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EDWARD BENNETT WILLIAMS (1920-1988)
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August 2, 2022

Via Email

Rex A. Mann, Esq.
Winston & Strawn LLP
2121 North Pearl Street, Suite 900
Dallas, TX 75201
rmann@winston.com

Re: *Hardin, et al. v. Samsung Electronics Co., Ltd., et al., civil action no. 2:21-cv-290-JRG (E.D. Tex.)*

Dear Rex:

I write regarding petitions for *inter partes* review (IPR) that will be filed imminently against certain claims of U.S. Patent Nos. 9,779,418, 10,049,387, and 10,984,447. Samsung hereby stipulates that:

- If the Patent Trial and Appeal Board (PTAB) institutes trial in IPR2022-01327, then Samsung Electronics Co., Ltd., and Samsung Electronics, America, Inc., (collectively, “Samsung”) will not pursue, with respect to the ’387 patent in Case No. 2:21-CV-00290-JRG, invalidity of the challenged claims based on the grounds instituted in IPR2022-01327, or based on any 35 U.S.C. §§ 102, 103 grounds using U.S. Patent Publication No. 2010/0279665 (“Hardin ’665”) as the primary reference.
- If the Patent Trial and Appeal Board (PTAB) institutes trial in IPR2022-01328, then Samsung will not pursue, with respect to the ’387 patent in Case No. 2:21-CV-00290-JRG, invalidity of the challenged claims based on the grounds instituted in IPR2022-01328, or based on any 35 U.S.C. §§ 102, 103 grounds using Hardin ’665 as the primary reference.
- If the Patent Trial and Appeal Board (PTAB) institutes trial in IPR2022-01329, then Samsung will not pursue, with respect to the ’387 patent in Case No. 2:21-CV-00290-JRG, invalidity of the challenged claims based on the grounds instituted in IPR2022-01329 or based on any 35 U.S.C. §§ 102, 103 grounds using Hardin ’665 as the primary reference.

Samsung et al. v. Hardin et al.
IPR2022-01327
Exhibit 1034

August 2, 2022

Page 2

- If the Patent Trial and Appeal Board (PTAB) institutes trial in IPR2022-01330, then Samsung will not pursue, with respect to the '418 patent in Case No. 2:21-CV-00290-JRG, invalidity of the challenged claims based on the grounds instituted in IPR2022-01330 or based on any 35 U.S.C. §§ 102, 103 grounds using Hardin '665 as the primary reference.
- If the Patent Trial and Appeal Board (PTAB) institutes trial in IPR2022-01331, then Samsung will not pursue, with respect to the '418 patent in Case No. 2:21-CV-00290-JRG, invalidity of the challenged claims based on the grounds instituted in IPR2022-01331 or based on any 35 U.S.C. §§ 102, 103 grounds using Hardin '665 as the primary reference.
- If the Patent Trial and Appeal Board (PTAB) institutes trial in IPR2022-01332, then Samsung will not pursue, with respect to the '418 patent in Case No. 2:21-CV-00290-JRG, invalidity of the challenged claims based on the grounds instituted in IPR2022-01332 or based on any 35 U.S.C. §§ 102, 103 grounds using Hardin '665 as the primary reference.
- If the Patent Trial and Appeal Board (PTAB) institutes trial in IPR2022-01333, then Samsung will not pursue, with respect to the '447 patent in Case No. 2:21-CV-00290-JRG, invalidity of the challenged claims based on the grounds instituted in IPR2022-01333 or based on any 35 U.S.C. §§ 102, 103 grounds using Hardin '665 as the primary reference.
- If the Patent Trial and Appeal Board (PTAB) institutes trial in IPR2022-01334, then Samsung will not pursue, with respect to the '447 patent in Case No. 2:21-CV-00290-JRG, invalidity of the challenged claims based on the grounds instituted in IPR2022-01334 or based on any 35 U.S.C. §§ 102, 103 grounds using Hardin '665 as the primary reference.
- If the Patent Trial and Appeal Board (PTAB) institutes trial in IPR2022-01335, then Samsung will not pursue, with respect to the '447 patent in Case No. 2:21-CV-00290-JRG, invalidity of the challenged claims based on the grounds instituted in IPR2022-01335 or based on any 35 U.S.C. §§ 102, 103 grounds using Hardin '665 as the primary reference.

In so stipulating, Samsung seeks to avoid multiple proceedings addressing the validity of the patents-in-suit based on the same grounds. Rather, consistent with Congressional intent, Samsung wishes the patentability of these patents over those grounds to be addressed at the PTAB. But, for the sake of clarity and to avoid any doubt, if the PTAB declines institution of one or more IPRs, Samsung reserves the right to pursue the grounds of those IPRs in this litigation.

WILLIAMS & CONNOLLY^{LLP}

August 2, 2022
Page 3

Sincerely,

A handwritten signature in black ink, appearing to read "Andrew V. Trask". The signature is fluid and cursive, with a prominent initial "A" and a long, sweeping tail.

Andrew V. Trask