SHOOK
HARDY & BACON

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VIA E-MAIL

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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 (IPR2024-01480) with the Patent Trial and Appeal Board (PTAB) to address the unpatentability of claims 1, 2, 3, 10, 11, 12, 13, 17, 20, 21, and 22 ("the Challenged Claims") of U.S. Patent No. 9,852,103 ("the '103 Patent"). The tables in attached Appendix A lists the grounds and references asserted in IPR2024-01480.

I write to inform you that HP Inc. hereby stipulates, in the above-captioned litigation, that if the PTAB institutes IPR2024-01480, then:

> The Petitioner, HP Inc. will not pursue in District Court litigation the specific grounds asserted in inter partes review IPR2024-01480, 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 IPR2024-01480.

Pursuant to *Sotera*, HP Inc. reserves the right to assert grounds in the above-captioned litigation 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 any doubt,

[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.

if the PTAB declines to institute IPR2024-01480, HP reserves the right to assert any grounds of invalidity in the above-captioned litigation against the '103 Patent.

Sincerely,

Lauren E. Douville

Appendix A – Grounds and Prior Art References

Ground	Patent Claims	Basis
1	1, 10, 11, 20, 21, 22	Anticipated under 35 U.S.C. §102 by U.S. Patent Pub. No. 2006/0076977 (Zhu)
2	1, 2, 10, 11, 12, 20, 21, 22	Obvious under 35 U.S.C. §103 over Zhu and knowledge of a POSITA
3	1, 2, 3, 10, 11, 12, 13, 17, 20, 21, 22	Obvious under 35 U.S.C. §103 over Zhu and DisplayPort 1.2
4	1, 2, 10, 11, 12, 17, 20, 21, 22	Obvious under 35 U.S.C. §103 over U.S. Patent No. 7,558,326 (Lyle) and knowledge of a POSITA
5	2, 3, 12, 13, 17	Obvious under 35 U.S.C. §103 over Lyle and U.S. Patent No. 5,974,464 (Shin)