

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE

ZAXCOM, INC.,	)	
	)	
Plaintiff,	)	
	)	
v.	)	C.A. No. 23-1245-JFM
	)	
RØDE MICROPHONES, LLC AND	)	
FREEDMAN ELECTRONICS PTY LTD.,	)	
	)	
Defendants.	)	

**OPENING BRIEF OF DEFENDANTS RØDE MICROPHONES, LLC.
AND FREEDMAN ELECTRONICS PTY LTD. IN SUPPORT OF THEIR
MOTION TO STAY LITIGATION PENDING INTER PARTES REVIEW**

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I. Introduction and Summary of the Argument

Defendants RØDE Microphones LLC (“RØDE”) and Freedman Electronic Pty, Ltd. (“Freedman”) (collectively, “Defendants”) respectfully move the Court to stay this case pending the outcome of three instituted and one filed *Inter Partes* Review (“IPR”) proceedings before the Patent Trial and Appeal Board (“PTAB”), including appeals therefrom. Final written decisions are expected for three instituted IPRs challenging three patents-in-suit, U.S. Patent Nos. 7,711,443 (the “’443 patent”), 7,929,902 (the “’902 patent”), and 10,276,207 (the “’207 patent”) by June 16, 2026. If the IPR is instituted for the fourth patent, U.S. Patent No. 12,051,444 (the “’444 patent”), a final written decision is likely to issue no later than October 7, 2026. The totality of factors this district considers support granting this motion to stay.

First, a stay will significantly streamline this case. IPRs challenge all asserted claims of the ’443 patent and fourteen of twenty asserted claims of the ’902 patent. The ’443 and ’902 patents are both the earliest issued, and with 2028 expiration dates, the latest expiring patents in this case. All other asserted patents expire in July 2025. Thus, the ’443 and ’902 patents would have the most significant impact on any consideration of damages. Moreover, the outcome of the IPR proceedings will also impact this Court’s consideration of the unchallenged claims, because most unchallenged claims share duplicative limitations with claims challenged in the IPRs.

Second, the district court case is at a logical stage to pause. The Court has not set a trial date, the parties have not taken any fact depositions, nor have the parties begun expert discovery. The most burdensome and costly stages of the litigation lay ahead.

Third, the stay of the litigation will not prejudice Plaintiff. Plaintiff has not sought a preliminary injunction. Five of the seven asserted patents expire next month, so any damages

would stop accruing long before any resolution of this litigation regardless of whether there is a stay.

Fourth, because all claims of the later-expiring '443 patent and most claims of the later-expiring '902 patent are subject to instituted IPR proceedings, litigation with respect to these patents will be significantly simplified and streamlined by a stay, alleviating burdens on the Court and parties. With the IPRs certain to impact all challenged claims and most unchallenged claims, duplicative efforts in the IPR proceedings and the litigation would waste the Court's and parties' resources. A stay, however, would save the Court and the parties a significant amount of work and expense.

II. Concise Statement of Facts and Nature and Stage of the Proceedings

Plaintiff filed its original complaint on October 31, 2023 asserting six patents, the '443 '902, and '207 patents, as well as U.S. Patent Nos. 8,385,814 (the "'814 patent"); 9,336,307 (the "'307 patent"); and 11,610,605 (the "'605 patent"). D.I. 1. ("Complaint"). Over a year later, on November 14, 2024, Plaintiff filed an amended complaint. D.I. 99 ("Amended Complaint"). The Amended Complaint added the '444 patent, which issued July 30, 2024, to the litigation. The '443 patent presently has 1062 days of Patent Term Adjustment (PTA) under 35 U.S.C. 154(b) that may extend its expiration from July 14, 2025 to June 10, 2028. D.I. 99-12 at 3091. The '902 patent has 1135 days of PTA to extend its expiration from July 14, 2025 to August 22, 2028. D.I. 99-12 at 3118. The '814, 307, '207, '605, and '444 patents have not received PTA extensions, so they all expire on July 14, 2025.¹

¹ The non-extended patents expire twenty years from the earliest non-provisional filing from which they claim priority—the July 14, 2005 filing of U.S. Application No. 11/181,062, which issued as the '443 patent. D.I. 99-14 at 3147; D.I. 99-15 at 3178; D.I. 99-16 at 3206-07; D.I. 99-17 at 3258-59; D.I. 99-18 at 3308-09.

Trial has not been scheduled. Neither party has taken any fact depositions. Declaration of Michael A. Fisher (filed herewith “Fisher Decl.”) at ¶ 13. The parties have yet to begin expert discovery, with opening expert reports scheduled to be served on September 10, 2025. The parties will soon file their joint claim construction brief (D.I. 139), and the claim construction hearing is scheduled for July 9, 2025. The parties have engaged in document discovery (Fisher Decl., at ¶ 13), and exchanged contentions (D.I. 79, 86, and 103).

Defendants have challenged four of the seven asserted patents in IPR proceedings before the Patent Trial and Appeal Board (“PTAB”). The three IPRs challenging the ’443, ’902, and ’207 patents, which were filed on December 4, 2024, were instituted on June 16, 2025. Fisher Decl. Ex. A, at 2; Ex B, at 2; Ex. C, at 2. In decisions instituting the three IPRs challenging the ’443, ’902, and ’207, the PTAB found that Defendants “demonstrated a reasonable likelihood of establishing” at least one claim was unpatentable for each challenged patent. *E.g.*, Fisher Decl. Ex. B, at 50. In the 2024 fiscal year of the Patent and Trademark Office (PTO), the PTAB found at least one claim unpatentable in 85% of instituted petitions reaching a final written decision.² The fourth IPR, challenging the ’444 patent, is in its pre-institution stage (*see* Fisher Decl. Ex. H) with an institution decision due on or before October 7, 2025.³ The later challenge to the ’444 patent, filed on February 7, 2025, was due to its later issuance than the other challenged patents, and Plaintiff’s delayed assertion of this patent until November 14, 2024. D.I. 99 at ¶¶ 8, 35. The

² The PTAB’s Fiscal 2024 Report Statistics (October 1, 2023 to September 30, 2024) indicate that for the 446 petitions that resulted in a final written decision determining the patentability of the challenged claims, 312 (70%) held all challenged claims unpatentable, 67 (15%) held one or more challenged claims unpatentable, and 67 (15%) held all challenged claims patentable. *See* Fisher Decl. Ex. G, at 10.

³ Under 35 U.S.C. § 314(b)(1), the Institution Decision is due within three months of the Patent Owner’s preliminary response, which itself is due three months after the Notice of Filing Date Accorded, filed April 7, 2025. Fisher Decl. Ex. J, at 1-2.

'443 patent IPR challenges all of claims asserted in this litigation, the '902 patent IPR challenges fourteen of twenty asserted claims, the '207 patent IPR challenges eleven of sixteen claims, and the '444 patent IPR challenges nineteen of twenty-one claims.

The final written decision is due June 16, 2026 for the three instituted IPRs on the '443, '902, and '207 patents. *See, e.g.*, Fisher Decl. Ex. A; 35 U.S.C. §316(a)(11). If the IPR on the '444 patent is instituted, the final written decision would be scheduled within a year of that decision, so no later than October 7, 2026. 35 U.S.C. §316(a)(11). There are presently one-hundred and twenty nine asserted claims, with sixty of those claims challenged in an IPR.

Most of the unchallenged claims share key limitations with the challenged claims. For example, the challenged claims in all four IPRs claim timecode generator elements, which the Petitions assert are unpatentable over certain prior art references. *See, e.g.*, Fisher Decl. Ex. D, at 37-38. Unchallenged claims in the patents subject to IPRs that contain a timecode and/or timestamp generator element include: '902 patent claims 9, 10, 13, and 21-23; all unchallenged claims of the '207 patent (claims 75-76, 91-92, and 98); and all unchallenged claims of the '444 patent (claims 28-29). D.I. 99-13, at 25:36-60, 26:18-32, 1:7-2:14 (IPR certificate); Ex. D.I. 99-16, at 49:1-31, 50:24-56, 51:12-14; D.I. 99-18, at 46:1-44. Similarly, for those patents that were not challenged in an IPR, most claims also have a timecode generator element, including: '814 patent, claims 5, 7, 8, 13, 16, 22, 23, 28, 32, 33, 40, 50-58, 60, 62, 63, and 65; '307 patent, claims, 24 and 27; and '605 patent, claims 2-6, 8, 10, 17, 18, 20, and 21. D.I. 99-14, at 24:15-20, 24:25-51, 25:5-6, 25:15-28, 26:3-11, 26:54-67, 27:33-45, 27:66-67, 1:8-2:48 (IPR Certificate), 2:51-56 (IPR Certificate), 3:1-8 (IPR Certificate), 4:4-9 (IPR Certificate); D.I. 99-15, at 2:1-4 (IPR Certificate), 2:31-37 (IPR Certificate); D.I. 99-16, at 43:54-44:18, 44:24-53, 44:60-62, 46:4-12, 46:16-31. The key art—U.S. Patent No. 6,825,875 ("Strub") and U.S. Patent No.

5,479,351 (“Woo”)—is asserted against those overlapping claim elements. D.I. 86, at Ex. B, Ex. C, and Ex. F. Thus, a decision on the claims challenged in the IPR is likely to be highly informative on the validity of the remaining asserted claims that were not challenged in the IPR.

III. Argument

A district court has the inherent power to control its own docket, including the power to stay proceedings before it. *See Clinton v. Jones*, 520 U.S. 681, 706 (1997); *Landis v. N. Am. Co.*, 299 U.S. 248, 254–55 (1936). Whether to stay proceedings pending review by the Patent and Trademark Office (“PTO”) of the validity of the patents at issue in the litigation is a matter committed to the district court’s discretion. *Destination Maternity Corp. v. Target Corp.*, 12 F. Supp. 3d 762, 766 (E.D. Pa. 2014) (citing *Cost Bros., Inc. v. Travelers Indemn. Co.*, 760 F.2d 58, 60 (3d Cir. 1985)); *see also Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1426–27 (Fed. Cir. 1988). “A stay is particularly justified when ‘the outcome of a PTO proceeding is likely to assist the court in determining patent validity or eliminate the need to try infringement issues.’” *British Telecomms. PLC v. IAC/InterActiveCorp*, No. 18-cv-366-WCB, 2019 WL 4740156, at *2 (D. Del. Sept. 27, 2019) (“BT”) (quoting *NFC Tech. LLC v. HTC Am., Inc.*, Case No. 2:13-cv-1058, 2015 WL 1069111, at *1 (E.D. Tex. Mar. 11, 2015)). “A court may decide to grant a motion to stay in order to avoid inconsistent results, narrow the issues, obtain guidance from the PTO, or simply to avoid the needless waste of judicial resources, especially if the evidence suggests that the patents-in-suit will not survive review.” *Destination Maternity*, 12 F. Supp. 3d at 766 (internal quotations omitted).

District courts typically consider three factors when determining whether to grant a stay pending IPR adjudication of the patent in suit: “(1) whether granting the stay will simplify the issues for trial; (2) the status of the litigation, particularly whether discovery is complete and a

trial date has been set; and (3) whether a stay would cause the non-movant to suffer undue prejudice from any delay, or allow the movant to gain a clear tactical advantage.” *BT*, 2019 WL 4740156, at *2 (quoting *Princeton Digit. Image Corp. v. Konami Digit. Ent. Inc.*, No. 12-cv-1461-LPS-CJB, 2014 WL 3819458, at *2 (D. Del. Jan. 15, 2014)).

Courts sometimes also consider a fourth factor—“whether a stay, or the denial thereof, will reduce the burden of litigation on the parties and on the court.” *Int’l Bus. Mach. Corp. v. Rakuten, Inc.*, No. 21-cv-461-GBW, 2022 WL 17848779, at *4 (D. Del. Dec. 22, 2022) (quoting *id.*); *Prolitec Inc. v. Scentair Techs., LLC*, No. 20-cv-984-WCB, 2023 WL 5037173, at *2 (D. Del. Aug. 8, 2023); *see also BT*, 2019 WL 4740156, at *2. Although this factor originally targeted stays pending the PTAB’s Covered Business Method (CBM) proceedings, “Congress’s desire to enhance the role of the PTO in deciding validity questions and to limit the burden of litigation on courts and parties was not restricted to CBM review proceedings” and has been applied to IPRs and *ex parte* reexaminations. *Prolitec*, 2023 WL 5037173, at *3; *see also BT*, 2019 WL 4740156, at *3.

A. A Stay Will Significantly Simplify the Case

A stay will significantly simplify the case for the courts and the parties. “The most important factor bearing on whether to grant a stay is whether the stay is likely to simplify the issues at trial.” *IOENGINE, LLC v. PayPal Holdings, Inc.*, No. 18-cv452-WCB, 2019 WL 3943058, at *8 (D. Del. Aug. 21, 2019). The PTAB has already instituted IPRs on three asserted patents and a fourth IPR is pending. *See generally* Fisher Decl. Ex. A, Ex. B, Ex. C, and Ex. H. “[A]fter the PTAB has instituted review proceedings, the parallel district court litigation ordinarily should be stayed.” *IOENGINE*. 2019 WL 3943058, at *4 (quoting *NFC*, 2015 WL 1069111, at *7).

Sixty of one-hundred and twenty-nine claims asserted in the litigation have been challenged in the IPR proceedings, of which forty one have reached the post-institution stage of the IPR. For claims challenged in the IPR, “the case will unquestionably become simpler” whether the PTAB finds those claims unpatentable or patentable. *BT*, 2019 WL 4740156, at *8. If those claims are found unpatentable, then nearly half the asserted claims in the litigation go away. Likewise, if the IPR proceeding results in one or more challenged claims being found patentable, then the “statutory estoppel provision, 35 U.S.C. § 315(e)(2), will bar the defendants from seeking to invalidate the claims that were included in the IPR on any ground that was raised in the IPR petition or could have been raised in that petition.” *Id.* “[T]he odds are high that the IPRs will reduce the number of claims at issue in this case.” *SITO Mobile R&D IP, LLC v. World Wrestling Ent., Inc.*, No. 21-cv-721-CFC, 2021 WL 7628181, at *1 (D. Del. Dec. 20, 2021).

Courts in this district have often held that “even when IPRs are instituted on fewer than all the asserted claims, the policies favoring simplification and the reduction of litigation burdens on the parties and the court are often applicable, particularly when the claims that are before the PTAB in an IPR are similar to those that are not.” *BT*, 2019 WL 4740156, at *7 (stayed when nine of eleven asserted claims of the patent-in-suit were challenged in an instituted IPR); *see also Helios Streaming, LLC v. Vudu, Inc.*, No. 19-cv-1792-CFC-SRF, 2021 WL 8155604, at *1-2 (D. Del. Aug. 5, 2021) (stayed when only one of the remaining eight patents-in-suit were challenged in instituted IPRs); *Ethicon LLC v. Intuitive Surgical, Inc.*, No. 17-cv-871-LPS, 2019 WL 1276029, at *1 (D. Del. Mar. 20, 2019) (stayed when “IPR proceedings have been instituted against six of the seven patents-in-suit.”); *SITO Mobile*, 2021 WL 7628181, at *1-2 (stayed when “[t]he IPRs cover seven of the 12 asserted patents” and “[t]he PTAB has instituted IPRs for

every claim of the seven patents in question for which post-grant review was sought.”); *Monterey Rsch., LLC v. Nanya Tech. Corp.*, No. 19-cv-2090, 2021 WL 6502552, at *1 n.1 (D. Del. June 25, 2021) (stayed when the IPRs covered 4 of 6 patents-in-suit).

The ’443 and ’902 patents are both the earliest issued, and the latest expiring, patents in this case. As such, the ’443 and ’902 patents would have the most significant impact on any consideration of damages. IPRs challenge all asserted claims of the ’443 patent and fourteen of twenty asserted claims of the ’902 patent. Thus, the IPRs will significantly simplify and streamline the consideration of these claims, which in turn will simplify and streamline any consideration of damages.

Additionally, most of the claims that have not been challenged in the IPRs contain numerous overlapping elements with the challenged claims. For example, as explained above (*supra* § II), all of the challenged claims have elements relating to a timecode generator. The claims that were not challenged have a claim element relating to “dropout repair or replacing remotely recorded audio data with local audio data.” *See* Fisher Decl. Ex. D, at 14; Ex. E, at 13; Ex. F, at 13. Many claims that have not been challenged in an IPR recite overlapping elements, such as the timecode generator elements that appear in over forty claims, which are central to the claims of the four IPR challenges. To illustrate this overlap, challenged claim 17 and unchallenged claim 75 of the ’207 patent are shown side-by-side.

	’207 Patent, Claim 17 (challenged in IPR3035-00232)	’207 Patent, Claim 75 (not challenged in an IPR)
Pre	17. At least one audio device wearable by a user for storing locally generated audio and transmitting the locally generated audio to a remote device,	75. A recording system, comprising:
A	the remote device including at least one of a receiver, a recorder , a mixer, and	a remote device, the remote device including at least one of a receiver and a

	'207 Patent, Claim 17 (challenged in IPR3035-00232)	'207 Patent, Claim 75 (not challenged in an IPR)
	combination thereof,	recorder; and
B	the at least one audio device comprising:	an audio device , including
C	a wireless transmitter,	a wireless transmitter,
D	an audio input port configured to couple to an audio input device to receive the locally generated audio;	
E	a memory;	a memory,
F	a local timecode generator operable to generate a local timecode;	a local timecode generator operable to generate a local timecode;
D'		an audio input port configured to couple to an audio input device to receive the locally generated audio, and
H	a control unit coupled to the wireless transmitter, the audio input port, the memory, and the local timecode generator, the control unit operable to:	a control unit coupled to the wireless transmitter, the memory, the local timecode generator and the audio input port, the control unit being operable to
I	(i) receive a master timecode from a master timecode generator and jam synchronize the local timecode generator to the master timecode generator using the master timecode,	(i) receive a master timecode from a master timecode generator and jam synchronize the local timecode generator to the master timecode generator using the master timecode,
J	(ii) transmit the locally generated audio to the remote device via the wireless transmitter; and	(ii) transmit the locally generated audio to the remote device via the wireless transmitter,
K	(iii) store the locally generated audio in the memory as audio data; and	(iii) store the locally generated audio in the memory as audio data; and
L	(iv) stamp at least a portion of the audio data with the local timecode.	(iv) stamp at least a portion of the audio data with the local timecode,
M		the audio data being retrievable from the memory post-recording, wherein the remote device is configured to permit an operator to correct for dropouts or interference in the locally generated audio transmitted to the remote device using the audio data retrieved from the memory post-recording.

Claims 17 and 75 share all but one claim element, element M (in red), which relates to dropout repair (in red). The other difference is merely the ordering of claim 17, element D, and claim 75, element D', but the order does not impact that term's meaning.

Because of shared claim scope, arguments concerning these claims will be impacted by admissions, evidence, and findings in the IPR proceedings, meaning that one-hundred and nine of the one-hundred and twenty-nine asserted claims in this litigation is likely to be impacted by the outcome of the IPRs. The patents at issue are all part of the same family, and Plaintiff's "statements to the PTO during the IPRs will become part of the various patents' file histories, thus helping to clarify and perhaps narrow the scope of the remaining claims." *SITO Mobile*, 2021 WL 7628181, at *1. Thus, "any decisions cancelling claims from the first three patents at issue will doubtlessly simplify the case before this court," which strongly favors a stay. *See Dental Monitoring v. Get-Grin Inc.*, No. 22-cv-647-WCB, 2024 WL 1603403, at *6 (D. Del. Apr. 9, 2024).

B. The Stage of Litigation Favors a Stay

The stage of the case, the second factor in the stay analysis, also favors a stay. Trial has not been scheduled, the parties have yet to begin expert discovery, neither party has taken any fact depositions, and the claim construction hearing has not yet occurred (D.I. 60, 132; Fisher Decl., at ¶ 13). *See Helios*, 2021 WL 8155604, at *3 ("In this case, fact discovery remains ongoing, no depositions have been taken, expert discovery has not yet begun . . .") "Although this case is not 'in its infancy,' a stay is warranted because 'the bulk of the expenses that the parties would incur ... is still in the future.'" *Id.* *3 (quoting *IOENGINE*, 2019 WL 3943058, at *5); *see also NFC*, 2015 WL 1069111, at *3 ("[I]t appears likely that the bulk of the expenses that the parties would incur in pretrial work and trial preparation are still in the future.").

Courts in this district and others have found stays warranted for much more advanced cases, including after parties have finished expert discovery and the court has issued a claim construction decision. *Consumeron, LLC v. MapleBear Inc.*, No. 21-cv-1147-GBW-MPT, 2023

WL 3434002, at *2 (D. Del. May 12, 2023). In fact, courts in this district have stayed cases pending IPRs mere months from trial dates. *See, e.g., Prolitec*, 2023 WL 5037173, at *7 (stay granted seven months before scheduled trial wherein some of the pretrial proceedings in this case have been completed); *see also TC Tech. LLC v. Sprint Corp.*, No. 16-cv-153-WCB, 2021 WL 4521045, at *7 (D. Del. Oct. 4, 2021) (stay granted less than two months before trial); *British Telecomms. PLC v. IAC/InterActiveCorp*, No. 18-cv-366-WCB, 2020 WL 5517283, at *5 (D. Del. Sept. 11, 2020) (stay granted less than three months before trial); *AGIS Software Dev. LLC v. Google LLC*, No. 19-cv-361-JRG, 2021 WL 465424, at *3 (E.D. Tex. Feb. 9, 2021) (stay granted three months before trial); *see also Ramot At Tel Aviv Univ. Ltd. v. Cisco Sys., Inc.*, No. 19-cv-225-JRG, 2021 WL 121154, at *2 (E.D. Tex. Jan. 13, 2021) (stay granted six weeks before trial); *CyWee Grp. Ltd. v. Samsung Elec. Co.*, No. 17-cv-140-WCB-RSP, 2019 WL 11023976, at *6–7 (E.D. Tex. Feb. 14, 2019) (stay granted three months before trial); *Ericsson Inc. v. TCL Commc'n Tech. Holdings, Ltd.*, No. 15-cv-11-RSP, 2016 WL 1162162, at *2 (E.D. Tex. Mar. 23, 2016) (stay granted within two months of trial). Staying this case at its current stage would be keeping with the common operation of Courts in this district.

The Court should not be dissuaded from staying the case based on the parties' upcoming submission of their joint claim construction brief (D.I. 139), or their exchange of documents (Fisher Decl., at ¶ 13 and contentions (D.I. 79, 86, and 103). *See RetailMeNot, Inc. v. Honey Sci. LLC*, No. 18-937-CFC-MPT, 2020 WL 373341, at *6 (D. Del. Jan. 23, 2020) (finding that the stage of the litigation weighed in favor of a stay, even though the claim construction Report and Recommendation was pending and depositions were continuing). The *RetailMeNot* decision explained that the stay would “avoid further fact discovery, the entirety of expert discovery and

associated expert reports, filing and responding to dispositive and other pretrial motions,” and otherwise preparing for and participating in trial. *Id.*

A similar rationale apply here. Costly and time-consuming fact depositions have not begun, expert discovery has yet to begin, and the Court has yet to issue its claim construction recommendation. Therefore, this case is at an “efficient stopping point, and any weight given to this factor is outweighed by the likelihood that the issues for trial will be simplified by a stay.” *Ethicon*, 2019 WL 1276029, at *2. “Because the PTAB’s final written decisions in the IPR proceedings are likely to substantially narrow the scope of the cases, many of the expenses incurred” by the parties “will be reduced and/or eliminated if a stay is entered.” *Helios*, 2021 WL 8155604, at *3. The reduced burden on the parties and the courts favors a stay.

C. A Stay Would Neither Unduly Prejudice nor Tactically Disadvantage Plaintiffs

In evaluating whether undue prejudice or a clear tactical advantage exists, courts in this district typically examine four sub-factors: (1) the timing of the request for review; (2) the timing of the request for a stay; (3) the status of the review proceedings; and (4) the relationship of the parties. *IOENGINE*, 2019 WL 3943058, at *5 (collecting cases). “The prejudice factor, unlike the others, cuts in favor of denying a stay, but only modestly.” *Dental Monitoring*, 2024 WL 1603403, at *8 (D. Del. Apr. 9, 2024).

Defendants acted with reasonable dispatch in filing their IPR petitions. In its Complaint, Plaintiff asserted six patents and one-hundred and fourteen claims. When Plaintiff refused to narrow the number of claims in this dispute, Defendant moved to compel narrowing of the litigation on November 4, 2024. D.I. 90. Upon filing the Amended Complaint November 13, 2024, Plaintiff had asserted seven patents and one-hundred and thirty-nine claims against Defendants. D.I. 79, 99. In view of the significant number of asserted patents and claims, the

filing of the three IPR petitions challenging the '443, '902, and '207 patents on the one-year statutory deadline was reasonable. *See Ethicon*, 2019 WL 1276029, at *3 (finding Plaintiff's "delay in narrowing its asserted claims weigh in favor of [Defendant]"). Moreover, Plaintiff did not add the '444 patent, which issued July 30, 2024, until filing its Amended Complaint several months later in November 13, 2024. Defendants promptly filed their IPR petition challenging the '444 patent less than three months later on February 7, 2025. Because it was the last filed IPR, the '444 patent IPR will likely determine the length of a stay. Plaintiff bears nearly all the responsibility for the timing of the '444 patent IPR by its decision to add the late-issuing '444 patent to this litigation and delaying its addition to the case by three and a half months—from July 30, 2024 to November 13, 2024—which is more time elapsed than from the '444 patents addition to this litigation to Defendants' IPR filing. Given this delay, Plaintiff's cannot now credibly allege that a stay would prejudice Plaintiffs.

Immediately following the institution decisions of June 16, 2025, Defendants informed Plaintiff of their intention to move for a stay on June 20, 2025 (Fisher Decl. Ex. I) and promptly moved for this stay the following week after meeting and conferring with Plaintiff on June 25, 2025. (Fisher Decl., at ¶ 13). Thus, the timing of the Defendants' stay request supports grant of a stay. *See, e.g., Consumeron*, 2023 WL 3434002, at *2 (finding that the stay motion filed within three weeks of the institution decision favored a stay); *Ethicon*, 2019 WL 1276029, at *2 (Defendants "move[] to stay within days of receiving the PTAB's first wave of institution decisions" favored a stay).

As explained above (*supra* § II), there is a high probability that some or all claims of the '443, '902, and '207 patent will be found unpatentable, thereby streamlining this case significantly. Additionally, if any claims are not found unpatentable, Defendants' will be subject

to statutory estoppel. As explained above (*infra* § III. A), the outcome of the IPR decisions will directly impact sixty of the one-hundred and twenty-nine asserted claims in this litigation.

Instituted IPRs challenge all asserted claims of the '443 patent and fourteen of twenty asserted claims of the '902 patent. The '443 and '902 patents are both the earliest issued, and with 2028 expiration dates, the latest expiring patents in this case, and will have most significant impact on any consideration of damages. Thus, the outcome of these IPRs may figure significantly into this case. *Supra* § II.

Because of the significant overlap of claim elements between challenged and unchallenged claims, the impact of the IPR proceedings is expected to potentially impact most unchallenged claims. Thus, the IPR outcomes will weigh in the Court's consideration of one hundred and seven of one-hundred and twenty-nine challenged claims. "[T]he IPR proceedings are already underway and, while the case will be delayed" by a stay "there is a significant likelihood that the IPRs would significantly impact this litigation in any event." *Consumeron*, 2023 WL 3434002, at *2.

Despite this case pending since late-2023, Plaintiff has not moved for a preliminary injunction. *See Ethicon*, 2019 WL 1276029, at *3 (Plaintiff's "decision not to seek a preliminary injunction" weighed against finding prejudice to the plaintiff.). The remaining patents-in-suit expire next month, on July 14, 2025. *Supra* § II. This fact further supports a stay because any potential damages related to these patents will cease accruing long before the litigation is resolved, whether or not the case is stayed. The totality of circumstances indicate that Plaintiff will not suffer undue prejudice if the case is stayed.

D. A Stay Will Decrease the Burdens of the Parties and the Court

A stay will substantially reduce the burden of the Court and the parties. As explained above (*supra* §§ III. A, B), many of the resources to be expended with respect to the '443, '902, '207, and '444 patents will be mooted by the IPR proceeding. And many issues relating to most of the unchallenged claims will also be addressed in the IPR proceedings. If the case continues concurrently with the IPR trials, however, the Court and the parties will face a substantial burden addressing issues that may be mooted by the IPR.

A substantial amount of work and expense is still needed in this case: (1) fact witness depositions have not begun (Fisher Decl., at ¶ 13.); (2) opening expert reports regarding infringement and invalidity for all the Asserted Patents are due September 10, 2025 through October 29, 2025, (3) the due dates for pre-trial disclosures and *motions in limine* have been set, and (4) the date for trial has not been set. D.I. 60. A significant amount of work would take place before the one-year deadline for the PTAB to issue its final written decisions on the '443, '902, and '207 patents, and the projected final written decision date for the IPR of the '444 patent.

“Although the three-factor test ... informs the court’s decision whether to issue a stay pending post-grant proceedings, that test merely provides general guidance; it is not a rigid template for decision.” *Prolitec*, 2023 WL 5037173, at *4 (citing *Murata Mach. USA v. Daifuku Co., Ltd.*, 830 F.3d 1357, 1362 (Fed. Cir. 2016)). This Court has the “discretionary prerogative to balance considerations beyond those captured by the three-factor stay test.” *Id.* The steps the parties have yet to complete here, including “completing discovery, preparing expert reports, filing and responding to pretrial motions, preparing for trial, going through the trial process, and engaging in post-trial motions practice” are “the most burdensome stages of the case.”

IOENGINE, 2019 WL 3943058, at *5 (citing *CyWee*, 2019 WL 11023976, at *6; *Smartflash LLC v. Apple Inc.*, 621 F. App'x 995, 1005 (Fed. Cir. 2015) (holding that the district court abused its discretion when it denied a stay prior to trial, because “[d]espite the substantial time and effort already spent in this case, the most burdensome task is yet to come.”)); *see also SITO Mobile*, 2021 WL 7628181, at *2; *Helios*, 2021 WL 8155604, at *3; *RetailMeNot*, 2020 WL 373341, at *8.

Moving forward with the case while the IPRs are pending before the PTAB will invariably lead to unnecessarily duplicative efforts for both the challenged patents and the unchallenged patents. Many of these efforts are likely to be obviated by final written decisions for the '443, '902, '207, and '444 patents. Thus, a stay will significantly reduce the burden and costs to the Court and the parties.

IV. Conclusion

For the foregoing reasons, the Court should enter an order staying the proceedings of this case pending the result of the IPRs instituted by the PTAB on the '443, '902, and '207 patents, as well as the IPR on the '444 patent, including any appeals therefrom.

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