

UNITED STATES DISTRICT COURT
CENTRAL DISTRICT OF CALIFORNIA
CIVIL MINUTES – GENERAL

Case No. **2:25-cv-08526-MCS-AGR** Date December 3, 2025

Title ***Wybotics Inc. v. Zodiac Pool Sys. LLC***

Present: The Honorable Mark C. Scarsi, United States District Judge

Stephen Montes Kerr
Deputy Clerk

Not Reported
Court Reporter

Attorney(s) Present for Plaintiff(s):
None Present

Attorney(s) Present for Defendant(s):
None Present

**Proceedings: (IN CHAMBERS) ORDER RE: DEFENDANTS’ MOTION TO DISMISS,
TRANSFER, OR STAY (ECF No. 27) (JS-6)**

Defendants Zodiac Pool Systems LLC and Zodiac Pool Care Europe move to dismiss, transfer, or stay the case given the pendency of an earlier-filed action in the United States District Court for the Eastern District of Texas, *Zodiac Pool Systems LLC v. Wybotics, Co. Ltd.*, No. 2:25-cv-00582-JRG-RSP. (Mot., ECF No. 27-1.) Plaintiffs Wybotics Inc. and Wybotics, Co. Ltd., filed a brief opposing the motion, (Opp’n, ECF No. 31), and Defendants filed a reply, (Reply, ECF No. 32). The Court deems the motion appropriate for decision without oral argument. Fed. R. Civ. P. 78(b); C.D. Cal. R. 7-15.

I. BACKGROUND

This is the third dispute between the parties in federal court concerning U.S. Patent Nos. 8,393,029 (“’029 Patent”) and 8,393,031 (“’031 Patent”). Zodiac Pool Care Europe initiated the first suit for infringement against Wybotics, Co. Ltd., and others in this district in 2022. Compl., *Zodiac Pool Care Europe v. Wybotics, Co. Ltd.*, No. 2:22-cv-05271-MCS-SHK (“*Zodiac I*”) (C.D. Cal. July 29, 2022), ECF No. 1. Zodiac Pool Care Europe ultimately voluntarily dismissed its claims without

prejudice. Notice of Voluntary Dismissal, *Zodiac I* (C.D. Cal. Mar. 29, 2023), ECF No. 24.

Over two years later, Zodiac Pool Systems LLC and Zodiac Pool Care Europe sued Wybotics, Co. Ltd., for infringement of the '029 and '031 Patents in the Eastern District of Texas. Compl., *Zodiac Pool Sys. LLC v. Wybotics, Co. Ltd.*, No. 2:25-cv-00582-JRG-RSP (“*Zodiac IP*”) (E.D. Tex. May 23, 2025), ECF No. 1. Over three months later, Wybotics Inc. and Wybotics, Co. Ltd., brought the instant suit against Zodiac Pool Systems LLC and Zodiac Pool Care Europe for a declaratory judgment of noninfringement and invalidity of the '029 and '031 Patents. (Compl., ECF No. 1.) Zodiac Pool Systems LLC and Zodiac Pool Care Europe amended their complaint in *Zodiac II* to add infringement claims pertaining to three additional patents, Nos. 11,880,207, 11,262,766, and 11,003,191 (together with the '029 and '031 Patents, “Patents-in-Suit”), First Am. Compl., *Zodiac II* (E.D. Tex. Sept. 22, 2025), ECF No. 14, and Wybotics Inc. and Wybotics, Co. Ltd., amended their complaint in this action to add noninfringement claims pertaining to the same three patents two days later, (FAC, ECF No. 18).

II. LEGAL STANDARD

“When two actions that sufficiently overlap are filed in different federal district courts, one for infringement and the other for declaratory relief, the declaratory judgment action, if filed later, generally is to be stayed, dismissed, or transferred to the forum of the infringement action.” *Futurewei Techs., Inc. v. Acacia Rsch. Corp.*, 737 F.3d 704, 708 (Fed. Cir. 2013). “This ‘first-to-file’ rule exists to avoid conflicting decisions and promote judicial efficiency.” *Id.* (internal quotation marks omitted); *see also Genentech, Inc. v. Eli Lilly & Co.*, 998 F.2d 931, 938 (Fed. Cir. 1993) (noting “the importance of conservation of judicial resources and the comprehensive disposition of litigation” as guiding principles), *abrogated on other grounds by Wilton v. Seven Falls Co.*, 515 U.S. 277 (1995); *Kohn Law Grp., Inc. v. Auto Parts Mfg. Miss., Inc.*, 787 F.3d 1237, 1240 (9th Cir. 2015) (“When applying the first-to-file rule, courts should be driven to maximize economy, consistency, and comity.” (internal quotation marks omitted)).¹

¹ Although Federal Circuit law governs application of the first-to-file rule in patent cases, *Futurewei Techs.*, 737 F.3d at 708, district courts sitting in this circuit often borrow principles from the substantially congruent first-to-file rule of the Ninth Circuit, *see, e.g., Amazon.com, Inc. v. LightGuide, Inc.*, No. 2:23-cv-00053-JHC, 2023 U.S. Dist. LEXIS 200063, at *3–4 (W.D. Wash. Nov. 7, 2023) (citing Ninth

“Application of the first-to-file rule is generally a matter for a district court’s discretion, exercised with governing legal constraints.” *Futurewei Techs.*, 737 F.3d at 708. “[C]ourts must generally consider: (1) the chronology of the actions; (2) the similarity of the parties; and (3) the similarity of the issues.” *Apple Inc. v. VoIP-Pal.com, Inc.*, 506 F. Supp. 3d 947, 958 (N.D. Cal. 2020) (citing *Alltrade, Inc. v. Unwield Prods., Inc.*, 946 F.2d 622, 625–26 (9th Cir. 1991)). Exceptions to the rule “may be made if justified by considerations of judicial and litigant economy, and the just and effective disposition of disputes.” *Futurewei Techs.*, 737 F.3d at 708 (internal quotation marks omitted). An exception may be appropriate upon consideration of “the convenience and availability of witnesses, or absence of jurisdiction over all necessary or desirable parties, or the possibility of consolidation with related litigation, or considerations relating to the real party in interest.” *Genentech*, 998 F.2d at 938.

III. DISCUSSION

A. Applying the First-to-File Rule Is Appropriate

Deference to Defendants’ earlier-filed infringement suit in the Eastern District of Texas is warranted here. Defendants filed *Zodiac II* over three months earlier than this one. All but one of the parties to this action are parties to *Zodiac II*. The Patents-In-Suit in both cases are the same, and the complaints are mirror images of one another—indeed, Plaintiffs added noninfringement claims concerning three additional patents to their complaint only after Defendants added infringement claims over the same patents to their *Zodiac II* complaint.

Plaintiffs’ arguments are unconvincing. First, Plaintiffs submit that the Court should consider Zodiac Pool Care Europe’s 2022 case against Wybotics, Co. Ltd., as

Circuit cases in evaluating first-to-file rule motion in patent case); *Apple Inc. v. VoIP-Pal.com, Inc.*, 506 F. Supp. 3d 947, 958 (N.D. Cal. 2020) (same); *T.C.T. Mobile U.S. Inc. v. Cellular Commc’ns Equip. LLC*, No. SACV 20-00702JVS(ADSx), 2020 U.S. Dist. LEXIS 250796, at *3–4 (C.D. Cal. July 31, 2020) (same). Indeed, rightly or wrongly, in unpublished decisions the Federal Circuit sometimes has applied Ninth Circuit precedents on the rule to a patent case. *E.g.*, *In re Miller Mendel, Inc.*, No. 2025-147, 2025 U.S. App. LEXIS 28150, at *5 (Fed. Cir. Oct. 28, 2025); *In re Founds. Worldwide, Inc.*, 542 F. App’x 998, 999 (Fed. Cir. 2013). Accordingly, the Court relies on authorities from both circuits in this Order.

the first-filed case. (Opp’n 10–11.) Treating *Zodiac I* as the first-filed case would not serve the purposes of the rule. The Court issued no orders on the merits in that case, which Zodiac Pool Care Europe voluntarily dismissed years ago. Accordingly, there is no risk of inconsistency with the substantive decisions of *Zodiac I*, and judicial economy would not be served by tethering the parties’ 2025 dispute to a long-concluded case. Tellingly, Plaintiffs offer no authorities suggesting the first-to-file rule may be applied in deference to a concluded case. (Opp’n 11 (citing only *Apple*, 506 F. Supp. 3d at 958, which considered “the history of disputes between the parties” in evaluating whether an *exception* to the rule should be made).)

Second, Plaintiffs note that Wybotics Inc. “is a necessary and desirable party to the resolution of this dispute” but is not a party to *Zodiac II*. (Opp’n 11–13.) Wybotics Inc.’s present nonparticipation in the parallel litigation is no barrier to the application of the first-to-file rule, as complete identity of the parties is not necessary. *Futurewei Techs., Inc. v. Acacia Rsch. Corp.*, No. SACV 12-0511 AG (JPRx), 2012 U.S. Dist. LEXIS 189582, at *12 (C.D. Cal. Oct. 22, 2012) (citing *Micron Tech., Inc. v. MOSAID Techs., Inc.*, 518 F.3d 897, 903 (Fed. Cir. 2008)), *aff’d*, 737 F.3d 704 (Fed. Cir. 2013); *see also Guthy-Renker Fitness, L.L.C. v. Icon Health & Fitness, Inc.*, 179 F.R.D. 264, 270 (C.D. Cal. 1998) (“[T]here is a sufficient similarity between the parties in the two actions to satisfy this factor of the first-to-file rule.”). The party discrepancy is immaterial here given the parent-subsidiary—and otherwise close—business relationship between Wybotics Inc. and the defendant to *Zodiac II*, Wybotics, Co. Ltd. (Compl. ¶¶ 5–7, 11.) *Cf. Microchip Tech., Inc. v. United Module Corp.*, Nos. CV-10-04241-LHK, CV-10-05196-LHK, CV-10-05290-LHK, CV-11-00430-LHK, 2011 U.S. Dist. LEXIS 73276, at *12 (N.D. Cal. July 7, 2011) (finding parties substantially similar where a defendant was the wholly owned subsidiary of a defendant to the first-filed suit). Further, nothing appears to impede Wybotics Inc. from bringing its claims or consenting to suit in the Eastern District of Texas.

Third, Plaintiffs contend that the first-filed suit is the product of forum shopping, and that the parties’ dispute would be more conveniently litigated here. (Opp’n 13–17.) Wybotics, Co. Ltd., may assert these arguments in the Eastern District of Texas, which is better positioned to assess them as the forum of the first-filed case. The Court defers to the decision of that court on these issues. *See, e.g., Optoma Tech. Inc. v. Maxell Ltd.*, No. 24-cv-08147-TLT, 2025 U.S. Dist. LEXIS 75200, at *8–9 (N.D. Cal. Mar. 14, 2025) (collecting cases applying Federal Circuit law for the proposition that “the court of the first-filed action, rather than the court

of the second-filed action, should decide whether an exception to the first-to-file rule applies”).

In short, application of the rule is appropriate.

B. A Stay Would Best Implement the Rule

Defendants submit that all three implementations of the rule—stay, dismiss, or transfer—are available here. (Mot. 17–18.) The Court elects to stay.

The briefing leaves uncertain whether transfer is available. “Although the first-to-file rule guides the district court’s exercise of discretion in handling related cases, the requirements of [28 U.S.C.] § 1404(a) cabin the exercise of that discretion.” *In re Bozic*, 888 F.3d 1048, 1054 (9th Cir. 2018). In other words, a district court may only transfer an action pursuant to the first-to-file rule to a transferee district “where it might have been brought.” *Id.* (quoting 28 U.S.C. § 1404(a)). The transferee court meets this requirement if: (1) it would have subject-matter jurisdiction; (2) defendants would be subject to personal jurisdiction; and (3) venue would be proper. *See Hoffman v. Blaski*, 363 U.S. 335, 343–44 (1960). The parties do not identify facts from which the Court could conclude personal jurisdiction and venue would lie in the proposed transferee district, and Defendants’ consent to transfer does not answer whether Plaintiffs might have brought the action there in the first place. *See id.* at 343 (confirming “the wish or waiver of the defendant” has no impact on the § 1404(a) inquiry).

A stay is preferable to a dismissal. First, absent Wybotics Inc.’s participation in *Zodiac II*, its claims might yet be litigated in this forum. Staying the claims instead of dismissing them recognizes that limitation. *See Intersearch Worldwide, Ltd. v. Intersearch Grp., Inc.*, 544 F. Supp. 2d 949, 963 (N.D. Cal. 2008) (“Dismissal is proper where the court of first filing provides adequate remedies.”). Second, should Wybotics, Co. Ltd., convince the Eastern District of Texas court to make an exception to the first-to-file rule or to transfer *Zodiac II* to this Court under § 1404(a), judicial economy would be served by keeping this case nominally alive and primed to coordinate with any proceedings in this district on the infringement claims.

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IV. CONCLUSION

The Court grants the motion to the extent Defendants seek a stay. This case is stayed pending resolution of proceedings in *Zodiac Pool Systems LLC v. Wybotics, Co. Ltd.*, No. 2:25-cv-00582-JRG-RSP. By notice, stipulation, or motion, the parties may dismiss or transfer Plaintiffs' claims in this action in favor of litigating the claims in the United States District Court for the Eastern District of Texas without separately seeking relief from the stay.

The Court directs the Clerk to remove the case from the Court's active caseload until further application by the parties or order of this Court. The parties shall file a joint status report within 120 days, and a further report every 120 days thereafter. Each report must state on the cover page the date the next report is due. Additionally, the parties must notify the Court within seven days of the conclusion of proceedings in the Eastern District of Texas.

IT IS SO ORDERED.