

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

DECENT ESPRESSO INTERNATIONAL LTD.,
Petitioner,

v.

DUVALL ESPRESSO IP ENFORCEMENT, LLC,
Patent Owner

U.S. Patent No. 11,957,271

**PETITIONER’S STIPULATION PURSUANT TO
SOTERA WIRELESS, INC. V. MASIMO CORP., IPR2020-01019 (2020)**

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P.O. Box 1450
Alexandria, VA 22313-1450

I. INTRODUCTION

Petitioner Decent Espresso International Ltd. (“Petitioner”) hereby agrees to be bound by the stipulation submitted herein for *inter partes* review of U.S. Patent No. 11,957,271. The stipulation submitted here by Petitioner is the same or similar to the stipulation presented in *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12, at 11-21 (Dec. 1, 2020) (designated precedential). In view of Petitioner’s stipulation and the factors set forth in *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (P.T.A.B. Mar. 20, 2020) (designated precedential May 5, 2020), the Board should not exercise discretion to deny institution in view of parallel district court litigation.

II. THE *SOTERA* DECISION

In *Sotera Wireless, Inc.*, the Board held a petitioner’s stipulation “to not pursue [in a parallel proceeding] any ground raised or that could have been reasonably raised” in an IPR proceeding “mitigates **any concerns** of duplicative efforts between the district court and the Board, as well as concerns of potentially conflicting decisions.” IPR2020-01019, Paper 12, at 11-21, (Dec. 1, 2020) (cleaned up; emphasis added) The Board in *Sotera* found that, based on petitioner’s stipulation, *Fintiv* Factor 4 “weigh[ed] strongly in favor of not exercising discretion to deny institution[.]” *Id.* The Board in *Sotera* further found that such a “broad stipulation ensures that an inter partes review is a ‘true alternative’ to the

district court proceeding.” *Id.*

III. STIPULATION OF PETITIONER DECENT ESPRESSO

Petitioner, Decent Espresso International Ltd., agrees to be bound by the following stipulation:

In the event that a Petition for *Inter Partes* Review is granted on U.S. Patent No. 11,957,271, Petitioner will not pursue in the Duvall Espresso v. Decent Espresso Litigation [*i.e.*, *Duvall Espresso IP Enforcement, LLC v. Decent Espresso International Ltd.*, Civil Action No. 9:23-cv-81246(S.D. Fla.)] any invalidity ground on that patent that was raised or that 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, e.g., Samsung Electronics Co., Ltd. v. Acorn Semi, LLC, IPR2020-01207, Paper 21 at 34-35 (Feb. 10, 2021); *Id.* at Paper 19 at 2-3.

As a result of Petitioner’s stipulation consistent with *Sotera, Fintiv* Factor 4 weighs “strongly in favor” of not exercising the Board’s discretion to deny institution and, accordingly, the Board should not discretionarily deny institution of *inter partes* review of U.S. Patent No. 11,957,271. Additionally, if institution of the Petition for *Inter Partes* Review is granted on U.S. Patent No. 11,957,271, Petitioner confirms that it will meaningfully abide by this stipulation and promptly

notify the District Court about the Board's decision. *See, e.g., Samsung Electronics Co., Ltd. v. Acorn Semi, LLC*, IPR2020-01207, Paper 21 at 34-35 (Feb. 10, 2021); *Id.* at Paper 19 at 2-3.

IV. CONCLUSION

Petitioner respectfully requests that the Board institute *inter partes* review for the reasons stated above and that the Board not discretionarily deny institution.

Dated: March 17, 2025

Respectfully submitted,

/Perry S. Clegg/
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CERTIFICATE OF SERVICE

I hereby certify that on March 17, 2025, I caused a true and correct copy of the foregoing materials:

- Petitioner's Stipulation Pursuant to Sotera Wireless, Inc. v. Masimo Corp.,
IPR2020-01019 (2020)

to be served via FedEx on the following correspondence address as listed on PAIR,
by depositing same with FedEx for overnight delivery:

Gideon Duvall
6850 North Grande Drive
Boca Raton, FL 33433

Respectfully submitted,

By: /s Perry S. Clegg/

Perry S. Clegg, Reg. No. 65,304