

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Samsung Electronics Co., Ltd.,

Petitioner

v.

Acorn Semi, LLC,

Patent Owner

IPR2020-01204; IPR2020-01264
U.S. Patent No. 8,766,336 B2

IPR2020-01205; IPR2020-01241
U.S. Patent No. 9,461,167 B2

IPR2020-01206; IPR2020-01279
U.S. Patent No. 9,905,691

IPR2020-01207; IPR2020-01282
U.S. Patent No. 10,090,395 B2

IPR2020-01182
U.S. Patent No. 7,084,423 B2

IPR2020-01183
U.S. Patent No. 9,209,261

**PETITIONER'S RESPONSE TO THE BOARD'S ORDER REGARDING
THE CONDUCT OF THE PROCEEDING**

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I. INTRODUCTION

Petitioner (“Samsung”) agrees to be bound by the stipulation presented by the Board. *See, e.g., Samsung Electronics Co., Ltd. v. Acorn Semi, LLC*, IPR2020-01204, Paper 18, at 2 (Dec. 18, 2020) (the “Board’s Stipulation Order”) (Order requesting that Samsung answer if it agrees to be bound by a stipulation similar to the one presented in the *Sotera* precedential decision). In view of Samsung’s stipulation, *Fintiv* Factor 4 weighs strongly against discretionary denial.

II. THE *SOTERA* DECISION

In *Sotera Wireless, Inc. v. Masimo Corp.*, the Board held that 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, 19 (Dec. 1, 2020) (internal quotation marks and citations omitted; emphasis added) (designated precedential). Based on the petitioner’s stipulation, the Board found that *Fintiv* Factor 4 “weigh[ed] strongly in favor of not exercising discretion to deny institution[.]” *Id.* Indeed, such a “broad stipulation ensures that an *inter partes* review is a ‘true alternative’ to the district court proceeding.” *Id.* (quoting *Sand Revolution II, LLC v. Continental Intermodal Group – Trucking LLC*, Case IPR2019-01393, Paper 24, at 12 n.5 (June 16, 2020) (designated informative)).

III. SAMSUNG'S STIPULATION

Samsung agrees to be bound by the stipulation proposed by the Board. Although this stipulation may be moot for IPR2020-01182¹ (U.S. Patent No. 7,084,423) and IPR2020-01183² (U.S. Patent No. 9,209,261), Samsung agrees to be bound by the following stipulation for all *ten* of the above-captioned cases:

In the event one or more of these Petitions is granted on a given patent, Petitioner will not pursue in the Acorn Litigation [*i.e.*, *Acorn Semi, LLC v. Samsung Electronics Co. Ltd.*, Civil Action No. 2:19-cv-347 (E.D. Tex.)] 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.

¹ After Judge Payne held the asserted '423 patent claims to be indefinite, Judge Gilstrap recently overruled Acorn's objections to Judge Payne's Order. *Acorn Semi*, No. 2:19-cv-00347, Dkt. No. 133 (Dec. 10, 2020) (overruling Acorn's objections and adopting Judge Payne's Claim Construction Memorandum Opinion and Order).

² Acorn excluded the '261 patent from its infringement expert report, effectively "dropping" this patent from the pending Acorn Litigation.

Quoting Board’s Stipulation Order at 2 (*citing Sotera*, IPR2020-01019, Paper 12).

As a result of Samsung’s stipulation, *Fintiv* Factor 4 weighs “***strongly*** in favor” of not exercising the Board’s discretion to deny institution. *Sotera*, IPR2020-01019, Paper 12, at 19. Additionally, if institution of one or more of these Petitions is granted, Samsung confirms that it will meaningfully abide by this stipulation and promptly notify the District Court about the Board’s decisions.

IV. CONCLUSION

Petitioner respectfully requests that the Board institute *inter partes* review for the reasons stated above.

Dated: December 23, 2020

Respectfully submitted,

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), the undersigned certifies that on December 23, 2020 a complete copy of the foregoing was served on counsel of record for the Patent Owner by filing this document through PTAB E2E and by sending this document via electronic mail to the following addresses:

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