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Subject: [EXT] Activity in Case 1:22-cv-01248-CJB Hilti Aktiengesellschaft v. Specified Technologies Inc. Oral Order
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U.S. District Court

District of Delaware

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Case Name: Hilti Aktiengesellschaft v. Specified Technologies Inc.

Case Number: [1:22-cv-01248-CJB](#)

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Docket Text:

ORAL ORDER: The Court has now reviewed Plaintiff's motion to sever and stay Defendant's counterclaims as to the 232 and 868 patents ("Motion"), (D.I. 121), and the briefing related thereto, (D.I. 122; D.I. 127; D.I. 131). With regard to the portion of the Motion seeking a stay, after considering the three stay-related factors, the Court hereby ORDERS that this portion of the Motion is DENIED without prejudice to renew, following a decision by the Patent Trial and Appeal Board ("PTAB") as to whether to institute IPR proceedings on the patents' claims. Here, the Court will follow its own recent, prior precedent as to stay motions filed prior to a PTAB institution decision. See *Blue Spike LLC v. Dish Network Corp.*, Civil Action No. 19-160-LPS-CJB, (D.I. 22); cf. *Advanced Microscopy Inc. v. Carl Zeiss Microscopy, LLC*, Civil Action No. 15-516-LPS-CJB, 2016 WL 558615, at *1-2 (D. Del. Feb. 11, 2016). As it has articulated in those cases, the Court (absent some unique circumstance not present here) does not see the wisdom in staying a case in favor of the occurrence of an event (grant of an IPR petition and subsequent institution of an IPR) that has not happened and that has a significant chance of never happening. (See D.I. 122, ex. E at 6) The Court also notes that this case is not exactly in its infancy, as: (1) it was filed in September 2022; (2) it has been nearly a year since a Scheduling Order issued; and (3) the Court and the parties have expended some resources on the case so far, and the parties are in the midst of the claim construction process. And lastly, the parties are direct competitors in what

appears to be a relatively small market. (D.I. 123 at 77, 81, 84, 89, 91) In the future, if either or both of the pending IPR petitions are granted, and if Plaintiff then wishes to renew this aspect of the Motion, it should file a one-page letter with the Court indicating its intent to do so. The Court will then set an abbreviated letter briefing schedule on the renewed motion (but will also take into account any relevant content from the briefs already filed as to the instant Motion).. Ordered by Judge Christopher J. Burke on 2/5/2024. (dlb)

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