

# Morgan Lewis

## Alexander B. Stein

Partner  
+1.650.843.7278  
alexander.stein@morganlewis.com

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### VIA EMAIL

Eric Robert Carr  
ecarr@wsltrial.com  
Williams Simons & Landis PLLC

John Wittenzellner  
johnw@wsltrial.com  
Williams Simons & Landis PLLC

Michael James Fagan, Jr.  
mfagan@wsltrial.com  
Williams Simons & Landis PLLC

Fred Irvin Williams  
fwilliams@wsltrial.com  
Williams Simons & Landis PLLC

Re: *DynaPass IP Holdings LLC v. Amazon.com, Inc., Case No. 2:23-cv-00063-JRG-RSP (E.D. Tex.)*

Dear Counsel:

I write regarding the above-captioned litigation (the “District Court Case”), and the related petition for *inter partes* review (IPR) in IPR2024-00283 that was filed today against certain claims of U.S. Patent No. 6,993,658.

Petitioner Amazon.com, Inc. hereby stipulates that if the Patent Trial and Appeal Board (PTAB) institutes an IPR based on the grounds identified below, then it will (i) not pursue the grounds identified below in the District Court Case, (ii) not pursue any other ground that reasonably could have been raised during the IPR (should it be instituted) in the District Court Case, and (iii) not pursue any other ground that was raised or reasonably could have been raised during the *Unified Patents, LLC v. Dynapass IP Holdings LLC*, IPR2023-00425, Paper 1 (PTAB Jan. 6, 2023) (“Unified IPR”) proceeding in the District Court Case.

The grounds presented in the IPR petition are reproduced below for convenience:

Ground	Prior Art	Statutory Basis	Claims Challenged from '658 Patent
1	<i>Veneklase</i> in view of <i>Jonsson</i> and <i>Sormunen</i>	§103	7

Morgan, Lewis & Bockius LLP

1400 Page Mill Road



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Ground	Prior Art	Statutory Basis	Claims Challenged from '658 Patent
2	<i>Veneklase</i> in view of <i>Jonsson, Sormunen, and Kaufman</i>	§103	2
3	<i>Kew</i> in view of <i>Sormunen</i>	§103	7
4	<i>Kew</i> in view of <i>Sormunen and Kaufman</i>	§103	2

In so stipulating, Petitioner Amazon.com, Inc. seeks to avoid multiple proceedings challenging the same claims on the same grounds. Consistent with Congressional intent, through this stipulation, Petitioner Amazon.com, Inc. expresses its intentions to have only the PTAB address the patentability of the challenged claims identified above on the grounds identified above. However, if the PTAB declines institution as to any grounds, then Petitioner Amazon.com, Inc. reserves the right to pursue any non-instituted grounds, including any grounds that were raised or that reasonably could have been raised in the Unified IPR, in the District Court Case.

This stipulation is not intended, and should not be construed, to limit Petitioner Amazon.com, Inc.'s abilities to assert invalidity or unenforceability of U.S. Patent No. 6,993,658 in the District Court Case on any other ground not covered by this stipulation (e.g., indefiniteness, written-description issues, enablement, unenforceability issues, ineligible subject matter, or invalidity on grounds that reasonably could not have been raised during the IPR if instituted).

Sincerely,

/Alexander B. Stein/

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