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.	Civil Action No. 1:24-cv-00028-MN

PLAINTIFF'S OPPOSITION TO DEFENDANTS' MOTION TO STAY PENDING *INTER PARTES* REVIEW

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I. INTRODUCTION AND SUMMARY OF ARGUMENT

Plaintiff's motion is premature. This Court has repeatedly found motions for a stay to be premature where any IPR institution decisions are still pending. *See, e.g., PayRange Inc v. CSC ServiceWorks, Inc.*, Case No. 1:23-cv-00278-61 (MN) (D. Del. Feb. 26, 2024) (stay motion premature where one of four IPR institution decisions was still pending); *Exact Scis. Corp. v. Geneoscopy, Inc.*, Case, No. 1:23-cv-01319-168 (MN) (Hearing Tr.), pp. 28-29 (D. Del. Nov. 1, 2024) (stay motion premature where one out of two IPR decisions was still pending). Here, **three of the four** currently asserted patents still await institution decisions; and the IPR challenging the fourth asserted patent is still awaiting Director review of the institution decision. In short, for none of the four patents has a final IPR institution decision been made, and for three of the four there has not even been an initial decision.

Defendants ignore this Court's repeated rulings on this issue, and instead erroneously suggest that, absent an immediate stay, the Court risks rendering a judgment inconsistent with the PTAB. Defendants' Opening Brief in Support of Their Motion to Stay Pending *Inter Partes* Review, D.I. 86 ("Mot.") at 7-8. Yet Defendants fail to mention the prudent third option taken by this Court multiple times in the past: deny Defendants' motion to stay without prejudice to renew after the PTAB renders institution decisions in the remaining IPRs.

The parties have nearly completed fact discovery, and the claim construction hearing is not scheduled to occur until almost two months after the last of the institution decisions is expected. Thus, the majority of the remaining schedule for this case (claim construction, expert discovery, and trial) will still be ahead of the parties after the final institution decision issues, which will be no later than July 29, 2025. At that time, if Defendants renew their motion, this Court will be better positioned to determine if a stay is appropriate. Indeed, denying this motion now as premature does not create any risk of inconsistent decisions, as the parties will not submit

their joint claim construction brief until nearly a month after the last institution decision. There will be time to decide whether a stay is appropriate well before this Court makes any rulings on claim construction.

Further, staying the case now will only serve to prejudice Plaintiff. Travel arrangements have already been made for Plaintiff's aging key witness—a named inventor on each of the asserted patents and the founder and CEO of Plaintiff NL Giken—who is set to travel from Japan to the United States for a two-day deposition in two weeks. Plaintiff would further be severely prejudiced if the trial date (currently scheduled for June 2026) were taken off the calendar based on mere speculation regarding the still-pending institution decisions.

Defendants also ignore the recent shifts in PTAB policy, which suggest that the Director is likely to discretionarily deny each of Defendants' petitions, including the previously instituted review over the '968 Patent. At the very least, there is a measure of uncertainty with regard to how the PTAB will operate under these new policies, further demonstrating the premature nature of Defendants' motion to stay.

For these reasons, Defendants' motion to stay should be denied.

II. NATURE AND STAGE OF PROCEEDINGS

A. The District Court Litigation

Plaintiff filed this case on January 11, 2024, alleging infringement of U.S. Patent Nos. 9,948,968 (the "'968 patent), 8,094,236 (the "'236 patent"), 10,880,592 (the "'592 patent"), 8,677,391 (the "'391 patent"), and 9,319,615 (the "'615 patent"). On April 7, 2025, Plaintiff disclaimed the '615 patent and, therefore, that patent is no longer at issue in this case. Ex. A (USPTO receipt for statutory disclaimer of '615 Patent).

This case is nearing the end of the fact discovery period, which closes June 2, 2025. D.I. 32 (Scheduling Order). The claim construction hearing is scheduled for September 16, 2025, and

the parties' opening expert reports are due by October 7, 2025. *Id*. A jury trial is scheduled for June 22, 2026. *Id*.

Defendants incorrectly state that depositions have not been scheduled. Mot. at 2-3. In fact, the deposition of Plaintiff's key witness, Mr. Masahide Tanaka, has been scheduled for over a month and is set to take place on May 6 and 7, 2025. Hrycyszyn Decl. ¶ 4; Ex. B (March 13, 2025 Email from Gerald Hrycyszyn to Catherine Huang regarding deposition dates for Mr. Tanaka). Mr. Tanaka is seventy-six years old[1] and, as a named inventor of the claimed inventions and the founder and CEO of NL Giken, is expected to be Plaintiff's key witness. Hrycyszyn Decl. ¶ 3. Mr. Tanaka resides in Japan, and travel arrangements (including flights and hotel rooms) to Boston, where the deposition will take place, have already been made. Hrycyszyn Decl. ¶¶ 2, 4.

On March 24, 2025, Plaintiff served a 30(b)(6) deposition notice on Defendants, and on April 4, 2025 Plaintiff filed 30(b)(1) deposition notices for three of Defendants' engineers. D.I. 75, 82-84. Deposition dates in May for six of Defendants' witnesses have been confirmed, and Defendants have indicated that they are still assigning topics to witnesses and assessing availability, after which the remaining depositions will be scheduled. Hrycyszyn Decl. ¶ 5.

B. Related IPRs

Defendants filed IPR petitions challenging the validity of each of the asserted patents. Exs. 2-5 to Mot. The PTAB has instituted review of only one of the four currently asserted patents, the '968 patent. And even that decision is not final, as Plaintiff has requested reversal of

[1] It is counsel's understanding that this Court is currently scheduling trial dates two to three years in advance. A year-long stay awaiting the conclusion of the '968 IPR alone could result in the trial date being pushed back three to four years. In four years, Mr. Tanaka will be eighty years old. An appeal of the Final Written Decision in that IPR could potentially result in another two- to three-year delay, at which point Mr. Tanaka would be well into his eighties.

that interim decision via a Petition for Director Review. Ex. 7 to Mot. (Institution Decision); Ex. C (Petition for Director Review). Institution decisions for the three remaining asserted patents are scheduled to be released by the end of July.[2] Should the Director decline to terminate the IPR of the '968 patent, a Final Written Decision in that IPR is expected by March 26, 2026.

Plaintiff has requested discretionary denial of each of the IPR petitions before the PTAB. For the '236 and '391 patents, Plaintiff has filed Requests to the Director for Discretionary Denial of Institution pursuant to the new bifurcated institution procedure outlined in the USPTO's recent March 26, 2025 memorandum regarding Interim Processes for PTAB Workload Management (Ex. D). Ex. E (Request to the Director for Discretionary Denial of Institution, '391 Patent); Ex. F (Request to the Director for Discretionary Denial of Institution, '236 Patent). For the '592 patent, Plaintiff requested discretionary denial in a Supplemental Preliminary Response to Address Discretionary Denial of Institution. Ex. G. Plaintiff has also filed a request for Director Review of the Board's Institution Decision for the '968 patent. Ex. C.

III. LEGAL STANDARD

"Courts typically review three factors in determining whether a stay is appropriate: '(1) whether a stay will simplify the issues for trial, (2) whether discovery is complete and a trial date has been set, and (3) whether a stay would unduly prejudice or present a clear tactical disadvantage to the non-moving party.'" *AgroFresh Inc. v. Essentiv LLC*, Case No. 1:16-cv-00662-467 (MN), 2019 WL 2327654, at *1 (D. Del. May 31, 2019) (quoting *Ethicon LLC v. Intuitive Surgical, Inc.*, Case No. 1:17-cv-00871-307 (LPS), 2019 WL 1276029, at *1 (D. Del. Mar. 20, 2019)).

[2] Institution decisions for the '592, '236, and '391 patents are due by May 28, June 30, and July 29, respectively. *See* 35 U.S.C. § 314(b) (requiring an institution decision within three months after a Patent Owner Preliminary Response is filed).

IV. ARGUMENT

A. Amazon's Motion is Premature, and a Stay at This Time Would Not Simplify Issues for Trial.

1. Three of the four asserted patents are still pending IPR Institution Decisions.

The simplification factor weighs against granting a stay at this time as three of the four asserted patents are still awaiting an institution decision. *See Copy Prot. LLC v. Netflix, Inc.*, Case No. 1:14-cv-00365-73 (LPS), 2015 WL 3799363, at *1 (D. Del. June 17, 2015) ("Generally, the 'simplification' issue does not cut in favor of granting a stay prior to the time the PTAB decides whether to grant the petition for *inter partes* review."); *PayRange Inc v. CSC ServiceWorks, Inc.*, Case No. 1:23-cv-00278-61 (MN) (D. Del. Feb. 26, 2024) (quotations removed) (oral order denying without prejudice motion to stay as "premature" when one of four institution decisions was still pending); *Aortic Innovations, LLC v. Edwards Lifescis Corp.*, Case No. 1:21-cv-01377-34 (JPM), (D. Del. May 10, 2022) ("Because the IPRs have not yet all been instituted, the Court finds it too speculative to order a stay at this stage in the case.").

With institution decisions for three out of the four IPR petitions not yet even rendered, there is no basis to conclude that any such institution is likely. Indeed, this Court has so held, noting that it is unwilling to "assume because one patent was instituted that the other[s] will be" even when the patents have "identical specifications." *Exact Scis. Corp. v. Geneoscopy, Inc.*, Case, No. 1:23-cv-01319-168 (MN) (Hearing Tr.), pp. 28-29 (D. Del. Nov. 1, 2024) (declining to consider motion to stay until "full scope" of IPR institutions is known).

Additionally, while the '593 and '236 patents share a common specification with the '968 patent, the claims of each of these patents are directed towards different inventions, as evidenced by the fact that none of the primary prior art references asserted in Defendants' petitions overlap between the asserted patents. *See* Ex. 2 to Mot. ('968 Petition) at 1, Ex. 3 to Mot. ('592 Petition)

at 1, Ex. 4 to Mot. ('236 Petition) at 1, Ex. 5 to Mot. ('391 Petition) at 1. Thus, Defendants' assertion that the IPR against the '968 patent will be "highly relevant to claim construction and invalidity" for the '592 and '236 patents falls flat. Mot. at 6-7.

2. Recent changes in PTAB policies make discretionary denial more likely, so Defendants' prediction of "simplification" is speculative.

The recent changes in PTAB policies, and the corresponding *Motorola* decision implementing those changes, make discretionary denial of the pending IPRs at the institution stage far more likely. Accordingly, Defendants' prediction that these IPRs will be instituted, and will subsequently result in "simplification" of issues, is at best speculative.

On February 28, 2025, the PTAB rescinded its prior policy memorandum that had provided a safe-harbor ensuring that "the PTAB will not discretionarily deny institution of an IPR" if the Petitioner has filed a *Sotera* stipulation (i.e., a stipulation "not to pursue in a parallel district court proceeding the same grounds as in the petition or any grounds that could have reasonably been raised in the petition." Ex. H (Rescinded June 1, 2022 Memorandum regarding Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation) at 7-8, Ex. I (March 24, 2025 Memorandum regarding Guidance on USPTO's Recission of June 21, 2022 Memo). Accordingly, Defendants can no longer avoid discretionary denial of their IPR petitions with *Sotera* stipulations.

In addition, on March 26, 2025, the USPTO issued a memorandum instructing that the Director will review all IPR petitions for discretionary denial and, if appropriate, will deny institution on that basis. Ex. D. Pursuant to this memorandum, a petition will only be evaluated on its merits if it survives discretionary denial by the Director. *Id*.

In the wake of the March 26, 2025 Memorandum, the Director reviewed institution of four IPR petitions filed by Motorola, vacating institution of each despite a stay having been

issued in the parallel district court proceedings, and stating that the PTAB failed to "give enough weight to the investment in the parallel proceeding and gave too much weight" to Motorola's *Sotera* stipulation.[3] *See Motorola Sols., Inc. v. Stellar, LLC*, IPR2024-01205, Paper 19 at 2 (PTAB Mar. 28, 2025). Thus, even if a stay were granted in this case, under the new policy the Director may discretionarily deny institution for any one or more of the IPRs, including the one involving the '968 patent for which institution has already provisionally been granted. In short, any stay that may be entered now, prior to the Director deciding whether or not to exercise her discretionary denial authority, creates the possibility of needlessly delaying the case despite ***none*** of the IPRs proceeding (and accordingly without any possible simplification of issues).

This Court has been reluctant to grant stays pending IPRs when there is uncertainty about whether any simplification will occur. *See Rex Comput., Inc. v. Cerebras Sys., Inc.*, Case No. 1:21-cv-00525-172 (MN) (Markman Tr.) at pp. 96-97 (D. Del. Nov. 30, 2022) ("[E]ven 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"). The USPTO's recent policy shifts create similar uncertainty and weigh heavily in favor of denying Defendants' motion, at least at the present time.

3. Defendants' stipulation does not result in simplification of the issues.

Defendants' proposed stipulation fails in its attempt to establish that simplification of the issues is likely. First, Defendants' stipulation only covers two of the four asserted patents. Defendants have not provided any stipulation with regard to the '968 or '592 patents, apparently

[3] Motorola's *Sotera* stipulation provided that Motorola would not "pursue as to the challenged claims any ground raised or that reasonably could have been raised during the IPR" in the parallel district court litigation. *Motorola Sols., Inc. v. Stellar, LLC,* IPR2024-01205, EX1043 (Communication comprising *Sotera* stipulation) (filed Nov. 27, 2024).

intending to raise the same prior art and issues before this Court should they be unsuccessful before the PTAB. Second, Defendants' stipulation only takes effect if the Director does not discretionarily deny the '236 or '391 petition. Thus, if a stay is put into place and the Director discretionarily denies the '236 and '391 petitions pursuant to the new PTAB procedure, Defendants' stipulation will have no effect whatsoever – it will have resulted in zero simplified issues. And, as described above, should the PTAB grant institution on the '236 and '391 petitions, this Court will still have ample opportunity to consider whether a stay may be appropriate at that time, prior to the claim construction hearing, so no potential for simplification will have been lost by denying the current motion as premature.

4. Final Written Decisions are not necessary to resolve any issue of alleged disclaimer.

Defendants claim that Final Written Decisions by the PTAB are necessary to resolve supposed "statements of disclaimer based on positions taken by Plaintiff during the IPR proceedings." Mot. at 6. But Plaintiff has made no such disclaimers. Indeed, Defendants' only example of any such alleged "disclaimer" is Plaintiff's construction of the term "designation software controller" as a means-plus-function limitation, which is the very position Plaintiff has taken in this litigation. *See* Ex. J (Draft Joint Claim Construction Chart, sent as attachment to March 10, 2025 email from John Custer to Jennifer Nall) at 2. Defendants fail to explain how Plaintiff's consistent claim construction positions are somehow a "disclaimer," or how they could possibly serve as a basis for prematurely entering a stay of this case prior to the issuance of institution decisions on three of the four asserted patents.

B. The Stage of Litigation Weighs in Favor of Denying a Stay at this Time.

The second factor also weighs against entering a stay at this time. The claim construction hearing is scheduled for September 16, 2025, almost two months after the final IPR Institution

Decision is expected. D.I. 32 (Scheduling Order). There is thus no loss in efficiency if the Court were to wait to consider whether a stay is appropriate until after the last institution decision issues, as there will be no risk of inconsistent decisions in the interim.

Nor will denying this motion as premature result in any wasted party resources. The deadline for fact discovery is June 2, 2025, which is only six weeks away. *Id*. The parties have undergone substantial fact discovery, and each party has already invested significant resources in this litigation. *See 6115187 Can., Inc. v. LG Elecs. USA, Inc.*, Case No. 1:18-cv-01630-78 (MN-CJB) (D. Del. Feb. 10, 2020) (oral order denying motion to stay with prejudice, in part because the cases "are not exactly in their infancy…and the parties are well into fact discovery."). The deposition of Mr. Tanaka, Plaintiff's key fact witness, is scheduled for May 6 and 7, 2025—just two weeks from the time of filing this brief—and preparation for his deposition is already underway. Hrycyszyn Decl. ¶ 4. And depositions for six of Defendants' 30(b)(6) witnesses have already been scheduled in May. Hrycyszyn Decl. ¶ 5. Far from saving resources, cancelling these already-scheduled depositions, for which both parties have been preparing and for which travel plans from Japan have been made, and delaying the end of fact discovery by two or more years, would result in wasted time and effort that would have to be redone after the stay is lifted. *See Universal Secure Registry, LLC v. Apple Inc.*, Case No. 1:17-cv-00585-138 (SRF), 2018 WL 4486379, at *3 (D. Del. Sept. 19, 2018) ("As a practical matter, putting the case on hold until the decision to institute is made is likely less efficient than continuing on track through discovery").

Instead, the more prudent approach would be to allow the parties to fully wrap up all remaining fact discovery and consider at a later date whether a stay is appropriate, after the PTAB issues the last of the institution decisions – if the issue has not by then been mooted by

those decisions. By doing so, even if a stay does then become appropriate, the case will be able to restart right where it will have left off (claim construction briefing) without further delay.

C. Plaintiff Will Be Prejudiced by A Stay.

The third factor also weighs against entering a stay at this time. Plaintiff will be prejudiced by a stay due to its significant investment of resources into fact discovery, including significant document production as well as the preparation for the deposition of Mr. Tanaka—Plaintiff's key fact witness—whose availability to testify is rendered more onerous if the case is stayed.

Despite Amazon's claims to the contrary (Mot. at 9-11), a patent owner is not barred from facing prejudice just because it licenses rights to practice its inventions rather than practicing the invention itself. *See Copy Prot.*, 2015 WL 3799363, at *1 ("potential for undue prejudice" exists for non-practicing entities).

Here, a stay would prejudice Plaintiff by at least the "loss of [its] chosen forum, the possibility of necessary witnesses' memories fading, and negative impact on [its] ability to license the patents-in-suit," all recognized in this District as counseling against granting a stay. *See Intellectual Ventures I LLC v. Toshiba Corp.*, Case. No. 1:13-cv-00453-150 (SLR), 2015 WL 3773779, at *2 (D. Del. May 15, 2015) (quoting *Benefit Funding Sys. LLC v. Advance Am., Cash Advance Ctrs, Inc.*, Case No. 1:12-cv-00801-51 (LPS), 2013 WL 3296230, at *2 (D. Del. June 28, 2013)).

First, Plaintiff's key witness, Mr. Tanaka, the founder and CEO of Plaintiff NL Giken and named inventor of each of the asserted patents, is 76 years old and would be nearly 80 after a delay of three to four years. Hrycyszyn Decl. ¶ 2. The risk of fading health or memory during such a lengthy delay is substantial, which would result in severe prejudice to Plaintiff.

Second, this Court is Plaintiff's chosen forum and Plaintiff will suffer prejudice should Defendants be allowed to stall the litigation here based solely on the institution (which may not even be final in light of Director Review) of an IPR over one asserted patent while the PTAB has yet to decide whether or not to institute IPRs on the three other asserted patents.

Third, a stay will have a "negative impact on [NL Giken's] ability to license the patents-in-suit" as other prospective licensees will have little motivation to enter into a license for any of the asserted patents before the conclusion of this case. *See Intellectual Ventures I*, 2015 WL 3773779, at *2.

Defendants, by contrast, have shown no prejudice from the case proceeding on schedule at least for now; and to the extent they allege any such prejudice, it is solely of their own making due to their delay in filing the still-pending IPR petitions. Plaintiff served its original Complaint upon Defendants on January 11, 2024. D.I. Nos. 1, 6-9. Defendants then waited eight months before filing any IPRs against the currently asserted patents, and did not file the last of them until just a few days before their one-year bar date.[4] Yet as evidenced by their invalidity initial disclosures, Defendants had knowledge of each of the primary references asserted in their Petitions against the '592, the '236, and the '391 patents months earlier – at least by November 15, 2024 (and likely earlier). *Compare* Ex. K (Excerpts of Defendants' Initial Invalidity Contentions) at 12-13, 18-19, 26-27 *with* Ex. 3 to Mot. ('592 Petition) at 1, Ex. 4 to Mot. ('236 Petition) at 1, Ex. 5 to Mot. ('391 Petition) at 1. Defendants cannot now complain that they will be forced to finish fact discovery prior to the final institution decision when this timing is of Defendants' own making.

[4] Defendants filed their petitions against the '968, '592, '236, and '391 patents on September 11, 2024, November 25, 2024, December 17, 2024, and January 3, 2025, respectively. Exs. 2-5 to Mot.

V. CONCLUSION

This Court has held stay motions premature where as little as one remaining IPR institution decision was pending. Here, three of the four IPR institution decisions are still pending; and even the fourth may actually end up non-instituted as a result of Director Review (the likelihood of which has increased in view of recent PTAB policy changes). Nor have Defendants undertaken by stipulation to any meaningful simplification of issues.

Defendants argue they did not "wait[] to file this motion to stay until the PTAB issues institution decisions on all … IPR petitions" so as to "maximize efficiency for the Court." Mot. at 12. But rushing to address that issue now is hardly in the interests of efficiency: the next substantive scheduled Court proceeding, namely the claim construction hearing, is not until some two months after the final institution decision will have been entered. D.I. 32 (Scheduling Order). Should the issue of a stay not be mooted by the PTAB's institution decisions in the meantime, there will be ample opportunity for the Court to consider whether a stay is appropriate after those decisions are all in.

For the above-stated reasons, Defendants' motion to stay should be denied without prejudice to refile after institution decisions are issued for all of the pending IPRs.

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