Subject: RE: Sotera Stipulations and Carbyne Biometrics, LLC v. Apple Inc., 1:23-cv-0032 (W.D. Tex.),
Date: Monday, April 22, 2024 at 11:51:58 AM Central Daylight Time
From: George T. Fishback, Jr.
To: O'Brien, David, Richard Kamprath
CC: Ehmke, Andrew S., Lyle, Kelly Gehrke, Shi, Hong, Roth, Cassandra
Attachments: image001.jpg, image005.png, image006.png, image007.png

David,

This response does not answer the question which is material to our response. Please provide your response to our question and the draft email to the Board before reaching out to the Board. Petitioner has had three months to make these stipulations so there is no reason for the arbitrary 3 PM deadline today. We need time to confer with our client.

As for our availability, we are free Thursday or Friday after 2PM CT.

Patent Owner's current position: "Patent Owner opposes Petitioner's stipulations. In the correspondence leading up to this Petitioner's request, Petitioner would not confirm that it would not raise the prior art in the Petitions in the district court litigation if the Petitions are instituted and the district court litigation is not stayed. Without that confirmation, it is unclear what the new stipulations would accomplish."

This position may change if Petitioner answers Patent Owner's question.

Thanks,
George

McKool Smith | George T. Fishback, Jr.
Associate | Austin, TX | Tel: (512) 692-8756

NOTICE OF CONFIDENTIALITY: The information contained in and transmitted with this e-mail is SUBJECT TO THE ATTORNEY-CLIENT and ATTORNEY WORK PRODUCT PRIVILEGE and is CONFIDENTIAL. It is intended only for the individual or entity designated above. You are hereby notified that any dissemination, distribution, copying, use or reliance upon the information contained in and transmitted with this e-mail by or to anyone other than the addressee designated above by the sender is unauthorized and strictly prohibited. If you have received this e-mail in error, please notify the sender by reply immediately. Any e-mail erroneously transmitted to you should be immediately destroyed.

From: O'Brien, David <David.OBrien@haynesboone.com>
Sent: Monday, April 22, 2024 9:01 AM
To: George T. Fishback, Jr. <gfishback@McKoolSmith.com>; Richard Kamprath <rkamprath@McKoolSmith.com>
Cc: Ehmke, Andrew S. <Andy.Ehmke@haynesboone.com>; Lyle, Kelly Gehrke <Kelly.Lyle@haynesboone.com>; Shi, Hong <Hong.Shi@haynesboone.com>; Roth, Cassandra <Cassandra.Roth@ropesgray.com>
Subject: RE: Sotera Stipulations and Carbyne Biometrics, LLC v. Apple Inc., 1:23-cv-0032 (W.D. Tex.),

Hi George,

Consistent with the Director Guidance, Apple's stipulations cover the same grounds as in the petition

and any grounds that could have reasonably been raised in the petition before the PTAB. They are, and are intended in each proceeding to be, dispositive of any *Fintiv* question. For your reference, I attach a copy of the Director Guidance.

As conveyed with the signed stipulations in my eMail of 17 April, we intend to request authorization to file the signed stipulations as exhibits in the respective proceedings. So that we may appropriately convey your response to M&C in that request, please respond today Monday 22 April, by 3pm ET with both (i) your opposition/non-opposition to Apple's request to file the stipulations and (ii) dates and times that would work for a Board conference, if such is called.

HAYNES BOONE

David O'Brien | Partner
david.obrien@haynesboone.com | (t) +1 512.867.8457

From: George T. Fishback, Jr. <gfishback@McKoolSmith.com>
Sent: Sunday, April 21, 2024 4:00 PM
To: O'Brien, David <David.OBrien@haynesboone.com>; Richard Kamprath <rkamprath@McKoolSmith.com>
Cc: Ehmke, Andrew S. <Andy.Ehmke@haynesboone.com>; Lyle, Kelly Gehrke <Kelly.Lyle@haynesboone.com>; Shi, Hong <Hong.Shi@haynesboone.com>; Roth, Cassandra <Cassandra.Roth@ropesgray.com>
Subject: Re: Sotera Stipulations and Carbyne Biometrics, LLC v. Apple Inc., 1:23-cv-0032 (W.D. Tex.),

EXTERNAL: Sent from outside Haynes and Boone, LLP

David, thanks for the reply. We are still waiting on our client's response and we will provide dates once we have discussed with our client.

In the meantime, can you please let us know if Apple's stipulations will prevent it from raising the prior art in the petitions in the district court litigation if the IPRs are instituted and the district court litigation is not stayed?

Thanks,
George

McKool Smith | George T. Fishback, Jr.
Associate | Austin, TX | Tel: (512) 692-8756

NOTICE OF CONFIDENTIALITY: The information contained in and transmitted with this e-mail is SUBJECT TO THE ATTORNEY-CLIENT and ATTORNEY WORK PRODUCT PRIVILEGE and is CONFIDENTIAL. It is intended only for the individual or entity designated above. You are hereby notified that any dissemination, distribution, copying, use or reliance upon the information contained in and transmitted with this e-mail by or to anyone other than the addressee designated above by the sender is unauthorized and strictly prohibited. If you have received this e-mail in error, please notify the sender by reply immediately. Any e-mail erroneously transmitted to you should be immediately destroyed.

From: O'Brien, David <David.OBrien@haynesboone.com>
Date: Friday, April 19, 2024 at 1:06 PM
To: George T. Fishback, Jr. <gfishback@McKoolSmith.com>, Richard Kamprath <rkamprath@McKoolSmith.com>
Cc: Ehmke, Andrew S. <Andy.Ehmke@haynesboone.com>, Lyle, Kelly Gehrke

<Kelly.Lyle@haynesboone.com>, Shi, Hong <Hong.Shi@haynesboone.com>, Roth, Cassandra <Cassandra.Roth@ropesgray.com>
Subject: RE: Sotera Stipulations and Carbyne Biometrics, LLC v. Apple Inc., 1:23-cv-0032 (W.D. Tex.),

Hi George. Thanks for the update. Please respond with dates and times that would work for Carbyne Biometrics' PTAB counsel for a Board conference.

HAYNES BOONE

David O'Brien | Partner
david.obrien@haynesboone.com | (t) +1 512.867.8457

From: George T. Fishback, Jr. <gfishback@McKoolSmith.com>
Sent: Friday, April 19, 2024 12:54 PM
To: O'Brien, David <David.OBrien@haynesboone.com>; Richard Kamprath <rkamprath@McKoolSmith.com>
Cc: Ehmke, Andrew S. <Andy.Ehmke@haynesboone.com>; Lyle, Kelly Gehrke <Kelly.Lyle@haynesboone.com>; Shi, Hong <Hong.Shi@haynesboone.com>; Roth, Cassandra <Cassandra.Roth@ropesgray.com>
Subject: RE: Sotera Stipulations and Carbyne Biometrics, LLC v. Apple Inc., 1:23-cv-0032 (W.D. Tex.),

EXTERNAL: Sent from outside Haynes and Boone, LLP

David,

We have passed this on to our client and we will let you know when we get a response.

Thanks,
George

MCKOOL SMITH

George T. Fishback, Jr.
Associate
Austin, TX
Tel: (512) 692-8756
www.mckoolsmith.com

NOTICE OF CONFIDENTIALITY: The information contained in and transmitted with this e-mail is SUBJECT TO THE ATTORNEY-CLIENT and ATTORNEY WORK PRODUCT PRIVILEGE and is CONFIDENTIAL. It is intended only for the individual or entity designated above. You are hereby notified that any dissemination, distribution, copying, use or reliance upon the information contained in and transmitted with this e-mail by or to anyone other than the addressee designated above by the sender is unauthorized and strictly prohibited. If you have received this e-mail in error, please notify the sender by reply immediately. Any e-mail erroneously transmitted to you should be immediately destroyed.

From: O'Brien, David <David.OBrien@haynesboone.com>
Sent: Wednesday, April 17, 2024 5:26 PM
To: George T. Fishback, Jr. <gfishback@McKoolSmith.com>; Richard Kamprath <rkamprath@McKoolSmith.com>
Cc: Ehmke, Andrew S. <Andy.Ehmke@haynesboone.com>; Lyle, Kelly Gehrke <Kelly.Lyle@haynesboone.com>; Shi, Hong <Hong.Shi@haynesboone.com>; Roth, Cassandra

<Cassandra.Roth@ropesgray.com>
Subject: Sotera Stipulations and Carbyne Biometrics, LLC v. Apple Inc., 1:23-cv-0032 (W.D. Tex.),

RE: *Apple Inc. v. Carbyne Biometrics, LLC*, IPR2024-00329 (PTAB)
Apple Inc. v. Carbyne Biometrics, LLC, IPR2024-00329 (PTAB),
Apple Inc. v. Carbyne Biometrics, LLC, IPR2024-00330 (PTAB),
Apple Inc. v. Carbyne Biometrics, LLC, IPR2024-00331 (PTAB),
Apple Inc. v. Carbyne Biometrics, LLC, IPR2024-00332 (PTAB),
Apple Inc. v. Carbyne Biometrics, LLC, IPR2024-00333 (PTAB),
Apple Inc. v. Carbyne Biometrics, LLC, IPR2024-00334 (PTAB), and
Apple Inc. v. Carbyne Biometrics, LLC, IPR2024-00507 (PTAB)

Counsel,

I attach stipulations for the above-identified proceedings at the Patent Trial and Appeal Board ("Board") in a letter form suitable for entry as an exhibit in each respective proceeding. We plan to request authorization from the Board to file the stipulations as exhibits.

Background: On March 19, 2024, the Court of Appeals for the Federal Circuit denied Apple's petition for writ of mandamus to direct United States District Court for the Western District of Texas to transfer Carbyne Biometrics' patent infringement case against Apple to the United States District Court for the Northern District of California. In view of the denial, and to avoid unnecessary briefing analyzing and applying factors from *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (designated precedential May 5, 2020), Apple stipulates in each of the seven (7) presently pending Apple IPRs challenging Carbyne Biometrics' patents in the manner provided by the USPTO Director's June 21, 2022 binding agency guidance memorandum, entitled Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation ("Director Guidance"). Consistent with the Director Guidance, such stipulations are dispositive. Director Guidance, 3, 7 ("the PTAB will not discretionarily deny institution in view of parallel district court litigation where a petitioner presents a stipulation not to pursue in a parallel proceeding the same grounds or any grounds that could have reasonably been raised" in the petition before the PTAB).

Apple has made its stipulations now with the goal of entering same into the record before Patent Owner Preliminary Responses are due.

Does Carbyne Biometrics oppose Apple's request for authorization to file the stipulations as exhibits? If not, please advise. If so, please advise regarding basis for opposition. In either case, given the possibility that the panel(s) may wish to schedule a conference call, please also respond with a few dates and times next week that would work for Carbyne Biometrics.

HAYNES BOONE

David O'Brien
Partner
david.obrien@haynesboone.com

Haynes and Boone, LLP
98 San Jacinto Boulevard
Suite 1500

Austin, TX 78701

(t) +1 512.867.8457

vCard | Bio | Website

CONFIDENTIALITY NOTICE: This electronic mail transmission is confidential, may be privileged and should be read or retained only by the intended recipient. If you have received this transmission in error, please immediately notify the sender and delete it from your system.

CONFIDENTIALITY NOTICE: This electronic mail transmission is confidential, may be privileged and should be read or retained only by the intended recipient. If you have received this transmission in error, please immediately notify the sender and delete it from your system.

CONFIDENTIALITY NOTICE: This electronic mail transmission is confidential, may be privileged and should be read or retained only by the intended recipient. If you have received this transmission in error, please immediately notify the sender and delete it from your system.