

Iturralde, Enrique W.

From: Iturralde, Enrique W.
Sent: Monday, January 28, 2019 3:21 PM
To: Lavenue, Lionel (lionel.lavenue@finnegan.com); Schulz, Bradford (Bradford.Schulz@finnegan.com); cory.bell@finnegan.com
Cc: AGIS-Lit; Hartman, Sarah G.
Subject: ZTE v. AGIS IPRs

Hi Lionel,

I write to request that ZTE immediately withdraw its frivolous IPR petitions against AGIS in IPR2019-00389 ('838 patent), IPR2019-00485 ('970 patent), and IPR2019-00487 ('055 patent). ZTE filed these petitions after filing its October 9, 2018 complaint for declaratory judgment for invalidity of the same patents in the Northern District of California. As you already know, Section 315(a)(1) prohibits a declaratory-judgment plaintiff from filing an IPR petition if the plaintiff filed a declaratory judgment complaint for invalidity before filing the IPR petition. (See <https://www.finnegan.com/en/insights/behind-bars-a-closer-look-at-the-statutory-bars-for-filing-inter.html>.) Accordingly, because ZTE chose the district court as its forum to challenge the validity of these patents, ZTE is statutorily barred from filing and maintaining these petitions.

ZTE lacked the requisite Rule 11 basis to file the petitions, and ZTE has no Rule 11 basis to maintain any petitions on the '838, '970, and '055 patents. ZTE's petitions advance frivolous grounds by statutorily-barred party and constitute an improper use of these proceedings. AGIS has been diligent in reviewing ZTE's filings and preparing responses to the petitions. AGIS reserves all rights and remedies, particularly for sanctions under 37 CFR 42.12, should ZTE maintain these petitions.

Please confirm, by 5:00 PM ET Wednesday, January 28th, that ZTE will withdraw its petitions in IPR2019-00389, IPR2019-00485, and IPR2019-00487.

Regards,
Enrique



Enrique W. Iturralde

Brown Rudnick LLP
Seven Times Square
New York, NY 10036
T: 212-209-4936
F: 212-938-2936
eiturralde@brownrudnick.com
www.brownrudnick.com

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