UNITED STATES DISTRICT COURT
EASTERN DISTRICT OF TEXAS
SHERMAN DIVISION

CHIEN-MIN SUNG	§	
	§	
v.	§	CIVIL NO. 4:23-CV-753-SDJ
	§	
TEXAS INSTRUMENTS	§	
INCORPRATED	§	

ORDER

Before the Court is Texas Instruments Incorporated's ("TI") Motion to Stay the Case Pending Resolution of TI's Motion for Summary Judgment. (Dkt. #27). Plaintiff Chien-Min Sung filed a response in opposition, (Dkt. #35), TI filed a reply, (Dkt. #39), and Sung filed a sur-reply, (Dkt. #46). Having considered the briefing and the applicable law, the Court concludes that the motion should be granted.

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). But as courts in this circuit have often explained, a discovery stay is "the exception rather than the rule."

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Id., at *1 (quoting *Yeti Coolers, LLC v. Magnum Solace*, LLC, No. 1:16-CV-663-RP, 2016 WL 10571903, at *1 (W.D. Tex. Oct. 19, 2016)).

The Court finds good cause to grant a stay. Under 35 U.S.C. § 102(b), a patent claim is invalid if it can be shown that the invention was "on sale in this country, more than one year prior to the date of the application for the patent in the United States." Invoking § 102(b), known as the "on-sale" bar, TI's motion for summary judgment asserts that this is the atypical case wherein the accused product was on sale before the critical dates of the asserted patents. Under these circumstances, where the patentee has accused a prior art product of infringement, summary judgment based on invalidity may be warranted if it can be shown that the accused product was on sale prior to the critical date. *See, e.g.*, *Evans Cooling Sys., Inc. v. Gen. Motors Corp.*, 125 F.3d 1448, 1451 (Fed. Cir. 1997); *Vanmoor v. Wal-Mart Stores, Inc.*, 201 F.3d 1363, 1366 (Fed. Cir. 2000). The Court concludes that this core question is ripe for adjudication and can be resolved without the need for further discovery or claim construction.

It is therefore **ORDERED** that TI's Motion to Stay the Case Pending Resolution of TI's Motion for Summary Judgment, (Dkt. #27), is **GRANTED**.

It is further **ORDERED** that all proceedings in this case are **STAYED** pending the Court's resolution of Defendant Texas Instruments' Motion for Summary Judgment of Invalidity. (Dkt. #26).

So ORDERED and SIGNED this 14th day of May, 2024.

SEAN D. JORDAN
UNITED STATES DISTRICT JUDGE