

**IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE**

APPLE INC.,

Plaintiff,

vs.

UNIVERSAL SECURE REGISTRY, LLC,

Defendant.

Civil Action No. 20-907-CFC

**STIPULATION AND ~~PROPOSED~~ ORDER STAYING
LITIGATION PENDING A DECISION
BY THE FEDERAL CIRCUIT IN RELATED CASE**

WHEREAS, on May 21, 2017, Universal Secure Registry, LLC (“USR”) filed a complaint for patent infringement against Apple Inc. (“Apple”), Visa Inc., and Visa U.S.A. Inc. (collectively, “Visa”) styled *Universal Secure Registry LLC v. Apple Inc., et al.*, Case No. 17-585-CFC-SRF (“17-585 Case”);

WHEREAS, USR asserted four patents in the 17-785 Case: U.S. Patent Nos. 8,577,813 (“813 patent”), 8,856,539 (“539 patent”), 9,100,826 (“826 patent”), and 9,530,137 (“137 patent”) (collectively, the “17-585 Case Patents”);

WHEREAS, on August 25, 2017, Apple and Visa moved to dismiss the 17-585 Case under Fed. R. Civ. P. 12(b)(6), *see* 17-585 Case, D.I. 16;

WHEREAS, Apple and Visa's motion argued that the 17-585 Case Patents were invalid for failure to claim patent-eligible subject matter under 35 U.S.C. § 101;

WHEREAS, on June 30, 2020, the Court issued a Memorandum Opinion and accompanying Order granting Apple and Visa's motion to dismiss the complaint in the 17-585 Case under Fed. R. Civ. P. 12(b)(6) ("101 Decision," 17-585 Case, D.I. 168);

WHEREAS, the 101 Decision ruled that the 17-585 Case Patents are invalid under 35 U.S.C. § 101, dismissed the complaint in the 17-585 Case with prejudice, and directed the case to be closed;

WHEREAS, on July 17, 2020, USR noticed its appeal of the Court's 101 Decision to the Federal Circuit ("17-585 Appeal," 17-585 Case, D.I. 170);

WHEREAS, on July 2, 2020, Apple filed a declaratory judgment complaint for non-infringement against USR, which requested the Court find that Apple does not infringe U.S. Patent Nos. 9,947,000 ("'000 patent"), 9,928,495 ("'495 patent"), and 10,163,103 ("'103 patent"), *see* D.I. 1; and

WHEREAS, on December 4, 2020, Apple filed an amended complaint for non-infringement against USR, which requested the Court find that Apple does not infringe the '103 patent;

NOW, THEREFORE, IT IS HEREBY STIPULATED AND AGREED, by the parties, and subject to the approval of the Court, as follows:

1. This case is stayed until the issuance of the mandate from the Federal Circuit with respect to the 17-585 Appeal.
2. If the Federal Circuit affirms the 101 Decision or if USR withdraws its appeal to the Federal Circuit of the 101 Decision with respect to any of the 17-585 Case Patents, then, based on this Court's reasoning in the 101 Decision, the '103 patent would be invalid for failure to claim patent-eligible subject matter under 35 U.S.C. § 101. If such occurs, then, within 7 days of the mandate issuing or 7 days of USR withdrawing its appeal with respect to any of the 17-585 Case Patents, the parties will submit a proposed order to the Court declaring the '103 patent is invalid for failure to claim patent-eligible subject matter under 35 U.S.C. § 101. The proposed order will include a statement that USR waives any right to appeal the order.

RICHARDS, LAYTON & FINGER, P.A.:

/s/ Jason J. Rawnsley

Fredrick L. Cottrell, III (#2555)

Jason J. Rawnsley (#5379)

920 North King Street

Wilmington, DE 19801

(302) 651-7700

cottrell@rlf.com

rawnsley@rlf.com

Attorneys for Plaintiff Apple Inc.

December 4, 2020

MORRIS, NICHOLS, ARSHT & TUNNELL
LLP

/s/ Jeremy A. Tigan

Jack B. Blumenfeld (#1014)

Jeremy A. Tigan (#5239)

1201 North Market Street

P.O. Box 1347

Wilmington, DE 19899-1347

(302) 658-9200

jblumenfeld@mnat.com

jtigan@mnat.com

*Attorneys for Defendant Universal
Secure Registry, LLC*

SO ORDERED this 7th day of December, 2020



United States District Court Judge