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From: ded_nefreply@ded.uscourts.gov
Sent: February 5, 2024 11:11 AM
To: ded_ecf@ded.uscourts.gov
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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Document Number: 155(No document attached)

Docket Text:

ORAL ORDER: The Court has 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 that asks the Court to "sever these claims into a separate case[.]" (D.I. 121), it is **DENIED** without prejudice to renew. The Court agrees with Plaintiff that the instant case is still plenty complex. And the Court is not entirely ruling out the prospect of further severance, depending on what happens between now and trial. But after having reviewed Federal Rule of Civil Procedure 21 and the factors that courts look to in assessing severance motions, see *In re Intex Recreation Corp.*, 2018-131, 2018 WL 3089215, at *3 (Fed. Cir. June 13, 2018); *In re EMC Corp.*, 677 F.3d 1351, 1356 (Fed. Cir. 2012); (D.I. 72), the Court concludes that severance is not appropriate at this time. The Court comes to this conclusion for the following reasons: (1) The Court disagrees with Plaintiff that there are no common issues of fact or overlapping evidence regarding the claims as to the 232 and 868 patents on the one hand, and the rest of the patents in the instant case on the other hand. As Defendant notes, certain of Defendant's products allegedly read on the claims of the 232 and 868 patents and are also accused of infringing certain of Plaintiff's patents-in-suit, while certain of Plaintiff's products are accused of infringing the 232 patent and also allegedly read on the claims of certain of Plaintiff's patents-in-suit. (D.I. 127 at 1-2); (2) This motion is not exactly like the earlier motion to sever (the "prior motion") the Court addressed in this case, (D.I. 72), in that with the prior motion, the 244 Action already existed, and the question was simply whether certain claims with a real connection to that action could

be removed from this case and added to the 244 Action, in order to make this case less daunting. Here though, Plaintiff is asking the Court to create a new, fourth case between the parties via severance, theoretically necessitating a fourth trial. The Court sees potential downside there, in terms of what it could mean regarding the expenditure of additional court and party resources.; and (3) Plaintiff says that its goal is to simplify the upcoming Markman process and the case more generally, by removing patents and claim terms at issue from this case. But the Court has already attempted to simplify the upcoming Markman hearing by ordering that it will hear argument on only 8 terms. And whether severance occurs or not, the Court will have to deal with claim construction disputes as to the other terms (if the parties truly have a dispute) at some point before trial. (D.I. 127 at 2) Additionally, the parties will be working to narrow the case in other ways as trial approaches. We will see if these efforts to streamline bear fruit. (Id. at 3) In light of the foregoing, today's scheduled videoconference is CANCELED. Ordered by Judge Christopher J. Burke on 2/4/2024. (dlb)

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