IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE

NL GIKEN INC., Plaintiff, v. AMAZON.COM, INC., AMAZON.COM SERVICES LLC, AMAZON WEB SERVICES, INC., and TWITCH INTERACTIVE, INC., Defendants.	C.A. No. 24-28-MN

DEFENDANTS' OPENING BRIEF IN SUPPORT OF THEIR
MOTION TO STAY PENDING *INTER PARTES* REVIEW

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NL Giken Exhibit 2003
Amazon v. NL Giken
IPR2025-00050

TABLE OF CONTENTS

Page

I. INTRODUCTION 1

II. NATURE AND STAGE OF THE PROCEEDINGS 3

III. LEGAL STANDARD 4

IV. ARGUMENT 5

A. A Stay Will Simplify This Case 5

B. The Most Burdensome Stages of Litigation Lie Ahead 8

C. Plaintiff Will Not Be Prejudiced by A Stay 9

1. The Relationship Between Plaintiff and Defendants Favors a Stay. 9

2. Defendants Were Diligent in Filing Their IPR Petitions and Stay Motion. 11

3. The Status of The Review Proceedings Will Not Prejudice Plaintiff, Because The FWDs Are Expected Around The Same Time As Trial. 12

V. CONCLUSION 13

TABLE OF AUTHORITIES

Page(s)

Cases

454 Life Scis. Corp. v. Ion Torrent Sys.,
No. 15-595-LPS, 2016 WL 6594083 (D. Del. Nov. 7, 2016).....4

Alloc, Inc. v. Unilin Decor N.V.,
No. 03-253-GMS, 2003 WL 21640372 (D. Del. July 11, 2003).....7

Aylus Networks, Inc. v. Apple Inc.,
856 F.3d 1353 (Fed. Cir. 2017).....6

In re Bear Creek Techs. Inc.,
No. 11-721 (GMS), 2013 WL 3789471 (D. Del. July 17, 2013).....10

Bio-Rad Labs. Inc. v. 10X Genomics, Inc.,
No. 18-1679-RGA, 2020 WL 2849989 (D. Del. June 2, 2020).....8

Bonutti Skeletal Innovations, L.L.C. v. Zimmer Holdings, Inc.,
No. 12-1107 (GMS), 2014 WL 1369721 (D. Del. Apr. 7, 2014).....5, 10

British Telecomms. PLC v. IAC/InterActiveCorp,
No. 18-366-WCB, 2019 WL 4740156 (D. Del. Sept. 27, 2019)..... *passim*

British Telecomms. PLC v. IAC/InterActiveCorp.,
No. 18-366-WCB, 2020 WL 5517283 (D. Del. Sept. 11, 2020).....10

Celorio v. On Demand Books LLC,
No. 12-821-GMS, 2013 WL 4506411 (D. Del. Aug. 21, 2013).....10

Cost Bros., Inc. v. Travelers Indem. Co.,
760 F.2d 58 (3d Cir. 1985).....5

CyWee Grp LTD v. Samsung Elecs. Co. LTD,
D.I. 331, slip op. (E.D. Tex. Feb. 14, 2019).....7

Ethicon LLC v. Intuitive Surgical, Inc.,
No. 17-871-LPS, 2019 WL 1276029 (D. Del. Mar. 20, 2019).....7, 8

Ethicon, Inc. v. Quigg,
849 F.2d 1422 (Fed. Cir. 1988).....5

Ever Win Int'l Corp. v. Radioshack Corp.,
902 F. Supp. 2d 503 (D. Del. 2012).....11

Gioello Enter. Ltd. v. Mattel, Inc.,
No. 99-375-GMS, 2001 WL 125340 (D. Del. Jan. 29, 2001) 10

Helios Streaming, LLC v. Vudu, Inc.,
No. 19-1792-CFC-SRF, 2021 WL 8155604 (D. Del. Aug. 15, 2021).....5, 7

Huvepharma Eood et al. v. Assoc. British Foods, PLC et al.,
No. 18-129-RGA, 2019 WL 3802472 (D. Del. Aug. 13, 2019) 8

IOENGINE, LLC v. PayPal Holdings, Inc.,
No. 18-452-WCB, 2019 WL 3943058 (D. Del. Aug. 21, 2019) 8, 13

Monterey Research, LLC v. Nanya Tech. Corp.,
No. 19-2090, 2021 WL 6502552 (D. Del. Jun. 25, 2021) 11

Neste Oil OYJ v. Dynamic Fuels, LLC,
No. 12-1744-GMS, 2013 WL 3353984 (D. Del. July 2, 2013) 11

Nexans, Inc. v. Belden, Inc.,
No. 12-1491-SLR-SRF, 2014 WL 651913 (D. Del. Feb. 19, 2014).....5

Princeton Digital Image Corp. v. Konami Digital Entm't Inc.,
No. 12-1461-LPS-CJB, 2014 WL 3819458 (D. Del. Jan. 15, 2014) 9

Rex Computing, Inc. v. Cerebras Sys., Inc.,
No. 21-525 (MN), D.I. 172 1

Textron Innovations Inc. v. Toro Co.,
No. 05-486 (GMS), 2007 WL 7772169 (D. Del. Apr. 25, 2007) 7

TruePosition, Inc. v. Polaris Wireless, Inc.,
No. 12-646-RGA-MPT, 2013 WL 5701529 (D. Del. Oct. 21, 2013).....11

Virtual Agility Inc. v. Salesforce.com, Inc.,
759 F.3d 1307 (Fed. Cir. 2014).....10

Statutes

35 U.S.C. § 315(b) 11

35 U.S.C. § 315(e) 1

Defendants Amazon.com, Inc., Amazon.com Services LLC, Amazon Web Services, Inc., and Twitch Interactive, Inc. (collectively, "Defendants") respectively request the Court stay this action brought by Plaintiff NL Giken Inc. ("Plaintiff") pending the Patent Trial and Appeal Board's ("PTAB") resolution of Amazon's five petitions for *inter partes* review ("IPR")—two of which have already been instituted—challenging the patentability of all asserted claims of all five asserted patents.

To maximize efficiency and simplification, Defendants stipulate that if the Court orders a stay, Defendants will not pursue ***any*** §§ 102 or 103 invalidity grounds— ***including system art***— for the already instituted '615 patent or for the '236 and '391 patents (***even if the PTAB denies institution on the merits***).[1] Defendants' stipulation goes far beyond the estoppel that would otherwise be imposed by 35 U.S.C. § 315(e) because it applies to system art and because it does not depend on the issuance of a final written decision ("FWD"). Defendants' stipulation thus substantially reduces the burden on the Court and favors a stay. *See Rex Computing, Inc. v. Cerebras Sys., Inc.*, No. 21-525 (MN), D.I. 172 (Markman Tr.) at pp. 96-97 (D. Del. Nov. 30, 2022) (denying motion to stay, because "even if the paper prior art that this is based on goes down, there is still system prior art out there . . . .and I don't really get rid of anything because the same stuff is argued as system art as paper art").

I. INTRODUCTION

Plaintiff has asserted five patents against Defendants in this litigation: U.S. Patent Nos. 9,319,615 (the "'615 patent"), 9,948,968 (the "'968 patent"), 8,094,236 (the "'236 patent"),

[1] The PTAB has instituted a new bifurcated institution procedure, per the USPTO Director's March 26, 2025 Memorandum, pursuant to which the Director will first decide whether to deny the petition on discretionary grounds and, if the petition is not denied, will then refer the petition to a panel of PTAB judges who will decide whether to institute on the merits. Should the PTAB deny institution on discretionary grounds, Defendants do not agree to be estopped.

10,880,592 (the "'592 patent"), and 8,677,391 (the "'391 patent") (collectively, the "asserted patents"). The '615 patent is a continuation of the '236 patent, and the '592 patent is a continuation of the '968 patent. Defendants have filed an IPR petition against each asserted patent seeking to invalidate all claims asserted against Defendants. The PTAB has already instituted the IPR on all asserted claims[2] of the '615 and '968 patents, and FWDs on those patents are expected in February and March 2026. Institution decisions for the IPRs filed against the remaining '592, '236, and '391 patents are expected in the next 4 months.

A stay pending IPR is therefore warranted for the following reasons:

First, a stay will simplify the issues before the Court, greatly reducing the burden on both the Court and the parties. The claims being challenged (as to validity) in the '615 and '968 IPRs represent 22 of 38 (58 percent) of Plaintiff's asserted claims in this case, and there is a high likelihood that at least some of those claims will be invalidated by the PTAB. In addition, given Defendants' stipulation, granting a stay now will allow the PTAB to decide all 102 and 103 invalidity issues—except system art for the '968 and '592 patents—that would normally require the Court's time and resources to resolve. For the related '968 and '592 patents, if the '592 IPR is instituted, both FWDs will issue prior to trial (scheduled for June 2026), and the only invalidity issue that will remain before this Court is whether certain system art anticipates / renders obvious the '968 and '592 patents.

Second, staying the case now will prevent the Court and parties from using valuable resources that could otherwise be avoided if the PTAB concludes the asserted claims are unpatentable. There is a significant amount of work to be done in this case. The parties have not

[2] Before institution, Plaintiff disclaimed asserted independent claim 6 and dependent claims 7-13 of the '592 patent.

scheduled, let alone taken, any depositions, claim construction briefing has not yet begun, and expert discovery, dispositive motions, and trial preparation all lie ahead—the most expensive and resource-intensive stages of litigation are yet to come.

Third, Plaintiff will not be prejudiced by staying the case now. Plaintiff does not practice the asserted patents, does not sell any product or service that competes with Defendants, and has not produced any evidence of irreparable harm that would warrant injunctive relief. Moreover, Defendants timely filed their IPR petitions and filed this motion within a week after the second IPR was instituted (against the '968 patent). As a result, all three factors weigh in favor of staying the case now.

II. NATURE AND STAGE OF THE PROCEEDINGS

Plaintiff does not sell any products or services capable of practicing the claims of the asserted patents. Plaintiff is comprised of only one employee and member who resides in Japan, Masahide Tanaka.

On January 11, 2024, Plaintiff filed suit against Defendants. D.I. 1. Based on its infringement contentions, Plaintiff alleges infringement of 38 claims across the five asserted patents: claims 4-6 and 8-14 of the '615 patent, claims 1-12 of the '968 patent, claims 1-2, 4, 6, and 15 of the '236 patent, claims 1-3 and 5 of the '592 patent, and claims 1, 9-10, and 12-15 of the '391 patent.

Defendants filed five IPR petitions challenging each asserted claim of each asserted patent, as summarized in the chart below. Exs. 1-5. The PTAB instituted review of the '615 and '968 patents on February 26, 2025 and March 26, 2025, respectively. Exs. 6-7. The instituted '615 and '968 IPRs represent 22 of 38 (or 58 percent) of Plaintiff's asserted claims. Institution decisions on the related '592 (a continuation of the '968 patent) and '236 (the parent of the '615 patent) IPRs are expected no later than May 28 and June 30, 2025, respectively.

Defendants' Instituted IPR Petitions		
IPR No.	**Patent**	**FWD Deadline**
IPR2024-01161	'615	Feb. 2026
IPR2024-01345	'968	Mar. 2026

Defendants' IPR Petitions Awaiting Institution			
IPR No.	**Patent**	**IPR Filing Date Accorded**	**Institution Decision Deadline**
IPR2025-00050	'592	Nov. 25, 2024	May 28, 2025
IPR2025-00250	'236	Dec. 17, 2024	June 30, 2025
IPR2025-00407	'391	Jan. 3, 2025	July 29, 2025

The parties are currently engaged in fact discovery, but significant case milestones still lie ahead:

- Fact discovery cut off is June 2, 2025
- Claim construction hearing is September 16, 2025
- No depositions have been taken
- No expert discovery has begun
- Expert discovery is scheduled to close on December 22, 2025
- The pretrial conference is scheduled for June 15, 2026
- Trial is scheduled for June 22, 2026

Based on the current trial schedule, the FWDs for the '615 and '968 IPRs are expected 3 months before trial in this case. If the PTAB institutes the related '592 IPR, that FWD would also issue before trial, and there is a strong likelihood that some portion of the 26 claims asserted in the '615, '968, and '592 patents are invalidated prior to trial. If the PTAB institutes the final two IPRs (the '236 and '391 patents), those FWDs would likewise issue very close to trial in this case. In other words, this litigation and the IPR proceedings will proceed in parallel, and at the risk of inconsistent decisions, without a stay.

III. LEGAL STANDARD

The decision to stay pending IPR lies within the sound discretion of the Court. *454 Life Scis. Corp. v. Ion Torrent Sys.*, No. 15-595-LPS, 2016 WL 6594083, at *2 (D. Del. Nov. 7, 2016)

(citing *Cost Bros., Inc. v. Travelers Indem. Co.*, 760 F.2d 58, 60 (3d Cir. 1985)); *see also 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 PTO reexamination.").

Courts in this District weigh three factors in deciding a motion to stay: (1) whether a stay would simplify the issues and the trial of the case; (2) the stage of the proceedings; and (3) whether a stay would unduly prejudice the nonmovant or allow the movant to gain a clear tactical advantage. *Helios Streaming, LLC v. Vudu, Inc.*, No. 19-1792-CFC-SRF, 2021 WL 8155604, at *2 (D. Del. Aug. 15, 2021).

IV. ARGUMENT

All three factors weigh in favor of a stay. A stay will simplify this case, conserve the resources of this Court and the parties before the litigation proceeds to the most expensive and resource-intensive stages of the case, and a stay will not cause any undue prejudice to Plaintiff.

A. A Stay Will Simplify This Case

The first factor, simplification of issues, favors a stay. Defendants' stipulation combined with the IPR institution decisions issued to date will enable the PTAB to greatly streamline the case and "reduce[] what otherwise could be duplication of effort." *British Telecomms. PLC v. IAC/InterActiveCorp*, No. 18-366-WCB, 2019 WL 4740156, at *8 (D. Del. Sept. 27, 2019) (collecting cases where courts granted stays in favor of IPR proceedings instituted on fewer than all of the claims); *Bonutti Skeletal Innovations, L.L.C. v. Zimmer Holdings, Inc.*, No. 12-1107 (GMS), 2014 WL 1369721, at *5 (D. Del. Apr. 7, 2014) (granting stay where four out of six asserted patents were subject to IPR petitions, two of which had been granted, and the majority of the asserted claims were not subject to the IPR petitions); *Nexans, Inc. v. Belden, Inc.*, No. 12-

1491-SLR-SRF, 2014 WL 651913, at *4 (D. Del. Feb. 19, 2014) ("A complete overlap of the issues in the litigation and the IPR is not required to establish simplification of the case.").

Staying the case now will allow the PTAB to significantly reduce the scope of this case. Because it is likely that the PTAB finds at least one challenged claim unpatentable, claim interpretation, infringement, invalidity, and damages issues will be narrowed in scope and the burden on the Court (to resolve these issues) will be greatly reduced.

Moreover, the PTAB's FWDs are necessary to resolve statements of disclaimer based on positions taken by Plaintiff during the IPR proceedings that have already become part of the file history of the '615 and '968 patents. *See Aylus Networks, Inc. v. Apple Inc.*, 856 F.3d 1353, 1362 (Fed. Cir. 2017) ("[S]tatements made by a patent owner during an IPR proceeding, whether before or after an institution decision, can be considered for claim construction and relied upon to support a finding of prosecution disclaimer."). For example, in its Patent Owner Preliminary Response for the '968 patent IPR, Plaintiff has stated that the claim term "designation software controller" is a means-plus-function limitation. Ex. 8, at 1, 12-13, 15-16. Positions that Plaintiff take on this claim term and likely others during the multiple IPR proceedings will help guide the Court on disputed claim construction issues concerning the '615 and '968 patents (and any other asserted patent where the IPR is instituted). *British Telecomms.* 2019 WL 4740156, at *8 ("[T]he expertise of the PTAB judges in this complex field of art is likely to be of considerable assistance to the Court") (collecting cases).

It is likely that more asserted patents will be subject to PTAB review. The IPR petitions filed against the '592 and '236 patents (whose institution decisions are expected on May 28, 2025 and June 30, 2025) seek review of claims in asserted patents that share a common specification with the '615 and '968 patents, for which the PTAB already instituted the IPR. Thus, the PTAB

written record for IPRs instituted against the ’615 and ’968 patents will be highly relevant to claim construction and invalidity for *four* of the *five* asserted patents. *See Helios Streaming*, 2021 WL 8155604, at *1 (staying eight-patent case pending IPR of three patents, only one of which was currently asserted, where some non-IPR patents “share[d] a common specification” with a patent subject to IPR); *Alloc, Inc. v. Unilin Decor N.V.*, No. 03-253-GMS, 2003 WL 21640372, at *2 (D. Del. July 11, 2003) (granting stay in case involving infringement of a continuation patent pending both reexamination of and Federal Circuit’s decision on continuation patents of the same patent family). The Court would therefore benefit from staying the case during the IPR proceedings so that it has a complete file history for at least the ’615 and ’968 patents, and potentially the related ’592 and ’236 patents.

On the other hand, if the parties proceed to claim construction or trial without a stay, there is a risk of inconsistent decisions between the Court and PTAB. *Textron Innovations Inc. v. Toro Co.*, No. 05-486 (GMS), 2007 WL 7772169, at *2 (D. Del. Apr. 25, 2007) (if claims are canceled without a stay, “the Court will have wasted time and the parties will have spent additional funds addressing an invalid claim or claims.”); *British Telecomms.*, 2019 WL 4740156, at *8 (granting stay because “allowing the PTO to adjudicate the validity of the claims before it in the IPR proceeding reduces what otherwise could be duplication of effort and possibly inconsistent results between the administrative agency and this Court”); *Ethicon LLC v. Intuitive Surgical, Inc.*, No. 17-871-LPS, 2019 WL 1276029, at *2 (D. Del. Mar. 20, 2019) (granting a stay where a jury verdict in October 2019 could conflict with outcome of PTAB’s IPR proceedings expected in December 2019). This is especially true with complex technology, as here, where the jury will benefit from a simplification of issues. *CyWee Grp LTD v. Samsung Elecs. Co. LTD*, D.I. 331, slip op. at 18 (E.D. Tex. Feb. 14, 2019) (“In a case involving technology as complex as the [software]

technology in this case, which is sure to challenge the ability of the jury to absorb and rationally decide issues of infringement and invalidity, there is a particularly high premium on simplification.”).

For these reasons, the first factor favors a stay.

B. The Most Burdensome Stages of Litigation Lie Ahead

The second factor, stage of proceedings, also weighs heavily in favor of a stay. A stay is favored where “the most burdensome stages of the case—completing discovery, preparing expert reports, filing and responding to pretrial motions, preparing for trial, going through the trial process, and engaging in post-trial motion practice—all lie in the future.” *Bio-Rad Labs. Inc. v. 10X Genomics, Inc.*, C.A. No. 18-1679-RGA, 2020 WL 2849989, at *1 (D. Del. June 2, 2020); *IOENGINE, LLC v. PayPal Holdings, Inc.*, No. 18-452-WCB, 2019 WL 3943058, at *5 (D. Del. Aug. 21, 2019).

Here, although fact discovery is ongoing, depositions have yet to be scheduled, claim construction briefing has not started, expert discovery has not begun, and trial is 14 months away. Based on the breadth of Plaintiff’s infringement contentions and the parties’ initial disclosures, the parties’ depositions will involve more than 20 fact witnesses, none of which have been scheduled. Courts in this District have found a stay appropriate in cases similarly situated or even at more advanced stages in the litigation. *See, e.g., Bio-Rad Labs.*, 2020 WL 2849989, at *1 (granting a stay where “no depositions have been taken, the Markman hearing has not yet been conducted, expert discovery has not begun, and trial is more than a year away”); *Ethicon*, 2019 WL 1276029, at *2 (“[T]he Court has already issued its claim construction order, fact discovery is complete, and expert discovery is nearly concluded . . . [but] the case is at ‘an efficient pausing point,’ so this factor should not weigh heavily against a stay.”); *Huvepharma Eood et al. v. Assoc. British Foods, PLC et al.*, No. 18-129-RGA, 2019 WL 3802472, at *1 (D. Del. Aug. 13, 2019) (granting a stay

pending IPR ten months prior to trial date, after claim construction and document production was fully complete).

Staying the case will ensure that the Court and parties can avoid significant effort that would be rendered completely redundant by, and potentially inconsistent with, the PTAB's FWDs. Pressing pause at this juncture, before the bulk of the work in this case will occur, is a prudent conservation of judicial and party resources. The second factor also favors a stay.

C. Plaintiff Will Not Be Prejudiced by A Stay

The third factor, undue prejudice, weighs heavily in favor of a stay when the nonmovant's ability to obtain an adequate remedy will not be diminished, and the moving party will not obtain an unfair advantage in the case. *British Telecomms.*, 2019 WL 4740156, at *5-*6. In considering whether a stay will be prejudicial or give a clear tactical advantage to the moving party, courts consider three factors: (1) the relationship of the parties; (2) the timing of the request for review and stay; and (3) the status of the review proceedings. *Princeton Digital Image Corp. v. Konami Digital Entm't Inc.*, No. 12-1461-LPS-CJB, 2014 WL 3819458, at *4 (D. Del. Jan. 15, 2014). Each of these considerations favors a stay.

1. The Relationship Between Plaintiff and Defendants Favors a Stay.

The risk of undue prejudice to Plaintiff is minimal because Plaintiff does not practice any of the asserted patents, does not have a business to protect, and is not at risk of losing any revenue from sales of any products or services. Plaintiff generates revenue purely by licensing its patents. In assessing the potential for undue prejudice, courts consider whether the parties are direct competitors and whether there are other active competitors in the relevant market. *Princeton Digital Image Corp.*, 2014 WL 3819458, at *6. Direct competition increases the chances that a delay in the adjudication will cause the non-moving party to suffer "loss of market share and an erosion of goodwill." *Id.* But a nonpracticing plaintiff is unlikely to experience any such harm.

British Telecomms. PLC v. IAC/InterActiveCorp., No. 18-366-WCB, 2020 WL 5517283, at *6 (D. Del. Sept. 11, 2020).

Here, Plaintiff is a nonpracticing entity and there is no competitive relationship—or really any relationship at all—between Defendants and Plaintiff. Plaintiff will not experience any loss of market share or erosion of goodwill, and can be adequately compensated by monetary damages. *Gioello Enter. Ltd. v. Mattel, Inc.*, No. 99-375-GMS, 2001 WL 125340, at *2 (D. Del. Jan. 29, 2001) (prejudice to the plaintiff is "slight, if any" because the plaintiff "is not selling or actively licensing goods or services related to the [asserted patents]," so "money damages is an adequate remedy for any delay in redress."); *Bonutti*, 2014 WL 1369721, at *4-*5 (granting stay because plaintiff, who did not manufacture products or "engage in head-to-head competition" with defendants, could be adequately compensated for any delay). Moreover, any delay in collecting monetary damages is not undue prejudice. *Virtual Agility Inc. v. Salesforce.com, Inc.*, 759 F.3d 1307, 1318 (Fed. Cir. 2014) ("A stay will not diminish the monetary damages to which [plaintiff] will be entitled if it succeeds in its infringement suit—it only delays realization of those damages."); *In re Bear Creek Techs. Inc.*, No. 11-721 (GMS), 2013 WL 3789471, at *2 (D. Del. July 17, 2013) ("Bear Creek is now a non-practicing entity comprised solely of the '722 Patent's inventor, undermining its prejudice assertions[.]"); *Celorio v. On Demand Books LLC*, No. 12-821-GMS, 2013 WL 4506411, at *1 n.1 (D. Del. Aug. 21, 2013) (no undue prejudice where patentee could be compensated with money damages).

Finally, Plaintiff has not presented any evidence of irreparable harm as a result of Defendants' alleged infringement. Nor has Plaintiff presented any evidence sufficient to meet the *eBay* factors for entry of an injunction. Indeed, Plaintiff is not seeking lost profits, did not pursue a preliminary injunction, and has offered to license and/or sell the patents to numerous companies,

all of which demonstrate that a permanent injunction against Defendants would be unwarranted. Since damages are an adequate remedy for any alleged infringement of the asserted patents, there is no undue prejudice to Plaintiff from a stay pending Defendants' IPRs.

2. Defendants Were Diligent in Filing Their IPR Petitions and Stay Motion.

The more diligent a defendant is in seeking IPR, the less likely it is the non-movant will be prejudiced by a stay. *TruePosition, Inc. v. Polaris Wireless, Inc.*, No. 12-646-RGA-MPT, 2013 WL 5701529, at *6 (D. Del. Oct. 21, 2013). Here, Defendants filed IPR petitions against all five asserted patents between August 2024 and January 3, 2025, all before the one-year statutory deadline under 35 U.S.C. § 315(b). Moreover, patentees suffer no prejudice where the "requests [for review] were filed at a time when little substantive activity had yet occurred." *Ever Win Int'l Corp. v. Radioshack Corp.*, 902 F. Supp. 2d 503, 508-09 (D. Del. 2012). Defendants filed their petitions even before the substantial completion of document production on February 13, 2025. Defendants were clearly diligent in filing IPR petitions.

Defendants were also diligent in filing this motion. Institution in IPR2024-01161 ('615 patent) was granted on February 26, 2025. Ex. 6. Institution in IPR2024-01345 ('968 patent) was granted on March 26, 2025. Ex. 7. Defendants expeditiously filed this instant motion only days after the second institution decision. Courts have found requests for a stay to be timely where a party moves within a few months of the institution decision. *Monterey Research, LLC v. Nanya Tech. Corp.*, No. 19-2090, 2021 WL 6502552, at *1 n.1 (D. Del. Jun. 25, 2021) (finding "the timing of the request for stay suggests no dilatory motive, as Defendants filed the underlying motion to stay two months after the PTAB instituted the IPR"); *Neste Oil OYJ v. Dynamic Fuels, LLC*, No. 12-1744-GMS, 2013 WL 3353984, at *2 (D. Del. July 2, 2013) ("Given the prompt

filing of both the petition for *inter partes* review and the motion to stay, the court cannot discern an improper dilatory motive.”).

Defendants are filing this motion to stay now to maximize time saved for the Court, based on the two IPR petitions being instituted and the high likelihood that two additional IPR petitions will be granted in the next 3 months. Filing now seeks to maximize efficiency for the Court, instead of waiting to file this motion to stay until the PTAB issues institution decisions on all five IPR petitions (the last one is expected July 29, 2025). Waiting until then to file this motion would run the high risk that the parties will have invested considerable time and resources on fact and corporate depositions, responding to recently propounded discovery requests, as well as investing heavily in claim construction briefing (Plaintiff’s opening brief due June 25 and Defendants’ answering brief due July 18, 2025)—prior to PTAB institution decisions being made that could clearly make all of this unnecessary at this time. Granting Defendant’s motion to stay now based solely on the IPR petitions instituted against the ’615 and ’968 patent just makes sense. Those two IPRs put 58 percent of the asserted claims at jeopardy of being found unpatentable and could greatly simplify the issues before the Court.

3. The Status of The Review Proceedings Will Not Prejudice Plaintiff, Because The FWDs Are Expected Around The Same Time As Trial.

The already-instituted IPRs—affecting 58 percent of the asserted claims in this case—will issue FWDs in February 2026 and March 2026, several months before trial and prior to the trial scheduling conference. Where the FWDs are expected to issue shortly before or near the trial date, this sub-factor weighs in favor of a stay. *See British Telecomms.*, 2019 WL 4740156, at *6 (“If a stay is not granted, a decision as to the validity of various claims of the [patent subject to IPR] could come shortly before the trial in this case. The prospect that a contemporaneous IPR decision

will have a significant effect on the issues presented in the litigation counsels in favor of a stay."); *IOENGINE*, 2019 WL 3943058, at *6 (same).

Given Defendants' stipulation and that the PTAB may invalidate up to 58 percent of Plaintiff's asserted claims on just the '615 and '968 IPRs, it makes sense for the Court to stay the case now and await the resolution of the Defendants' IPRs. A stay will streamline this case, reduce the burden on the Court, and eliminate the potential for inconsistent rulings. As the court in *IOENGINE* explained, "the preferable course is to enter a stay now, subject to possible reconsideration if circumstances change in the coming months and a request is made to vacate the stay." *IOENGINE*, 2019 WL 3943058, at *40. This factor therefore also favors a stay.

V. CONCLUSION

For the foregoing reasons, Defendants respectfully requests that the Court stay this action pending the resolution of the Defendants' IPRs.

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