

**UNITED STATES DISTRICT COURT
MIDDLE DISTRICT OF FLORIDA
ORLANDO DIVISION**

THE NOCO COMPANY, INC.,

Plaintiff,

v.

**Case No: 6:20-cv-50-PGB-LHP
[Consolidated with Case No.
6:23-cv-2194-PGB-LHP]**

**DELTONA TRANSFORMER
CORPORATION and DELTRAN
USA, LLC,**

Defendants.

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ORDER

The following matters are before the Court:

1. Defendant Deltran USA, LLC's ("**Deltran**") Motion to Stay Pending *Inter Partes* Review of Consolidated Patents-in-Suit (Case No. 6:20-cv-50, Doc. 155; Case No. 6:23-cv-2194, Doc. 85);
2. Plaintiff The NOCO Company, Inc.'s ("**NOCO**") Response in Opposition (Case No. 6:20-cv-50, Doc. 158; Case No. 6:23-cv-2194, Doc. 93); and
3. Deltona Transformer Corporation's ("**DTC**") Response in Support of Motion to Stay Pending *Inters Partes Review* (Case No. 6:20-cv-50, Doc. 159; Case No. 6:23-cv-2194, Doc. 94).

Upon consideration, Deltran's Motion to Stay is granted.

I. BACKGROUND¹

On November 13, 2023, NOCO sued DTC, Deltran, and Deltran Operations USA, Inc. (“**Deltran Operations**”) (collectively, the “**Defendants**”) for allegedly violating three patents that NOCO owns. (Doc. 1 (the “**Complaint**”). The patents at issue are U.S. Patent Nos. 11,447,023 (“**’023 Patent**”), 11,584,243 (“**’243 Patent**”), and 11,667,203 (“**’203 Patent**”) (collectively, the “**Asserted Patents**”). (*Id.* ¶ 17). All three patents pertain to portable devices capable of jump-starting an automobile. (*Id.* ¶¶ 18–20). NOCO also sued DTC and Deltran for allegedly infringing the ’015 Patent. (Case No. 6:20-cv-50, Doc. 23). The Court granted DTC and Deltran’s Unopposed Motion to Stay pending *inter partes* review (“**IPR**”) of the ’015 Patent. (Case No. 6:20-cv-50, Docs. 69, 70).

Ultimately, the Patent Trial and Appeal Board (“**PTAB**”) invalidated all but one claim of the ’015 Patent.² Defendants seek to stay Case No. 6:23-cv-2194 and contend that two of the three patents NOCO asserts (the ’023 and ’243 Patents) are already subject to IPR commenced by a third party, ADC Solutions Auto, LLC (“**ADC**”). (Doc. 85, p. 6). ADC filed a petition for IPR seeking to invalidate claims 1, 32, 38, 39, 47, 52, and 54 of the ’023 Patent. (*Id.*). ADC’s petition also seeks to

¹ Since the IPRs and Petition concern Case No. 6:23-cv-2194, all docket citations herein are to Case No. 6:23-cv-2194, unless otherwise stated.

² See *Shenzhen Carku Tech. Co. v. NOCO Co.*, IPR2020-00944, 2021 WL 5193901, at *38–39, 44 (P.T.A.B. Nov. 3, 2021) (invalidating claims 1–10, 12–23, but finding Carku did “not establish[] a prima facie case of obviousness” as to claim 11), *aff’d* *NOCO Co. v. Shenzhen Carku Tech. Co.*, No. 2022-1646, 2022-1741, 2024 WL 540022 (Fed. Cir. Feb. 12, 2024).

invalidate claims 1, 2, 15, 17, 18, 51, 54, and 57 of the '243 Patent.³ Accordingly, every claim asserted by NOCO in Case No. 6:23-cv-2194 is at issue in the petition for IPR commenced by ADC. On September 9, 2024, Deltran filed a Petition for IPR of all claims of the '203 Patent. (*Id.* at p. 7). Deltran argues Case No. 6:20-cv-50 should also be stayed due to the overlap between the patent claims and technology in Case Nos. 6:23-cv-2194 and 6:20-cv-50, which will likely render claim 11 of the '015 Patent invalid. (*Id.* at pp. 5–6).

II. LEGAL STANDARD

District courts have broad discretionary power to grant stays in patent cases. *See, e.g., Procter & Gamble Co. v. Kraft Foods Glob., Inc.*, 549 F.3d 842, 849 (Fed. Cir. 2008); *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1426–27 (Fed. Cir. 1988) (“Courts have inherent power to manage their dockets and stay proceedings, including the authority to order a stay pending conclusion of a [Patent and Trademark Office (“USPTO”)] reexamination.”); *Gould v. Control Laser Corp.*, 705 F.2d 1340, 1341 (Fed. Cir. 1983). “In patent cases, a number of courts reason that such stays should be liberally granted when there is a pending administrative proceeding pending before the USPTO.” *Andersons, Inc. v. Enviro Granulation, LLC*, 2014 WL 4059886, at *2 (M.D. Fla. Aug. 14, 2014) (citation omitted); *see also Sabert Corp. v. Waldington N. Am.*, 2007 WL 2705157, at *5 (D.N.J. Sept. 14,

³ In Case No. 6:23-cv-2194, NOCO asserts that the Accused Products infringe claims 1, 39, 47, 52, and 54 of the '023 Patent. (Doc. 71, ¶ 108). Therefore, every claim asserted in the Amended Complaint is at issue in ADC’s IPR. As relates to the '243 Patent, NOCO alleges the Accused Products infringe claims 1 and 57. (*Id.* ¶ 114). And for the '203 Patent, NOCO contends claim 1 is infringed. (*Id.* ¶ 120).

2007) (highlighting the “liberal policy in favor of granting motions to stay proceedings” because review by the USPTO “might assist the court in making a validity determination or [] eliminate the need to make an infringement determination”); *WABCO Holdings, Inc. v. Bendix Com. Vehicle Sys., LLC*, 2010 WL 2628335, at *2 n.2 (D.N.J. June 28, 2010) (“[T]he liberal policy towards stays arises due to the potential waste in using a court’s time and energy when a USPTO decision could drastically alter the nature of the case.”).

“In determining whether to stay patent infringement litigation pending *inter partes* review, courts consider the following factors, among other individualized considerations: (1) whether the stay would 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 a stay will reduce the burden of litigation on the participants or the court.” *Andersons*, 2014 WL 4059886, at *2 (citing *Capriola Corp. v. Larose Indus.*, No. 8:12-cv2346-T-23-TBM, 2013 WL 1868344, at *1 (M.D. Fla. Mar. 11, 2013)). “Courts also consider whether discovery is complete and whether a trial date has been set.” *Andersons*, 2014 WL 4059886, at *2; see also *Patent Asset Licensing, LLC v. Bright House Networks, LLC*, 2016 WL 4431574, at *2 (M.D. Fla. Aug. 22, 2016). This is a totality of the circumstances consideration. *Patent Asset Licensing*, 2016 WL 4431574, at *2. However, a stay should ordinarily be denied unless there is a substantial issue of patentability. *Procter & Gamble Co.*, 549 F.3d at 849 (citing *Amazon.com v. Barnesandnoble.com, Inc.*, 239 F.3d 1343, 1350–51 (Fed. Cir. 2001)).

III. DISCUSSION

Defendants contend that the IPRs commenced by ADC and Deltran's petition are likely to result in some, if not many, of the claims at issue being invalidated. (Doc. 85, p. 2). Deltran cites the PTAB cancellation rate of 83% coupled with the fact that all but one claim of the '015 Patent was invalidated based on the same material prior art at issue in the IPRs and petition. (*Id.* at pp. 2–3). Defendants also argue that NOCO will not be unduly prejudiced by the stay since it did not seek a preliminary injunction and acquiesced in the stay in Case No. 20-cv-50. (*Id.*). Finally, Defendants note the expected commencement date of the IPR for the '203 Patent is just after the close of expert discovery, and the expected IPR decision on the '203 IPR, if commenced, is one month after the trial deadline. (*Id.* at p. 10). Staying Case No. 23-cv-2194 will simplify litigation by narrowing the number of patents, asserted claims, and causes of action and help focus claim construction disputes and invalidity arguments. (*Id.* at p. 13). Defendants convincingly argue that the PTAB's prior invalidity findings in the '015 Patent claims predict the cancellation of claims at issue here. (*Id.* at p. 14). The two ADC IPRs involve claim construction briefing requested by the PTAB on the “USB input circuit,” which has been identified by the parties as a claim term to be construed by this Court. (*Id.* at p. 14; Doc. 92, p. 6). Allowing the PTAB to complete its construction of this term is helpful to avoid conflicting constructions.

NOCO opposes the Motion to Stay and submits, in part, that the pending IPR actions and petition filed by Deltran will not address 64 claims identified in its

infringement contentions. (Doc. 93, pp. 5–6). NOCO’s infringement contentions were prepared on March 15, 2024, and identified 78 claims infringed across various Accused Products. (Doc. 93-2). The Amended Complaint filed in July 2024 lists 8 claims over three patents, as did the initial complaint. (Docs. 1, 71). The parties represented in the Case Management Report that Case No. 23-cv-2194 will require 5 trial days. (Doc. 35, p. 4). Trying a case involving 78 patent infringement claims in 5 days is impossible. NOCO fails to identify good cause for expanding the case from the original 8 claims to 78. *See In re Katz Interactive Call Processing Patent Litig.*, 639 F.3d 1202, 1312–13 (Fed. Cir. 2011). Accordingly, NOCO is limited to the 8 claims across three patents alleged in the Amended Complaint.

NOCO next submits that Defendants did not join the IPRs commenced by ADC and will not be bound by collateral estoppel or Section 315(e). (Doc. 93, pp. 8–9). That said, if the PTAB invalidates a base claim and the finding is affirmed by the Federal Circuit, the invalidity determination is final. *See XY, LLC v. Trans Ova Genetics*, 890 F.3d 1282, 1294 (Fed. Cir. 2018).⁴ NOCO’s argument that important testimonial and documentary evidence regarding the USB standards known to those of skill in the art at the time of the claimed invention could be lost is, at best, hypothetical. (Doc. 93, p. 13). NOCO offers no support for this proposition.

⁴ It is unclear whether the Federal Circuit’s recent opinion in *ParkerVision, Inc. v. Qualcomm Inc.*, --- F.4th ---, 2024 WL 4094640 (Fed. Cir. Sept. 6, 2024), stands for the proposition that PTAB findings do not have collateral estoppel effect in district court due to the lower burden of proof alters the holding of *XY, LLC*. The issue in *ParkerVision* was whether the PTAB’s invalidity ruling applies to separate, related claims. At a minimum, an invalidity determination by the PTAB will be accompanied by reasoning that is undoubtedly helpful to the district court.

NOCO's generalized claim that further delay may result in valuable customers and goodwill loss is mere speculation. (*Id.* at p. 16). Regardless, if proven, the loss of customers and goodwill are compensable damages.

On balance, the Court finds that staying Case Nos. 6:23-cv-2194 and 6:20-cv-50 promotes judicial efficiency and is not unduly burdensome or prejudicial to NOCO.

IV. CONCLUSION

Accordingly, it is **ORDERED AND ADJUDGED** as follows:

1. Deltran's Motion to Stay Pending *Inter Partes* Review (Case No. 6:23-cv-2194-PGB-LHP, Doc. 85; Case No. 6:20-cv-50-PGB-LHP, Doc. 155) is **GRANTED**.
2. Case Nos. 6:23-cv-2194-PGB-LHP and 6:20-cv-50-PGB-LHP are hereby **STAYED**.
3. The Clerk of Court is **DIRECTED** to administratively close Case Nos. 6:23-cv-2194-PGB-LHP and 6:20-cv-50-PGB-LHP.
4. The parties shall notify the Court once the PTAB has issued its findings on ADC's IPRs and has commenced or declined Deltran's Petition.

DONE AND ORDERED in Orlando, Florida on December 18, 2024.



PAUL G. BYRON
UNITED STATES DISTRICT JUDGE

Copies furnished to:

Counsel of Record
Unrepresented Parties