

Allan A. Kassenoff
Tel 212.801.2157
kassenoffa@gtlaw.com

December 17, 2021

VIA EMAIL

Daniel J. Schwartz
Nixon Peabody LLP
70 West Madison, Suite 3500
Chicago, IL 60602-4224
djschwartz@nixonpeabody.com

Re: *MemoryWeb, LLC v. Samsung Elecs. Co. Ltd. et al*, No. 21-cv-411 (W.D. Tex.)

Counsel:

We write regarding the petition for *inter partes* review (“IPR”) filed against one of the patents in suit, U.S. Patent No. 10,423,658 (“the ’658 patent”) in the above-captioned litigation. We write to inform you that Samsung Electronics Co., Ltd. and Samsung Electronics America, Inc. (collectively, “Samsung”) hereby stipulate that, if the Patent Trial and Appeal Board (“PTAB”) institutes this petition on the grounds presented, then Samsung will not seek resolution in the district court of any ground of invalidity as to the ’658 patent that utilizes U.S. Patent App. Pub. No. 2011/0122153 A1 (“Okamura”), the primary reference asserted in the IPR proceeding.

In so stipulating, Samsung seeks to avoid multiple proceedings addressing the validity of the ’658 patent based on the same primary reference. Rather, consistent with Congressional intent, Samsung wishes the patentability of this patent over grounds based on Okamura to be addressed at the PTAB. But, for the sake of clarity and to avoid any doubt, if the PTAB declines institution of Samsung’s IPR petition relating to the ’658 patent, Samsung reserves the right to pursue this prior art in the litigation.

Sincerely,

/Allan A. Kassenoff/
Allan A. Kassenoff