminary reply to address the same is unnecessary at this time.

The Board will enter counsel's email and this response in the record of each proceeding.

Regards,

Franchesca I. Alicea Villanueva
Supervisory Paralegal
Patent Trial & Appeal Board
U.S. Patent & Trademark Office

From: Sharifahmadian, Ali R. <Ali.Sharifahmadian@arnoldporter.com>
Sent: Friday, December 6, 2024 2:31 PM
To: Trials <Trials@USPTO.GOV>
Cc: James Tsuei <jtsuei@raklaw.com>; Peter Tong <ptong@raklaw.com>; bwang@raklaw.com; aweiss@raklaw.com; rak_cerence@raklaw.com; Reidy, Patrick C. <Patrick.Reidy@arnoldporter.com>; Clark, Douglas <Douglas.Clark@arnoldporter.com>; Boardman, Albert <Albert.Boardman@arnoldporter.com>; xSamsung Cerence AP <xSamsungCerenceAP@arnoldporter.com>; bhaber@omm.com; Baxter, Jeff <jbaxter@omm.com>; Zervos, Renia <rzervos@omm.com>; kbutler@omm.com
Subject: Samsung et al v. Cerence, IPR2024-00978, and -00979

CAUTION: This email has originated from a source outside of USPTO. PLEASE CONSIDER THE SOURCE before

Ex. 3001,
IPR2024-00978;
IPR2024-00979

responding, clicking on links, or opening attachments.

Dear Honorable Board,

Petitioners respectfully seek authorization to file, as an exhibit in each of IPR2024-00978 and -00979, a copy of a letter that Co-Petitioners Samsung Electronics Co., Ltd. and Samsung Electronics America, Inc. (“the Samsung Co-Petitioners”) sent to Patent Owner containing a *Sotera*-type prior art stipulation related to the co-pending district court Case No. 2:23-cv-00482-JRG-RSP, in which each of the subject patents is asserted in the Eastern District of Texas. The stipulation specifies that for each of the above petitions, if the PTAB institutes review, the Samsung Co-Petitioners 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). Patent Owner has argued in its POPRs that the petitions should be discretionarily denied under *Fintiv*. Petitioners additionally seeks leave to submit a 1-page preliminary reply, limited to explaining that this stipulation resolves this *Fintiv* issue under the Director’s current guidance.

For the sake of clarity, Co-Petitioner Google, Inc. is not a party to the pending, parallel district court litigation and is not a party to the stipulation.

Counsel for Patent Owner is copied on this request, and does not oppose it.

Should the Board require a conference call, the parties will confer and provide times of mutual availability.

Sincerely,

Ali Sharifahmadian
Counsel for Petitioners

Ali R. Sharifahmadian
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