IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF VIRGINIA
Alexandria Division

DIVX, LLC,	)	
	)	
Plaintiff,	)	
	)	
v.	)	Civil Action No. 1:24-cv-2061
	)	
AMAZON.COM, INC., et al.,	)	
	)	
Defendants.	)	

ORDER

THIS MATTER comes before the Court on Defendants Amazon.com, Inc. and Amazon Web Services, Inc.'s ("Amazon") Motion to Stay Pending *Inter Partes* Review.

Plaintiff DivX, LLC ("DivX") asserts seven patents against Amazon for patent infringement. On March 7, 2025, Amazon filed its Motion to Dismiss DivX's Amended Complaint for failure to state a claim, which was denied by the Court on April 21, 2025. Subsequently, Amazon filed its Answer to DivX's Amended Complaint on May 5, 2025. Now, Amazon moves to stay the case pending the conclusion of *inter partes* review ("IPR") proceedings before the Patent Trial and Appeal Board ("PTAB").

At the time of filing the Motion to Stay, Amazon had filed one petition for IPR of U.S. Patent No. 10,715,806 ("'806 Patent") and "expect[ed] to file petitions challenging *at least* four more by the end of July." As of July 1, 2025, Amazon has now filed two

additional IPRs of U.S. Patent Nos. 10,412,141 ('141 Patent) and 11,611,785 ('785 Patent). The PTAB has not yet instituted IPR challenging the '806 Patent, '141 Patent, and '785 Patent, but Amazon asserts that the PTAB will likely issue its institution decision six months from filing.

In determining whether to exercise its discretion to stay patent litigation pending an IPR proceeding, district courts consider three factors, including: (1) the stage of the litigation; (2) whether the stay would simplify the issues before the court; and (3) whether the stay would unduly prejudice or clearly disadvantage the nonmoving party. See Centripetal Networks, LLC v. Keysight Techs., Inc., No. 2:22-CV-00002, 2023 WL 5127163, at *3 (E.D. Va. Mar. 20, 2023) (internal citations omitted). Here, the Court finds that the factors weigh against a stay.

Starting with the second factor, the Court finds that Amazon has not demonstrated that a stay, at this time, would simplify the issues before the Court. First, only three petitions for IPR challenging the asserted claims of the '806 Patent, '141 Patent, and '785 Patent have been filed. If IPR is instituted, a final written decision on the validity of these patents will have no effect on Amazon's ability to assert invalidity grounds in the District Court with respect to the remaining four asserted patents. Second, Amazon's claim that it intends to file additional IPR petitions in the future falls short of showing that a stay will

simplify issues before the Court. Even if Amazon files more IPR petitions challenging all asserted claims in the additional patents at issue, at least two of Plaintiff's asserted patents will not be challenged, leaving all issues with respect to those patents unaffected. Unlike Airspace Sys., Inc. v. Axon Enter., Inc., Amazon is not challenging all patent claims of all asserted patents brought by Plaintiff. No. 1:24-cv-1625, Dkt. No. 61 (E.D. Va. Apr. 17, 2025). Thus, Amazon's three IPR petitions, if instituted, will only have a marginal effect on the issues before this Court, and if additional IPR petitions are filed, claim construction and validity issues, among other issues, will still remain as to at least some asserted patents. Thus, the Court finds that this factor weighs against a stay.

As to the first factor, while the Court agrees that the case is in the early stages of litigation in so far as the Court has not yet issued a scheduling order and no discovery has taken place, the Court finds that a stay pending the PTO's decision to grant or deny the IPR petitions, and on the basis of a promise to file additional IPR petitions, is not the better practice. In Airspace, the defendants filed all relevant IPRs prior to seeking the stay. By contrast, Amazon has now filed three IPRs, seeking to challenge all claims in three (of seven) of the asserted patents. At this time, the Court does not believe it is the better practice to grant a stay while Amazon has not yet filed all of their IPR petitions.

Therefore, the Court finds that this factor also weighs against a stay.

Finally, the Court does not find that a stay would unduly prejudice or unfairly disadvantage Plaintiff. To show undue prejudice, a patentee must demonstrate that monetary damages will be insufficient to remedy their losses. Sec. First Innovations, LLC v. Google, LLC, No. 2:23-cv-97, 2024 WL 234720, at *4 (E.D. Va. Jan. 22, 2024); VirtualAgility Inc. v. Salesforce.com, Inc., 759 F.3d 1307, 1318 (Fed. Cir. 2014) ("A stay will not diminish the monetary damages to which [the patentee] will be entitled if it succeeds in its infringement suit—it only delays realization of those damages and delays any potential injunctive remedy."). Here, Plaintiff has not made such a showing.

Plaintiff further argues that it would suffer prejudice because Amazon timed its motion to gain a tactical advantage, but the evidence does not establish that Amazon exhibited a dilatory motive for moving for a stay. While Plaintiff highlights that Amazon filed its IPR petition after filing its motion to dismiss, and after the motion to dismiss was denied, and now seeks to "slowly roll[] out IPRs," "timing alone is insufficient to establish that [Defendants] [are] engaging in delay tactics to gain an advantage." Sec. First Innovations, 2024 WL 234720, at *4.

Considering the relevant factors, the Court finds that overall, the factors weigh against granting a stay at this time. Accordingly, it is hereby

ORDERED that Amazon's Motion to Stay Pending *Inter Partes* Review is DENIED.

Claude M. Hilton
CLAUDE M. HILTON
UNITED STATES DISTRICT JUDGE

Alexandria, Virginia
July 1, 2025