

IN THE UNITED STATES DISTRICT COURT
FOR THE WESTERN DISTRICT OF TEXAS
WACO DIVISION

VOIP-PAL.COM, INC.

Plaintiff,

v.

AMAZON.COM, INC.;
AMAZON.COM SERVICES LLC; and
AMAZON.COM WEB SERVICES, INC.;

Defendants.

CIVIL ACTION NO. 6:20-cv-272-ADA

OPPOSED MOTION TO LIFT STAY AND RESET *MARKMAN* HEARING DATE

VoIP-Pal respectfully requests that the Court lift the stay entered in this case on June 1, 2022 and reset the *Markman* Hearing date. The Court stayed this case and two related cases—*VoIP-Pal.com, Inc. v. Meta Platforms, Inc. et al.*, Case No. 6:20-cv-00267-ADA (W.D. Tex.) (“the Meta case”) and *VoIP-Pal.com, Inc. v. Google LLC*, Case No. 6:20-cv-00269-ADA (W.D. Tex.) (“the Google case”)—pending resolution of motions to transfer in all three cases. All of these cases concern VoIP-Pal’s U.S. Patent No. 10,218,606 (“the ’606 patent”). The Court granted the motion to transfer the Meta case to the Northern District of California (“NDCAL”) on July 22, 2022. *See* Case No. 6:20-cv-267-ADA, Dkt. No. 97. The Court granted the motion to transfer the Google case to the NDCAL on September 21, 2022. *See* Case No. 6:20-cv-269-ADA, Dkt. No. 99. The Court denied the motion to transfer the instant case to the NDCAL on October 19, 2022. *See* Dkt. No. 78. Thus, the Court has resolved all of the transfer motions in the related cases and the conditions for lifting the stay have been satisfied since October 19, 2022.

At the time the Court stayed the instant case, the Court had set this case for a *Markman*

Hearing on June 2, 2022. *See* Dkt. No. 76. Accordingly, the Court should lift the stay, reset this case for a *Markman* Hearing, and require the parties to meet and confer regarding the remaining pretrial dates and to submit to the Court a proposed amended scheduling order based on the new *Markman* Hearing date.

Despite the conditions for lifting the stay being fully satisfied, Amazon opposes this Motion because it believes that the case should remain stayed until after a status conference set in the Meta and Google NDCAL cases for January 26, 2023. *See VoIP-Pal.Com, Inc. v. Meta Platforms, Inc. et al.*, Case No. 3:22-cv-4279-JD, Dkt. No. 86 (N.D. Cal.). Although this Court transferred those cases to the NDCAL several months ago, other than administrative activity, no activity has taken place in those cases except that Meta filed a motion for judgment on the pleadings under 35 U.S.C. § 101 on November 11, 2022 and Google filed a similar motion on November 15, 2022. *See VoIP-Pal.com, Inc. v. Meta Platforms, Inc. et al.*, Case No. 3:22-cv-4279-JD, Dkt. No. 122 (N.D. Cal.); *VoIP-Pal.com, Inc. v. Google LLC*, Case No. 3:22-cv-5419-JD, Dkt. No. 124 (N.D. Cal.). Both motions attempt to piggyback off of previous NDCAL decisions invalidating certain claims of patents in the same family as the '606 patent under § 101. The NDCAL terminated Meta's and Google's motions without prejudice to renewal after the status conference. *See* Case No. 3:22-cv-4279-JD, Dkt. No. 87; Case No. 3:22-cv-5419-JD, Dkt. No. 126. Presumably, the real reason that Amazon opposes this Motion is because Amazon believes that the Meta and Google motions are potentially dispositive of the issues in the instant case. But whatever Amazon's reasons are, they do not support maintaining the stay in this case.

First, the present stay is not conditioned on any activity in the Meta and Google NDCAL cases. Those cases have no bearing on whether the Court should lift the stay as there is nothing that will occur at the January 26 status conference that will prevent this Court from proceeding with the instant case. Second, it is uncertain if and when Meta and Google will refile their motions for

judgement on the pleadings. Third, even if Meta and Google refile their motions, the NDCAL will not conduct a hearing on those motions for at least five weeks and likely will not rule on those motions for several months after the hearing. In that time, this Court could conduct a *Markman* hearing and issue a claim construction order in this case. Additionally, the parties in this case could make significant progress in discovery. Finally, there is no guarantee that the NDCAL will grant Meta's and Google's motions. Thus, maintaining the stay in this case pending the uncertain outcome of yet-to-be filed motions, which is apparently what Amazon wants to do, could all be for nothing. In addition, maintaining the stay will only further delay resolving this case, which the Court previously stayed for over a year. *See* Dkt. Nos. 47 and 61. Accordingly, Amazon's rationale for maintaining the stay in this case should be rejected.

In conclusion, because all of the conditions for lifting the stay have been satisfied, the Court should lift the stay and reset this case for a *Markman* Hearing.

Dated: January 19, 2023

Respectfully submitted,

By: /s/Lewis E. Hudnell, III

Lewis E. Hudnell, III

lewis@hudnelllaw.com

Nicolas S. Gikkas

nick@gikkaslaw.com

Hudnell Law Group P.C.

800 W. El Camino Real Suite 180

Mountain View, California 94040

T: 650.564.3698

F: 347.772.3034

Sean Franklin Parmenter

sean@parmenterip.com

Parmenter Intellectual Property Law, PLLC

8980 N Pine Hollow Drive

Cedar Hills, Utah 84062

T: 925.482.6515

ATTORNEYS FOR PLAINTIFF

VOIP-PAL.COM, INC.

CERTIFICATE OF SERVICE

The undersigned certifies that all counsel of record who are deemed to have consented to electronic service are being served with a copy of the forgoing OPPOSED MOTION TO LIFT STAY AND RESET *MARKMAN* HEARING DATE via the Court's CM/ECF system pursuant to the Federal Rules of Civil Procedure and Local Rule CV-5(b)(1) this 19th day of January, 2023.

By: /s/Lewis E. Hudnell, III

Lewis E. Hudnell, III

lewis@hudnelllaw.com

Hudnell Law Group P.C.

800 W. El Camino Real Suite 180

Mountain View, California 94040

T: 650.564.3698

F: 347.772.3034