



March 10, 2025

VIA E-MAIL

BC Law Group, P.C.
200 Madison Avenue, 24th Floor
New York, NY 10016
Phone: (212) 951-0100

Lauren E. Douville
2555 Grand Blvd.
Kansas City, Missouri 64108
t 816.474.6550
d 816.559.0348
f 816.421.5547
ldouville@shb.com

Re: *Universal Connectivity Technologies Inc. v. HP Inc.*, 5:24-cv-04097-NW (N.D. CA)

Counsel:

HP has filed an *inter partes* review (IPR) petition (IPR2024-01478) with the Patent Trial and Appeal Board (PTAB) to address the unpatentability of claims 1, 2, 3, 5, 7, and 9 (“the Challenged Claims”) of U.S. Patent No. 8,680,712 (“the ’712 Patent”). The tables in attached Appendix A lists the grounds and references asserted in IPR2024-01478.

I write to inform you that HP Inc. hereby stipulates, in the above-captioned litigation, that if the PTAB institutes IPR2024-01478, then:

The Petition, HP Inc., will not pursue in District Court litigation the specific grounds asserted in inter partes review IPR2024-01478, or on any other ground that was raised or could have been reasonably raised in an IPR (i.e., any ground that could be raised under §§ 102 or 103 on the basis of prior art patents or printed publications).

See Sotera Wireless, Inc. v. Masimo Corporation, IPR2020-01019, Paper 12 (PTAB Dec. 1, 2020) (precedential); Board’s e-mail to the parties dated March 3, 2025.

This language is the same as that set forth in the Board’s e-mail dated March 3, 2025, authorizing submission of such a stipulation to the Board with respect to IPR2024-01478.

Pursuant to *Sotera*, HP Inc. reserves the right to assert grounds in the above-captioned litigation proceedings based on any art not comprised solely of patents and printed publications, including system art, either alone, or in combination with other prior art.¹ For the sake of clarity and to avoid

¹ HP notes that system art is not eligible for PTAB consideration in an IPR proceeding, and grounds based on system art either alone, or in combination with patent or printed publication prior art, could not have reasonably been raised before the PTAB in the IPR petitions. *See* 35 U.S.C. § 311(b). Further, discovery in the above-captioned litigation is currently ongoing and HP expects there to be additional materials and/or testimony relating to system art. For the avoidance of doubt, HP reserves the right to rely on such forthcoming productions in the above-captioned litigation.

any doubt, if the PTAB declines to institute IPR2024-01478, HP reserves the right to assert any grounds of invalidity in the above-captioned litigation proceedings against the '712 Patent.

March 10, 2025
Page 2

Sincerely,



Lauren E. Douville

Appendix A – Grounds and Prior Art References

Ground	Patent Claims	Basis
1	1, 2, 3, 5	35 U.S.C. §103 over U.S. Pat. App. Pub. No. 2006/0089230 A1 (Biederman) in view of 802.3af-2003 IEEE Standard for Information Technology (IEEE 802.3af)
2	1, 2, 3, 5	35 U.S.C. §103 over Biederman in view of U.S. Pat. App. Pub. No. 2006/0100799 A1 (Karam)
3	1, 2, 3, 5	35 U.S.C. §103 over Biederman in view of IEEE 802.3af and U.S. Pat. App. Pub. No. 2008/0168283 A1 (Penning)
4	1, 2, 3, 5	35 U.S.C. §103 over Biederman in view of Karam and Penning
5	1, 2, 3, 5	35 U.S.C. §103 over Biederman in view of IEEE 802.3af, Karam, and Penning
6	7, 9	35 U.S.C. §102 over Karam