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Re: ***Mullen Industries LLC v. Samsung Electronics Co., Ltd. and Samsung Electronics America, Inc., 2:24-cv-00049-JRG (EDTX)***

Dear Peter:

We write regarding IPR2025-00197, in which Petitioners Samsung Electronics Co., Ltd., Samsung Electronics America, Inc. (together "Samsung"), and Google LLC ("Google") challenge the patentability of claims 1-19 of U.S. Patent No. 11,109,218 ("the '218 patent"). Samsung hereby stipulates that, if the Patent Trial and Appeal Board ("PTAB") permits Samsung to file this stipulation as an exhibit in the IPR proceeding prior to issuing its decision on institution and, thereafter, institutes this IPR petition on the grounds presented therein, then Samsung will not pursue in the above-captioned litigation any grounds that were raised or reasonably could have been raised in the IPR. For the sake of clarity, this stipulation does not extend to co-petitioner Google, which is not a party to the above-referenced litigation.

In so stipulating, Samsung seeks to avoid multiple proceedings addressing the validity of claims 1-19 of the '218 patent based on the grounds that were raised or reasonably could have been raised in this IPR. But, for the sake of clarity and to avoid any doubt, if the PTAB does not permit Samsung to file this stipulation as an exhibit in the IPR proceeding prior to its decision on institution, declines institution, or later vacates institution of this IPR, Samsung reserves the right to pursue in this litigation any ground that was raised or reasonably could have been raised in the IPR. This stipulation is not intended, and should not be construed, to limit Samsung's ability to assert invalidity of the asserted claims of the '218 patent on any other ground (e.g., invalidity under 35 U.S.C. §§ 102 and 103 not available in IPR and under 35 U.S.C. §§ 101 and 112), regardless of whether IPRs are instituted.

Google Exhibit 1079
Google v. Mullen
IPR2025-00197

Sincerely,

/s/ Ben Haber

Ben Haber
Partner
of O'MELVENY & MYERS LLP