

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE

INTELLECTUAL VENTURES I LLC,	)	
	)	
Plaintiff,	)	
	)	
v.	)	C.A. No. 23-CV-865-JLH
	)	
UBIQUITI, INC.,	)	
	)	
Defendant.	)	
	)	

ORDER

At Wilmington, this 21st day of May 2024:

WHEREAS, on August 8, 2023, Plaintiff initiated the present action (D.I. 1), alleging that Defendant infringes U.S. Patent No. 8,594,122 (“the ’122 patent”);

WHEREAS, on October 9, 2023, Defendant moved to dismiss the Complaint (D.I. 7), arguing that all of the claims of the ’122 patent are directed to ineligible subject matter under 35 U.S.C. § 101 because they are directed to “printed matter”;

WHEREAS, Defendant asserts that claim 11 is representative of all the claims of the patent-in-suit, which Plaintiff disputes;

WHEREAS, Defendant asserts that claim construction is unnecessary to resolve this motion, which Plaintiff disputes;

WHEREAS, should this case proceed past the motion to dismiss stage, the asserted claims will be narrowed through the parties’ disclosures and discovery and, as such, most of the claims subject to Defendants’ motion will not be in issue at later stages of the case (including at trial);

WHEREAS, it is not an efficient use of the Court’s time to address the patent eligibility of 42 claims at the motion to dismiss stage, particularly where the parties dispute whether certain

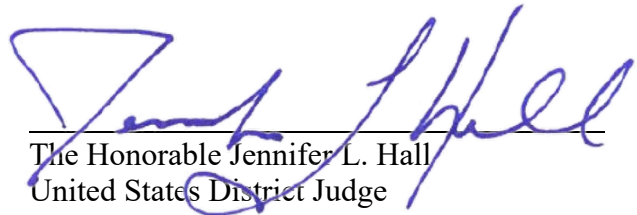
claims are representative and when some (and perhaps even most) of those claims are not even asserted;

WHEREAS, the Court has also reviewed the patent in suit and has concerns about whether and how the so-called printed matter doctrine applies to a patent that appears to be related to the improvement of wireless network communications;

WHEREAS, even if the Court were to conclude, at *Alice* step one,¹ that the focus of the claimed advance was printed matter, the minimal record currently before the Court is insufficient to establish as a matter of law, at *Alice* step two, that the “ordered combination” of elements claimed is not an inventive concept;

THEREFORE, IT IS HEREBY ORDERED that Defendant’s motion to dismiss is DENIED without prejudice to renew its § 101 arguments at a later stage of the case.

IT IS FURTHER ORDERED that, within thirty days, the parties shall jointly prepare and file the following: (i) a proposed Scheduling Order consistent with Judge Hall's “Rule 16 Scheduling Order - Patent,” and (ii) a letter, not to exceed three pages, setting forth (a) a description of what this case is about; (b) the parties’ positions regarding any disputes in the proposed Scheduling Order; and (c) a list of any other issues the parties want to address at the Rule 16 Scheduling Conference. Thereafter, the Court may schedule a Rule 16 Scheduling Conference to be held with Judge Hall. The parties are encouraged to discuss whether modifications to the Court’s standard scheduling order are appropriate in order to ensure the just, speedy, and inexpensive determination of this action.



The Honorable Jennifer L. Hall
United States District Judge

¹ See *Alice Corp. Pty. Ltd. v. CLS Bank Int'l*, 573 U.S. 208, 217 (2014) (setting forth a two-step framework for assessing § 101 challenges).