

Bajaj, Raghav (ATX)

From: Joseph Mercadante <jmercadante@fabricantllp.com>
Sent: Monday, October 13, 2025 1:30 PM
To: Lee, Joseph; Young, Patricia (NY-Bay Area); Vincent Rubino; Makker, Amit (Bay Area); Julian Pymonto; Alyssa Fioretti; Tzeng, Lin (Bay Area); mikejones@potterminton.com; shaunhassett@potterminton.com; #C-M GOOGLE LLC - ADVANCED CODING TECH LITIGATION - LW TEAM; Chin, Michelle (CH); Google ACT; Lumish, Doug; Campbell, Julianne (NY)
Cc: Advanced Coding; sbaxter@mckoolsmith.com; jtruelove@mckoolsmith.com
Subject: RE: ACT v. Google - Correspondence

Dropping a patent for the purposes of streamlining the case is not a dismissal with prejudice, and therefore we will not agree to such a stipulation. *Oyster Optics, LLC v. Cisco Sys., Inc.*, No. 2:20-CV-00211-JRG, 2021 WL 1530935, at *5 (E.D. Tex. Apr. 16, 2021) (“As this Court has stated, a patentee’s voluntary withdrawal of previously asserted patent claims for the purpose of narrowing a case is treated as a dismissal without prejudice”) (internal quotations omitted); see also *Realtime Data LLC v. EchoStar Corporation*, C.A. No. 6:17-CV-00084-JDL, 2018 WL 6267332, at *3 (E.D. Tex. Nov. 29, 2018); *SanDisk Corp. v. Kingston Tech. Co.*, 695 F.3d 1348, 1353 (Fed. Cir. 2012)).

We do not need the code printouts for the 101 patent.

Joseph Mercadante

Partner
Fabricant LLP
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From: Lee, Joseph <Joseph.Lee@weil.com>
Sent: Monday, October 13, 2025 2:27 PM
To: Joseph Mercadante <jmercadante@fabricantllp.com>; Patricia.Young@lw.com; Vincent Rubino <vrubino@fabricantllp.com>; Amit.Makker@lw.com; Julian Pymonto <jpymonto@fabricantllp.com>; Alyssa Fioretti <afioretti@fabricantllp.com>; Linfong.Tzeng@lw.com; mikejones@potterminton.com; shaunhassett@potterminton.com; GOOGLELLCADVANCEDCODINGTECHLITIGATION.LWTEAM@lw.com; Michelle.Chin@lw.com; Google ACT <Google.ACT@weil.com>; Lumish, Doug <Doug.Lumish@weil.com>; Julianne.Campbell@lw.com
Cc: Advanced Coding <advancedcoding@fabricantllp.com>; sbaxter@mckoolsmith.com; jtruelove@mckoolsmith.com
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Hi Joseph,

Thank you for letting us know that ACT will no longer be asserting the 101 patent. Please confirm that ACT will stipulate to a dismissal with prejudice of its claims involving the 101 patent.

Additionally, in light of ACT’s no longer asserting infringement of the 101 patent, we assume ACT no longer needs the source code printouts it requested as they relate to products ACT is accusing of infringing the 101 patent, and accordingly Google does not plan to produce them. If Google’s assumption is not correct, please let us know, including an identification of which source code ACT contends is related to products that are still being accused in this case.

Joe

Google
Exhibit 1125
Google v. Advanced Coding
IPR2025-01277
Ex. 1125-001

From: Joseph Mercadante <jmercadante@fabricantllp.com>

Sent: Monday, October 13, 2025 6:24 AM

To: Patricia.Young@lw.com; Vincent Rubino <vrubino@fabricantllp.com>; Amit.Makker@lw.com; Julian Pymonto <jpymento@fabricantllp.com>; Alyssa Fioretti <afioretti@fabricantllp.com>; Linfong.Tzeng@lw.com; mikejones@potterminton.com; shaunhassett@potterminton.com; GOOGLELLCADVANCEDCODINGTECHLITIGATION.LWTEAM@lw.com; Michelle.Chin@lw.com; Lee, Joseph <Joseph.Lee@weil.com>; Google ACT <Google.ACT@weil.com>; Lumish, Doug <Doug.Lumish@weil.com>; Julianne.Campbell@lw.com

Cc: Advanced Coding <advancedcoding@fabricantllp.com>; sbaxter@mckoolsmith.com; jtruelove@mckoolsmith.com

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Counsel for Google,

To streamline the issues in this case for trial, ACT is no longer asserting infringement of the '101 Patent in this action.

Joseph Mercadante

Partner

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