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August 7, 2020

VIA ELECTRONIC MAIL

Joseph S. Grinstein
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Susman Godfrey L.L.P.
1000 Louisiana, Suite 5100
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Re: **Personalized Media Communications, LLC v. Google LLC**
Case No. 2:19-cv-00090 (E.D. Tex.)

Dear Counsel,

We write regarding the pending petitions for *inter partes* review (IPR) filed against U.S. Patent Nos. 8,739,241; 8,601,528; 7,747,217; and 7,769,344 corresponding to IPR Nos. IPR2020-00719, -00720, -00722, -00723, and -00724. We write to inform you that Google hereby stipulates that if the Patent Trial and Appeal Board (PTAB) institutes one or more of the IPR petitions on the same grounds presented in the respective IPR (a table of which is reproduced below), then Google will not pursue those same instituted grounds in the above-captioned litigation, 2:19-cv-00090.

While this stipulation applies to the grounds identified in the noted IPR proceedings, for convenient reference, we list those grounds in the table below:

Patent	Proceeding	Claims[1]	Basis
8,739,241	IPR2020-00719	16, 22, 23, 25, 27, 30, 31, 33-35, and 39	35 U.S.C. § 103: *Cogswell* and *Cox*
		17 and 37	35 U.S.C. § 103: *Cogswell*, *Cox*, and *Campbell*
		36	35 U.S.C. § 103: *Cogswell*, *Cox*, and *Cox '404*
		23, 25, and 27	35 U.S.C. § 103: *Cogswell*, *Cox*, and *Haselwood*
8,601,528	IPR2020-00720	21-25 and 27	35 U.S.C. § 102: *Marti*
		21-29	35 U.S.C. § 103: *Marti* in view of *Cox*
		32, 37-39, and 26	35 U.S.C. § 103: *Marti*, or *Marti* and *Cox*, in combination with the knowledge of one skilled in the art and/or *Parsons*
7,747,217	IPR2020-00722	1-3, 7-9, 11, 12, 16-18, and 20-22	35 U.S.C. § 103: *Millar* in view of *Keiser*

[1] PMC has statutorily disclaimed claims 16, 17, 25, 27, and 35 of the '241 patent; claims 28 and 29 of the '528 patent; claims 7 and 8 of the '217 patent; and claim 3 of the '344 patent. Google identifies those claims for completeness here because they are identified in each IPR petition.

Patent	**Proceeding**	**Claims**[1]	**Basis**
		11, 12, and 16-18	35 U.S.C. § 103: *Millar* in view of *Keiser* and *Thonnart*
7,747,217	IPR2020-00723	1-3, 7-9, 11, 12, 16-18, and 20-22	35 U.S.C. § 103: *Campbell* in view of *Millar*
		11, 12, and 16-18	35 U.S.C. § 103: *Campbell* in view of *Millar* and *Thonnart*
7,769,344	IPR2020-00724	1 and 3	35 U.S.C. § 103: *Nagel '490* in view of *Beakhust*
		2	35 U.S.C. § 103: *Nagel '490* in view of *Beakhust* and *Ricketts*

In so stipulating, Google seeks to avoid multiple proceedings addressing the validity of the patents in suit based on the same grounds. Consistent with Congressional intent, through this stipulation, Google expresses its intention to have only the PTAB address the patentability of each patent in view of the identified grounds if the respective IPR is instituted. If the PTAB declines institution of one or more IPRs, Google reserves the right to pursue the grounds in the declined IPRs in this litigation. Additionally, Google reserves its rights to continue to assert all other grounds identified in its invalidity contentions and reports, including any bases that contain the references in the above-listed grounds.

Joseph S. Grinstein
August 7, 2020

Very truly yours,

Mark Tung

MT

Enclosure

cc: Counsel of record