IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF TEXAS
SHERMAN DIVISION

CHIEN-MIN SUNG, Plaintiff, v. SAMSUNG ELECTRONICS CO. LTD., SAMSUNG ELECTRONICS AMERICA, INC., SAMSUNG SEMICONDUCTOR, INC., and SAMSUNG AUSTIN SEMICONDUCTOR, LLC, Defendants.	Case No. 4:23-cv-752 **JURY TRIAL DEMANDED**

DEFENDANTS' MOTION TO STAY
PENDING RESOLUTION OF TI'S MOTION FOR SUMMARY JUDGMENT

TABLE OF CONTENTS

Page

I. INTRODUCTION 1

II. BACKGROUND 2

III. LEGAL STANDARD.....3

IV. ARGUMENT 3

A. There is good cause to stay this case because TI's Motion for Summary Judgment can be resolved without further discovery or claim construction, and can completely dispose of both the TI Case and this case. 3

B. Each of the *Ericsson* factors favors staying the case. 5

1. A stay of the case will *not* unduly prejudice Dr. Sung. 5

2. A stay will potentially dispose of the case, or at least simplify issues, due to the complete overlap of asserted claims. 6

3. A stay is warranted because of the early stage of the case—discovery is ongoing and no trial has been set. 7

V. THE PARTIES' MEET-AND-CONFER EFFORTS 7

VI. CONCLUSION.....8

TABLE OF AUTHORITIES

Page(s)

Cases

Blonder–Tongue Labs., Inc. v. Univ. of Ill. Found.,
402 U.S. 313 (1971) 4

Cypress Lake Software, Inc. v. Samsung Elecs. Am., Inc.,
No. 6:18-CV-30-JDK, 2019 WL 13335932 (E.D. Tex. Aug. 28, 2019) 6

Datatreasury Corp. v. Wells Fargo & Co.,
490 F. Supp. 2d 749 (E.D. Tex. 2006) 3

Fujita v. United States,
416 F.App'x 400 (5th Cir. 2011) 3

Glob. Equity Mgmt. (SA) Pty. Ltd. v. Ericsson, Inc.,
No. 2:16-CV-00618, 2017 WL 365398 (E.D. Tex. Jan. 25, 2017) 3, 5

James J. Flanagan Shipping Corp. v. Port of Beaumont of Jefferson Cty.,
No. 1:20-CV-191, 2020 WL 4365595 (E.D. Tex. July 29, 2020) 3

Motion Games, LLC v. Nintendo Co.,
No. 6:12-CV-878-JDL, (E.D. Tex. Sept. 23, 2014) 4

Peters v. Active Mfg. Co.,
129 U.S. 530 (1889) 1

Petrus v. Bowen,
833 F.2d 581 (5th Cir. 1987) 3

Rapid Completions LLC v. Baker Hughes Inc.,
No. 6:15-cv-724, 2016 WL 3079509 (E.D. Tex. June 1, 2016) 6

Reyes v. Equifax Info. Servs., LLC,
No. 4:21-CV-639-SDJ, 2023 WL 3681684 (E.D. Tex. Apr. 13, 2023) 4

Soverain Software LLC v. Victoria's Secret Direct Brand Mgmt., LLC,
778 F.3d 1311 (Fed. Cir. 2015) 4, 7

UMBRA Technologies Ltd., v. Cisco Systems, Inc.,
No. 1:23-CV-903-DII, 2024 WL 2155274 (W.D. Tex. Apr. 25, 2024) 6

Statutes

35 U.S.C. § 102(b) 1

TABLE OF AUTHORITIES (cont'd)

Pages

Rules

Federal Rule of Civil Procedure 26(c)(1) 3

I. INTRODUCTION

Defendants Samsung Electronics Co., Ltd. ("SEC"), Samsung Electronics America, Inc. ("SEA"), Samsung Semiconductor, Inc. ("SSI"), and Samsung Austin Semiconductor, LLC ("SAS") (collectively, the "Samsung Defendants") respectfully request that the Court stay this litigation in its entirety pending resolution of Texas Instruments Incorporated's ("TI") Motion for Summary Judgment in a parallel action before this Court. (Civ. Action No. 4:23-cv-00753-SDJ ("TI Case"), Dkt. No. 26).

On May 14, 2024, this Court granted TI's Motion to Stay the Case Pending Resolution of TI's Motion for Summary Judgment. (TI Case, Dkt. No. 68 (granting Dkt. No. 27)). TI's Motion for Summary Judgment demonstrates that pre-AIA 35 U.S.C. § 102(b)'s on-sale bar renders the asserted claims of each of Dr. Sung's patents invalid because Dr. Sung accused as infringing a product that "was on sale before the critical dates of the asserted patents." (TI Case, Dkt. No. 28 at 6-7). It is axiomatic "that which infringes, if later, would anticipate if earlier." *Peters v. Active Mfg. Co.*, 129 U.S. 530, 537 (1889). The Court found "good cause to grant a stay" in the TI Case because TI's Motion for Summary Judgment presented a "core question [] ripe for adjudication." (TI Case, Dkt. No. 68 at 2).

The Samsung Defendants submit that the Court should also stay this case pending resolution of TI's Motion for Summary Judgment. There is complete overlap between the patents and asserted claims implicated by TI's Motion for Summary Judgment, on the one hand, and those asserted by Dr. Sung against the Samsung Defendants, on the other. Thus, a determination of invalidity based on TI's Motion for Summary Judgment will have the same dispositive effect in this case. Because, like the TI Case, this case "can be resolved without the need for further discovery or claim construction" (TI Case, Dkt. No. 68 at 2), there is good cause to stay the case.

II. BACKGROUND

On August 21, 2023, Dr. Sung filed suit against the Samsung Defendants alleging infringement of U.S. Patent Nos. 9,138,862 ("the '862 patent"), 9,724,802 ("the '802 patent"), and 8,974,270 ("the '270 patent"). (Dkt. No. 1 ¶¶ 23-28). The asserted patents are directed to a "common" semiconductor manufacturing technique known as "Chemical Mechanical Polishing (CMP)," which uses a "polishing pad in combination with an abrasive slurry" to create smooth, polished wafers. (*See id*. ¶¶ 29, 32). Dr. Sung alleges that the Samsung Defendants infringe the asserted patents because they allegedly purchase and use certain "pad conditioners"—manufactured by various third parties—to condition CMP pads that are used to polish wafers, which are then incorporated into end-user products, such as mobile phones and home appliances. (*Id*. ¶¶ 10–11).

This case is still in its early stages. On November 27, 2023, Defendants filed a Motion to Dismiss. (Dkt. No. 19). On February 22, 2024, Defendants filed a Motion to Transfer to the Northern District of California. (Dkt. No. 38). Both of those motions are pending before this Court.[1] The bulk of discovery and other events in this case have yet to occur and key milestones remain months away: the *Markman* hearing is scheduled for September 4, 2024; discovery will not close until February 2, 2025; final dispositive motions are due March 5, 2025; and the final pretrial conference is set for September 5, 2025. (Dkt. No. 37). No trial date has been set. (*Id*.).

[1] The Samsung Defendants have also filed three petitions for *Inter Partes* Review, challenging the validity of all claims of the asserted patents. *Samsung Electronics Co. Ltd. et al v. Chien-Min Sung*, Case No. IPR2024-00533 (P.T.A.B. February 29, 2024) (challenging the '270 patent); Case No. IPR2024-00534 (P.T.A.B. February 29, 2024) (challenging the '862 patent); Case No. IPR2024-00535 (P.T.A.B. February 29, 2024) (challenging the '802 patent). As the Samsung Defendants previously stated, the Samsung Defendants will also file a motion to stay this case if and when the Patent Trial and Appeal Board of the United States Patent and Trademark Office institutes the Samsung Defendants' *Inter Partes* Reviews. (*See* Dkt. No. 43). Institution decisions are expected by September 28, 2024.

III. LEGAL STANDARD

A federal district court has "broad discretion and inherent power to stay discovery until preliminary questions that may dispose of the case are determined." *Fujita v. United States*, 416 F.App'x 400, 402 (5th Cir. 2011) (quoting *Petrus v. Bowen*, 833 F.2d 581, 583 (5th Cir. 1987)). The court may, for example, stay discovery for "good cause" under Federal Rule of Civil Procedure 26(c)(1). *See id*. Good cause may exist when "resolving a [dispositive motion] might reduce or preclude the need for discovery or when 'further discovery will impose undue burden or expense without aiding the resolution of the dispositive motions.'" *James J. Flanagan Shipping Corp. v. Port of Beaumont of Jefferson Cty*., No. 1:20-CV-191, 2020 WL 4365595, at *1 (E.D. Tex. July 29, 2020) (quoting *Fujita*, 416 F.App'x at 402).

Additionally, in considering a motion to stay, courts in this district may consider: "(1) whether a stay will unduly prejudice or present a clear tactical disadvantage to the nonmoving party; (2) whether a stay will simplify the issues in question and trial of the case; and (3) whether discovery is complete and whether a trial date has been set." *Glob. Equity Mgmt. (SA) Pty. Ltd. v. Ericsson, Inc.*, No. 2:16-CV-00618, 2017 WL 365398, at *10 (E.D. Tex. Jan. 25, 2017) (quoting *Datatreasury Corp. v. Wells Fargo & Co.*, 490 F. Supp. 2d 749, 754 (E.D. Tex. 2006)).

IV. ARGUMENT

A. There is good cause to stay this case because TI's Motion for Summary Judgment can be resolved without further discovery or claim construction, and can completely dispose of both the TI Case and this case.

As the Court explained in the TI Case, "good cause [to stay] may exist when 'resolving a [dispositive motion] might reduce or preclude the need for discovery or when further discovery will impose undue burden or expense without aiding the resolution of the dispositive motions.'" (TI Case, Dkt. No. 68 at 1) (quoting *James J. Flanagan Shipping Corp.*, 2020 WL 4365595, at *1. Good cause exists here because TI's Motion for Summary Judgment could dispose of both the TI

case and this case, where Dr. Sung asserts the same patents and claims, in their entirety under issue preclusion without the need for further discovery or claim construction. *See Soverain Software LLC v. Victoria's Secret Direct Brand Mgmt., LLC,* 778 F.3d 1311, 1313–16 (Fed. Cir. 2015) (affirming invalidity of the asserted claims due to issue preclusion (citing *Blonder–Tongue Labs., Inc. v. Univ. of Ill. Found*., 402 U.S. 313, 349–50 (1971)).

As the Court already determined in the TI Case, the "core question" of invalidity presented by TI's Motion for Summary Judgment "is ripe for adjudication and can be resolved without the need for further discovery or claim construction." (TI Case, Dkt. No. 68 at 2). That holds equally true in Dr. Sung's case against the Samsung Defendants. (Ex. 1, *Motion Games, LLC v. Nintendo Co.*, No. 6:12-CV-878-JDL, D.I. 216 (E.D. Tex. Sept. 23, 2014) (ordering a stay to "eliminat[e] time-consuming and costly discovery which will likely have no effect on the merits of the case")); *Reyes v. Equifax Info. Servs., LLC*, No. 4:21-CV-639-SDJ, 2023 WL 3681684, at *1 (E.D. Tex. Apr. 13, 2023) ("[R]esolution of Equifax's summary-judgment motion could obviate the need for trial, saving both parties considerable litigation expense, and Reyes's allegations of prejudice stemming from the continued passage of time from her alleged injury to her ultimate trial testimony fail to establish any meaningful competing interest counseling against a stay.").

That this case can be disposed of without further discovery strongly supports a stay because Dr. Sung has pursued unduly burdensome and unnecessary discovery. For example, Dr. Sung seeks discovery relating to exceedingly broad categories of end user products, including "memory, mobile devices (e.g., mobile phones), smart devices (e.g., smart watches), LED panels, solid-state drives, processors, image sensors, virtual reality headsets, computing devices and tablets, security/monitoring systems, TVs and displays, home appliances, audio systems and devices, and other semiconductor system, products, devices, and integrated circuits" that are "design[ed],

develop[ed], or manufacture[d] . . . us[ing] or employ[ing]" the identified third-party CMP pad conditioners. (Dkt. No. 1 ¶¶ 11-12; *see also* Ex. 2 at ¶ AA (defining "Accused Products" as those described in the Complaint)). Dr. Sung's failure to identify accused products with specificity is particularly unduly burdensome on the Samsung Defendants given the tenuous relationship between the expansive set of accused end user products and the alleged inventions related to CMP pad conditioners.

Moreover, Dr. Sung fails to tie the broad classes of accused products to any particular Samsung Defendant. Dr. Sung does not differentiate between the four different named Samsung entities under his various theories of infringement: (1) SEC (a Korean entity); (2) SEA (a New York entity that does not purchase or use CMP pad conditioners); (3) SSI (a California entity that does not purchase or use CMP pad conditioners); and (4) SAS (a Delaware entity). The Samsung Defendants are left guessing, at considerable expense, as to what is responsive to Dr. Sung's sweeping discovery requests.

Because resolving TI's Motion for Summary Judgment can obviate the need for discovery, and further discovery will impose undue burden on the Samsung Defendants without affecting the resolution of TI's Motion for Summary Judgment, the Samsung Defendants respectfully request that the Court enter a stay in this case.

B. Each of the *Ericsson* factors favors staying the case.

If the Court finds that there is good cause to stay this case—just as it did in the TI Case—the Court need not consider the *Ericsson* 3-factor test. If the Court, however, reaches the *Ericsson* analysis, that test confirms that a stay is warranted in this case.

1. <u>A stay of the case will *not* unduly prejudice Dr. Sung.</u>

The Court has already stayed the parallel TI Case, finding that it "can be resolved without the need for further discovery or claim construction." (TI Case, Dkt. No. 68 at 2). Like in the TI

Case, Dr. Sung faces no undue prejudice from an identical stay in this case. The lack of undue prejudice is particularly apparent here because Dr. Sung: (1) seeks only monetary relief (*see* Dkt. No. 1 at 34-35; *see also Cypress Lake Software, Inc. v. Samsung Elecs. Am., Inc.*, No. 6:18-CV-30-JDK, 2019 WL 13335932, at *2 (E.D. Tex. Aug. 28, 2019) (quoting *Rapid Completions LLC v. Baker Hughes Inc.*, No. 6:15-cv-724, 2016 WL 3079509, at *2 (E.D. Tex. June 1, 2016)) (granting stay and explaining that "when a patentee seeks exclusively monetary damages, rather than a preliminary injunction or other relief, 'mere delay in collecting those damages does not constitute undue prejudice'")); and (2) does not claim to practice the asserted patents or sell any products and, accordingly, does not compete with the Samsung Defendants (*see UMBRA Technologies Ltd., v. Cisco Systems, Inc.*, No. 1:23-CV-903-DII, 2024 WL 2155274, at *2 (W.D. Tex. Apr. 25, 2024) (holding that, because "the parties do not compete, a stay will not unduly prejudice [plaintiff's] interests."); *see also Bell Semiconductor, LLC v. NXP Semiconductors*, N.V., No. 1:20-CV-611-LY, 2022 WL 1447948, at *2 (W.D. Tex. Feb. 7, 2022) ("Because Bell Semic does not produce products on its patents or otherwise compete with NXP, a stay will not unduly prejudice Bell Semic's interests.")).

2. <u>A stay will potentially dispose of the case, or at least simplify issues, due to the complete overlap of asserted claims.</u>

The patents and claims asserted in the TI Case completely subsume the patents and claims asserted here against the Samsung Defendants. In the TI Case, Dr. Sung asserts claims 1–13, 15, 17–20 of the '862 patent; claims 1–21 of the '802 patent; and claims 1–8 of the '270 patent. (*See* TI Case, Dkt. No. 28 at 3 (explaining that Dr. Sung asserts "'862 patent claims 1–13, 15, 17–20; '802 patent claims 1–21; and '270 patent claims 1–8" against TI)). In this case, Dr. Sung likewise asserts the same set of claims in the '862 and '802 patents. (Dkt. No. 1 at ¶¶ 23-28; *see also* Ex.

3 at 3 (asserting '862 patent claims 1-13, 15, 17-20 and '802 patent claims 1-21)).[2] A finding of invalidity in the TI Case would thus render all of Dr. Sung's asserted claims in this case invalid. *Soverain Software LLC,* 778 F.3d at 1313–16 (Fed. Cir. 2015).

3. A stay is warranted because of the early stage of the case—discovery is ongoing and no trial has been set.

Despite being filed on the same day as the TI Case, this case has advanced more slowly. For example, the TI Case has already completed opening, responsive, and reply claim construction briefing. (*See* TI Case, Dkt. Nos. 57, 61, 65). In contrast, opening claim construction briefing in this case is not scheduled to occur until June 12, 2024. (Dkt. No. 37). Similarly, although the final pretrial conference in the TI Case is scheduled for February 3, 2025, (TI Case, Dkt. No. 12), the final pretrial conference in this case is not scheduled until September 3, 2025—seven months later. (Dkt. No. 37). The much earlier posture of this case as compared to the already-stayed TI Case further favors a stay.

V. THE PARTIES' MEET-AND-CONFER EFFORTS

The Samsung Defendants requested a meet-and-confer concerning this Motion on May 14, 2024—the same day that the Court issued its order staying the TI Case. (Ex. 4). The parties then conferred via teleconference on May 17, 2024. Dr. Sung's counsel followed up by email on May 20, 2024, offering to agree to stay the case after claim construction briefing is complete (on July 17, 2024). (Ex. 5). There is certainly some merit to Dr. Sung's proposal insofar as it would provide a convenient stopping point for the case with *Markman* briefing being completed. Accordingly, the Samsung Defendants are open to that approach if the Court deems it best. However, the Samsung Defendants respectfully submit that the better approach is to stay the case sooner to avoid

[2] Dr. Sung's Preliminary Infringement Contentions dropped the '270 patent, explaining "Plaintiff will no longer pursue infringement based on double-sided pad conditioners." (Ex. 3 at n. 1).

the expense of completing *Markman* briefing and proceeding through burdensome discovery while the Court considers the validity of all asserted claims in both this case and the TI case. As the Court found in the TI Case, "this core question [of invalidity] is ripe for adjudication and can be resolved ***without the need for further discovery or claim construction***." (TI Case, Dkt. No. 68 at 2) (emphasis added).

VI. CONCLUSION

For all the reasons set forth above, the Samsung Defendants respectfully request that the Court grant this motion to stay the case pending resolution of TI's Motion for Summary Judgment as it has done in the TI Case.

Dated: May 21, 2024

By: *<u>/s/ Cosmin Maier (with permission, by Collin Maloney)</u>*

Otis Carroll
Collin Maloney
Mandy Nelson
CARROLL MALONEY
HENRY & NELSON PPLC
1327 Dominion Plaza Ste. 100
Tyler, TX 75703
Tel: (903) 561-1600
otis@cmhnlaw.com
collin@cmhnlaw.com
mandy@cmhnlaw.com

John Desmarais (Admitted Pro Hac Vice)
Paul Bondor (Admitted Pro Hac Vice)
Cosmin Maier (Admitted Pro Hac Vice)
Yung-Hoon Ha (Admitted Pro Hac Vice)
Taeg Sang Cho (Admitted Pro Hac Vice)
DESMARAIS LLP
230 Park Avenue
New York, New York 10169
Tel: (212) 351-3400
Fax: (212) 351-3401
jdesmarais@desmaraisllp.com
pbondor@desmaraisllp.com
cmaier@desmaraisllp.com
yha@desmaraisllp.com
tcho@desmaraisllp.com

David Cho (Admitted Pro Hac Vice)
Paxton Lewis (Admitted Pro Hac Vice)
DESMARAIS LLP
1899 Pennsylvania Avenue, NW, Suite 400
Washington, DC 200069
Tel: (202) 451-4900
Fax: (202) 451-4901
dcho@desmaraisllp.com
plewis@desmaraisllp.com

Attorneys for Defendants Samsung Electronics Co. Ltd., Samsung Electronics America, Inc., Samsung Semiconductor, Inc., and Samsung Austin Semiconductor LLC

CERTIFICATE OF CONFERENCE

I hereby certify that counsel for Defendants has complied with the meet and confer requirement set forth in Local Rule CV-7(h), and this motion is opposed. On May 17, 2024, Defendants' counsel—Cosmin Maier—met and conferred with Plaintiff's counsel—Alex Chan—on Defendants' request to stay the case. Plaintiff's counsel stated that he is agreeable to staying the case after the parties have completed claim construction briefing, on or about July 17, 2024. Plaintiff's counsel confirmed on May 20, 2024 that Plaintiff is not amenable to Defendants' proposed immediate stay pending resolution of TI's Motion for Summary Judgment.

/s/ Cosmin Maier (with permission, by Collin Maloney)
Cosmin Maier

CERTIFICATE OF SERVICE

I hereby certify that on May 21, 2024, I electronically filed the foregoing with the Clerk of the Court using the CM/ECF system, which will send notification of such filing to all counsel of record.

/s/ Collin Maloney

IN THE UNITED STATES DISTRICT
COURT FOR THE EASTERN DISTRICT
OF TEXAS SHERMAN DIVISION

CHIEN-MIN SUNG, Plaintiff, v. SAMSUNG ELECTRONICS CO. LTD., SAMSUNG ELECTRONICS AMERICA, INC., SAMSUNG SEMICONDUCTOR, INC., and SAMSUNG AUSTIN SEMICONDUCTOR, LLC, Defendants.	C.A. No. 4:23-cv-752-SDJ **JURY TRIAL DEMANDED**

ORDER GRANTING DEFENDANTS' MOTION TO STAY
PENDING RESOLUTION OF TI'S MOTION FOR SUMMARY JUDGMENT

BEFORE THE COURT is Defendants' Motion to Stay Pending Resolution of Texas Instruments Incorporated's ("TI") Motion for Summary Judgment, as well as the supporting Declaration of Kyle Curry along with Exhibits 1–5 (together, "Motion"). The Court, having considered the Motion, finds that it is meritorious and should be **GRANTED**.

It is therefore **ORDERED** that any deadlines and hearings scheduled in this matter are **STAYED** until resolution of TI's Motion for Summary Judgment (Dkt. No. 26) in Civ. Action No. 4:23-cv-00753-SDJ.

IN THE UNITED STATES DISTRICT COURT FOR THE EASTERN DISTRICT OF TEXAS SHERMAN DIVISION

CHIEN-MIN SUNG, Plaintiff, v. SAMSUNG ELECTRONICS CO. LTD., SAMSUNG ELECTRONICS AMERICA, INC., SAMSUNG SEMICONDUCTOR, INC., and SAMSUNG AUSTIN SEMICONDUCTOR LLC, Defendants.	Civil Action No. 4:23-cv-00752 **JURY TRIAL DEMANDED**

DECLARATION OF KYLE CURRY IN SUPPORT OF DEFENDANTS' MOTION TO STAY PENDING RESOLUTION OF TI'S MOTION FOR SUMMARY JUDGMENT

I, Kyle Curry, declare as follows:

1. I am an associate with the law firm of Desmarais LLP, counsel for Samsung Electronics Co., Ltd. ("SEC"), Samsung Electronics America, Inc. ("SEA"), Samsung Semiconductor, Inc. ("SSI"), and Samsung Austin Semiconductor LLC ("SAS") (collectively, "Defendants") in the above-captioned litigation. I am licensed to practice law in the State of California and have been admitted *pro hac vice* to practice before this Court.

2. I submit this Declaration in support of Defendants' contemporaneously filed Motion to Stay Pending Resolution of TI's Motion for Summary Judgment.

3. The matters set forth herein are within my personal knowledge.

4. If sworn as a witness, I could and would competently testify regarding the matters set forth herein.

5. Attached hereto as **Exhibit 1** is a true and correct copy of Docket Number 216 in

Motion Games, LLC v. Nintendo Co., No. 6:12-CV-878-JDL (E.D. Tex. Sept. 23, 2014).

6. Attached hereto as **Exhibit 2** is a true and correct copy of a highlighted excerpt of Plaintiff's First Set of Interrogatories to Defendants (Nos. 1-12), dated January 18, 2024.

7. Attached hereto as **Exhibit 3** is a true and correct copy of highlighted excerpts of Plaintiff Dr. Chien Min-Sung's Preliminary Disclosure of Asserted Claims and Infringement Contentions, dated February 21, 2024.

8. Attached hereto as **Exhibit 4** is a true and correct copy of counsel correspondence between Cosmin Maier and Joel Glazer, dated May 14, 2024.

9. Attached hereto as **Exhibit 5** is a true and correct copy of counsel correspondence between Cosmin Maier and Alex Chan, dated May 21, 2024.

I declare under penalty of perjury under the laws of the United States that to the best of my knowledge and recollection, the foregoing is true and correct.

Executed this 21st day of May, 2024 in San Francisco. California.

/s/ Kyle Curry
Kyle Curry

EXHIBIT 1

IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF TEXAS
TYLER DIVISION

MOTION GAMES, LLC	§	
Plaintiff,	§	
	§	**Cause No. 6:12-cv-878-JDL**
vs.	§	
	§	**JURY TRIAL DEMANDED**
NINTENDO CO., LTD.; *et al.*	§	
Defendants.	§	

ORDER

Before the Court is Defendants'[1] Emergency Motion to Stay Proceedings and for Protective Order (Doc. No. 203) ("MOTION"). Motion Games, LLC ("Motion Games") responded (Doc. No. 207) ("RESPONSE"). Defendants have asked the Court to stay all proceedings, deadlines, and discovery obligations pending the Court's ruling on (1) Defendants' motion to sever, stay, and reconsider denial of venue transfer (Doc. No. 178); and (2) Defendants' motion to stay pending *inter partes* review. After considering the Motion and other matters of record, the Court rules as follows:

1. The Court *sua sponte* **ORDERS** that discovery is stayed as to RAC and GameStop (collectively the "Retailers"). "The power to stay proceedings is incidental to the power inherent in every court to control the disposition of the causes on its docket with economy of time and effort for itself, for counsel, for litigants." *Landis v. N Am. Co.*, 299 U.S. 248, 254 (1936); *see also Gould v. Control Laser Corp.*, 705 F.2d 1340, 1341 (Fed. Cir. 1983). The application of this power requires "the exercise of judgment, which must weigh competing interests and maintain an even balance." *Landis*, 299 U.S. at 254-55. Courts evaluate three factors when considering a motion to stay: "'(1) whether a stay will unduly prejudice or present a clear tactical disadvantage to the non-moving party; (2) whether a stay will simplify the issues in question and

[1] The Defendants are Nintendo Co., Ltd. ("NCL"), Nintendo of America Inc. ("NOA"), Retro Studios, Inc. ("Retro"), Rent-A-Center, Inc. ("RAC") and GameStop Corp. ("GameStop") (collectively "Defendants").

trial of the case; and (3) whether discovery is complete and whether a trial date has been set.'" *Lodsys v. Brother Int'l Corp.*, No. 2:11-cv-90, 2013 U.S. Dist. LEXIS 51336, at *42 (E.D. Tex. Jan. 14, 2013) (quoting *Soverain Software LLC v. Amazon. com, Inc.*, 356 F. Supp. 2d 660, 662 (E.D. Tex. Feb. 9, 2005)).

First, a stay as to the Retailers will not prejudice Motion Games. Motion Games has a recognized interest in the timely enforcement of its patent rights. Retailer defendants likely possess little or no evidence regarding the underlying technology of the accused products, and discovery as to the Retailers will not produce evidence regarding the substantive aspects of the infringement case. *See In re Nintendo Co., Ltd.*, 544 Fed. App'x 934, 940 (Fed. Cir. 2013). By eliminating time-consuming and costly discovery which will likely have no effect on the merits of the case, a stay will ensure that Motion Games' interest in proceeding quickly to trial is secure. As such, this factor weighs in favor of a stay.

The second factor, whether a stay will simplify the issues in question and the trial of the case, favors a stay. Motion Games argues that discovery against the Retailers is necessary because the Retailers "sell non-Nintendo products that are accused of infringement" and "engage[] in conduct that creates liability for infringement of at least the asserted method claims of the patents-in-suit." RESPONSE at 2. To that end, Motion Games has served broad discovery requests which are seemingly unconnected to the merits of the case.[2] These broad requests are

[2] Motion Games' original deposition notices requested *inter alia*:

- "Defendant's email and data backup and restoration policies, practices, procedures, and schedules (including media and software used and storage locations) during the last ten years." (Doc. No. 203, Group Exhibit No. 2, Notice at No. 5)
- "Defendant's employee computer use policies, practices, and procedure and the documents evidencing same during the last ten years." *Id.* at No. 9.
- "The existence of and Defendant's typical use of software and online applications which have any interaction with the Accused Instrumentalities, including but not limited to" over 29 programs including accounting software, human resources programs, employee directory programs, media players, calendars, word processing and presentation software. *Id.* at No. 10.
- "Defendant's software and hardware upgrade and re-assignment practices, policies, and procedures during the last ten years." *Id.* at No. 14.

MOTION at 3-4.

made despite the peripheral status of the Retailers to this case.[3] Staying discovery as to the Retailers will streamline discovery by eliminating these broad and likely fruitless discovery requests. Furthermore, a stay will simplify the issues in question. At a minimum, resolving the claims against NCL, NOA, and Retro will resolve the claims regarding Nintendo products, which account for the vast majority of the claims against the Retailers. And potentially, the resolution of the claims against NCL, NOA, and Retro could resolve the entire case against the Retailers. Order at 2, *UltimatePointer LLC v. Nintendo Co., Ltd., et al.*, 6:11-cv-496 and 6:11-cv-571 (E.D. Tex. June 17, 2014), Doc. No. 448. Accordingly this factor weighs in favor of Defendants' motion to stay.

The third factor, whether discovery is complete and a trial date has been set, is neutral. Litigation in this case began more than a year and a half before this motion was filed, a *Markman* hearing was held on May 15, 2014, the parties' claim construction positions have been submitted, and trial is scheduled October 13, 2015. However, the underlying policy of this factor is judicial economy. Focusing discovery on the parties with evidence relevant to the merits of the case is certainly a more efficient use of the resources of the Court and litigants. That discovery directed toward the Retailers has only recently begun also weighs in favor of a stay. Although the trial date has been set and the progress in discovery weigh against staying the case, the peripheral status of the Retailers and the potential to avoid unnecessary use of judicial

[3] Well-established authority states that "a patent infringement claim against a retailer, distributor or customer of infringing products is peripheral to a claim against a manufacturer." *MGT Gaming v WMS Gaming, Inc.*, 978 F. Supp. 647, 664 (S.D. Miss. 20123) (citing *LG Elecs., Inc. v. Advance Creative Computer Corp.*, 131 F. Supp. 2d 804, 811 (E.D. Va. 2001); *Koh v. Microteck int'l, Inc.*, 250 F. Supp. 2d 627, 632 (E.D. Va. 2003). In *Corry v. CFM Majestic, Inc.*, 16 F. Supp. 2d 660 (E.D. Va. 1998), the court held that a distributor's involvement was peripheral to the case because "(i) the distributor was secondarily involved, (ii) did not manufacture the alleged infringing device, and (iii) would only be liable if the manufacturer was liable." *Id.* at 666. Furthermore, in *MGT Gaming* the court reasoned that these peripheral retailers and distributors were peripheral because they "were not involved and do not have substantive knowledge about the patent infringement, which would begin at the design and manufacture stages." *Id. at* 665.

resources with regard to these peripheral defendants offsets these concerns. Therefore, this factor is neutral.

In sum, two factors support staying discovery as to the Retailers. The third factor is neutral. Accordingly, discovery against Rent-A-Center, Inc. and GameStop Corp is **STAYED**.

2. Defendants' Motion to Sever, Stay, and Reconsider Transfer (Doc. No. 178) and Defendants' Motion to Stay Pending *Inter Partes* Review (Doc. No. 176) were recently decided. Accordingly, and in light of the above *sua sponte* order, Defendants' motion to stay all discovery directed to the Retailers pending final resolution of Defendants' Motion to Sever, Stay, and Reconsider Transfer (Doc. No. 178) and Defendants' Motion to Stay Pending *Inter Partes* Review (Doc. No. 176) is moot;

3. Defendants' Motion to Sever, Stay, and Reconsider Transfer (Doc. No. 178) and Defendants' Motion to Stay Pending *Inter Partes* Review (Doc. No. 176) were recently decided. Accordingly, Defendants' motion to stay discovery as to NCL, NOA, and Retro pending the Court's ruling on this motion is **DENIED AS MOOT**; and

4. Defendants' Motion to Sever, Stay, and Reconsider Transfer (Doc. No. 178) and Defendants' Motion to Stay Pending *Inter Partes* Review (Doc. No. 176) were recently decided. Accordingly, Defendants' request for a protective order pending a final determination on these motions is **DENIED AS MOOT**.

So ORDERED and SIGNED this 23rd day of September, 2014.

JOHN D. LOVE
UNITED STATES MAGISTRATE JUDGE

EXHIBIT 2

IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF TEXAS
SHERMAN DIVISION

CHIEN-MIN SUNG, Plaintiff, v. SAMSUNG ELECTRONICS CO. LTD., SAMSUNG ELECTRONICS AMERICA, INC., SAMSUNG SEMICONDUCTOR, INC., and SAMSUNG AUSTIN SEMICONDUCTOR LLC, Defendants.	Civil Action No. 4:23-cv-752-SDJ JURY TRIAL DEMANDED

PLAINTIFF'S FIRST SET OF INTERROGATORIES TO DEFENDANTS (NOS. 1-12)

Pursuant to Rules 26 and 33 of the Federal Rules of Civil Procedure, Plaintiff Chien-Min Sung ("Dr. Sung" or "Plaintiff"), by and through his attorneys, hereby requests that Defendants Samsung Electronics Co. Ltd., ("SEC"), Samsung Electronics America Inc. ("SEA"), Samsung Semiconductor Inc., ("SSI"), and Samsung Austin Semiconductor LLC ("SAS") respond to the following Interrogatories within thirty (30) days of service of these Interrogatories.

DEFINITIONS

A. "Samsung," "Defendants," "You," or "Your" shall mean, individually and collectively, Samsung Electronics Co. Ltd., ("SEC"), Samsung Electronics America Inc. ("SEA"), Samsung Semiconductor Inc., ("SSI"), and Samsung Austin Semiconductor LLC ("SAS"), and all of its corporate locations, and all predecessors, subsidiaries, parents, and affiliates; and all past or present directors, officers, agents, representatives, employees,

Z. "Manufacturing Equipment" shall mean any polishers, cleaners, metrology, inspection, lithography, or semiconductor machinery, tools, systems, as well as all associated models, versions, and their predecessors, designed, developed, assembled, and/or configured to perform CMP, Pad Conditioning and/or Pad Dressing.

AA. The "Accused Products" means and includes those products accused of infringement as described in Plaintiff's Complaint filed in the Action, including memory, mobile devices (e.g., mobile phones), smart devices (e.g., smart watches), LED panels, solid-state drives, processors, image sensors, virtual reality headsets, computing devices and tablets, security/monitoring systems, TVs and displays, home appliances, audio systems and devices, and other semiconductor system, products, devices, and integrated circuits.

BB. "Third Party Product Manufacturer" shall mean any third-party manufacturer(s) contracted, engaged, retained, instructed, or requested by, or on behalf of, You to manufacture, fabricate, and/or assemble the Accused Products.

CC. The terms "sale" and "sold" means the transfer of title to property from one party to another and includes the granting of a license with respect to products containing software or firmware.

DD. "Prior Art" means any patent, publication, device, or activity that may fall within the scope of 35 U.S.C. §§ 102 and/or 103.

EE. "Person" shall mean any natural person or any business, proprietorship, firm, partnership, corporation, association, organization, or other legal entity. The acts of a Person shall include the acts of directors, officers, owners, members, employees, agents, attorneys, or other representatives acting on the Person's behalf.

the Accused Products, have no nexus to, or were not made in, used in, sold in, offered for sale in, or imported into, the United States or are otherwise beyond the reach of United States Patent laws, including any product You contend is not manufactured, designed, developed, conditioned, dressed within the United States and/or imported into the United States, or that the claims asserted in this Action are/were not practiced, performed, implemented, executed, or otherwise carried out in the United States, state Your basis and Identify Documents, Communications, or Things that support Your contention.

Dated: January 18, 2024

DEVLIN LAW FIRM LLC

By: */s/ Alex Chan*
Alex Chan
achan@devlinlawfirm.com
1526 Gilpin Ave.
Wilmington, Delaware 19806
Telephone: (302) 449-9010
Facsimile: (302) 353-4251

Counsel for Plaintiff
Dr. Chien-Min Sung

EXHIBIT 3

IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF TEXAS
SHERMAN DIVISION

CHIEN-MIN SUNG, *Plaintiff,* v. SAMSUNG ELECTRONICS CO. LTD., SAMSUNG ELECTRONICS AMERICA, INC., SAMSUNG SEMICONDUCTOR, INC., and SAMSUNG AUSTIN SEMICONDUCTOR LLC, *Defendants.*	Civil Action No. 4:23-cv-752-SDJ JURY TRIAL DEMANDED

PLAINTIFF DR. CHIEN MIN-SUNG'S PRELIMINARY DISCLOSURE OF ASSERTED CLAIMS AND INFRINGEMENT CONTENTIONS

Pursuant to Local Patent Rules of the Eastern District of Texas, particularly Patent Rule 3-1, and the Court's Order Governing Proceedings (Patent Case) (Dkt. 23), Plaintiff Dr. Chien-Min Sung ("Dr. Sung" or "Plaintiff"), by and through his attorneys, hereby serves his Preliminary Infringement Contentions on Defendants Samsung Electronics Co. Ltd., Samsung Electronics America, Inc., Samsung Semiconductor, Inc., and Samsung Austin Semiconductor LLC ("Defendants" or "Samsung"), as well as Dr. Sung's accompanying document production. These contentions address Samsung's infringement of U.S. Patent Nos. 9,138,862 ("the '862 patent") and 9,724,802 ("the '802 patent") (collectively, the "Asserted Patents").[1]

[1] Plaintiff's Complaint also asserts Defendants' infringement of U.S. Patent No. 8,974,270 via certain pad conditioners designed, developed, manufactured or supplied by, among others, Minnesota Mining and Manufacturing Company ("3M") used by or on behalf of Defendants to manufacture, fabricate, or assemble the Accused Products. Samsung represents in a declaration attached to its Motion for Intra-District Transfer to the Northern District of California (Dkt. 30-1) that Samsung does not use double-sided conditioners from 3M. Relying on Defendants' representation, Plaintiff will no longer pursue infringement based on double-sided pad conditioners designed, developed, manufactured or supplied by 3M. However, Plaintiff reserves the right to amend these

This disclosure is made solely for the purpose of this action. This disclosure is subject to all objections as to competence, relevance, materiality, propriety, and admissibility, and to any other objections on grounds that would require the exclusion of statements contained herein if such disclosure were asked of, or statement contained herein were made by, a witness present and testifying in court, all of which objections and grounds are expressly reserved and may be interposed at the time of trial.

Discovery in this matter has just begun, and Dr. Sung's investigation of Samsung's infringement is ongoing. Moreover, Samsung has yet to make any production of core technical documents necessary for these contentions despite its ongoing discovery obligations to produce such documents without awaiting a discovery request. This disclosure is, therefore, based upon information that Dr. Sung has been able to obtain publicly, together with Dr. Sung's current good faith beliefs regarding the Accused Products and Accused Instrumentalities. Further, this disclosure is given without prejudice to Dr. Sung's rights, and Dr. Sung hereby expressly reserves his rights under P.R. 3-6 or any other applicable bases, to further supplement or amend his contentions, including, without limitation, to add asserted claims or Accused Instrumentalities as additional facts are ascertained, analyses are made, research is completed, contentions are made, and claims are construed. The following disclosures are made subject to, and without waiving, any of the foregoing.

I. INFRINGEMENT CONTENTIONS

---

contentions and asserts infringement of the '270 patent pursuant to 35 U.S.C. §§ 271(a), (b), and (g) based on any make, use, sale, offer for sale, or importation of such conditioners from 3M by or on behalf of Defendants should discovery reveal that Defendants' representation is false or incorrect. Additionally, Defendants have not stated nor produced any information on whether they design, develop, manufacture, or supply their own pad conditioners, or whether Defendants use double-sided pad conditioners designed, developed, manufactured or supplied by another third party (e.g., third party other than 3M). Plaintiff therefore reserves the right to assert infringement over such conditioners should discovery later reveal that Defendants do design, develop, manufacture, or supply their own pad conditioners, or such pad conditioners manufactured by other third parties (i.e., other than 3M), and that such conditioners infringe at least one of the asserted claims pursuant to 35 U.S.C. §§ 271(a), (b), and (g).

A. DISCLOSURE OF CLAIMS ASSERTED AGAINST SAMSUNG

Pursuant to P.R. 3-1(a), based on the information presently available to it, and subject to ongoing discovery, Dr. Sung asserts that Samsung infringes each of the following claims under 35 U.S.C. § 271(a) ("the 271(a) Asserted Claims"):

Asserted Patents	Asserted Claims
U.S. Patent No. 9,138,862	Claims 1-13, 15, 17-20
U.S. Patent No. 9,724,802	Claims 1-21

Samsung infringes the 271(a) Asserted Claims, pursuant to § 271(a), by making, using, selling, and/or offering to sell, within the United States, and importing into the United States, products including semiconductor devices and/or integrated circuits (as well as systems, products, and/or devices containing these semiconductor devices and/or integrated circuits including at least the Accused Products) that are/were manufactured, fabricated, and/or assembled using certain infringing chemical mechanical polishing/planarization ("CMP") pad conditioners, including pad conditioners designed, developed, manufactured, fabricated or supplied by EHWA Diamond Industrial Co. Ltd. ("EHWA"), Shinhan Diamond Ind. Co., Ltd. ("Shinhan"), and Saesol Diamond Ind. Co. ("Saesol"), and/or pad conditioners designed, developed, manufactured, fabricated or supplied by other pad conditioner manufacturers that contain the claimed structural characteristics and features (collectively, "Accused Instrumentalities" or "infringing pad conditioners") in violation of 35 U.S.C. § 271(a) as indicated in Appendices A1-A6 and disclosed in Dr. Sung's Complaint (Dkt. 1).[2] Based on the information presently available

[2] Although Plaintiff's Complaint also identifies certain pad conditioners designed, developed, manufactured or supplied by Minnesota Mining and Manufacturing Company ("3M") and Abrasive Technology, LLC ("AT") as

Pursuant to P.R. 3-2, Dr. Sung makes a document production accompanying these disclosures and states that based on Dr. Sung's present information and reasonable search, documents corresponding to P.R. 3-2(a) (documents sufficient to evidence each discussion with, disclosure to, or other manner of providing to a third-party, or sale of or offer to sell, the claimed inventions prior to the date of application for the patent in suit) are produced at SUNG_SAMSUNG001386-SUNG_SAMSUNG003108; Dr. Sung has identified no any documents corresponding to P.R. 3-2(b) (conception, reduction to practice, design and development); documents corresponding to P.R. 3-2(c) (file histories for each Asserted Patent) are produced at the following Bates ranges:

'862 Patent file history: SUNG_SAMSUNG001386-SUNG_SAMSUNG002668

'802 Patent file history: SUNG_SAMSUNG002669-SUNG_SAMSUNG003059

DATED: February 21, 2024

/s/ Alex Chan

Alex Chan
State Bar No. 24108051
achan@devlinlawfirm.com
DEVLIN LAW FIRM LLC
1526 Gilpin Avenue
Wilmington, Delaware 19806
Telephone: (302) 449-9010
Facsimile: (302) 353-4251

ATTORNEY FOR PLAINTIFF,
DR. CHIEN-MIN SUNG

EXHIBIT 4

From: Cosmin Maier
To: _oel_la_er; Taeg Sang_Tim_Cho; Mariam Clayton; _axton Le_is; David Cho
Cc: Sung-Samsung-DLF_Intl; Samsung Sung Service; otis_cmhnla_.com; collin_cmhnla_.com; mandy_cmhnla_.com; _ohn Desmarais; _ung-_oon_Sam_a; _aul_ondor
Subject: Chien-Min Sung v. Samsung Elecs. Co. Ltd. et al., No. 4:2 -cv-00 52 E.D. Tex - Motion to Stay
Date: Tuesday, May 14, 2024 2:48:59 M
ttac me t : image001._ng

Counsel,

We saw that the Court in the TI case granted TI's motion to stay pending resolution of TI's motion for summary judgment of invalidity. Because TI's motion for summary judgment of invalidity implicates all of the asserted claims in this case, please confirm whether Plaintiff will agree to stay this case pending resolution of TI's motion for summary judgment of invalidity. If Plaintiff will not agree, please provide your availability to meet and confer this week.

Cosmin

EXHIBIT 5

From: Cosmin Maier
To: Alex Chan
Cc: Sung-Samsung-DLF_Intl; Samsung Sung Service; Collin Maloney; Mandy Nelson; Otis Carroll
Subject: RE: Call re Sung v. Samsung
Date: Tuesday, May 21, 2024 9:58:02 AM

Hi Alex,

Thank you for providing Plaintiff's position and for your compromise offer. We certainly appreciate Plaintiff's willingness to work with us. However, we still believe that we should file our motion to stay now, rather than waiting until after claim construction briefing, for two reasons. First, we believe that the Court would appreciate knowing the parties' positions on a stay now, shortly after the Court granted a stay in the TI case, rather than waiting another two months to raise it. Second, the parties can still avoid unnecessary expenses by not having to go through the full *Markman* briefing process when the asserted claims may subsequently be found invalid as a result of TI's motion for summary judgment. As you requested, we will mention Plaintiff's compromise offer in our briefing.

Thank you,

Cosmin

From: Alex Chan <achan@devlinlawfirm.com>
Sent: Monday, May 20, 2024 3:29 PM
To: Cosmin Maier <CMaier@desmaraisllp.com>
Cc: Sung-Samsung-DLF_Intl <Sung-Samsung-DLF_Intl@devlinlawfirm.com>
Subject: [Ext] Re: Call re Sung v. Samsung

****EXTERNAL EMAIL** This email originated from outside the company. Do not click on any link unless you recognize the sender and have confidence the content is safe.**

Cosmin—

We spoke with the client. Given that the parties are in the midst of their claim construction phase, Plaintiff will agree to Samsung's proposed stay once the parties have completed their claim construction briefing (i.e., 7/17/24, which is the date on which Plaintiff's reply claim construction brief is due). Dr. Sung understands that Samsung is not amenable to this approach when I brought up this option last Friday but let us know if Samsung is willing to reconsider. If not, please state in the Certificate of Conference that Dr. Sung had made the foregoing proposal but Samsung did not accept.

Thanks much,
Alex

From: Cosmin Maier <CMaier@desmaraisllp.com>
Date: Monday, May 20, 2024 at 12:24 PM
To: Alex Chan <achan@devlinlawfirm.com>
Subject: RE: Call re Sung v. Samsung

Alex,

Thanks for the call on Friday. I wanted to follow up today as we discussed. Will Plaintiff agree to stay the case pending resolution of TI's motion for summary judgment of invalidity? If so, we will prepare the papers for your review. If not, please confirm that Plaintiff opposes and we will proceed to file our motion.
Cosmin

Cosmin Maier
DESMARAIS LLP
230 Park Avenue
New York, NY 10169
T: (212) 351-3400 | F: (212) 351-3401
D: (212) 351-5493 | E: cmaier@desmaraisllp.com

This email may contain confidential and privileged material for the use of the intended recipient. Any review, use, or distribution by anyone other than the addressee is strictly prohibited. If you are not the intended recipient, please contact the sender by reply email and delete all copies of this message.