



1526 Gilpin Avenue
Wilmington, Delaware 19806
United States of America
Tel: 302-449-9010
Fax: 302-353-4251
www.devlinlawfirm.com

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BY E-MAIL (jamarlott@jonesday.com)

John A. Marlott, Partner
JONES DAY
110 North Wacker Drive
Suite 4800
Chicago, IL 60606

Re: Motorola's December 10, 2024 letter

Counsel:

We are in receipt of your December 10, 2024 letter indicating that Motorola will “stipulate that, for each of the inter partes review (“IPR”) proceedings [i.e., IPR2024-01284, 1285, 1313, and 1314], if the Patent Trial and Appeal Board (“PTAB”) institutes IPR, then Motorola will not pursue as to the challenged claims any ground raised or that reasonably could have been raised during the IPR in the above-captioned litigation, EDTX 4:23-cv-750-SDJ.”

As with Motorola's letter of November 11, 2024 proposing a similar stipulation with respect to IPR2024-1205, 1206, 1207, and 1208, Motorola's December 10 letter does not suffice to meet the criteria specified in the USPTO Director's June 21, 2022 Memorandum Re: “*Interim Procedure For Discretionary Denials In AIA Post-Grant Proceedings With Parallel District Court Litigation*,” for a stipulation pursuant to *Sotera*.¹

As is stated in the Memorandum, a stipulation pursuant to *Sotera* must be “a stipulation **not to pursue** in a parallel proceeding the same grounds or any grounds that could have reasonably been raised before the PTAB.” Here, the December 10 letter is too late as Motorola **has already pursued** the same grounds (as well as grounds that reasonably could have been raised) by pursuing these theories through the completion of fact and expert discovery. Motorola, despite being aware of the prior art at issue in the IPRs for months, chose to wait until the eve of the one-year statutory deadline to file its IPR petitions. Motorola waited until eleven months after service of the complaint in the district court litigation to file the first four of its eight IPR petitions and nearly three weeks later to file its next four petitions. Motorola then waited an additional four months to send its stipulation letters, but still never filed (or otherwise submitted) these stipulations to the district court to ensure its intention to be bound. The district court trial is scheduled to start in July 2025, which is six months **before** a final written decision on the IPRs, which (if instituted) is expected by February 16, 2026.

¹ *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 (PTAB Dec. 1, 2020) (precedential as to § II.A) (hereinafter “*Sotera*”).

In addition, Stellar reiterates its request for Motorola to clarify which of its currently asserted invalidity theories it deems “*could have been raised during the IPR*,” and thus are part of its “*stipulation*” to forego invalidity theories in the district court case. Specifically, Motorola alleges obviousness theories based on “*system*” prior art, but these theories cite to several printed records. Not only did Motorola have the opportunity to submit in its IPRs the user manuals and user guides cited in connection with its system art theories, but these assertions are not substantively different from the grounds that were already raised in these IPRs. Despite this, Motorola refuses to clarify whether its stipulation covers the system art theories offered in the district court if the IPRs are instituted. Such a clarification is necessary in order to: (i) meaningfully spare Stellar the burden of preparing to try invalidity theories based on Watchguard, Coban, and Kustom Signals literature that could have been raised in the IPRs; and (ii) spare the Board from reconsidering patent claims whose validity was previously tried before the district court should the Board grant institution as to those claims.²

In view of the foregoing, Motorola should promptly identify with specificity the grounds in the district court litigation it will stipulate not to pursue in the event an IPR as to those challenged claims is instituted.

Sincerely,

s/James M. Lennon/
James M. Lennon
1526 Gilpin Avenue
Wilmington, DE 19806
Tel: (302) 449-9010
JLennon@DevlinLawFirm.com

cc:

Motorola-JD@jonesday.com
Stellar-DLF_intl@devlinlawfirm.com
Stellar@nelbum.com
TDevlin@devlinlawfirm.com

² *Ericsson Inc. et al v. Active Wireless Technologies LLC*, IPR2024-00886, Paper 8 (PTAB Nov. 12, 2024), at 13.