

1 Vernon M. Winters (SBN 130128)
Irene Yang (SBN 245464)
2 SIDLEY AUSTIN LLP
555 California Street, Suite 2000
3 San Francisco, California 94104-1715
Telephone: (415) 772-1200
4 Facsimile: (415) 772-7400
Email: irene.yang@sidley.com
5 Email: vwinters@sidley.com

6 David T. Pritikin (*Pro Hac Vice*)
7 SIDLEY AUSTIN LLP
One South Dearborn
8 Chicago, IL 60603
Telephone: (312) 853-7359
9 Facsimile: (312) 853-7036
Email: dpritikin@sidley.com

10 Jeffrey P. Kushan (*Pro Hac Vice*)
11 Thomas A. Broughan III (*Pro Hac Vice*)
Hamilton C. Simpson (*Pro Hac Vice*)
12 SIDLEY AUSTIN LLP
13 1501 K Street, N.W.
Washington, DC 20005
14 Telephone: (202) 736-8000
Facsimile: (202) 736-8711
15 Email: jkushan@sidley.com
16 Email: tbroughan@sidley.com
Email: hsimpson@sidley.com

17 *Attorneys for Defendant and Counter Claimant*
18 *Apple Inc.*

19 UNITED STATES DISTRICT COURT
20 NORTHERN DISTRICT OF CALIFORNIA
21 OAKLAND DIVISION

22 OMNI MEDSCI, INC.,
23 *Plaintiff and Counter*
Defendant,

24 v.

25 APPLE INC,
26 *Defendant and Counter*
27 *Claimant.*
28 _____

Ching-Lee Fukuda (*Pro Hac Vice*)
Sharon Lee (*Pro Hac Vice*)
SIDLEY AUSTIN LLP
787 Seventh Avenue
New York, NY 10019
Telephone: (212) 839-5300
Facsimile: (212) 839-5599
Email: clfukuda@sidley.com
Email: sharon.lee@sidley.com

Kelley A. Conaty (*Pro Hac Vice*)
SIDLEY AUSTIN LLP
2021 McKinney Avenue, Suite 2000
Dallas, TX 75201
Telephone: (214) 981-3300
Facsimile: (214) 981-3400
Email: kconaty@sidley.com

Brooke S. Zarouri (SBN 318372)
SIDLEY AUSTIN LLP
555 West Fifth Street
Los Angeles, CA 90013
Phone: (213) 896-6633
Fax: (213) 896-6600
Email: bzarouri@sidley.com

) Case No.: 19-cv-05673-YGR
)
) **STIPULATION AND [PROPOSED]**
) **ORDER TO STAY PENDING**
) **RESOLUTION OF APPLE INC.'S**
) **REQUEST FOR LEAVE TO FILE**
) **MOTION FOR RECONSIDERATION OF**
) **STANDING MOTION [ECF 208] AND**
) **INTER PARTES REVIEW PETITIONS**
)
)
)
)

1 Pursuant to Civil L.R. 7-12, Plaintiff Omni MedSci Inc. (“Omni”) and Defendant Apple
2 Inc. (“Apple”), stipulate and agree as follows:

3 WHEREAS Omni filed its Complaint against Apple in the U.S. District Court for the
4 Eastern District of Texas (“Texas Court”) on October 15, 2018 alleging infringement of U.S.
5 Patent Nos. 10,098,546 (the “’546 patent”), 9,861,286 (the “’286 patent”), and 9,885,698 (the
6 “’698 patent”). (Dkt. 1.) On January 28, 2019, Omni filed an Amended Complaint adding
7 allegations of infringement of U.S. Patent No. 10,188,299 (the “’299 patent”). (Dkt. 42.) On
8 February 26, 2019, Omni filed a Second Amended Complaint adding allegations of infringement
9 of U.S. Patent No. 10,213,113 (the “’113 patent”).

10 WHEREAS on June 19, 2019, the parties stipulated to a dismissal with prejudice of all of
11 Omni’s claims and without prejudice of all of Apple’s claims pertaining to the ’698 patent. (Dkt.
12 119.) The Texas Court granted the parties’ stipulation. (Dkt. 123.)

13 WHEREAS Omni asserts claims 16 and 19 of the ’286 patent, claims 1, 5, 8, 9, 11-13, 15,
14 16, and 18 of the ’546 patent, claims 7 and 10-14 of the ’299 patent, and claims 1-6 and 22-25 of
15 the ’113 patent.

16 WHEREAS on April 10, 2019, Apple filed a request for *inter partes* review of all asserted
17 claims of the ’286 patent, along with requests for *inter partes* reviews of patents that Omni is
18 asserting against Apple in *Omni MedSci, Inc. v. Apple Inc.*, Case No. 19-cv-05924-YGR and are
19 related to the ’546, ’299, and ’113 patents.

20 WHEREAS on August 14, 2019, the Texas Court entered a Claim Construction
21 Memorandum Opinion and Order. (Dkt. 152.) In that Memorandum, the Court determined that
22 claims 2, 3, 4, and 23 of the ’113 patent are indefinite. (Dkt. 152.) Because other asserted claims
23 of the ’113 patent depend on claims 2, 3, 4 or 23, they are also rendered indefinite by the Court’s
24 Order. Accordingly, asserted claims 2-6 and 23-25 of the ’113 patent have been held indefinite.

25 WHEREAS on August 14, 2019, the Texas Court granted Apple’s motion to transfer to the
26 Northern District of California (Dkt. 154), and denied Apple’s motion to dismiss for lack of
27 standing. (Dkt. 151). On August 16, 2019, the Texas Court granted the parties’ joint motion to
28 stay certain deadlines pending transfer to the Northern District of California. (Dkt. 157.)

1 WHEREAS on September 11, 2019, the transferred case was received in the Northern
2 District of California (Dkt. 167). The case was assigned to this Court on September 25, 2019.
3 (Dkt. 173). On October 29, 2019, this Court granted Apple's motion to relate this case with co-
4 pending case, *Omni MedSci, Inc. v. Apple Inc.*, Case No. 19-cv-05924-YGR. (Dkts. 315, 316.) A
5 case management conference is scheduled for December 16, 2019 at 2:00 p.m. (Dkt. 174.)

6 WHEREAS between October 17, 2019 and November 6, 2019, the Patent Trial and Appeal
7 Board ("PTAB") issued decisions to institute *inter partes* review on the '286 patent and patents
8 that Omni is asserting against Apple in *Omni MedSci, Inc. v. Apple Inc.*, Case No. 19-cv-05924-
9 YGR that are related to the '546, '299, and '113 patents. See Exhibits 1-3. On October 17, 2019,
10 Apple filed a request for *inter partes* review of all asserted claims of the '546 patent. Apple
11 intends to file requests for *inter partes* review of all asserted claims of the '299 and '113 patents.

12 WHEREAS on November 8, 2019, Apple filed a Civil Local Rule 7-9 Request for Leave to
13 File Motion for Reconsideration Regarding Subject-Matter Jurisdiction (Dkt. 208) and a Motion to
14 Stay Pending Resolution of Apple's Standing Motion (ECF 208) (Dkt. 209).

15 NOW THEREFORE, in light of the PTAB's decisions to institute *inter partes* review on all
16 asserted claims of the '286 patent and patents related to the other asserted patents, and Apple's
17 intention to file requests for *inter partes* review on the remaining asserted patents, the parties by
18 and through their respective counsel of record, hereby stipulate and agree that:

19 a) This case should be stayed in its entirety except for the Court's consideration of
20 Apple's pending Request for Leave to File a Motion for Reconsideration Regarding Subject-
21 Matter Jurisdiction (Dkt. 208) and, if the Court grants Apple's Request for Leave, except for
22 proceedings related to that Request.

23 b) If the Court does not dismiss this case based on subject-matter jurisdiction, the case
24 should continue to be stayed until final resolution, including appeals, of all *inter partes* review
25 proceedings in which the asserted patents are at issue.

26 **IT IS SO STIPULATED.**

1 Dated: November 19, 2019

2

3 By: /s/ Thomas A Lewry

4 Thomas A. Lewry (Admitted *Pro Hac Vice*)
tlewry@brookskushman.com
5 John S. LeRoy (Admitted *Pro Hac Vice*)
jleroy@brookskushman.com
6 Christopher C. Smith, State Bar No. 238882
csmith@brookskushman.com
7 John M. Halan (Admitted *Pro Hac Vice*)
Jhalan@brookskushman.com
8 BROOKS KUSHMAN P.C.
1000 Town Center, Twenty-Second Floor
9 Southfield, MI 48075
Tel. (248) 358-4400; Fax (248) 358-3351

10 William E. Thomson, Jr., State Bar No. 47195
wthomson@brookskushman.com
11 BROOKS KUSHMAN P.C.
12 601 S. Figueroa St., Suite 2080
Los Angeles, CA 90017-5726
13 Tel. (213) 622-3003; Fax (213) 622-3053

14 *Attorneys for Plaintiff/Counter-Defendant*
Omni MedSci, Inc.

15

16

17

18

19

20

21

22

23

24

25

26

27

28

By: /s/ Irene Yang

Irene Yang (SBN 245464)
Vernon M. Winters (SBN 130128)
SIDLEY AUSTIN LLP
555 California Street, Suite 2000
San Francisco, California 94104-1715
Telephone: (415) 772-1200
Facsimile: (415) 772-7400
Email: irene.yang@sidley.com
Email: vwinters@sidley.com

David T. Pritikin (*Pro Hac Vice*)
SIDLEY AUSTIN LLP
One South Dearborn
Chicago, IL 60603
Telephone: (312) 853-7359
Facsimile: (312) 853-7036
Email: dpritikin@sidley.com

Jeffrey P. Kushan (*Pro Hac Vice*)
Thomas A. Broughan III (*Pro Hac Vice*)
Hamilton C. Simpson (*Pro Hac Vice*)
SIDLEY AUSTIN LLP
1501 K Street, N.W.
Washington, DC 20005
Telephone: (202) 736-8000
Facsimile: (202) 736-8711
Email: jkushan@sidley.com
Email: tbroughan@sidley.com
Email: hsimpson@sidley.com

Ching-Lee Fukuda (*Pro Hac Vice*)
Sharon Lee (*Pro Hac Vice*)
SIDLEY AUSTIN LLP
787 Seventh Avenue
New York, NY 10019
Telephone: (212) 839-5300
Facsimile: (212) 839-5599
Email: clfukuda@sidley.com
Email: sharon.lee@sidley.com

Kelley A. Conaty (*Pro Hac Vice*)
SIDLEY AUSTIN LLP
2021 McKinney Avenue, Suite 2000
Dallas, TX 75201

1 Telephone: (214) 981-3300
2 Facsimile: (214) 981-3400
3 Email: kconaty@sidley.com

4 Brooke S. Zarouri (SBN 318372)
5 SIDLEY AUSTIN LLP
6 555 West Fifth Street
7 Los Angeles, CA 90013
8 Phone: (213) 896-6633/Fax: (213) 896-6600
9 Email: bzarouri@sidley.com

10 *Attorneys for Defendant and Counter*
11 *Claimant Apple Inc.*

12 **CERTIFICATION PURSUANT TO CIVIL L.R. 5-1(i)(3)**

13 Pursuant to Civil Local Rule 5-1(i)(3), I hereby certify that concurrence in the filing of this
14 document has been obtained from the signatories for whom a signature is indicated by a conformed
15 signature (/s/). I have on file records to support this concurrence for production for the Court if so
16 ordered.

17 Dated: November 19, 2019


18 /s/ Irene Yang
19 Irene Yang

20 **PURSUANT TO STIPULATION, IT IS SO ORDERED:**

21 *Omni MedSci, Inc. v. Apple Inc.*, Case No. 19-cv-05673-YGR, is hereby STAYED until
22 resolution of Apple's Request for Leave to File a Motion for Reconsideration Regarding Subject-
23 Matter Jurisdiction (Dkt. 208) and, if the Court grants Apple's Request for Leave, the Court's
24 decision on the Motion for Reconsideration Regarding Subject-Matter Jurisdiction.

25 If this case is not dismissed based on subject-matter jurisdiction, this case will continue to
26 be STAYED until final resolution of all of the *inter partes* review proceedings in which the
27 asserted patents are at issue.

28 Dated: November 20, 2019

By: 
Hon. Yvonne Gonzalez Rogers
United States District Court Judge