UNITED STATES DISTRICT COURT
FOR THE WESTERN DISTRICT OF TEXAS
AUSTIN DIVISION

CARBYNE BIOMETRICS, LLC, Plaintiff, v. APPLE INC., Defendant.	Case No. 1:23-CV-00324-ADA **JURY TRIAL DEMANDED**

APPLE INC.'S REPLY IN SUPPORT OF ITS MOTION TO STAY PENDING THE COURT'S WRITTEN ORDER ON TRANSFER

Carbyne's opposition underscores why a stay is appropriate.

Carbyne does not dispute that a written order on Apple's transfer motion must be issued before case activities proceed. *See generally* ECF No. 79. In fact, pausing case activities is what Federal Circuit case law requires when a court has not yet issued a written order explaining the reasons for its ruling on a filed transfer motion. *In re TracFone Wireless, Inc.*, 848 F. App'x 899, 901 (Fed. Cir. 2021) (non-precedential) ("[T]he district court is ordered to issue its ruling on the motion to transfer within 30 days from the issuance of this order, and to provide a reasoned basis for its ruling that is capable of meaningful appellate review. . . . We also order that all proceedings in the case are stayed until further notice.") (citing *In re SK hynix Inc.*, 835 F. App'x 600, 601 (Fed. Cir. 2021) (non-precedential) ("[T]he district court must stay all proceedings concerning the substantive issues of the case and all discovery until such time that it has issued a ruling on the motion capable of providing meaningful appellate review of the reasons for its decision.")). Apple's motion cited these cases, yet Carbyne's opposition does not even address them, let alone offer a justification for deviating from their holdings.

Instead, Carbyne argues only that this case should not be stayed because a written order on Apple's transfer motion is, according to Carbyne's speculation, imminent. ECF No. 79. Even if Carbyne's speculation were correct, that would be no reason to deny a stay, particularly in view of the case law cited above. Indeed, Carbyne's argument only reinforces the conclusion that a stay would not prejudice Carbyne because, according to Carbyne, that stay would be brief. Nor does Carbyne identify any prejudice that would result from a stay, further underscoring that none exists (factor 1 of the stay analysis). In contrast, Apple explained the prejudice that Apple would suffer if a stay is not granted (factor 2 of the stay analysis), *see* ECF No. 73 at 7-8, to which Carbyne offers no rebuttal. Finally, Carbyne does not dispute that a stay would conserve judicial resources

(factor 3 of the stay analysis). Indeed, Carbyne's stay opposition tellingly addresses none of the stay factors.

While Carbyne also purports to incorporate by reference its arguments made in opposition to Apple's pre-*Markman* stay request, ECF No. 79 at 1 n.1, this case is now in a much different procedural posture, and Carbyne fails to explain how its previous arguments apply now. Since briefing on Apple's pre-*Markman* stay request concluded, Apple's transfer motion has been denied without a written order; the Court has held a *Markman* hearing and issued claim construction rulings; and fact discovery has commenced, including the exchange of discovery requests and responses, the service of third-party subpoenas, additional source code productions, and multiple conferences of counsel that have occurred or been scheduled to address discovery disputes. Throughout this time, Apple has been requesting a written order setting forth the reasons for the Court's denial of Apple's transfer motion. Carbyne's earlier stay opposition, which it purports to incorporate by reference now, does not address this changed set of circumstances—let alone the cases requiring that a reasoned transfer order issue before substantive case activities progress.

For the foregoing reasons, and for the reasons set forth in Apple's motion to stay (ECF No. 73), Apple respectfully requests that the Court stay all case activity until the Court issues its written decision explaining the reasons for the Court's denial of Apple's motion to transfer venue.

Dated: January 24, 2024

/s/ Andrew Radsch

Melissa R. Smith
Texas Bar No. 24001351
GILLAM & SMITH, LLP
303 South Washington Avenue
Marshall, Texas 75670
Telephone: (903) 934-8450
Facsimile: (903) 934-9257
Email: melissa@gillamsmithlaw.com

James Travis Underwood
Texas Bar No. 24102587
GILLAM & SMITH, LLP
102 North College, Suite 800
Tyler, Texas 75702
Telephone: (903) 934-8450
Facsimile: (903) 934-9257
Email: travis@gillamsmithlaw.com

James R. Batchelder (*pro hac vice*)
Andrew Radsch
James Mack
ROPES & GRAY LLP
1900 University Avenue
East Palo Alto, CA 94303-2284
Telephone: (650) 617-4000
Facsimile: (650) 617-4090
Email: James.Batchelder@ropesgray.com
Email: Andrew.Radsch@ropesgray.com
Email: James.Mack@ropesgay.com

Cassandra Roth (*pro hac vice*)
ROPES & GRAY LLP
1211 Avenue of the Americas
New York, NY 10036-8704
Telephone: (212) 596-9000
Facsimile: (212) 596-9090
Email: Cassandra.Roth@ropesgray.com

Allen S. Cross (*pro hac vice*)
Nicole Pobre (*pro hac vice*)
ROPES & GRAY LLP
2099 Pennsylvania Avenue, N.W
Washington, DC 20006
Telephone: (202) 508-4600
Facsimile: (202) 508-4650

Email: Allen.cross@ropesgray.com
Email: Nicole.Pobre@ropesgray.com

S. Lara Ameri (*pro hac vice*)
ROPES & GRAY LLP
Prudential Tower
800 Boylston Street
Boston, Massachusetts 02199-3600
Telephone: (617) 951-7000
Facsimile: (617) 951-7050
Email: Lara.Ameri@ropesgray.com

Attorneys for Defendant, Apple Inc

CERTIFICATE OF SERVICE

I hereby certify that all counsel of record are being served with a copy of the foregoing document via the Court's CM/ECF system on January 24, 2024.

/s/ Melissa R. Smith
Melissa R. Smith