

From: [Trials](#)
To: [David A. Walker](#); [Trials](#); [Lu Ling](#)
Cc: [Shawn Hunter](#); ray.ferrera@arlaw.com; [Robert Greeson](#); [R. Ross Viguet](#)
Subject: RE: IPR2023-00153, -00154, and -00568 - Patent Owner's Petition for Writ of Certiorari
Date: Wednesday, July 3, 2024 1:59:45 PM
Attachments: [image001.png](#)

Counsel,

Based on the parties' representation that Patent Owner has filed a petition for writ of certiorari from the Federal Circuit's decision affirming the invalidation of all claims challenged in the above referenced proceedings, the Board will stay the upcoming hearing scheduled for July 15th. All deadlines related to the hearing are hereby stayed. The Board is considering the parties' joint request for an extension of the final written decision deadlines in these proceedings and will issue an order in due course.

Regards,

Esther Goldschlager
Supervisory Paralegal Specialist
Patent Trial & Appeal Board
U.S. Patent & Trademark Office

From: David A. Walker <dwalker@schneiderwallace.com>
Sent: Wednesday, July 3, 2024 11:00 AM
To: Trials <Trials@USPTO.GOV>; Lu Ling <lu.ling@nortonrosefulbright.com>
Cc: Shawn Hunter <shunter@schneiderwallace.com>; ray.ferrera@arlaw.com; Robert Greeson <robert.greeson@nortonrosefulbright.com>; R. Ross Viguet <ross.viguet@nortonrosefulbright.com>
Subject: RE: IPR2023-00153, -00154, and -00568 - Patent Owner's Petition for Writ of Certiorari

CAUTION: This email has originated from a source outside of USPTO. **PLEASE CONSIDER THE SOURCE** before responding, clicking on links, or opening attachments.

Dear Ms. Goldschlager,

We have left messages at the Court, yesterday and today, requesting information and apprising them of your directive. We will let know when we get a response.

Regards,



David A. Walker
Attorney at Law
3700 Buffalo Speedway, Suite 960

IPR2023-00153, -00154, -00568
Ex. 3005

Houston, Texas 77098
Main Line: (713) 338-2560
Toll Free: (800) 689-0024
Direct: (713) 999-1842
Facsimile: (415) 421-7105
www.schneiderwallace.com

From: Trials <Trials@USPTO.GOV>

Sent: Tuesday, July 2, 2024 11:20 AM

To: Lu Ling <lu.ling@nortonrosefulbright.com>; Trials <Trials@USPTO.GOV>

Cc: Shawn Hunter <shunter@schneiderwallace.com>; David A. Walker <dwalker@schneiderwallace.com>; ray.ferrera@arlaw.com; Robert Greeson <robert.greeson@nortonrosefulbright.com>; R. Ross Viguet <ross.viguet@nortonrosefulbright.com>

Subject: RE: IPR2023-00153, -00154, and -00568 - Patent Owner's Petition for Writ of Certiorari

Notice: This email originated from outside of the organization. Please use caution before opening any attached file you did not expect from the sender. Contact support@langtech.com if in doubt.

Counsel,

The parties are directed to identify by docket number the case pending before the Supreme Court in the parallel litigation.

Regards,

Esther Goldschlager
Supervisory Paralegal Specialist
Patent Trial & Appeal Board
U.S. Patent & Trademark Office

From: Lu Ling <lu.ling@nortonrosefulbright.com>

Sent: Wednesday, June 26, 2024 6:10 PM

To: Trials <Trials@USPTO.GOV>

Cc: shunter@schneiderwallace.com; dwalker@schneiderwallace.com; ray.ferrera@arlaw.com; Robert Greeson <robert.greeson@nortonrosefulbright.com>; R. Ross Viguet <ross.viguet@nortonrosefulbright.com>

Subject: RE: IPR2023-00153, -00154, and -00568 - Patent Owner's Petition for Writ of Certiorari

CAUTION: This email has originated from a source outside of USPTO. **PLEASE CONSIDER THE SOURCE** before responding, clicking on links, or opening attachments.

Dear Board,

Apologies, the IPR numbers provided previously contain a typographical error. The correct IPR numbers are IPR2023-00153, -00154, and -00568.

Lu Ling | Associate
Norton Rose Fulbright US LLP
1550 Lamar Street, Suite 2000, Houston, Texas 77010-4106
Tel +1 713 651 5327 | Fax +1 713 651 5246
lu.ling@nortonrosefulbright.com

NORTON ROSE FULBRIGHT

Law around the world
[nortonrosefulbright.com](https://www.nortonrosefulbright.com)

From: Lu Ling
Sent: Wednesday, June 26, 2024 5:06 PM
To: Trials@USPTO.GOV
Cc: shunter@schneiderwallace.com; dwalker@schneiderwallace.com; ray.ferrera@arlaw.com;
Robert Greeson <robert.greeson@nortonrosefulbright.com>; R. Ross Viguet
<ross.viguet@nortonrosefulbright.com>
Subject: IPR2023-00153, -00154, and -00569 - Patent Owner's Petition for Writ of Certiorari

Dear Board,

Patent Owner in IPR2023-00153, -00154, and -00569 informed Petitioner last night that it filed a petition for writ of certiorari on Monday, June 24, 2024, appealing the invalidation of all claims of all challenged patents under 35 U.S.C. § 101 in the parallel district court litigation. Petitioner will file an Updated Mandatory Notices listing the Supreme Court's corresponding docket number once issued.

Further, the Board previously denied a request to stay the proceedings pending the Court's certiorari decision "[g]iven that Patent Owner has yet to file a petition for writ of certiorari with the Supreme Court." *E.g.*, IPR2023-00153, Paper 18 at 6. In view of Patent Owner now having filed the petition, Petitioner and Patent Owner jointly seek to renew the earlier request to stay the proceedings pending the Court's decision on the petition. *See, e.g.*, IPR2023-00153, EX3001 at 1. As both parties recognize, there is an exceedingly high likelihood that the Court will deny the petition to make the invalidity of all challenged patents final, upon which the parties will seek termination of the proceedings for mootness. A stay thus would equally likely save Board and party resources.

The previous stay request noted a date of the Court's certiorari decision being likely August 5, 2024. *See, e.g.*, IPR2023-00153, EX3001 at 1. Upon further research, however, the certiorari decision date will in fact be later than this date. The Court's 2023 term calendar indicates that its last conference of the term to decide on pending petitions was held last week, June 20, 2024, before Patent Owner's petition was filed. [2023TermCourtCalendar.pdf \(supremecourt.gov\)](#). The Court's 2024 term calendar indicates that its first post-recess conference to decide on pending petitions—which would include Patent Owner's petition—will be held September 30, 2024. [2024TermCourtCalendar.pdf \(supremecourt.gov\)](#). A decision on Patent Owner's petition would thus "reasonably be expected" to be issued the following Monday, i.e., October 7, 2024. *See* [reportersguide.pdf \(supremecourt.gov\)](#) at 15.

The final written decision deadlines in the IPRs are September 5 and October 2, 2024. A stay

pending the above October 7, 2024 date would thus require an extension of the final written decision deadlines, which may be extended by the Chief Administrative Patent Judge up to March 5 and April 2, 2025, respectively, should good cause be shown. 37 CFR § 42.100(c). The exceedingly high likelihood that Board and party resources would be preserved by a stay, as previously noted, provides such good cause.

Lu Ling | Associate
Norton Rose Fulbright US LLP
1550 Lamar Street, Suite 2000, Houston, Texas 77010-4106
Tel +1 713 651 5327 | Fax +1 713 651 5246
lu.ling@nortonrosefulbright.com

NORTON ROSE FULBRIGHT

Law around the world
nortonrosefulbright.com

This email message and any attachments are for the sole use of the intended recipient(s). Any unauthorized review, use, disclosure, copying or distribution is prohibited. If you are not the intended recipient, please contact the sender by reply email and destroy all copies of the original message and any attachments.

To reply to our email administrator directly, send an email to nrfus.postmaster@nortonrosefulbright.com.

Norton Rose Fulbright US LLP, Norton Rose Fulbright LLP, Norton Rose Fulbright Australia, Norton Rose Fulbright Canada LLP and Norton Rose Fulbright South Africa Inc are separate legal entities and all of them are members of Norton Rose Fulbright Verein, a Swiss verein. Norton Rose Fulbright Verein helps coordinate the activities of the members but does not itself provide legal services to clients. Details of each entity, with certain regulatory information, are available at nortonrosefulbright.com.