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**

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

TABLE OF CONTENTS

Page

I. THE GOOD CAUSE STANDARD SUPPORTS STAYING THE CASE BEFORE THE COMPLETION OF CLAIM CONSTRUCTION BRIEFING. 1

II. PLAINTIFF FAILS TO REBUT DEFENDANTS' SHOWING THAT THE *ERICSSON* FACTORS ALSO FAVOR AN IMMEDIATE STAY. 3

III. CONCLUSION.....5

TABLE OF AUTHORITIES

Page(s)

CASES

Ameranth, Inc. v. Par Tech. Corp.,
No. 2:10–CV–294, 2011 WL 4370539 (E.D. Tex. Aug. 16, 2011).....5

Promethean Insulation Tech. LLC v. Sealed Air Corp.,
No. 2:13–CV–1113, Dkt. No. 222 (E.D. Tex. July 22, 2015).....5

Soverain Software LLC v. Victoria's Secret Direct Brand Mgmt.,
LLC, 778 F.3d 1311 (Fed. Cir. 2015).....1, 2

Sung v. Texas Instruments Inc.,
No. 4:23–CV–00753, Dkt. No. 68 (E.D. Tex. May 14, 2024).....2, 5

Uniloc 2017 LLC v. Samsung Elecs. Am., Inc.,
No. 2:19–CV–00259, 2020 WL 1433960 (E.D. Tex. Mar. 24, 2020).....4, 5

STATUTES

35 U.S.C. § 315(e)(2).....2, 4

Both parties agree that the case should be stayed pending resolution of Texas Instruments' ("TI") motion for summary judgment. Mot. 1; Opp. 12 ("Dr. Sung has agreed to stay these proceedings. . . ."). The only issue for the Court to resolve is ***when*** the stay should take effect—before or after the parties complete claim construction briefing and parallel discovery. As stated in the Motion, Defendants submit that a stay now would save the parties additional expenses associated with claim construction briefing and at least five weeks of further discovery, but otherwise defer to the Court's sound judgment on the timing. Mot. 7–8. Defendants nevertheless briefly respond to several of Plaintiff's arguments in this Reply.

Plaintiff also suggests—without much analysis or legal support—that Defendants should be estopped from raising the same invalidity argument advanced in TI's motion for summary judgment. Opp. 9–11. Although it is highly unlikely that Defendants would "us[e] the exact same arguments word-for-word" (*id.* at 10) if the Court denies TI's motion, Plaintiff points to no case law that warrants estoppel, and there is no basis for that request.

I. THE GOOD CAUSE STANDARD SUPPORTS STAYING THE CASE BEFORE THE COMPLETION OF CLAIM CONSTRUCTION BRIEFING.

Plaintiff argues that this case should proceed with discovery and claim construction briefing that may eventually prove needless. Opp. 5. But Plaintiff's arguments mischaracterize the law, ignore this Court's ruling in the similarly situated TI Case, and actually showcase why there is good cause for an immediate stay.

First, Plaintiff argues that TI's motion for summary judgment "does not support Samsung's requested stay" because the two cases involve different parties. Opp. 6. But Plaintiff asserts the ***same*** patents and claims against Defendants that are the subject of TI's motion. Mot. 1, 4, 6. An invalidity finding in the TI Case would thus render the same asserted patents and claims invalid in this case. *Soverain Software LLC v. Victoria's Secret Direct Brand Mgmt.*, LLC, 778 F.3d 1311,

1313–16 (Fed. Cir. 2015) (affirming invalidity of asserted claims due to issue preclusion).[1]

Plaintiff further asserts that TI's motion for summary judgment does not justify a stay in this case because Defendants are not "bound by the outcome" of TI's motion. Opp. 6 (emphasis omitted). But that fact bears no relation to the underlying merits of the stay—as the Court recognized, a stay pending TI's motion serves efficiency in resolution of the dispute (*see* Fed. R. Civ. P. 1); likewise, Plaintiff will be bound by an invalidity finding against him, resolving this case. That efficiency rationale does not depend on any sort of estoppel against Defendants, or, for that matter, against TI. If the Court denies TI's motion because, for example, the Court finds that material factual disputes exist, TI can still raise the same invalidity arguments at trial and present those factual disputes to the jury. This is not a motion to stay pending resolution of *inter partes* review ("IPR") proceedings where ***statutory*** estoppel attaches upon a Final Written Decision by the Patent Trial and Appeal Board. 35 U.S.C. § 315(e)(2). In short, efficiency justifies the stay in this case just as it did in the TI case, and Plaintiff's estoppel-based complaints are immaterial.

Second, Plaintiff fails to even acknowledge this Court's ruling that good cause existed to stay the TI Case because it "can be resolved ***without*** the need for further discovery or claim construction." Civ. Action No. 4:23–CV–00753–SDJ ("TI Case"), Dkt. No. 68 at 2 (emphasis

[1] In *Sovereign Software*, a jury had found that the defendants infringed five claims from two patents and that those claims were not invalid (the "first case"). *Id*. at 1313, 1314. The district court in the first case entered judgment in favor of the plaintiff. *Id.* In another case (the "second case"), the Federal Circuit reversed a district court's judgment of infringement and no invalidity, finding the same five claims at-issue in the first case invalid as obvious. *Id*. Applying Fifth Circuit law, the Federal Circuit then held that issue preclusion rendered the claims in the first case invalid as a result of the invalidity finding in the second case. *Id*. at 1313, 1315 ("The Supreme Court has held that a defense of issue preclusion applies where a party is facing a charge of infringement of a patent that has once been declared invalid, even though the party asserting the defense was not a party to the action where the patent was invalidated. . . . We have similarly held that once the claims of a patent are held invalid in a suit involving one alleged infringer, an unrelated party who is sued for infringement of those claims may reap the benefit of the invalidity decision under principles of collateral estoppel.") (internal citations and quotations omitted).

added). Plaintiff's contention that the parties should proceed with further discovery and claim construction ignores the Court's ruling in the TI Case. Mot. 3–5. No further discovery or claim construction briefing in this case will impact the resolution of TI's motion for summary judgment.

Third, Plaintiff complains that Defendants served an additional third–party subpoena while the parties were briefing the motion to stay. Opp. 8. But the fact that Defendants must proceed with discovery absent a stay makes Defendants' point: the parties continue to incur expenses in a case that may ultimately be fully resolved by TI's motion for summary judgment. Plaintiff cannot expect Defendants to cease discovery and act like a stay is in place before a stay is actually granted.

II. PLAINTIFF FAILS TO REBUT DEFENDANTS' SHOWING THAT THE *ERICSSON* FACTORS ALSO FAVOR AN IMMEDIATE STAY.

Plaintiff's arguments under the *Ericsson* factors are similarly unavailing.

Under the first *Ericsson* factor (undue prejudice to non-movant), Plaintiff contends that a stay disadvantages him if the stay issues after Plaintiff files his opening claim construction brief (filed June 12) but before Defendants file their responsive claim construction brief (due July 3). Opp. 9. But that purported tactical disadvantage is of Plaintiff's own making. Defendants asked Plaintiff to agree to stay the case on May 14—the same day the Court stayed the TI Case—***before*** the parties submitted their P.R. 4–3 Joint Claim Construction and Prehearing Statement, ***before*** the parties conducted claim construction discovery, and ***well before either party*** filed any claim construction brief. Dkt. No. 56–6 (May 14, 2024 email from Cosmin Maier, counsel for Defendants); Dkt. No. 37 (Scheduling Order). Plaintiff refused and instead opted to proceed with claim construction briefing while this motion is resolved.[2]

[2] A minor point: Plaintiff requested a one-week extension to file its opposition to Defendants' stay motion (Ex. 1 at 2); Defendants stated that they would not oppose, provided that Plaintiff would not use the extension as a basis for opposing the stay (*id.* at 1); Plaintiff agreed (*id.*), yet appears to have reneged on that agreement by arguing that an immediate stay is unwarranted because, for

Plaintiff also argues that he will be disadvantaged because no estoppel attaches to Defendants as a result of TI's motion for summary judgment. Opp. 9. In particular, Plaintiff argues that Defendants would not be estopped from "using the exact same arguments word-for-word" if the Court denies TI's motion for summary judgment. *Id*. at 10; *see also id.* at 9. But that argument is entirely misplaced. Not only is it peculiar to assume that Defendants would raise "the exact same arguments word-for-word" (*id.* at 10) in this case if TI's motion for summary judgment is denied, it remains true that even TI is not necessarily estopped from pursuing the same grounds at trial. If, for example, the Court denies TI's motion for summary judgment because it finds material factual disputes, TI is still free to present those factual disputes to the jury. As noted above, the efficiency justification of the stay exists entirely independent of any estoppel issues.

Dr. Sung's reliance on *Uniloc 2017* is misguided. *See* Opp. 10. *Uniloc 2017* concerned a motion to stay pending resolution of IPRs filed by non–parties. Unlike a summary judgment motion, a Final Written Decision in an IPR proceeding results in a ***statutory*** estoppel that binds the petitioner and its real-parties-in-interest. 35 U.S.C. § 315(e)(2). In *Uniloc 2017*, the court was concerned that the defendants might gain a tactical advantage because it appeared that they were ***not*** subject to the ***statutory*** estoppel that applied to the non–parties who filed the IPRs. *Uniloc 2017 LLC v. Samsung Elecs. Am., Inc.*, No. 2:19–CV–00259, 2020 WL 1433960, at *4, *6 (E.D. Tex. Mar. 24, 2020). That scenario does not exist here. Unlike in the IPR setting, no statutory estoppel attaches to TI as a result of TI's summary judgment motion. Thus, Plaintiff cannot suffer a disadvantage based on a perceived lack of statutory estoppel that does not exist.

Plaintiff also ignores that the *Uniloc 2017* court found that the non–party IPRs implicated

---

example, Plaintiff's opening claim construction brief was to be filed the day after the post-extension deadline for Plaintiff's opposition to the stay motion (rather than eight days later absent the extension) (Opp. 5–6, 9).

only eight of 19 asserted claims, such that even successful IPRs would not dispose of all—or even a majority of—the asserted claims. *Uniloc 2017*, 2020 WL 1433960, at *2, 6. In stark contrast, an invalidity determination as a result of TI's motion for summary judgment would dispose of this case entirely because TI's motion implicates ***all*** of the same asserted patents and claims.

Under the second *Ericsson* factor, Plaintiff argues that absent estoppel there will be no simplification of the issues. Opp. 11. That is plainly incorrect. If the Court grants TI's motion for summary judgment and finds the asserted claims invalid, Plaintiff's cause of action becomes moot, and this case similarly disappears pending any appeal. *Ameranth, Inc. v. Par Tech. Corp.*, No. 2:10–CV–294, 2011 WL 4370539, at *1–2 (E.D. Tex. Aug. 16, 2011), *report and recommendation adopted*, 2011 WL 4369449 (E.D. Tex. Sept. 19, 2011) (dismissing causes of action based on claims which were found invalid in a separate litigation).

Under the third *Ericsson* factor, Plaintiff argues that an immediate stay is unwarranted because Defendants' stay motion was filed after the P.R. 4-3 statement and because the parties—due to Plaintiff's refusal to agree to stay the case on May 14 when the TI Case was stayed—are now "in the midst of claim construction." Opp. 11. But the Court has already found that the asserted patents' validity "can be resolved ***without*** the need for further discovery ***or claim construction***." TI Case, Dkt. No. 68 at 2 (emphases added).[3] Accordingly, there is no reason to complete claim construction briefing before a stay.

III. CONCLUSION

For the reasons set forth above, Defendants respectfully submit that their motion to stay should be granted.

---

[3] *Promethean Insulation Tech. LLC v. Sealed Air Corp.*, 2:13–CV–1113, Dkt. No. 222 (E.D. Tex.) (*see* Opp. 11–12) is not analogous. In that case, some of the defendants opposed another subset of the defendants' motion to stay, and the Court relied on differences among the legal theories that applied to the various defendants, among other reasons, to deny the stay.

Dated: June 17, 2024

By: *<u>/s/ Cosmin Maier (with permission of 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)
Jamie Kringstein (Admitted Pro Hac Vice)
Alexander Walker (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
jkringstein@desmaraisllp.com
lwalker@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

Kyle Curry (Admitted Pro Hac Vice)
Kurt Fredrickson (Admitted Pro Hac Vice)
kcurry@desmaraisllp.com
kfredrickson@desmaraisllp.com
DESMARAIS LLP
101 California St., Suite 3000
San Francisco, CA 94111
(415) 573–1900

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

CERTIFICATE OF SERVICE

I hereby certify that on June 17, 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

EXHIBIT 1

From: Joel Glazer
To: Cosmin Maier; Jamie Kringstein; David Cho
Cc: Collin Maloney; Mandy Nelson; Otis Carroll; Samsung Sung Service; Sung-Samsung-DLF_Intl
Subject: [Ext] RE: Chien-Min Sung v. Samsung Elecs. Co. Ltd. et al., No. 4:23-cv-00752 (E.D. Tex.) - One Week Extension to Respond to Motion to Stay
Date: Monday, June 3, 2024 9:53:12 AM
Attachments: image001.png

****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,

Thank you. Plaintiff agrees that he will not use this extension **as a basis for opposing the stay**.

Regards,
Joel

From: Cosmin Maier <CMaier@desmaraisllp.com>
Sent: Sunday, June 2, 2024 9:26 PM
To: Joel Glazer <jglazer@devlinlawfirm.com>; Jamie Kringstein <JKringstein@desmaraisllp.com>; David Cho <DCho@desmaraisllp.com>
Cc: Collin Maloney <collin@cmhnlaw.com>; Mandy Nelson <mandy@cmhnlaw.com>; Otis Carroll <otis@cmhnlaw.com>; Samsung Sung Service <SamsungSungService@desmaraisllp.com>; Sung-Samsung-DLF_Intl <Sung-Samsung-DLF_Intl@devlinlawfirm.com>
Subject: RE: Chien-Min Sung v. Samsung Elecs. Co. Ltd. et al., No. 4:23-cv-00752 (E.D. Tex.) - One Week Extension to Respond to Motion to Stay

Joel,

We do not oppose, provided that Plaintiff will not use the one-week extension to the briefing schedule as a basis for opposing the stay.

Regards,

Cosmin

From: Joel Glazer <jglazer@devlinlawfirm.com>

Sent: Friday, May 31, 2024 11:03 AM
To: Cosmin Maier <CMaier@desmaraisllp.com>; Jamie Kringstein <JKringstein@desmaraisllp.com>; David Cho <DCho@desmaraisllp.com>
Cc: Collin Maloney <collin@cmhnlaw.com>; Mandy Nelson <mandy@cmhnlaw.com>; Otis Carroll <otis@cmhnlaw.com>; Samsung Sung Service <SamsungSungService@desmaraisllp.com>; Sung-Samsung-DLF_Intl <Sung-Samsung-DLF_Intl@devlinlawfirm.com>
Subject: [Ext] RE: Chien-Min Sung v. Samsung Elecs. Co. Ltd. et al., No. 4:23-cv-00752 (E.D. Tex.) - One Week Extension to Respond to Motion to Stay

****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.**

Counsel,

Plaintiff intends to seek a one week extension to respond to Samsung's Motion to Stay. Please let us know whether Samsung opposes this extension.

Thank you,
Joel

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.