

UNITED STATES DISTRICT COURT
EASTERN DISTRICT OF TEXAS
MARSHALL DIVISION

GENGHISCOMM HOLDINGS, LLC

Plaintiff,

v.

SAMSUNG ELECTRONICS AMERICA,
INC.,

Defendant

Case No. 2:24-cv-00901-RWS-RSP

**PLAINTIFF'S OPPOSITION TO DEFENDANT'S MOTION TO STAY BEFORE
INSTITUTION OF INTER PARTES REVIEW (DKT. NO. 27) AND PLAINTIFF'S
REQUEST FOR FEES**

I. Introduction and Summary

Samsung's requested IPR has not been instituted. *See* IPR 2025-00899. On May 27, 2025, after Samsung's Motion, the PTAB issued a Notice of Filing Date Accorded in the IPR. Any institution decision (on the merits) in the IPR is expected around November 27, 2025. In light of the June 2026 trial date in this case, the PTAB may issue a discretionary denial before that, likely around September 27, 2025. The 11,431,386 patent is also not the subject of any other post-grant proceeding at the USPTO.

This Court has issued guidance that it will not stay its proceedings before IPRs are instituted. For example, in *Scorpcast, LLC v. Boutique Media Pty Ltd.*, 2020 WL 7631162, at *3 (E.D. Tex. Dec. 22, 2020), this Court explained: "The 'universal practice' in this District, as well as the practice of most district courts, is to deny a motion for stay when the Board has not yet acted on a petition for IPR." *SB IP Holdings, LLC V. Vivint, Inc.*, Civil Action 4:21-CV-00912 Dkt. 59 (E.D. Tex. April 6, 2023) explained: "When a motion to stay is filed before the PTAB institutes post-grant review, courts in this district typically refrain from ruling on the motion pending action by the PTAB or deny the motion without prejudice to refile in the event that the PTAB institutes a proceeding."

Although plaintiff provided these cases to Samsung before its filing, Samsung filed its motion to stay but did not address the cases or acknowledge this Court's repeated and clear guidance. Ex. 1. In the meet and confer and its motion, Samsung was unable to identify any case in which a Court in this District granted the relief that Samsung's motion requests. *Id.*

On May 16-19, 2025, in a related case between the same parties, case no. 2:24-cv-00242, Samsung filed a similar pre-institution motion to stay and this Court *sue sponte* denied Samsung's motion within one business day after Samsung filed it, explaining again at Dkt. No. 50:

The “universal practice” in this District, as well as the practice of most district courts, is to deny a motion for stay when the Patent Trial and Appeal Board has not yet acted on a petition for inter partes review. *Trover*, 2015 WL 1069179, at *6 (collecting cases); *see also Peloton Interactive*, 2019 WL 3826051, at *2 (citation omitted). Here, the Board has not instituted *inter partes* review on several of the asserted patents in this case, with these patents (*e.g.*, the ’842 Patent1) also not being the subject of any other post-grant proceeding. *See* Dkt. No. 49 at 2. Accordingly, the Court DENIES Samsung’s Motion as premature.

After this Court’s Order, plaintiff asked Samsung to withdraw the present motion for a pre-institution stay without requiring the Court or the Plaintiff and to undertake the time and expense of filing an opposition, but Samsung declined. Ex. 1.

Including this Court’s recent Order in the related case, Samsung itself has repeatedly requested pre-institution stays of cases in this Court and this Court has repeatedly denied Samsung’s requests for pre-institution stay 13 times (or more). For example:

1. *Resonant Systems, Inc. v. Samsung*, case no. 2:22-cv-00423-JRG, Dkt. No. 56 (E.D. Tex. August 9, 2023) (“Indeed, this Court has a consistent practice of denying motions to stay when the PTAB has yet to institute post-grant proceedings.”)
2. *Polaris Power Techs., LLC v. Samsung*, case no. 2:22-CV-00469-JRG, 2023 WL 12065780, at *1 (E.D. Tex. Aug. 18, 2023) (“this Court has a consistent practice of denying motions to stay when the PTAB has yet to institute post-grant proceedings”).
3. *Cardware Inc. v. Samsung*, case no. 2:22-cv-00141-JRG-RSP, Dkt. No. 64 (E.D. Tex. Feb. 16, 2023) ((citing *Trover Group, Inc. v. Dedicated Micros USA*, 2015 WL 1069179, at *6 (E.D. Tex. Mar. 11, 2015) (“In this district, that is not just the majority rule; it is the universal practice.”)).
4. *California Institute of Technology v. Samsung*, case no. 2:21-cv-00446-JRG, Dkt. No. 108 (E.D. Tex. Jan. 20, 2023) (“it is the Court’s established policy that motions to stay pending IPR proceedings that have not yet been instituted are inherently premature.”)
5. *Nanoco Techs. Ltd. v. Samsung*, case no. 2:20-CV-00038-JRG, Dkt. No. 63 (Jan. 8, 2021) (“this Court has a consistent practice of denying motions to stay when the PTAB has yet to institute post-grant proceedings”)
6. *Clear Imaging Rsch., LLC v. Samsung*, No. 2:19-CV-00326-JRG, 2020 WL 13886381, at *2 (E.D. Tex. Dec. 21, 2020) (“It is the Court's established

policy that motions to stay pending IPR proceedings that have not been instituted are inherently premature. At this nascent stage—before the PTAB has made any decision as to institution of the Petitions—it is impossible for the Court to determine ‘whether the stay will likely result in simplifying the case before the court.’”)

7. *Acorn Semi, LLC v. Samsung*, case no. 2:19-CV-00347-JRG, 2020 WL 10284981, at *1 (E.D. Tex. Sept. 14, 2020) (“this Court has a consistent practice of denying motions to stay when the PTAB has yet to institute post-grant proceedings.”)
8. *Snik LLC v. Samsung*, case no. 2:19-CV-00387-JRG, 2020 WL 9076438, at *2 (E.D. Tex. Oct. 5, 2020) (“this Court has a consistent practice of denying motions to stay when the PTAB has yet to institute post-grant proceedings.”)
9. *Solas Oled Ltd v. Samsung*, case no. 2:19-CV-00152-JRG, Dkt. No. 69 (Feb. 4, 2020) (“It is the Court’s established practice to consider that motions to stay pending IPR proceedings that have not been instituted are inherently premature and should be denied as such.”)
10. *Barkan Wireless IP Holdings, L.P. v. Samsung*, case no. 2:18-CV-00028-JRG, 2019 WL 8647996, at *2 (E.D. Tex. Mar. 15, 2019) (“this Court has a consistent practice of denying motions to stay when the PTAB has yet to institute post-grant proceedings.”)
11. *Polaris PowerLED Techs., LLC v. Samsung Elecs. Am., Inc.*, case no. 2:17-CV-00715-JRG, 2018 WL 11508221, at *1 (E.D. Tex. Sept. 5, 2018) (“this Court has a consistent practice of denying motions to stay when the PTAB has yet to institute post-grant proceedings.”)
12. *Image Processing Techs., LLC v. Samsung*, case no. 2:16-CV-505-JRG, 2017 WL 10185855, at *1 (E.D. Tex. Feb. 17, 2017) (“a stay of these proceedings in advance of the PTAB’s decision on whether or not to grant the petitions for *inter partes* review should be denied”)

Samsung’s motion to stay should be denied. Further, given this Court’s repeated guidance, Samsung should not have required the Court and the Plaintiff to spend money or time responding to Samsung’s motion for a pre-institution stay.¹ Plaintiff is concerned that Samsung had no

¹ During the meet and confer process, the only justification Samsung offered for filing its motion in conflict with the Court’s guidance was that “regardless of whether the Court is inclined to stay this particular case before an institution decision, the timing of the motion is a factor that the court will consider in a renewed, post-institution motion. *See, e.g., E-Watch, Inc. v. Apple Inc.*, 2015 WL 129151668 [sic] (E.D. Tex. Mar. 25, 2015).” Ex. 1. Plaintiff responded by offering

reasonable basis for filing its motion other than to increase the cost and burden of this case.

Plaintiff therefore also respectfully requests an award of costs and fees for Samsung requiring plaintiff to respond to this motion.

II. Facts

Samsung's motion does not tell the Court that the PTAB has not yet been instituted. *See* IPR2025-00899.

Samsung's Motion also does not mention the USPTO's new 2025 process for discretionary denials of IPR Petitions.² Because the PTAB issued a Notice of Filing Date in the IPR on May 27, patent owner's PTAB brief requesting discretionary denial is not due until July 28. The PTAB's decision on discretionary denial considerations is expected September 27. Any institution decision (on the merits) would be expected November 27, 2025. Patent Owner believes that non-institution of Samsung's IPR is likely given that, if instituted, the PTAB would not issue any final written decision until, at best, November 27, 2026, about six months after the trial date in this case (plus additional time for Director review and appeals).

III. Argument

A. None of Samsung's Cited Cases Are Instances in Which the Courts in this District Granted the Relief that Samsung Seeks Here

Samsung's motion represents that "courts often grant stays *before* institution, recognizing

this agreement: "if the timing of an initial motion to stay is truly Samsung's concern, to avoid the waste of money and time on this frivolous motion for a pre-institution stay, we are willing to reach a reasonable agreement on that issue (e.g. if IPRs are instituted and Samsung brings a motion to stay at that time, that motion can be treated as a 'renewed' motion and the Court can assign the appropriate weight to the timing of Samsung bringing up the idea of filing a motion to stay now per-institution). We believe that this resolves the issue and the need for any motion." Ex.1. Samsung declined and instead filed its motion.

² *See, e.g.* March 26, 2025 Interim Process for PTAB Workload Management memorandum; <https://www.uspto.gov/sites/default/files/documents/InterimProcesses-PTABWorkloadMgmt-20250326.pdf>

that even the possibility of simplification justifies a pause,” citing three California cases. Dkt. 27, p. 2 (emphasis in original).

Samsung’s motion also represents: “This Court has granted stays pending post-grant proceedings including IPRs in circumstances similar to this case.” *Id.* p. 3. In support, Samsung’s Motion cites only a 2006 case from *before* the 2012 creation of the PTAB. Its holding from Judge Craven was limited to the “particular circumstances of this case.” *EchoStar Techs. Corp. v. TiVo, Inc.*, No. 5:05 CV 81 DF, 2006 WL 2501494, at *4 (E.D. Tex. July 14, 2006). In 2012, the AIA introduced the IPR (inter partes review), and replaced the previously existing inter partes reexamination. This case is inapposite.

B. The Factors that Courts Consider All Disfavor Stays

This Court routinely denies pre-institution motions to stay. *See, e.g., GenghisComm v. Samsung*, case no. 2:24-cv-00242, Dkt. No. 50 (May 19, 2025); *Cardware Inc. v. Samsung Elecs. Co., Ltd.*, No. 2:22- CV-00141-JRG-RSP, Dkt. 64 (E.D. Tex. Feb. 16, 2023); *Image Processing Techs., LLC v. LG Elecs. Inc.*, No. 2:22-cv-00077-JRGRSP, Dkt. 41 (E.D. Tex. Dec. 15, 2022); *United Services Automobile Assoc. v. Truist Bank*, No. 2:22-cv-00291-JRG-RSP, Dkt. 70 (E.D. Tex. Mar. 22, 2023). However, if the Court undertakes a more detailed review of the factors, none favor a stay.

1. A Stay Would Unfairly Prejudice Plaintiff And Present a Clear Tactical Disadvantage To Plaintiff

GenghisComm filed this case in November 2024. This Court set a trial date in June 2026. Samsung chose to wait to file its IPR until April 2025 to file its requested IPR and a decision on any IPR, if instituted, would not issue until November 27, 2026 (plus Director review and appeals).

Samsung now wants this Court to stay this case, and take the Court’s Ordered trial date in

June 2026 off calendar, so that the PTAB will not discretionarily deny its IPR, which it is likely to do because Samsung chose to wait so long before filing it.

Samsung's argues that Plaintiff GenghisComm cannot be prejudiced by a stay simply it it does not compete in the market for manufacturing or selling smartphones and tablets. But removing this Court's June 2026 trial date would be highly and unfairly prejudicial to plaintiff, both at the PTAB and in this Court. This Court has repeatedly recognized that a patent holder has "an interest in the timely enforcement of its patent right." *Lennon Image Techs., LLC v. Macy's Retail Holdings, Inc.*, No. 2:13-CV-00235-JRG, 2014 WL 4652117, at *2 (E.D. Tex. Sept. 18, 2014) ("The Court places much importance on proceeding to trial on the date set forth in the scheduling order, unless extraordinary circumstances arise. The Court does not believe that reexamination or the possibility of an IPR qualifies as an extraordinary circumstance in this case."); *Trover Grp., Inc. v. Dedicated Micros USA*, No. 2:13-CV-1047-WCB, 2015 WL 1069179, at *2 (E.D. Tex. Mar. 11, 2015) ("the plaintiffs' claim of prejudice is entitled to consideration, as is the general right of patent owners to timely enforcement of their patent rights"); *Realtime Data LLC v. Actian Corporation*, No. 6:15-CV-463-RWS-JDL, 2016 WL 3277259, at *2 (E.D. Tex. June 14, 2016) ("The fact that Realtime is a non-practicing entity and is merely pursuing monetary damages would not preclude Realtime from experiencing prejudice if the Court granted Defendants' motion to stay.")

GenghisComm would thus "would certainly be prejudiced by a delay in its ability to vindicate its patent rights caused be a stay. *Clear Imaging Rsch., LLC v. Samsung Elecs. Co.*, No. 2:19-CV-00326-JRG, 2020 WL 13886381, at *1 (E.D. Tex. Dec. 21, 2020). If the PTAB denies institution, this case would be needlessly delayed for months or years. If the IPRs are instituted, final written decisions would not be expected until well after the June 2026 trial in this case.

2. A Stay Will Not Simplify The Issues In Question or Trial of This Case

All of Samsung's arguments regarding purported issue simplification fail for one reason—the PTAB has not yet acted on any of its pending IPR petitions. That is because at this nascent stage of the PTAB proceedings, it is impossible for the Court to determine “whether the stay will likely result in simplifying the case before the court.” *Clear Imaging Rsch., LLC v. Samsung Elecs. Co.*, No. 2:19-CV-00326-JRG, 2020 WL 13886381, at *2 (E.D. Tex. Dec. 21, 2020). “Indeed, if the PTAB denies institution of the IPRs, there will be no simplification of the case before the Court at all.” *Viavi Sols. Inc. v. Zhejiang Crystal-Optech Co.*, No. 2:21-CV-00378-JRG, 2022 WL 16856099, at *5 (E.D. Tex. Nov. 10, 2022) “It is the Court's established practice to consider that motions to stay pending IPR proceedings which have not been instituted are inherently premature and should be denied as such.”) Any simplification of the issues is speculative at best. Samsung's motion to stay should be denied for this reason alone.³

3. Discovery Is Well Underway and A Trial Date Has Been Set in June 2026

On March 3, 2025, this Court entered a Docket Control Order setting a trial date of June 15, 2026. Dkt. No. 22.

On March 27, 2025, Samsung served its invalidity contentions in this case. Although only one patent is at issue in this specific case, Samsung's cover pleading was 43 pages. Samsung also produced nine purported invalidity claim charts extending 1,617 pages. GenghisComm believes that Samsung likely spent over \$1 million on its invalidity contentions alone.

³ In the first part of its first argument (Dkt. 27, p. 3), Samsung relies on *Village Green Techs., LLC v. Samsung Elecs. Co.*, No. 2:22-CV-00099-JRG, 2023 WL 416419, at *3 (E.D. Tex. Jan. 25, 2023), a case in which a stay was granted *after* IPRs on all claims have been instituted on by the PTAB.

Discovery in this case is well underway and the parties are working on it essentially everyday. For example, Samsung has responded to nine interrogatories. GenghisComm has answered at least nine interrogatories in this case. It is difficult to tell how many documents Samsung has produced specific to this case (compared to the related case 2:24-cv-00242) although Samsung has produced over 750,000 pages across both cases.

IV. Conclusion

Samsung's motion to stay should be denied. Given the Court's repeated guidance on its "universal practice," Plaintiff also respectfully requests an award of costs and fees for Samsung requiring plaintiff to respond to this motion.

Date: May 29, 2025

Respectfully submitted,

By: /s/ Alison Aubry Richards

Alison Aubry Richards

(IL Bar # 6285669, *also admitted in ED Texas*)

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CERTIFICATE OF SERVICE

I hereby certify that on May 29, 2025, the foregoing was electronically filed with the CM/ECF system, which will send a notification of such filing to all counsel of record.

/s/ Alison Aubry Richards