

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

BOE TECHNOLOGY GROUP CO., LTD.,  
Petitioner,

v.

138 EAST LCD ADVANCEMENTS LIMITED,  
Patent Owner.

---

Case No. IPR2024-00977  
U.S. Patent No. 9,557,606

**PETITIONER'S *SOTERA* STIPULATION  
AND PRE-INSTITUTION REPLY**

By email, the Board authorized Petitioner to submit this paper to: “(1) provide Sotera stipulation(s) addressing *Fintiv* issues raised in Patent Owner’s Preliminary Response; and (2) show good cause for why the Sotera stipulation(s) were not filed earlier with the Petition (see 37 C.F.R. § 42.108(c)).”

**Sotera Stipulation**

Consistent with *Sotera Wireless, Inc.*, Petitioner hereby stipulates for the ’606 patent “that, if the PTAB institutes *inter partes* review, Petitioner ‘will not pursue in [*Longitude Licensing Ltd. v. BOE Tech. Group Co., Ltd.*, 2:23-cv-00515 (EDTX)] the specific grounds [asserted in IPR2024-00977], or . . . 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 patent or printed publications.).” *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 at 13-14 (PTAB Dec. 1, 2020) (precedential as to § II.A.).

**“Good Cause” Is Not Required For a Sotera Stipulation After the Petition**

Petitioner’s stipulation, above, disposes of the issue of discretionary denial under *Fintiv*. The Director’s Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation (“Interim

Procedure”<sup>1</sup>) directs that “the PTAB will not discretionarily deny institution of an IPR or PGR in view of parallel district court litigation where a petitioner stipulates not to pursue in a parallel district court proceeding the same grounds as in the petition or any grounds that could have reasonably been raised in the petition.” Petitioner has so stipulated; therefore, the Board “will not discretionarily deny institution.” *Id.*

There is no “time limit by which a *Sotera* stipulation must be submitted before [the Board] enter[s its] decision on institution.” *BMW of N. Am., LLC v. Northstar Sys. LLC*, IPR2023-01017, Paper 12 at 10 (PTAB Dec. 8, 2023). As the Director has held, “the only appropriate time for a petitioner to offer a stipulation related to the *Fintiv* factor 4 analysis is prior to the Board’s decision of whether to institute review.” *NXP USA v. Impinj, Inc.*, IPR2021-01556, Paper 13 at 4 (PTAB Sept. 7, 2022) (precedential). Accordingly, because there is no earlier deadline for a *Sotera* stipulation, petitioners have routinely submitted such stipulations *after* the petition and before the institution decision. *See, e.g., BMW*, Paper 12 at 10 (“Petitioner submitted its *Sotera* stipulation to Patent Owner by email . . . several days after Patent Owner filed its Preliminary Response.”); *Samsung Elecs. Co., Ltd. v. Sung*,

---

<sup>1</sup> Available at [https://www.uspto.gov/sites/default/files/documents/interim\\_proc\\_discretionary\\_denials\\_aia\\_parallel\\_district\\_court\\_litigation\\_memo\\_20220621.pdf](https://www.uspto.gov/sites/default/files/documents/interim_proc_discretionary_denials_aia_parallel_district_court_litigation_memo_20220621.pdf).

IPR2024-00533, Paper 11 at 4-5 (July 25, 2024) (“Petitioner may file [stipulation] simultaneously with its Preliminary Reply . . . .”); *Vector Flow, Inc. v. HID Global Corp.*, IPR2023-00353, Paper 15 at 8-9 (Oct. 17, 2023) (“follow[ing] the Interim Procedure’s directive and declin[ing] to deny the Petition on a discretionary basis” when stipulation was filed with the preliminary reply); *Samsung Elecs. Co., Ltd. v. Apex Beam Techs., LLC*, IPR2023-00598, Paper 9 at 3 (Aug. 8, 2023) (“[W]e have discretion to permit filing a stipulation at this stage [after the POPR], prior to institution.”).

Moreover, because a petitioner may stipulate at any time before the institution decision, “good cause” is not required for a petitioner to make a stipulation. Indeed, the Board has authorized filing *Sotera* stipulations even in cases where it found no good cause to support filing a preliminary reply under 37 C.F.R. 42.108(c). *Apex Beam*, Paper 9 at 3-4 (authorizing stipulation but denying request to file a preliminary reply).

**“Good Cause” Under 37 C.F.R. § 42.108(c)**

A petitioner may file a *preliminary reply* paper only upon showing of “good cause.” 37 C.F.R. § 42.108. As noted above, “good cause” is not required to enter a *Sotera* stipulation under the Interim Guidelines and the Director’s decision in *NXP USA*. Moreover, the Board has already authorized this paper (as well as the stipulation); therefore, the requirements of § 42.108(c) are moot. Nevertheless, the

Board's prior authorization was well founded.

Preliminarily, Petitioner notes that the Board's established practice of permitting post-petition *Sotera* stipulations makes sound logical sense, given typical pre-institution IPR procedure. When it files the petition, a petitioner cannot know whether the patent owner will argue for discretionary denial under *Fintiv*. Only after a petitioner learns of such arguments—i.e., after the patent owner preliminary response—can the petitioner understand whether a *Sotera* stipulation may be necessary or appropriate. Specifically, in this case, the Board's prior authorization of this paper and stipulation was justified by the changed circumstance of Patent Owner presenting its *Fintiv* arguments.

In addition, the Board's practice of permitting post-*Sotera* stipulations also is supported by the realities of litigation discovery. In many cases—including this one—the petition was filed during the early stages of litigation discovery. Three months after filing, Petitioner is in a better position to assess the extent of the parties' investment in litigation—a factor that bears directly on the *Fintiv* analysis (Factor 3) and, by extension, the decision whether to enter into a *Sotera* stipulation. Since filing the Petition here, for example, Petitioner has taken the deposition of the named inventor of one asserted patent (the '606 patent, subject to IPR2024-00977) and noticed the depositions of 13 other individuals and/or companies, discovered several non-publication-type prior-art systems pertinent to another asserted patent (the '157

patent, subject to IPR2024-00973), and learned that Patent Owner will not make available for deposition the inventor of another patent (the '079 patent, subject to IPR2024-00976). Petitioner's investment in such discovery, as well as its results, has materially impacted Petitioner's assessment of the litigation since the Petition was filed.

Respectfully submitted,

Dated: October 15, 2024

By: /Joshua L. Goldberg/  
Joshua L. Goldberg  
Reg. No. 59,369

**CERTIFICATE OF SERVICE**

The undersigned hereby certifies that a copy of the foregoing **Petitioner's**  
**Sotera Stipulation and Pre-Institution Reply** was served on October 15, 2024, via  
email directed to counsel of record for Patent Owner at the following:

Cyrus A. Morton  
Samuel J. LaRoque  
Aaron R. Rahrenkrog  
Emily J. Tremblay  
William R. Jones  
Robins Kaplan LLP  
800 LaSalle Avenue, Suite 2800  
Minneapolis, MN 55402  
CMorton@RobinsKaplan.com  
SLaRoque@RobinsKaplan.com  
AFahrenkrog@RobinsKaplan.com  
ETremblay@RobinsKaplan.com  
WJones@RobinsKaplan.com

Dated: October 15, 2024

By: /William Esper/  
William Esper  
Legal Assistant and PTAB Coordinator  
FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, LLP