
From: Trials <Trials@USPTO.GOV>
Sent: Friday, February 7, 2025 11:41 AM
To: Border, Scott; Nick Cerrito; Eric Stops; Brian Forsatz; Lin, Sharon; Klein, Chuck; Wong, Jovial; Rennecker, Lauren M.; Frank Calvosa
Cc: Trials
Subject: RE: IPR2024-01418

[EXTERNAL EMAIL from trials@uspto.gov]

Counsel,

Petitioner's request for authorization to file correspondence regarding a proposed *Sotera* stipulation is granted. Petitioner may file the correspondence as an exhibit. Petitioner is also authorized to file a one-page Preliminary Reply to Patent Owner's Preliminary Response limited to the subject matter of its stipulation. Petitioner's Preliminary Reply shall be filed on or before February 12, 2025. Patent Owner is authorized to file a one-page Preliminary Sur-reply limited to the subject matter of Petitioner's Preliminary Reply. Patent Owner's Preliminary Sur-reply shall be filed on or before February 19, 2025.

Regards,

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

From: Border, Scott <SBorder@winston.com>
Sent: Thursday, February 6, 2025 8:41 AM
To: Trials <Trials@USPTO.GOV>
Cc: Nick Cerrito <nickcerrito@quinnemanuel.com>; Eric Stops <ericstops@quinnemanuel.com>; Brian Forsatz <brianforsatz@quinnemanuel.com>; Lin, Sharon <SLin@winston.com>; Klein, Chuck <CKlein@winston.com>; Wong, Jovial <JWong@winston.com>; Rennecker, Lauren M. <LRennecker@winston.com>; Frank Calvosa <frankcalvosa@quinnemanuel.com>
Subject: IPR2024-01418

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Your Honors –

Petitioner has offered the following *Sotera* stipulation to counsel for Patent Owner related to IPR2024-01418:

In accordance with the Board's precedential decision in *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 at 18-19 (PTAB Dec. 1, 2020), Hikma Pharmaceuticals ("Hikma") agrees that if IPR2024-01418 is instituted, Hikma will not pursue "any ground that [Hikma] raised or reasonably could have raised" during the IPR in the related district court proceeding, *Axsome Malta Ltd., et al. v. Alkem Laboratories Ltd., et al.*, Civil Action No. 23-20354 (MCA)(LDW) (D.N.J.)). See 35 U.S.C. § 315(d).

Petitioner requests permission to file as an exhibit the correspondence to Patent Owner offering the *Sotera* stipulation for the Board's consideration, and also requests permission to file a 1-page reply to Patent Owner's Preliminary Response addressing the stipulation by next Wednesday. To minimize any disputes between the parties and to minimize the use of the resources of the Board, Petitioner would not oppose a 1-page sur-reply by the Patent Owner.

Counsel for Patent Owner does not object to Petitioner's request.

Sincerely,
Scott Border
Counsel for Petitioner

Scott Border

Partner

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