

From: [Steve McBride](#)
To: [Trials](#); [Scott W. Hejny](#)
Cc: [Nicholas Mathews](#); [Christian Hurt](#); [Carmichael, Jim \(External\)](#); [Mitch Yang](#); [Celerity IPRs](#); [Celerity IPRs](#)
Subject: RE: AT&T et al. v. ASUS Technology Licensing, Inc. / Innovative Sonic Limited IPR2024-00992, IPR2024-00997, IPR2024-01142, IPR2024-01143, IPR2024-01144, and IPR2024-01145
Date: Thursday, January 23, 2025 12:22:11 PM
Attachments: [image001.png](#)
[image002.png](#)
[image003.png](#)
[image004.png](#)

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Dear Honorable Board,

Per the Board's request, Patent Owner writes to inform the Board that the stay in the corresponding district court case was lifted at a hearing earlier today. The new trial date will be October 6, 2025. The Court expressly rejected Petitioner's request for an additional extension in the schedule. Patent Owner will confer with Petitioners regarding submitting the updated district court scheduling order when it issues.

Best regards,

Steve McBride



Stephen McBride
Carmichael IP, PLLC
8607 Westwood Center Drive, Suite 270
Tysons, VA 22182
(703) 646-9247
stevemcbride@carmichaelip.com

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From: Trials <Trials@USPTO.GOV>
Sent: Friday, December 20, 2024 3:13 PM
To: Scott W. Hejny <shejny@McKoolSmith.com>; Steve McBride <stevemcbride@carmichaelip.com>; Trials <Trials@USPTO.GOV>
Cc: Nicholas Mathews <nmathews@McKoolSmith.com>; Christian Hurt <churt@McKoolSmith.com>; James Carmichael <jim@carmichaelip.com>; Mitch Yang <Mitch@carmichaelip.com>; Celerity IPRs <CelerityIPRs@carmichaelip.com>; Celerity IPRs <Celerity_IPRs@mckoolsmith.com>
Subject: RE: AT&T et al. v. ASUS Technology Licensing, Inc. / Innovative Sonic Limited IPR2024-

Exhibit 3001
IPR2024-01142

00992, IPR2024-00997, IPR2024-01142, IPR2024-01143, IPR2024-01144, and IPR2024-01145

Counsel:

At this time, Patent Owner is not authorized to file the documents that it seeks to have entered into the record of the noted IPR proceedings. The parties, however, should update the Board as necessary as to any matters arising in parallel proceedings that may impact the IPR proceedings, including the lifting of the stay referenced by both parties.

The parties are also reminded that e-mail correspondence to the Board does not constitute briefing and should not contain substantive arguments. If the parties, after meeting and conferring, cannot reach agreement on a matter, the parties should seek a conference call with the Board.

Best regards,
Eric W. Hawthorne
Supervisory Paralegal Specialist
Patent Trial and Appeal Board

From: Scott W. Hejny <shejny@McKoolSmith.com>
Sent: Wednesday, December 18, 2024 6:03 PM
To: Steve McBride <stevemcbride@carmichaelip.com>; Trials <Trials@USPTO.GOV>
Cc: Nicholas Mathews <nmathews@McKoolSmith.com>; Christian Hurt <churt@McKoolSmith.com>; Carmichael, Jim (External) <jim@carmichaelip.com>; Mitch Yang <Mitch@carmichaelip.com>; Celerity IPRs <CelerityIPRs@carmichaelip.com>; Celerity_IPRs <Celerity_IPRs@mckoolsmith.com>
Subject: RE: AT&T et al. v. ASUS Technology Licensing, Inc. / Innovative Sonic Limited IPR2024-00992, IPR2024-00997, IPR2024-01142, IPR2024-01143, IPR2024-01144, and IPR2024-01145

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Your Honors,

I apologize for the additional email, but Petitioners were preparing a response to Patent Owner when this email was received. Petitioners' position follows.

Petitioners oppose the request for two reasons. First, briefing on (a) the motion to lift the stay and (b) the motion for leave to file an amended pleading is not yet complete. Petitioners' brief in opposition to the motion for leave to amend is due this Friday (12/20), and the brief in opposition to the motion to lift the stay is due Monday (12/23). To the extent the Board would find this briefing helpful, Petitioners believe that it would be improper to submit less than a full record for the Board's consideration. Second, Petitioners object to the attorney argument included in the final paragraph of Patent Owner's email (which is impermissible) and Patent Owner's implication that Petitioners sought to use any "delay" in expedited briefing (which the court has not granted) as a tactical advantage before the Board. The Order attached to Petitioners' Preliminary Reply in IPR2024-01121

(Ex-1017) explains the reasons for the stay being granted.

Petitioners would not object to Patent Owner informing the Board of any forthcoming order from Judge Payne lifting the stay if and when that occurs.

Petitioners are available Friday (12/20) between noon and 2:30 PM ET and Monday (12/23) before 3 PM ET.

Sincerely,
Scot Hejny
Counsel for Petitioners

McKool Smith

Scott W. Hejny
Principal
Dallas, TX
Tel: (214) 978-4241
www.mckoolsmith.com

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From: Steve McBride <stevemcbride@carmichaelip.com>

Sent: Wednesday, December 18, 2024 4:51 PM

To: Trials <Trials@USPTO.GOV>

Cc: Scott W. Hejny <shejny@McKoolSmith.com>; Nicholas Mathews <nmathews@McKoolSmith.com>; Christian Hurt <churt@McKoolSmith.com>; James Carmichael <jim@carmichaelip.com>; Mitch Yang <Mitch@carmichaelip.com>; Celerity IPRs <CelerityIPRs@carmichaelip.com>; Celerity IPRs <Celerity_IPRs@mckoolsmith.com>

Subject: AT&T et al. v. ASUS Technology Licensing, Inc. / Innovative Sonic Limited IPR2024-00992, IPR2024-00997, IPR2024-01142, IPR2024-01143, IPR2024-01144, and IPR2024-01145

Dear Honorable Board:

Patent Owner hereby requests authorization to submit the following documents as exhibits in IPR2024-00992, IPR2024-00997, IPR2024-01142, IPR2024-01143, IPR2024-01144, and IPR2024-01145:

- Petitioners' Preliminary Response filed December 17, 2024, in IPR2024-01121
- Memorandum Order, Dkt 328, Case 2:23-cv-00486-JRG-RSP
- Plaintiff's Motion to Lift Stay, Dkt 329, Case 2:23-cv-00486-JRG-RSP
- Plaintiff's Motion for Expedited Briefing on the Motion to Lift Stay, Dkt 330, Case 2:23-cv-00486-JRG-RSP
- Defendant's Opposition to Plaintiff's Motion for Expedited Briefing, Dkt 331, Case 2:23-cv-00486-JRG-RSP

- Plaintiff's Reply ISO Plaintiff's Motion for Expedited Briefing, Dkt 332, Case 2:23-cv-00486-JRG-RSP
- Notice of Mootness of Defendants' Motions to Dismiss, Dkt 85, Case 2:24-cv-00721-JRG-RSP
- Notice of Hearing on Defendants' Motions to Dismiss, Case 2:24-cv-00721-JRG-RSP
- Plaintiff's Motion for Leave to File Amended Pleading Dismissing with Prejudice, Dkt. 84, Case 2:24-cv-00721-JRG-RSP and Ex. A
- Official Transcript of Case Management Conference held 11/19/24 before Judge Payne

The basis for Patent Owner's request is that Petitioners, in their Preliminary Reply filed 17 December 2024 in IPR2024-01121, argue that a 06 December 2024 Memorandum Order temporarily staying the District Court case affects the *Fintiv* analysis in that other IPR. In its forthcoming response in that IPR, Patent Owner will explain why that is not so, especially in light of the other documents listed above. While Petitioner did not make such an argument in the IPRs above, Patent Owner nonetheless requests to make these documents of record in the IPRs listed above for completeness.

At the request of Petitioners, on December 6, the District Court temporarily stayed the infringement case pending "resolutions of the motions to dismiss" in which Petitioners sought to dismiss anti-trust, unfair competition and tortious interference claims pending against them in a related case. On that same day, the Patent Owner mooted the stay by dismissing with prejudice the antitrust, unfair competition and tortious interference claims. The stay has not yet been lifted because lead counsel for Petitioners in the District Court requested the full period of time (two weeks) to respond because he was attending an ITC proceeding. Petitioners never disclosed to the District Court they would use their requested delay in responding to the motion to lift the stay for the purposes being employed before the Board in the -01121 submission and Patent Owner is asking the Court to rule in an expedited fashion that the stay has been lifted now that the antitrust and related claims are being dismissed with prejudice.

Patent Owner requested Petitioner's position on December 17, 2024, but Petitioner has not yet responded. If a call with the Board is necessary, Patent Owner is available on Friday, December 20 or Monday, December 23.

Best regards,



Stephen McBride
 Carmichael IP, PLLC
 8607 Westwood Center Drive, Suite 270
 Tysons, VA 22182
 (703) 646-9247
stevemcbride@carmichaelip.com

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