

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

KIRSCH RESEARCH AND  
DEVELOPMENT, LLC,

Plaintiff,

V.

DUPONT DE NEMOURS, INC., E.I. DU  
PONT DE NEMOURS AND COMPANY,

Defendants.

CIVIL ACTION NO. 5:20-CV-00057-RWS

**(LEAD CASE)**

V.

ATLAS ROOFING CORPORATION,  
Defendant.

CIVIL ACTION NO. 5:20-CV-00055-RWS

**(CONSOLIDATED CASE)**

V.

FT SYNTHETICS INC.,  
Defendant.

CIVIL ACTION NO. 5:20-CV-00058-RWS

**(CONSOLIDATED CASE)**

## ORDER

Before the Court is Defendants' Joint Motion to Stay Pending *Inter Partes* Review of the '482 Patent. Docket No. 163. For the reasons set forth below, the motion is **DENIED**.

## BACKGROUND

On April 24, 2020, Plaintiff sued DuPont for infringement of U.S. Patent Nos. 6,308,482 and 8,765,251, and it sued FTS for infringement of the '482 Patent. The Court consolidated the cases at Defendants' request. Docket No. 24. Plaintiff also sued Atlas Roofing for infringement of the '482 and '251 Patents, which was similarly consolidated. Docket No. 64.

Also, on April 24, 2020, Plaintiff filed a complaint with the International Trade Commission that named DuPont as a respondent and accused the same Plaintiff products that are

at issue in this case of infringing the '251 Patent. Docket No. 27-2. The ITC instituted an investigation on June 1, 2020, and Defendants requested that the Court stay this case pending the outcome of the ITC investigation. *See* Docket Nos. 22, 27. This Court granted a mandatory stay of the '251 Patent and denied a discretionary stay as to the '482 Patent, finding that: (1) prejudice to Plaintiff neither favored nor disfavored a stay; (2) a stay as to the '482 Patent was not likely to simplify issues; and (3) Defendants' prejudice did not support a stay. Docket No. 60. Defendants moved for reconsideration. Docket No. 87. The Court denied the motion on October 20, 2020. Docket No. 117.

On February 18, 2021, the PTAB instituted an IPR on all 34 claims of the '482 Patent in IPR2020-01389, brought by Owens Corning Roofing & Asphalt, LLC. Docket No. 162-1. On May 25, 2021, the PTAB instituted an IPR on all 34 claims of the '482 Patent in IPR2021-00192, brought by GAF Materials LLC. Docket No. 259-1.

On February 22, 2021, the ITC's determination as to the '251 Patent became final and Plaintiff requested that the Court lift the stay as to that patent. Docket No. 164. Defendants opposed lifting the statutory stay, arguing the Court should in fact stay the entire case. Docket No. 183. The Court lifted the statutory stay on the '251 Patent on March 3, 2021. Docket No. 185. The Court also set the '251 Patent on a condensed schedule to align it with the schedule set for the '482 Patent. A *Markman* hearing for both patents was held on May 12, 2021. Docket No. 250.

The Court now addresses Defendants' request for a discretionary stay. Although the motion was titled as a stay for the '482 Patent, the arguments address placing the '251 Patent under discretionary stay as well, and thus the Court addresses Defendants' request as one to stay the entire case.

### APPLICABLE LAW

The Court has the inherent power to control its own docket, including the power to stay proceedings. *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 the court’s docket “calls for the exercise of judgement, which must weigh competing interests and maintain an even balance.” *Landis*, 299 U.S. at 254–55. The proponent of a stay bears the burden of establishing its need. *Id.* at 255. “In deciding whether to stay litigation pending reexamination, courts typically consider: (1) whether a stay will 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.” *Soverain Software LLC v. Amazon.com, Inc.*, 356 F. Supp. 2d 660, 662 (E.D. Tex. 2005) (citing *Xerox Corp. v. 3Com Corp.*, 69 F. Supp. 2d 404, 406 (W.D.N.Y. 1999)).

### DISCUSSION

Defendants have not carried their burden to demonstrate the necessity of a stay.

First, Plaintiff’s potential prejudice cuts against a stay. The Court has already held in this matter that “a stay could cause the loss of testimonial and documentary evidence and reduction in market share because Plaintiff and Defendants are direct competitors.” Docket No. 60 (citing *Align Tech., Inc. v. 3Shape A/S*, No. 17-1646-LPS-CJB, 2018 WL 4292675, at \*3 (D. Del. Sept. 7, 2018)). And, while the ’482 Patent has expired, this Court has previously held that the mere fact that a plaintiff is not currently practicing a patent does not mean that, as a matter of law, it is not prejudiced by a substantial delay of its trial date. *See Maxell, Ltd. v. Apple Inc.*, Case No. 5:19-cv-36-RWS, Docket No. 587 at 3 (E.D. Tex. Nov. 17, 2020); *see also Rembrandt Wireless Techs.*,

*LP v. Samsung Elecs. Co.*, Case No. 2:13-cv-213-JRG-RSP, 2015 WL 627887, at \*2 (E.D. Tex. Jan. 29, 2015). The prejudice factor accordingly weighs against a stay.

Second, whether the stay is likely to simplify the issues also weighs against a stay. The Court has already found that the two patents “are not related, do not share a specification or prosecution history and claim different subject matter.” Docket No. 60 at 4; *see also Align Tech.*, 2018 WL 4292675, at \*2 (“Overlapping subject matter, without more—such as overlapping specifications, prosecution history, or a familial relationship—does not provide much support for a stay.”). Further, this Court and others in the district have declined to grant a discretionary stay when not all claims in a case are subject to PTAB review, finding that proposed simplification by IPR is speculative. *See Maxell*, Case No. 5:19-cv-36-RWS, Docket No. 587 at 5–6 (denying discretionary stay when only 8 of the 20 asserted claims were under review); *see also Commc’ns LLC v. ZTE Corp.*, No. 2:15-cv-349-JRG, 2017 WL 3396399, at \*2 (E.D. Tex. Jan. 17, 2017) (denying stay where only one of five asserted patents were instituted). Indeed, this Court has denied a discretionary stay where all claims were under some form of review at the PTAB. *See Maxell*, Case No. 5:19-cv-36-RWS, Docket No. 662 at 6–8 (E.D. Tex. Mar. 15, 2021) (denying stay motion where all claims were either under IPR or EPR); *see also Ramot at Tel Aviv University Ltd. v. Cisco Systems, Inc.*, Case No. 2:19-cv-225-JRG, Docket No. 205 at 2 (E.D. Tex. Nov. 23, 2020). This case has not reached even that stage. Here, only one of the two patents is subject to review, and the patents do not have overlapping subject matter. Accordingly, this factor weighs against a stay.

Third, this case has moved past its earliest stages, and this factor weighs slightly against a stay. The *Markman* hearing in this matter has been completed. The two patents have been set on the same schedule after the mandatory stay on the ’251 Patent was lifted. The stage of the case

thus weighs against a stay because “whether discovery is complete and whether a trial date has been set[] weighs in favor of denying the stay.” *Forgent Networks, Inc. v. Echostar Techs. Corp.*, No. 6:06-CV-208 LED, 2006 WL 6922224, at \*2 (E.D. Tex. Nov. 20, 2006) (“In addition, the parties have also fully briefed and argued the claim construction issues, and the Court is currently working on its claim construction order.”).

“Given the resources that the parties and the Court have already invested in this case, staying the case, based solely on speculation of what might possibly happen during reexamination, would be inefficient and inappropriate.” *Soverain*, 356 F. Supp. 2d at 663. Having considered the prejudice to Plaintiff, the speculative nature of any simplification of issues and stage of the case, the Court finds that the relevant factors weigh against granting a stay at this time. Defendants’ motion to stay is accordingly **DENIED**.

**So ORDERED and SIGNED this 7th day of July, 2021.**

  
ROBERT W. SCHROEDER III  
UNITED STATES DISTRICT JUDGE