IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF TEXAS
TEXARKANA DIVISION

MAXELL, LTD.,	§	
	§	
Plaintiff,	§	
	§	
v.	§	CIVIL ACTION NO. 5:25-CV-52-RWS
	§	
SAMSUNG ELECTRONICS CO., LTD., and SAMSUNG ELECTRONICS AMERICA, INC.,	§	
	§	
Defendants.	§	

ORDER

Before the Court is Defendants Samsung Electronics Co., Ltd. and Samsung Electronics America, Inc.'s ("Samsung") Motion to Stay Pending *Inter Partes* Review. Docket No. 53. The motion is fully briefed. Docket Nos. 55, 56, 58. On December 10, 2025, the Court heard oral argument on the motion. Docket No. 63.

BACKGROUND

On April 21, 2025, Maxell filed the instant action in this Court against Samsung Electronics Co., Ltd. and Samsung Electronics America, Inc. (collectively, "Samsung"), alleging the infringement of ten patents: U.S. Patent Nos. 7,577,417; 7,952,645; 8,180,198; 8,471,950; 10,783,228; 10,812,646; 11,026,088; 11,277,650; 11,812,091; and 12,160,681. Docket No. 1.

Since then, Samsung has challenged all 63 asserted claims of all 10 Maxell asserted patents in *inter partes* review ("IPR") proceedings at the Patent Office, with the last petition filed on October 13, 2025. Docket No. 53; *see* Docket Nos. 53-1–10. None of the petitions has been instituted. *See id.* The institution deadlines for the 10 petitions range from January 30, 2026 to April 16, 2026. *See id.*

LEGAL STANDARD

The Court has the inherent power to control its own docket, including the power to grant a stay. *Landis v. N. Am. Co.*, 299 U.S. 248, 254 (1936); *see also Ethicon v. Quigg*, 849 F.2d 1422, 1426 (Fed. Cir. 1988). How to best manage a court's docket "calls for the exercise of judgment, which must weigh competing interests and maintain an even balance." *Landis*, 299 U.S. at 254–255. The proponent of a stay bears the burden of establishing its need. *Id.* at 255.

In deciding whether to grant a request for a stay, the Court considers: "(1) whether a stay would unduly prejudice or present a clear tactical disadvantage to the nonmoving party; (2) whether a stay will simplify the issues in question and trial of the case; and (3) whether discovery is complete and whether a trial date has been set." *Black Hills Media, LLC v. Samsung Elecs. Co.*, No. 2:13-CV-379-JRG-RSP, 2014 WL 12951780, at *1 (E.D. Tex. Mar. 17, 2014).

ANALYSIS

"[T]he most important factor bearing on whether to grant a [discretionary] stay" is "whether the stay is likely to simplify the issues at trial." *Uniloc 2017 LLC v. Samsung Elecs. Am., Inc.*, No. 2:19-CV-259-JRG-RSP, 2020 WL 1433960, at *5 (E.D. Tex. Mar. 24, 2020).

No doubt, Samsung's argument on the unique circumstances regarding Maxell's recent litigation against Samsung is compelling. *See, e.g.*, Docket No. 63 (Hearing Tr.) at 4:14–9:23. Looking back at the No. 5:23-CV-92-RWS case before the Court with the same parties, the issues for that trial would certainly have been significantly simplified had the case been stayed pending IPR. Indeed, the Patent Trial and Appeal Board ("PTAB") has since found unpatentable all asserted claims of at least two of the three patents that the Court tried this past year in the No. 5:23-CV-92-RWS case. Docket No. 63 (Hearing Tr.) at 6:19–25; Docket Nos. 56-4–5. It also found

unpatentable all asserted claims of a patent the Court found not infringed during summary judgment in the same case. Docket No. 63 (Hearing Tr.) at 7:1–5; *see* IPR2024-00717.

But Samsung has not identified any authority from this district where a pre-institution stay was granted. Docket No. 53 at 11 (citing *Fall Line Patents, LLC v. Zoe's Kitchen, Inc.*, No. 6:18-CV-407-RWS, 2019 WL 11025871, at *1 (E.D. Tex. Aug. 9, 2019), as granting a pre-institution stay, when the stay was actually granted post-institution). Where a motion to stay is filed before the PTAB institutes any proceeding, courts often withhold a ruling pending action on the petition by the PTAB or deny the motion without prejudice to refiling in the event that the PTAB institutes a proceeding. *VirtualAgility Inc. v. Salesforce.com, Inc.*, 759 F.3d 1307, 1316 (Fed. Cir. 2014) (citing *Checkfree Corp. v. Metavante Corp.*, 2014 WL 466023, at *1 (M.D. Fla. Jan. 17, 2014)); *see also NFC Techs. LLC v. HTC Am., Inc.*, No. 2:13-CV-1058-WCB, 2015 WL 1069111, at *6 (E.D. Tex. Mar. 11, 2015). Indeed, courts in this district have a consistent practice of denying motions to stay when the PTAB has yet to institute post-grant proceedings. *See, e.g.*, *Netlist, Inc. v. Samsung Elecs. Co.*, No. 2:22-CV-293-JRG, 2023 WL 12098382, at *1 (E.D. Tex. Oct. 17, 2023); *Polaris Power Techs., LLC v. Samsung Elecs. Co.*, No. 2:22-CV-469-JRG, 2023 WL 12065780, at *2 (E.D. Tex. Aug. 18, 2023); *Trover Group, Inc. v. Dedicated Micros USA*, 2015 WL 1069179, at *6 (E.D. Tex. Mar. 11, 2015) (Bryson, J.) ("This Court's survey of cases from the Eastern District of Texas shows that when the PTAB has not yet acted on a petition for inter partes review, the courts have uniformly denied motions for a stay.").

Considering these circumstances, the Court concludes that Samsung's motion is premature given that none of the petitions on the asserted patents in this case has been instituted. A stay of these proceedings in advance of the PTAB's decision on whether to institute *inter partes* review as to any or all of the asserted patents should be denied.

CONCLUSION

For the reasons set forth above, it is

ORDERED that Samsung's motion for a stay (Docket No. 53) is **DENIED-WITHOUT-PREJUDICE** as to refiling of the same.

So ORDERED and SIGNED this 15th day of December, 2025.

ROBERT W. SCHROEDER III
UNITED STATES DISTRICT JUDGE