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

MOLECULAR REBAR DESIGN, LLC, BLACK DIAMOND STRUCTURES, LLC,	§	
v.	§	CIVIL ACTION NO. 2:24-CV-00107-JRG (Lead Case)
LG ENERGY SOLUTION, LTD.	§	

MOLECULAR REBAR DESIGN, LLC, BLACK DIAMOND STRUCTURES, LLC,	§	
v.	§	CIVIL ACTION NO. 2:24-CV-00108-JRG (Member Case)
SAMSUNG ELECTRONICS CO., LTD., AND SAMSUNG ELECTRONICS AMERICA, INC.	§	

ORDER

Before the Court is Defendant LG Energy Solution, LTD.'s ("Defendant" or "LGES") Motion to Stay Pending *Inter Partes* Review (the "Motion") (Dkt. No. 47). In the Motion, LGES asks the Court to stay all action in the above-captioned matter pending the Patent Trial and Appeal Board's ("PTAB") *inter partes* review ("IPR") of the patents-in-suit. (*Id.* at 1).

Plaintiffs Molecular Rebar Design, LLC and Black Diamond Structures, LLC ("Plaintiffs") have asserted five patents against LGES: U.S. Patent No. 8,808,909 ("the '909 Patent"), U.S. Patent No. 8,968,924 ("the '924 Patent"), U.S. Patent No. 10,153,483 ("the '483 Patent"), U.S. Patent No. 9,636,649 ("the '649 Patent"), and U.S. Patent No. 10,608,282 ("the '282 Patent") (collectively, the "Asserted Patents"). (Dkt. No. 1). LGES has filed five IPR petitions, challenging

the patentability of all claims asserted in this case. (Dkt. No. 74 at 1). The petition challenging the '649 Patent was filed on June 7, 2024.[1] (*Id.*). The petition challenging the '909 Patent was filed on June 7, 2024.[2] (*Id.*). The petition challenging the '924 Patent was filed on June 12, 2024.[3] (*Id.*). The petition challenging the '282 Patent was filed on June 12, 2024.[4] (*Id.*). The petition challenging the '483 Patent was filed on June 12, 2024.[5] (*Id.*).

The district court has the inherent power to control its own docket, including the power to stay proceedings. *Clinton v. Jones*, 520 U.S. 681, 706 (1997). How to best manage the court's docket "calls for the exercise of judgment, which must weigh competing interests and maintain an even balance." *Landis v. N. Am. Co.*, 299 U.S. 248, 254–55 (1936).

"District courts typically consider three factors when determining whether to grant a stay pending *inter partes* review of a patent in suit: (1) whether the stay will unduly prejudice the nonmoving party, (2) whether the proceedings before the court have reached an advanced stage, including whether discovery is complete and a trial date has been set, and (3) whether the stay will likely result in simplifying the case before the court." *NFC Techs. LLC v. HTC Am., Inc.*, Case No. 2:13-cv-1058-WCB, 2015 WL 1069111, at *2 (E.D. Tex. Mar. 11, 2015) (Bryson, J.). "Based on th[ese] factors, courts determine whether the benefits of a stay outweigh the inherent costs of postponing resolution of the litigation." *Id.*

Where a motion to stay is filed before the PTAB institutes any proceeding, courts often withhold a ruling pending action on the petition by the PTAB or deny the motion without prejudice to refiling in the event that the PTAB institutes a proceeding. *VirtualAgility Inc. v. Salesforce.com,*

[1] IPR2024-01005.
[2] IPR2024-01006.
[3] IPR2024-01011.
[4] IPR2024-01012.
[5] IPR2024-01013.

Inc., 759 F.3d 1307, 1316 (Fed. Cir. 2014) (citing *Checkfree Corp. v. Metavante Corp.*, No. 12-cv-15, 2014 WL 466023, at *1 (M.D. Fla. Jan. 17, 2014)); *see also NFC Techs.*, 2015 WL 1069111, at *6. Indeed, this Court has a consistent practice of denying motions to stay when the PTAB has yet to institute post-grant proceedings. *Trover Group, Inc. v. Dedicated Micros USA*, No. 2:13-cv-1047-WCB, 2015 WL 1069179, at *6 (E.D. Tex. Mar. 11, 2015) (Bryson, J.) ("This Court's survey of cases from the Eastern District of Texas shows that when the PTAB has not yet acted on a petition for *inter partes* review, the courts have uniformly denied motions for a stay."). At present the PTAB has not instituted IPR review as to any asserted claim herein, nor are any such decisions anticipated for months.

Considering these circumstances, the Court concludes that LGES's motion is premature, and a stay of these proceedings in advance of the PTAB's decision on whether or not to institute *inter partes* review of any of the Asserted Patents should be denied. Accordingly, the Motion is **DENIED WITHOUT PREJUDICE** to refiling of the same, which refiling shall be permitted within fourteen (14) days following the PTAB's institution decision regarding the last of the Asserted Patents to be acted upon by the PTAB.

So ORDERED and SIGNED this 19th day of July, 2024.

RODNEY GILSTRAP
UNITED STATES DISTRICT JUDGE