

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

ACORN SEMI, LLC,	§	
	§	
<i>Plaintiff,</i>	§	
	§	
v.	§	CIVIL ACTION NO. 2:19-CV-00347-JRG
	§	
SAMSUNG ELECTRONICS CO., LTD.,	§	
SAMSUNG ELECTRONICS AMERICA,	§	
INC., SAMSUNG SEMICONDUCTOR,	§	
INC., SAMSUNG AUSTIN	§	
SEMICONDUCTOR, LLC,	§	
	§	
<i>Defendants.</i>	§	

ORDER

Before the Court is Defendants Samsung Electronics Co. Ltd., Samsung Electronics America, Inc., Samsung Semiconductor, Inc., and Samsung Austin Semiconductor, LLC's (collectively, "Defendants" or "Samsung") Motion to Stay Pending *Inter Partes* Review (the "Motion") (Dkt. No. 60). In the Motion, Samsung asks the Court to stay all action in the above-captioned matter pending the Patent Trial and Appeal Board's ("PTAB") *inter partes* review ("IPR") of the patents-in-suit.

Plaintiff Acorn Semi, LLC ("Plaintiff" or "Acorn") has asserted six patents against Samsung: U.S. Patent Nos. 7,084,423 (the "'423 Patent"); 8,766,336 (the "'336 Patent"); 9,209,261 (the "'261 Patent"); 9,461,167 (the "'167 Patent"); 9,905,691 (the "'691 Patent"); and 10,090,395 (the "'395 Patent") (collectively, the "Asserted Patents"). (Dkt. No. 1, at 3–5). Samsung has filed ten IPR petitions, effectively challenging the patentability of all claims asserted in this case. (Mot. at 2). Two petitions challenging the '423 and '261 Patents were filed on June

24, 2020.¹ (*Id.*). Four petitions challenging the '336, '167, '691, and '395 Patents were filed on June 29, 2020.² (*Id.*). A further four petitions challenging the '336, '167, '691, and '395 Patents were filed July 6, 8, 10, and 13, 2020.³ (*Id.*). The PTAB is expected to begin issuing institution decisions in January of 2021, and is expected to issue institution decisions on the last of the petitions in March of 2021. (*Id.* at 3).

The district court has the inherent power to control its own docket, including the power to stay proceedings. *Clinton v. Jones*, 520 U.S. 681, 706 (1997). How to best manage the court's docket "calls for the exercise of judgment, which must weigh competing interests and maintain an even balance." *Landis v. N. Am. Co.*, 299 U.S. 248, 254–55 (1936).

"District courts typically consider three factors when determining whether to grant a stay pending *inter partes* review of a patent in suit: (1) whether the stay will unduly prejudice the nonmoving party, (2) whether the proceedings before the court have reached an advanced stage, including whether discovery is complete and a trial date has been set, and (3) whether the stay will likely result in simplifying the case before the court." *NFC Techs. LLC v. HTC Am., Inc.*, Case No. 2:13-cv-1058-WCB, 2015 WL 1069111, at *2 (E.D. Tex. Mar. 11, 2015) (Bryson, J.). "Based on th[ese] factors, courts determine whether the benefits of a stay outweigh the inherent costs of postponing resolution of the litigation." *Id.*

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.*, No. 12-

¹ IPR2020-01182; IPR2020-01183.


² IPR2020-01204; IPR2020-01205; IPR2020-01206; IPR2020-01207.

³ IPR2020-01241; IPR2020-01264; IPR2020-01279; IPR2020-01282.

cv-15, 2014 WL 466023, at *1 (M.D. Fla. Jan. 17, 2014)); *see also NFC Techs.*, 2015 WL 1069111, at *6. Indeed, this Court has a consistent practice of denying motions to stay when the PTAB has yet to institute post-grant proceedings. *Trover Group, Inc. v. Dedicated Micros USA*, No. 2:13-cv-1047-WCB, 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 the Samsung’s motion is premature, and a stay of these proceedings in advance of the PTAB’s decision on whether or not to institute *inter partes* review of any of the Asserted Patents should be denied. Accordingly, the Motion is **DENIED WITHOUT PREJUDICE** to refiling of the same, which shall be permitted within fourteen (14) days following the PTAB’s institution decision regarding the last of the patents-in-suit to be acted upon by the PTAB.

So ORDERED and SIGNED this 14th day of September, 2020.



RODNEY GILSTRAP
UNITED STATES DISTRICT JUDGE