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UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA

BRIGHTEX BIO-PHOTONICS, LLC,

Plaintiff,

v.

L'OREAL USA, INC.,

Defendant.

Case No. 3:24-cv-07919-JCS

**DEFENDANT'S NOTICE OF MOTION
AND MOTION TO STAY PENDING
INTER PARTES REVIEW**

Date: July 16, 2025
Time: 9:30 a.m.
Location: Zoom
Judge: Hon. Joseph C. Spero

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8 H.R. Rep. No. 112-98 3

NOTICE OF MOTION AND MOTION

PLEASE TAKE NOTICE that on July 16, 2025, at 9:30 a.m., by Zoom in the Courtroom of the Honorable Joseph C. Spero, Courtroom D, 15th Floor, 450 Golden Gate Avenue, CA 94102, Defendant L’Oreal USA, Inc. (“L’Oreal”), will move to stay this case until the U.S. Patent and Trademark Office (“PTO”) determines the validity of the patent claims of U.S. Patent No. 9,542,595 (the “’595 Patent”) asserted by Brightex Bio-Photonics, LLC (“Brightex”). A proposed order is also being lodged for the Court’s consideration. Brightex has indicated that it opposes the motion.

MEMORANDUM OF POINTS AND AUTHORITIES

I. INTRODUCTION

Congress created *inter partes* reviews (“IPRs”) to provide a cost-effective, streamlined process for the PTO to reconsider and cancel invalid patent claims, and as an alternative to resource-intensive district court litigation. Courts in this district consider three primary factors in deciding whether to stay a case pending IPR: (1) the stage of discovery and proximity of trial; (2) whether the stay would likely simplify the issues; and (3) whether the stay would unduly prejudice the nonmoving party.

All three factors warrant a stay here. Discovery is at an early stage with the claim construction hearing scheduled for October 29, 2025 (Dkt. 34), and all other dates to follow a claim construction decision. The IPR is highly likely to simplify the issues. L’Oreal has filed an IPR against all asserted claims. If the PTO invalidates any of the asserted claims, which is likely, the scope of the case will be narrowed. Even if some claims survive the IPR proceeding, this case would be simplified because (a) if there is a final written decision, L’Oreal will be estopped from presenting certain invalidity arguments, and (b) Brightex’s arguments in the IPR and any claim construction issues addressed by the PTO would aid this Court in performing its own claim construction analysis. Finally, a stay would not cause undue prejudice to Brightex. Brightex cannot show it would be prejudiced by having to wait for legal or equitable relief. Brightex is not claiming irreparable harm or even seeking equitable relief. Regarding monetary relief, the Complaint seeks royalty damages, pre- and post-judgment interests and costs, enhanced damages and attorneys’ fees, and post-judgment royalties. If Brightex is found to be

1 entitled to any compensation, which is unlikely, monetary damages will be sufficient to address any
2 delay.

3 Courts in this district routinely stay patent cases pending IPRs on the asserted patents. And this
4 Court and others often do so without waiting for the PTO's institution decision. Accordingly, the Court
5 should stay this case during the pendency of the IPR proceedings.

6 **II. FACTUAL BACKGROUND**

7 **A. This Case Currently Involves One Patent**

8 This is a patent infringement case currently involving one patent, with a pending appeal on
9 a second patent. On November 12, 2024, Brightex filed its Complaint, which accused L'Oreal of
10 infringing two patents, the '595 Patent and U.S. Patent No. 9,842,358 ("the '358 Patent"). Dkt. 1.

11 On January 24, 2025, L'Oreal filed a Motion to Dismiss the '358 Patent under Fed. R. Civ.
12 P. 12(b)(6) because it is directed to a patent ineligible subject matter under 35 U.S.C. § 101. Dkt.
13 25. The court granted L'Oreal's Motion to Dismiss on March 6, 2025, effectively removing the
14 '358 Patent from this case. Dkt. 32.

15 On March 27, 2025, Brightex filed a Motion for Entry of Judgment that sought a final
16 judgment on the dismissal of the '358 Patent. Dkt. 37. The court granted that motion on May 7,
17 2025. Dkt. 44. Brightex then filed an appeal on the Motion to Dismiss the '358 Patent with the
18 Federal Circuit on May 28, 2025, which is currently pending before the Federal Circuit. Dkt. 48.

19 The case is in its early stages. The Court's Patent Case Management and Pretrial Order
20 (Dkt. 34) has scheduled claim construction briefing this summer, with a claim construction hearing
21 for October 29, 2025. The remaining schedule is set based on a claim construction decision.

22 **B. L'Oreal Has Filed an IPR Petition on the Asserted Patent**

23 An IPR is a proceeding for challenging the validity of an issued patent at the PTO. 35
24 U.S.C. §§ 311-319. To initiate an IPR, a party files a petition requesting that the PTO cancel one
25 or more claims of a patent under 35 U.S.C. § 102 (lack of novelty) or 35 U.S.C. § 103
26 (obviousness) based on prior-art patents and printed publications. 35 U.S.C. § 311(b).

On May 12, 2025, L’Oreal filed an IPR petition against the ’595 patent.¹ See attachment A; Dkt. 47. The IPR explains why the claims of the ’595 patent are invalid in light of prior art, including prior art not considered by the PTO in the original examination. L’Oreal has stipulated that if the IPR is instituted, it will not pursue any invalidity grounds in this litigation that are part of the IPR. Dkt. 47. Because the PTAB must decide whether to institute an IPR within six months of a filing date, its institution decision will issue around November 2025.

III. LEGAL STANDARD

Congress established IPRs to provide “a more efficient system for challenging patents that should not have issued” and to reduce “unwarranted litigation costs.” H.R. Rep. No. 112-98, at 39-40 (2011). The Federal Circuit’s affirmance of a PTAB decision canceling a patent “has an immediate issue-preclusive effect on any pending or co-pending actions involving the patent,” *XY, LLC v. Trans Ova Genetics, L.C.*, 890 F.3d 1282, 1294 (Fed. Cir. 2018), and the Federal Circuit will vacate a district court’s judgment in the patentee’s favor once it affirms an IPR decision invalidating a patent, *Soverain Software LLC v. Victoria’s Secret Direct Brand Mgmt., LLC*, 778 F.3d 1311, 1313, 1320 (Fed. Cir. 2015).

District courts have inherent power to stay a patent case in view of a co-pending IPR. *Murata Mach. USA v. Daifuku Co.*, 830 F.3d 1357, 1361 (Fed. Cir. 2016). There is “a liberal policy in favor of granting motions to stay” in view of pending PTO proceedings. *Finjan, Inc. v. Symantec Corp.*, 139 F. Supp. 3d 1032, 1035 (N.D. Cal 2015) (internal quotes and citation omitted). Courts in this district routinely stay patent cases pending an IPR, even where institution of the IPR is still pending. *See, e.g., Brixham Sols. Ltd. v. Juniper Networks, Inc.*, No. 13-CV-00616-JCS, 2014 WL 1677991 (N.D. Cal. Apr. 28, 2014) (one pending IPR petition); *Google LLC v. EcoFactor, Inc.*, No. 21-cv-03220-HSG, 2022 WL 6837715 (N.D. Cal. Oct. 11, 2022) (IPRs instituted for three of four asserted patents); *IXI Mobile (R & D) Ltd. v. Samsung Elecs. Co Ltd*, No. 15-CV-03752-HSG, 2015 WL 7015415 (N.D. Cal. Nov. 12, 2015) (three pending IPRs petitions); *Speir Techs. Ltd. v. Apple, Inc.*, No. 5:23-CV-00095-EJD, 2023 WL 2714931 (N.D.

¹ L’Oreal anticipates it will soon receive an official filing date.

1 Cal. Mar. 30, 2023) (IPR instituted for one of four asserted patents); *Security People, Inc. v. Ojmar*
 2 *US, LLC*, 2015 WL 3453780, *3-*5 (N.D. Cal. 2015) (one pending IPR petition).

3 Three factors guide the stay inquiry: “(1) whether discovery is complete and a trial date
 4 has been set; (2) whether a stay will likely simplify the issues in question and trial of the case; and
 5 (3) whether a stay would unduly prejudice or present a clear tactical disadvantage to the
 6 nonmoving party.” *PersonalWeb Techs., LLC v. Apple Inc.*, 69 F. Supp. 3d 1022, 1025 (N.D. Cal.
 7 2014). Courts can also consider other factors in assessing a stay. *See Murata*, 830 F.3d at 1362
 8 (“Attendant to the district court’s inherent power to stay proceedings is the court’s discretionary
 9 prerogative to balance considerations beyond those captured by the three-factor stay test.”). All
 10 factors favor granting a stay in this case.

11 **IV. THE CASE SHOULD BE STAYED PENDING THE IPR**

12 **A. This Case Is in Its Early Stages**

13 In analyzing the first stay factor, “the proper time to measure the stage of litigation” is “the
 14 date of the filing of the motion to stay.” *VirtualAgility Inc. v. Salesforce.com, Inc.*, 759 F.3d 1307,
 15 1316 (2014). “Issues for consideration include whether the parties have engaged in costly expert
 16 discovery and dispositive motion practice, whether the parties have fully briefed the issue of claim
 17 construction, attended a Markman hearing and received a claim construction order, and whether a
 18 court has set a trial date.” *HD Silicon Solutions LLC v. Microchip Tech. Inc.*, No. 21-cv-08295-
 19 SK, 2022 WL 3084315 *2 (N.D. Cal. Aug. 3, 2022). Grant of a “stay is particularly appropriate
 20 for cases in the initial stages of litigation or in which there has been little discovery.” *Finjan, Inc.*
 21 *v. Symantec Corp.*, 139 F. Supp. 3d 1032, 1035 (N.D. Cal. 2015).

22 Here, the case is at an early stage. Very limited discovery has occurred and no depositions.
 23 Outside of this, the parties have not engaged in any expert discovery, completed any damages
 24 contentions, briefed the claim construction, and are not due to file their Joint Claim Construction
 25 & Prehearing Statement until July 18, 2025. Further, the claim-construction hearing is not
 26 scheduled until October 29, 2025. Dkt. 34. Accordingly, the first factor weighs heavily in favor of
 27 a stay given the case’s early stage.
 28

B. A Stay Will Simplify This Case

“Staying the case pending the outcome of IPR could simplify the case by rendering some or all of [Brightex’s] infringement claims moot, estopping [L’Oreal] from asserting any arguments they raised or reasonably could have raised in the IPR, and providing the Court with [the] PTAB’s expert opinion on the claims at issue.” *IXI Mobile*, 2015 WL 7015415 at *3. Thus, this factor also favors a stay.

Although the PTO has yet to issue an institution decision on the IPR, IPRs were instituted about 68% statistics of the time in the last years. https://www.uspto.gov/sites/default/files/documents/ptab_aia_fy2025_q2_roundup.pdf. And about half of claims subject to an institution decision are found unpatentable. *Id.* In sum, it is likely that the IPR will be instituted and at least some of the challenged claims found unpatentable. If the PTAB institutes the IPR and invalidates the asserted claims, it could completely resolve or at least significantly simplify the issues. *See Speir Techs.*, 2023 WL 2714931 at *2 (“even a single PTAB decision has the potential to streamline the case significantly”); *see also EcoFactor*, 2022 WL 6837715 at *2 (granting stay where “53 of 70 claims” were “subject to potential invalidation” at PTAB). Under these circumstances, a stay “effectuates the intent of the AIA by allowing the agency with expertise to have the first crack at cancelling any claims that should not have issued in the patents-in-suit before costly litigation continues.” *Software Rts. Archive, LLC v. Facebook, Inc.*, No. C-12-3970 RMW, 2013 WL 5225522, *6 (N.D. Cal. Sept. 17, 2013).

Alternatively, “[e]ven if all the asserted claims survive [after institution], the case could still be simplified because [L’Oreal] would be bound by the estoppel provisions ... and thus could not raise before this Court any arguments it raised, or reasonably could have raised, at the PTO in its petitions.” *Neodron, Ltd. v. Lenovo Group, Ltd.*, No. 19-cv-05644-SI, 2020 WL 5074308 *2 (N.D. Cal., Aug. 27, 2020). Such an outcome “would assist in streamlining the presentation of evidence and benefit the trier of fact by providing the expert opinion of the PTO.” *PersonalWeb Techs.*, 2014 WL 116340 at *4. This “heavily tips the scale in favor of granting the stay.” *Software Rts. Archive*, 2013 WL 5225522 at *4.

C. A Stay Will Not Unduly Prejudice or Tactically Disadvantage Brightex

Courts “address four considerations when evaluating undue prejudice: (1) the timing of the IPR petition; (2) the timing of the stay request; (3) the status of review; and (4) the relationship of the parties.” *Apple Inc. v. AliveCor, Inc.*, No. 22-cv-07608-HSG, 2023 WL 9187388 *3 (N.D. Cal. Dec. 29, 2023). Courts in this district “have repeatedly found no undue prejudice unless the patentee makes a specific showing of prejudice beyond the delay necessarily inherent in any stay.” *PersonalWeb Techs.*, 69 F. Supp. 3d at 1029 (collecting cases). Brightex cannot make such a showing.

First, Brightex cannot assert any undue prejudice based on the timing of L’Oreal’s IPR petition. Congress granted defendants the right to file an IPR petition within a year of being served with a patent infringement complaint. 35 U.S.C. § 315(b); *see also Nanometrics, Inc. v. Nova Measuring Instruments, Ltd.*, 2007 WL 627920 (N.D. Cal. 2007) (“the re-examination process is a Congressionally created option of which any person or party may avail themselves.”). L’Oreal has acted diligently to file an IPR petition against Brightex’s remaining asserted patent within the statutory window. L’Oreal’s timely exercise of its statutory right does not suggest any dilatory motive. *See IXI Mobile*, 2015 WL 7015415 at *4.

Second, Brightex cannot assert any undue prejudice or surprise based on the timing of this motion. This request for the stay was filed within the same month the IPR petitions were filed. Therefore, Brightex cannot claim that the timing of the request, before institution, has caused it any prejudice. *Fisher-Price, Inc. v. Dynacraft BSC, Inc.*, No. 17-CV-3745-PJH, 2017 WL 5153588, at *2 (N.D. Cal. Nov. 7, 2017); *Uniloc*, 2019 WL 1905161 at *6 (“the Court finds no undue prejudice or tactical disadvantage to Uniloc, notwithstanding that the PTO has not yet instituted IPR.”); *IXI Mobile*, 2015 WL 7015415 at *1 (granting a motion to stay the case pending the institution decision citing conserving judicial resources and lack of prejudice to the nonmovant); *Security People*, 2015 WL 3453780 at *3-*5 (granting the motion to stay the case pending the institution decision noting that if it were to “deny the stay until a decision on institution is made, the parties and the Court would expend significant resources on claim construction proceedings that could eventually be mooted by the IPR decision.”). Given the PTO’s high rate of instituting IPRs, Brightex cannot credibly assert

1 enough prejudice to deny this motion based on this sub-factor.

2 Finally, the relationship between the parties is not a source of undue prejudice. The parties are
 3 not competitors, and Brightex is not asserting irreparable harm from the alleged infringement. Courts
 4 have historically considered the question of “whether the patentee will be unduly prejudiced by a stay
 5 in the district court proceedings” by considering “the irreparable harm-type inquiry [and] focus[ing]
 6 on the patentee’s need for an expeditious resolution of its claim.” *VirtualAgility*, 759 F.3d at 1318.
 7 Here, Brightex only seeks monetary relief. In such circumstances, courts have consistently found that
 8 a patent licensor cannot be prejudiced by a stay because monetary damages provide adequate redress
 9 for infringement. *Pragmatus AV, LLC v. Facebook, Inc.*, No. 11–CV–02168–EJD, 2011 WL 4802958,
 10 at *4 (N.D. Cal., Oct. 11, 2011) (quoting *Implicit Networks, Inc. v. Advanced MicroDevices*, No. 08-
 11 CV-184-JLR, 2009 WL 357902, at *3 (W.D. Wash. Feb. 9, 2009)). Moreover, courts in this district
 12 have recognized that a party’s “failure to seek a preliminary injunction cuts against its claim of
 13 prejudice from delay. *GoPro, Inc. v. C&A Mktg., Inc.*, No. 16-CV-03590-JST, 2017 WL 2591268, at
 14 *6 (N.D. Cal. June 15, 2017). Thus, Brightex has not shown it is entitled to expedited relief.

15 **D. L’Oreal Would Be Unfairly Prejudiced Without a Stay**

16 In addition to the three common factors, this Court should exercise its discretion to consider
 17 the harm to L’Oreal without a stay. *See Murata*, 830 F.3d at 1362. Absent a stay, L’Oreal faces
 18 significant prejudice in terms of costs and distraction from its business. Plaintiff is already
 19 aggressively demanding discovery and depositions, and it is unlikely L’Oreal can recover the fees
 20 and costs it will need to expend defending itself against a patent that will likely be found invalid.
 21 Both parties would be subject to expend greater resources defending multiple, simultaneous
 22 actions involving the same subject matter. Such inefficiency and risk of double review constitute
 23 sufficient prejudice to warrant granting a stay, thereby conserving both judicial and party
 24 resources.

25 **V. CONCLUSION**

26 For the foregoing reasons, this Court should stay this case until the pending IPR is resolved.
 27
 28

1 Dated: June 5, 2025

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CERTIFICATE OF SERVICE

I hereby certify that on June 5, 2025, I electronically filed the foregoing document with the Clerk of the Court using the CM/ECF system which sent notification of such filing to all counsel of record in this matter.

/s/ Ramsey M. Al-Salam