KRAMER ALBERTI LIM & TONKOVICH LLP
Robert F. Kramer (SBN 181706)
rkramer@krameralberti.com
David Alberti (SBN 220625)
dalberti@krameralberti.com
Sal Lim (SBN 211836)
slim@krameralberti.com
Russell S. Tonkovich (SBN 233280)
rtonkovich@krameralberti.com
Lawrence G. McDonough (SBN 218364)
lmcdonough@krameralberti.com
Hong Lin (SBN 249898)
hlin@krameralberti.com
Jeremiah Armstrong (SBN 253705)
jarmstrong@krameralberti.com
Aidan Brewster (SBN 319691)
abrewster@krameralberti.com
950 Tower Lane, Suite 1725
Foster City, CA 94404
Tel: 650 825-4300/Fax: 650 460-8443

Attorneys for Plaintiff
Polaris PowerLED Technologies, LLC

UNITED STATES DISTRICT COURT

CENTRAL DISTRICT OF CALIFORNIA

POLARIS POWERLED TECHNOLOGIES, LLC,

Plaintiff,

v.

WESTERN DIGITAL CORPORATION, and WESTERN DIGITAL TECHNOLOGIES, INC.,

Defendants.

Case No. 2:24-cv-02864-ODW-MAR

PLAINTIFF'S OPPOSITION TO MOTION TO STAY

Date: March 3, 2025
Time: 1:30 p.m.
Dept: 5D

TABLE OF CONTENTS

TABLE OF AUTHORITIES

CASES

STATUTES

I. INTRODUCTION

Defendants filed three requests (*i.e.*, petitions) asking the Patent Trial and Appeal Board ("PTAB") to institute an *inter partes review* ("IPR") proceeding challenging the validity of each of the three patents-in-suit. The PTAB has not yet acted on any of Defendants' petitions. There is nothing in the record suggesting that it will institute any of Defendants' requested IPRs.

Defendants' premature motion to stay, filed *before* the PTAB has decided whether the institute any of the three requests for IPR, disregards established practice in this District, in which pre-institution motions are commonly denied. Defendants offer no compelling justification for deviating from this well-established practice, nor do Defendants present any unique circumstances that warrant such a departure. Their request is simply premature and should be denied. If the PTAB ultimately chooses to institute any of the three IPR petitions come August 2025, Defendants will have ample opportunity to raise the issue of a stay at that juncture. Before then, Defendants' arguments are based on conjecture and would simply delay the case for no good reason.

Evidencing gamesmanship to delay this litigation, the three IPR petitions were filed mere days before the January 30, 2025 one-year deadline to file petitions per 35 U.S.C. § 315(b).[1] In fact, the '085 Patent IPR petition was filed *one day* before the deadline. Trial in this case is June 16, 2026. And, if any IPRs were to be instituted—given their delay in filing the IPR petitions—the PTAB's decision (called a Final Written Decision)—would not even issue until August 2026, two months *after* the trial. Efforts to stall this litigation by filing late stage IPR petitions should not be

[1] This litigation was originally filed in the Western District of Texas on January 30, 2024 as Case No. 1:24-cv-00101, but refiled in this District on April 9, 2024, to resolve a threatened motion to transfer by Defendants. The 35 U.S.C. § 315(b) one-year time bar for filing IPR petitions is tied to the filing of the first case. *See Click-To-Call Techs, LP v. Ingenio, Inc., YellowPages.com, LLC*, 899 F.3d 1321, 1328 n.3 (Fed. Cir. 2018) (*en banc*), *vacated on other grounds*.

rewarded—a principle recognized in this District. *See Nike, Inc. v. Skechers U.S.A., Inc.*, No. 19-cv-9230-MWF-JDEX, 2020 WL 8512299, at *1 (C.D. Cal. Dec. 30, 2020) ("The Court also notes that Defendant waited almost a year after it was served with the Complaint to file its IPR petitions. Defendants' delay in filing its IPR petitions also weighs against granting a stay.") (citation omitted); *see also Jiaxing Super Lighting Elec. Appliance Co. v. MaxLite, Inc.*, No. 19-cv-4047-PSG-MAAx, 2020 WL 5079051, at *4 (C.D. Cal. June 17, 2020) ("Such a delay cuts against granting a stay because 'courts expect accused infringers to evaluate whether to file, and then to file, IPR petitions as soon as possible after learning that a patent may be asserted against them.'") (citation omitted).

Any expectation of simplifying the issues in this case is speculative. PTAB statistics paint a clear picture: 35% of IPR petitions are never instituted. This means that there is only a 27.5% chance of all three IPR petitions being instituted.[2] Further, of those that *are* instituted, the PTAB ultimately invalidates only 52% of the challenged claims. Ex. A (PTAB Trial Statistics FY25 Q1 Outcome Roundup) at 6, 13. Therefore, even if all three IPR petitions were to be instituted (which is unlikely), there is a substantial likelihood statistically that half of the 30 asserted claims of the three Asserted Patents will survive the IPR proceedings and will remain to be litigated against Defendants in this Court.

Here, the petitioned IPRs also will provide no simplification of the issues because only one of the two Defendants is subject to estoppel under 35 U.S.C. § 315(e)(2). While Western Digital Technologies, Inc. may be subject to estoppel as a petitioner in the IPRs, Western Digital Corporation will not be subject to any estoppel because it is not a petitioner on any of the three IPRs. *Id*. Therefore, Western Digital Corporation can assert at trial in this Court all prior art invalidity grounds, including the prior art invalidity grounds raised in the IPRs, thereby forcing

[2] Patent Office statistics show that 65% of IPR petitions are instituted. So, there is a 27.5% chance of institution on all three petitions (i.e., 0.65*0.65*0.65). Ex. A, 6, 13.

Polaris to litigate the same prior art invalidity arguments in both the PTAB and district court. This is potentially an enormous amount of prior art given that Defendants have so far identified *74 prior art references* in their Invalidity Contentions. *See* Ex. B (12/16/2024 Invalidity Contentions). This unfairly gives Defendants' two bites at the apple on invalidity defenses with the *same* 74 prior art references while greatly increasing costs for Polaris and burden on the Court.

Further undercutting Defendants' efficiency and estoppel arguments, Defendants have been unwilling to confirm whether they would agree to a *Sotera* stipulation, which would accelerate the estoppel provisions of 35 U.S.C. § 315(e) to the time of the PTAB's institution decision, rather than when the PTAB issues a final written decision, one year after the institution decision. *Sotera Wireless, Inc. v. Masimo Corp.*, No. IPR2020-01019, 2020 WL 7049373, at *7 (P.T.A.B. Dec. 1, 2020); Armstrong Decl., ¶ 2. Defendants' refusal of the *Sotera* stipulation signifies that Defendants are not confident in the outcome of the IPR petitions, thus underscoring why a stay of the case at this stage is unwarranted. Further, by failing to agree to the *Sotera* stipulation, Defendants can present all invalidity arguments at trial, which is scheduled about two months *before* the final written decision from the PTAB since, without the *Sotera* stipulation, estoppel would not attach until the final written decision. As a result, there is no meaningful simplification of the issues as to invalidity.

Contrary to Defendants' argument, IPRs are unlikely to affect claim construction in this Court. Of the 25 terms that Defendants have proposed for construction in this case, Defendants are expected to argue that many of those terms are indefinite, which is an issue that the PTAB cannot consider. *See* Ex. C (Defendants' 1/24/2025 Identification of Claim Terms for Construction). On the other hand, the petitioners have asked the PTAB to construe a total of only *two* terms across the three IPR petitions. Even after Defendants winnow down their terms for construction to 10 from 25, as required in the Court's standing order, the outcome of

the PTAB's potential constructions—in the unlikely event the PTAB were to institute the three IPR petitions—will have, at best, minimal impact on claim construction in this case because the PTAB is only asked to construe two terms. Therefore, any effect of the IPRs on claim construction is pure speculation at this time.

A stay would complicate the issues and lead to wasteful litigation thereby unduly prejudicing Polaris. Defendants have alleged that all of the asserted claims are indefinite. *See* Ex. B (12/16/2024 Invalidity Contentions) at 24. If the Court were to construe any of the 10 winnowed claim terms as indefinite, it would invalidate at least some claims of the Asserted Patents and render all or some of the IPR proceedings moot. To avoid wastefully litigating the IPRs and any Federal Circuit appeals that could easily last 2 to 3 years, the Court should deny the stay and proceed with the claim construction hearing on August 22, 2025, which is the same month that the PTAB's institution decisions are expected. By doing so, the Court will be able to resolve claim construction issues regarding indefiniteness before the parties litigate the IPRs. Otherwise, the parties could spend 2 to 3 years litigating the IPRs and appeals before returning to the district court just to litigate indefiniteness at that time. That would be an enormous waste of the PTAB's judicial resources and the parties' financial resources.

As this Court recognized, rather than staying the case pending the outcome of an IPR, "[t]he most efficient, economical, and fair course of action is addressing the indefiniteness issue now because the issues do not overlap and can be outcome determinative. A finding of indefiniteness would be dispositive as to the entire case; therefore, the Court finds the issue appropriate for consideration at this time." *Farstone Tech., Inc. v. Apple Inc.*, No. 8:13-cv-1537-ODW-JEMX, 2015 WL 14094881, at *1 (C.D. Cal. Sept. 25, 2015) (Wright, J.).

Polaris would be further prejudiced by having to serially litigate the same prior art in both the PTAB and district court as one of the two Defendants are not subject to any estoppel from the IPR pursuant to 35 U.S.C. § 315(e)(2). Additionally, a stay

lasting several years through the IPRs and appeals would likely result in memories fading, the loss of available witnesses, and the loss of relevant evidence.

Therefore, given the totality of the circumstances, the Court should deny Defendants' motion to stay in this case.

II. BACKGROUND

Plaintiff Polaris PowerLED Technologies, LLC ("Polaris" or "Plaintiff") filed this action on April 9, 2024, accusing Defendants of infringing the asserted claims of U.S. Patent Nos. 8,554,968 ("the '968 Patent"), 9,183,085 ("the '085 Patent"), and 8,601,346 ("the '346 Patent") (collectively, "Asserted Patents") by making, using, selling, offering for sale, and importing certain solid-state drive ("SSD") products ("Accused Products"), and inducing and contributing to others making, using, offering for sale, selling, and importing into the United States the Accused Products. Polaris contends that this is an exceptional case and seeks compensatory damages, fees, and all other available remedies.

In accordance with the Northern District of California Patent Local Rules as adopted by the Court, Polaris served its Infringement Contentions and accompanying document production on October 2, 2024, and Defendants served their Invalidity Contentions with the required document production on December 16, 2024. Polaris served document requests and interrogatories on October 2, 2024. Defendants served responses on November 1 and 22, 2024, respectively. Per stipulation, Polaris served Amended Infringement Contentions on February 4, 2025, and Defendants served Amended Invalidity Contentions on February 6, 2025. The Court issued a scheduling order on January 27, 2025, setting trial for June 16, 2026, with fact and expert discovery closing on February 18 and March 11, 2026, respectively.

Claim construction efforts are underway as the parties exchanged proposed terms on January 24, 2025 (see Exhibit C) with the Joint Claim Construction Statement due June 3, 2025, and a hearing set for August 22, 2025. Dkt. 54.

III. LEGAL STANDARD

Under similar circumstances to this case, **this Court has stated that it "agrees with other courts that have held that the stay of a patent infringement action is not warranted when based on nothing more than the fact that a petition has been filed in the PTO."** *Zipshade Indus. (B.V.I.) Corp. v. Lowe's Home Centers, LLC*, No. 2:14-cv-05934-ODW-RZX, 2015 WL 14094882, at *2 (C.D. Cal. Sept. 18, 2015) and *MyMedicalRecords, Inc. v. Jardogs, LLC*, No. 2:13-cv-03560-ODW-SHX, 2014 WL 12967515, at *2 (C.D. Cal. Dec. 16, 2014) (citing *Ultratec, Inc. v. Sorenson Commc'ns, Inc.*, No. 13-cv-346-BBC, 2013 WL 6044407, at *3 (W.D. Wis. Nov. 14, 2013) ("[T]he fact that the Patent Office has not yet granted the petitions to review the nine patents adds an additional layer of doubt whether the *inter partes* review will even occur, let alone whether it will simplify the issues or reduce the burden of litigation for the parties or the court."); *Comcast Cable Commc'ns Corp., LLC v. Finisar Corp.*, No. 06-cv-04206-WHA, 2007 WL 1052883, at *1 (N.D. Cal. Apr. 5, 2007) ("If litigation were stayed every time a claim in suit undergoes reexamination, federal infringement actions would be dogged by fits and starts. Federal court calendars should not be hijacked in this manner."). Ultimately, "[a] court is under no obligation to stay proceedings pending parallel litigation in the PTAB." *Entropic Commc'ns, LLC v. DirecTV, LLC*, No. 2:22-cv-07775-JWH-JEM, 2023 WL 3407132, at *2 (C.D. Cal. Apr. 17, 2023) (quoting *DiCon Fiberoptics, Inc. v. Preciseley Microtechnology Corp.*, No. 5:15-cv-01362-BLF, 2015 WL 12859346, at *2 (N.D. Cal. Oct. 13, 2015)).

In this District, courts apply three factors to requests to stay pending IPR: "(1) whether discovery is complete and whether a trial date has been set; (2) whether a stay will simplify the issues in question and trial of the case; and (3) whether a stay would unduly prejudice or present a clear tactical disadvantage to the nonmoving party." *Universal Elecs., Inc. v. Universal Remote Control, Inc.*, 943 F. Supp. 2d 1028, 1030-31 (C.D. Cal. 2013) (quotations omitted). "Another consideration is the

Court's ability to control its docket to ensure that cases are managed in the interest of justice." *Id*. at 1035. Ultimately, "the totality of the circumstances governs." *Id*. at 1031 (quotations omitted). "The moving party bears the burden of demonstrating that a stay is appropriate." *Entropic*, 2023 WL 3407132, at *2 (quoting *Finjan, Inc. v. Symantec Corp.*, 139 F. Supp. 3d 1032, 1035 (N.D. Cal. 2015)).

IV. ARGUMENT

A. The Simplification of Issues Factor Weighs Strongly Against a Stay and Defendants Provide No Legitimate Basis for Deviating From the Court's Practice of Denying Pre-Institution Motions to Stay.

1. Under the Specific Facts of This Case, A Stay Will Not Simplify the Issues.

The simplification of issues factor weighs strongly against a stay under the specific facts of this case. ***First***, any simplification is merely speculative at this point. The IPRs have not been instituted, and a stay should be denied prior to institution. *DMF, Inc. v. AMP Plus, Inc.*, No. 2:18-cv-07090-CAS-GJSx, 2019 WL 13378212, at *1 (C.D. Cal. July 12, 2019) ("The Court will not entertain any motions to stay the case until the PTAB has granted defendants' IPR petition."). Since 35% of all IPRs are denied institution, it is pure speculation at this point that IPRs will even be instituted. Ex. A at 6. If 65% of IPR petitions are instituted, there is only a 27.5% of all three petitions here being instituted. Further, even in the unlikely event that all three petitions are instituted, only 52% of claims are found unpatentable by the PTAB, according to recent USPTO statistics. *Id*. at 13. That means that, even if the IPRs are instituted, half of the 30 asserted claims in this case are likely be found patentable and will continue to be litigated in this Court.

As this Court has previously recognized, "[a]t this point the Court can only speculate as to whether the PTAB will grant review of the new petition and, even if it does, to what extent the review will encompass the claims at issue in this case." *Zipshade*, 2015 WL 14094882, at *1. Other courts in this District have likewise agreed that early stays are unwarranted. "It is generally this Court's practice to deny

motions to stay until after the PTAB has made a decision regarding whether it will actually institute the IPR." *Realtime Adaptive Streaming LLC v. Adobe Sys. Inc.*, No. 2:18-cv-09344-GW-JCx, 2019 WL 11717183, at *5 (C.D. Cal. May 14, 2019); *Ancora Techs., Inc. v. TCT Mobile (US), Inc.*, No. 8:19-cv-02192-GW-ADSx, 2020 WL 13900673, at *3 (C.D. Cal. Nov. 12, 2020) ("the Court can only speculate as to whether the PTAB will institute IPR and would not find a stay warranted until the PTAB does so."); *California Inst. of Tech. v. Broadcom Ltd.*, No. 2:16-cv-03714-GW-AGRx, 2017 WL 11835427, at *2 (C.D. Cal. Mar. 2, 2017) ("One wonders about the need or desirability of a stay when the IPR petitions have not yet been granted. . . . [U]ntil PTAB decides whether it will institute the IPRs, a stay of this action would appear to be unwarranted."); *RealD, Inc. v. MasterImage 3D, Inc.*, No. 2:14-cv-2304-GW-MANx, 2014 WL 13074571, at *2 (C.D. Cal. Oct. 12, 2014) ("the Court will not stay this action based on the mere filing of petitions for *inter partes* review"); *Fontem Ventures, B.V. v. NJOY, Inc.*, No. 2:14-cv-01645-GW-MRWx, 2014 WL 13074569, at *1 (C.D. Cal. Sept. 24, 2014) (same).

Therefore, because the IPRs have not been instituted and any institution is purely speculative, the Court should follow its practice and deny Defendants' motion to stay. This Court's practice of denying pre-institution motions to stay is consistent with the practice of many courts in both this District and other districts. *See, e.g.*, *Entropic*, 2023 WL 3407132, at *2; *Polaris Innovations Ltd. v. Kingston Tech. Co., Inc.*, No. 8:16-cv-00300-CJC-RAOx, 2016 WL 7496740, at *2 (C.D. Cal. Nov. 17, 2016); *California Inst. of Tech.*, 2017 WL 11835427, at *2 (collecting cases from E.D. Tex., D. Minn., W.D. Wis., W.D. Tenn., D. Or., and D. Del. all denying motions to stay where PTAB had not yet issued institution decisions); *Trover Grp., Inc. v. Dedicated Micros USA*, No. 2:13-cv-1047-WCB, 2015 WL 1069179, at *5 (E.D. Tex. Mar. 11, 2015) (Judge Bryson of the Federal Circuit sitting by designation and noting "the majority of courts that have addressed the issue have postponed ruling on stay requests or have denied stay requests when the PTAB has not yet acted on the

petition for review.").

Second, there will be no real simplification of the issues from an IPR because no estoppel under 35 U.S.C. § 315 would apply to Western Digital Corporation in this case. The IPR petitions are clear that Western Digital Corporation is not a real party-in-interest and would not be subject to any of the estoppel provisions of 35 U.S.C. § 315(e)(2) from the IPR proceedings. Thus, the standard argument that an IPR provides simplification due to the broad estoppel that excludes all grounds that could have been raised by the petitioner defendant is inapplicable here as one defendant, Western Digital Corporation, is not subject to the estoppel. *California Inst. of Tech. v. Broadcom Ltd.*, 25 F.4th 976, 991 (Fed. Cir. 2022), *cert. denied sub nom. Apple Inc. v. California Inst. of Tech.*, 143 S. Ct. 2658 (2023) ("[E]stoppel applies not just to claims and grounds asserted in the petition and instituted for consideration by the Board, but to all grounds not stated in the petition but which reasonably could have been asserted against the claims included in the petition").

Therefore, Western Digital Corporation in this case is ***not*** subject to the estoppel provisions of 35 U.S.C. § 315(e)(2). As a result, it is indisputable that there will be no simplification of the issues as Western Digital Corporation can raise any invalidity ground in the district court, including the exact same grounds adjudicated in the IPRs filed by petitioner Western Digital Technologies, Inc. (if they are instituted). The IPRs will thus have no effect on what defenses these defendants are able to raise.[3]

Third, even for Western Digital Technologies, Inc., the petitioner in the IPR, the estoppel will have a small overall impact. The estoppel applies to written prior art grounds. 35 U.S.C. § 315(e)(2). However, because Western Digital Corporation

[3] If the Court is inclined to grant Defendants' motion to stay, the Court should require that all Defendants agree to be estopped as if they were parties to the IPRs subject to 35 U.S.C. § 315(e)(2), which courts have mandated in prior cases. *See, e.g., Vivint, Inc. v. SkyBell Techs., Inc.*, No. 2:21-cv-09472-GW-GJSx, 2022 WL 18587113, at *5 (C.D. Cal. Nov. 9, 2022).

is not subject to estoppel, it can raise all 74 prior references at trial regardless of whether they were used in the IPR. Further, both Defendants have asserted an additional 72 grounds of lack of written description, lack of enablement, and indefiniteness. Ex. B (Invalidity Contentions), 24-27, 43-44, 62-64.[4] Because the 74 asserted written prior art references can still be raised by Western Digital Corporation and Defendants assert another 72 lack of written description, enablement, and indefiniteness defenses that cannot be addressed in IPRs, there will be no significant reduction in validity issues in the district court litigation as a result of IPRs.

Fourth, a stay would actually complicate the issues in the case and may lead to wasteful and unnecessary litigation. Defendants have so far identified 25 terms for claim construction by the Court. Ex. C. In their invalidity contentions, Defendants allege that every asserted claim is invalid for indefiniteness. Ex. B, 24-27, 43-44, 62-64. Defendants are expected to contend that many of those terms in the Asserted Patents are indefinite under 35 U.S.C. § 112. *Id.* If the Court were to find these terms indefinite, it would invalidate some, and potentially all, asserted claims of the Asserted Patents and render the entire IPR proceeding moot. This Court has denied similar motions to stay when it can "adjudicate [plaintiff]'s claims long before the completion of any PTAB review, assuming the PTAB even choses to institute the new petition." *Zipshade*, 2015 WL 14094882, at *1.

Therefore, denying the stay and deciding indefiniteness during claim construction in the district court would provide the most simplification of the issues.

---

[4] Defendants' invalidity contentions broadly assert there exist relevant products that constitute prior art from at least the following 24 entities: "Advanced Micro Devices, Inc.; Broadcom Ltd.; Compaq Computer Corporation; DensBits Technologies Ltd.; EMC Corporation; Fusion-io, Inc.; Hitachi, Ltd.; IBM Corp.; Intel Corporation; LSI Corporation; Micron Technology, Inc.; MSystems Ltd.; Network Appliance, Inc. (a/k/a NetApp, Inc.); NVIDIA Corporation; Overland Storage Inc.; Panasonic Corp.; SanDisk; SharkMp6 and SpinnerMp6 products; Sun Microsystems, Inc.; Super Talent Electronics, Inc.; Texas Memory Systems, Inc.; Toshiba; VMWare, Inc.; and Western Digital" Ex. B (Invalidity Contentions).

If the Court finds the claims indefinite, the IPRs may be moot and the case is resolved pending appeal. If the Court finds the claims valid and definite, then the parties can wait for the institution decision to evaluate if a stay is warranted. Given that the claim construction hearing is scheduled for August 22, 2025, which is the same month the PTAB's institution decisions are likely due, the Court should deny the stay at this time and proceed with the claim construction process to determine if the terms are indefinite as that is the most efficient procedure for simplifying the issues.

Granting a stay now would complicate the issues and be inefficient for the parties. If a stay is granted, the parties could spend 2-3 years litigating the IPRs and appeals before returning to the district court just to litigate indefiniteness at that time. That would be an enormous waste of the PTAB's judicial resources and the parties' financial resources. The most efficient path, under the facts of this case, is to deny the motion for stay and proceed with the case through claim construction to determine whether the claims are indefinite. Based on that outcome, the parties and the Court can decide how to proceed at that time.

Fifth, contrary to Defendants' arguments, IPR proceedings are unlikely to have any real effect on claim construction in the district court. The IPR petitioners have taken the position in the IPR that only two claim terms across all three IPRs need to be expressly construed to resolve the invalidity issues in the petitions. Similarly, at this juncture, Polaris does not anticipate arguing that any of the claim terms at issue in the IPR petitions warrant claim construction by the PTAB. Accordingly, the prosecution history, regardless of the status of the potentially instituted IPRs, will not be substantively amended so as to "provide any 'explanation, elaboration, or qualification' that better 'capture[s] the scope of the actual invention' than the [intrinsic] claim language itself." *XMTT, Inc. v. Intel Corp.*, No. 1:18-cv-01810-MFK, 2022 WL 2904308, at *5 (D. Del. July 22, 2022) (quoting *AstraZeneca AB v. Mylan Pharms. Inc.*, 19 F.4th 1325, 1335 (Fed. Cir. 2021)); *see also SkyHawke Techs., LLC v. Deca Int'l Corp.*, 828 F.3d 1373, 1376 (Fed. Cir. 2016) ("[T]he claim

construction adopted by the [PTAB] cannot create prosecution history disclaimer, at least because a party can avoid such disclaimer by opposing such statements when made by the Patent Office[.]"). Thus, Defendants' IPR estoppel, prosecution disclaimer and claim cancellation arguments are merely hypothetical speculation and not rooted in the facts of this case.

Finally, undermining Defendants' simplification argument, it is improbable—even if instituted—that the potentially instituted IPRs will have any bearing on claim construction in this case. The district court is not bound by the PTAB's claim constructions unless the terms have been subject to appellate review. *See In re Koninklijke Philips Pat. Litig.*, No. 4:18-cv-01885-HSG, 2020 WL 2733931, at *1 (N.D. Cal. May 26, 2020) ("the claim construction issues were not actually addressed and decided by the Federal Circuit and the Court is not bound by the underlying PTAB interpretations.") (citing *Koninklijke Philips N.V. v. Google LLC*, 948 F.3d 1330, 1334 n.5 (Fed. Cir. 2020)).

For the foregoing reasons, the simplification factor weighs against a stay.

2. The Cases Cited by Defendants Are Inapposite on the Facts.

The cases that Defendants cite are inapposite on the facts. Defendants wrongly compare the present litigation to *Mediatek, Inc. v. NXP Semiconductors N.V.*, No. 2:21-cv-04969-GW-AFMx, 2022 WL 17185976 (C.D. Cal. June 21, 2022). There, one of MediaTek's asserted patents had already expired and there were IPR petitions filed by NXP pending against five of the six patents asserted by Mediatek. Additionally, NXP had cross-asserted four of its own patents against Mediatek, who had already filed two IPR petitions on those patents and was planning to file more. Accordingly, there were major opportunities to simplify a complex patent competitor litigation given there were 10 patents asserted amongst the parties at various stages of post-grant review at the USPTO. Further, given there were a "myriad of distinct products and product types" (*Id.* at 3) and substantial third-party discovery was needed, the court decided a short stay was appropriate.

However, the *Mediatek* court recognized the circumstances were unique to that case and provided the following caution: "[T]he Court ***does not intend to alter its typical practice of waiting for institution decisions before considering stay motions***. The Court ***makes an exception*** to that practice here based on the specific facts of the case, including the combined factors of the cross-asserted patents and petitions, as well as the short duration of the allowed stay." *Id*. (emphasis added). In the present litigation, all of the accused products are Western Digital-branded SSDs, minimal (if any) third party discovery is expected, and there are only three asserted patents. Thus, the *Mediatek* exception should not be applied in the present litigation.

Other cases cited by Defendants are also distinguishable. In *Tire Hanger Corp. v. My Car Guy Concierge Servs. Inc.*, No. 5:14-cv-00549-ODW, 2015 WL 857888, at *2 (C.D. Cal. Feb. 27, 2015) (Wright, J.) the institution decision was expected to come very shortly after the court's decision and the parties had not yet participated in claim construction efforts—both of which are not found in the present litigation.

In *Dennis Fernandez v. Toyota Motor Corporation et al.*, No. 2:11-cv-09605, Dkt. 60 (C.D. Cal. Nov. 27, 2012) (Wright, J.) the case was at an earlier stage than the here because no discovery requests were served until two weeks before the motion and defendant had yet to serve responses. In *Lund Motion Products, Inc. v. T-Max Hangzhou Tech. Co.*, No. 17-cv-01914-CJC-JPR, 2019 WL 116784, at *2 (C.D. Cal. Jan. 2, 2019), along with the defendant being subject to estoppel, the case was at a different stage because no infringement contentions had been served on any of the 85 asserted claims in the four asserted patents, the IPR proceedings were at a later stage because plaintiff already filed its patent owner preliminary response (POPR), and the PTAB's institution decision was due within four months of the Court's decision, rather than nearly eight months (August 2025) in the present case.

In *One-E-Way, Inc. v. Apple Inc.*, No. 2:20-cv-06339-JAK-GJS, 2021 WL 4932518, at *4 (C.D. Cal. Mar. 16, 2021), unlike the present case, the defendant was

subject to estoppel, no trial date had been set, the parties had not exchanged any terms for construction, and no invalidity contentions had been served. In *SCA Hygiene Prods. Aktiebolag ("AB") v. Tarzana Enterprises, LLC*, No. 2:17-cv-04395-AB-JPRx, 2017 WL 5952166 (C.D. Cal. Sept. 27, 2017), unlike the present case, the defendant was subject to estoppel, no discovery responses had been served, and no trial date had been set. *Sleep No. Corp. v. Sizewise Rentals, LLC*, No. 5:18-cv-00356-AB-SPx, 2019 WL 1091335 (C.D. Cal. Feb. 12, 2019), involved multiple patents and in multiple cases, thereby making that case more complex—with the prospect of more potential conservations of judicial resources via a stay—than the present litigation.

In the remaining cases cited by Defendant, those parties were bound by the statutory estoppel provisions of 35 U.S.C. § 315(e)(2), which Western Digital Corporation has not agreed to in the present litigation. *See Wonderland Nursery Goods Co. v. Baby Trend, Inc.*, No. 5:14-cv-01153-VAP-SPx, 2015 WL 1809309 (C.D. Cal. Apr. 20, 2015) (trial date had not yet been set); *MicroPairing Techs. LLC v. Am. Honda Motor Co.*, No. 2:21-cv-04034-JVS-KES, 2022 WL 17219084, *1 (C.D. Cal. June 24, 2022) (estoppel applied); *Weserve Drone, LLC v. SZ DJI Tech. Co.*, No. 2:19-cv-04382-AB-AFMx, 2020 WL 4373365 (C.D. Cal. Mar. 17, 2020) (same); *Caravan Canopy Int'l, Inc. v. Home Depot U.S.A., Inc.*, No. 8:19-cv-01072-PSG-ADS, 2020 WL 5834297 (C.D. Cal. Aug. 19, 2020) (same); *Core Optical Techs., LLC v. Fujitsu Network Commc'ns, Inc.*, No. 8:16-cv-00437-AG-JPRx, 2016 WL 7507760, at *2 (C.D. Cal. Sept. 12, 2016) (same).

Lastly, Judge Birotte's February 4 decision in *Nike, Inc. v. Skechers U.S.A., Inc.*, No. 2:23-cv-09346-AB-PVC, 2025 WL 439935 (C.D. Cal. Feb. 4, 2025), while not yet cited by Defendants, is distinguishable from the present case. In *Nike*, the IPRs offered a very significant opportunity for simplification as Nike asserted six patents and *120* claims, compared to Polaris' three patents and *30* claims. The defendant in Nike was subject to 35 U.S.C. § 315(e)(2) estoppel, unlike Western

Digital Corporation. The PTAB's institution decisions in *Nike* were due within three months of the stay order, whereas here, the institution decisions will not come until August 2025. Also, two of Nike's asserted patents were subject to other instituted IPRs (highlighting their existing vulnerability), with final decisions expected soon after the stay order, potentially resolving a third of Nike's case quickly. None of these factors are present in Polaris' case.

Accordingly, the facts of the present litigation are different from those cases cited by Defendants, thereby making them inapplicable.

B. The Stage of the Case Factor Is Neutral.

Contrary to Defendants' assertions, there has already been significant work undertaken in this case that weighs against a stay. *See Polaris Innovations*, 2016 WL 7496740, at *2 (denying a stay because "the parties and the Court have expended non-trivial resources into this litigation. The parties have exchanged written interrogatories, requests for production, and proposed claim constructions."). Here, Polaris served document requests and interrogatories on October 2, 2024. Defendants served responses on November 1 and 22, 2024, respectively. Furthermore, substantial work has already been performed in preparing the parties' infringement and invalidity contentions. Polaris invested substantial resources in analyzing the Accused Products to prepare the comprehensive infringement contentions that were served October 2, 2024, and amended contentions served February 4, 2025. Polaris has spent substantial time analyzing Defendants' invalidity contentions, which total over 3,000 pages. And the parties have already accrued substantial time in the development and analysis of claim construction positions, which were exchanged on January 24, 2025. Given the stage of this case, Defendants' motion should be denied because "[s]taying this case now for months would prejudice Polaris and undermine this Court's efficient management of the case." *See Id.*

For the aforementioned reasons, this factor is neutral.

C. Polaris Would Be Unduly Prejudiced By a Stay, Thereby Weighing Against a Stay.

The third factor asks whether a stay would "unduly prejudice or present a clear tactical disadvantage to the nonmoving party." *Core Optical Techs.*, 2016 WL 7507760, at *2. As this Court has recognized, "the speculative nature of the petition also limits this Court's consideration of whether the parties would be prejudiced." *Zipshade*, 2015 WL 14094882, at *1. In addressing the "tactical advantage" factor, courts often "consider four sub-factors: '(1) the timing of the petition for review; (2) the timing of the request for the stay; (3) the status of review proceedings; and (4) the relationship of the parties." *Jiaxing Super Lighting Elec. Appliance*, 2020 WL 5079051, at *4 (citations omitted). In the present case, the status of the review proceedings and posture of the parties is dispositive.

1. Polaris is Unduly Prejudiced by Having to Relitigate the Same Prior Art in Different Venues.

Polaris faces significant prejudice by having to relitigate the same prior art in multiple venues. Western Digital Corporation, not being a party to the IPR petitions, gains a tactical advantage by getting two bites at the apple from an invalidity perspective, as it is not bound by 35 U.S.C. § 315(e)(2) estoppel. Evidence of Defendants' effort to exploit this advantage is clear, as the primary prior art references in the IPR petitions are also the primary references in Defendants' December 16, 2024, invalidity contentions. Additionally, most of the secondary references in the IPR petitions, except for U.S. Patent No. 5,787,460 ("Yashiro"), are also cited in Defendants' invalidity contentions. The following table illustrates the primary prior art reference overlap:

Prior Art Reference	Invalidity Contentions	IPR Petition
Asserted '346 Patent		
U.S. Pat. App. Pub. 2011/0078496 ("Jeddeloh")	Chart A1	Primary Reference
U.S. Patent No. 5,950,225 ("Kleiman")	Chart A2	Primary Reference
U.S. Patent No. 8,341,332 ("Mae")	Chart A3	Primary Reference

Asserted '085 Patent		
U.S. Patent No. 8,176,360 ("Frost")	Chart B1	Primary Reference
U.S. Pat. App. Pub. 2014/0136927 ("Li")	Chart B2	Primary Reference
U.S. Pat. App. Pub. 2008/0222490 ("Leung")	Chart B4	Primary Reference
U.S. Patent No. 9,037,951 ("Cideciyan")	Chart B12	Primary Reference
Asserted '968 Patent		
U.S. Pat. App. Pub. 2010/0262979 ("Borchers")	Chart C1	Primary Reference
PCI Local Bus Specification Revision 3.0; PCI Express® 2.0 Base Specification Revision 0.9	Chart C2	Primary Reference
U.S. Pat. App. Pub. 2011/0197003 ("Serebrin")	Chart C3	Primary Reference

Since Western Digital Corporation is not subject to estoppel, Polaris would be forced to litigate the prior art both in the IPRs and in the district court. This situation creates an unfair advantage for Defendants, allowing them to delay the litigation without repercussions while compelling Polaris to address the same prior art in two separate venues with different fact-finders.

2. Polaris is Unduly Prejudiced Because the IPRs Are Not Dispositive on Claim Construction Issues.

A stay in this case would unduly prejudice Polaris and lead to years of wasteful litigation because it may take 2-3 years to resolve the IPRs and appeals. In claim construction, Defendants are expected to argue that at least some, if not all, claim terms are indefinite, an issue the PTAB cannot consider. If this Court finds these terms indefinite, the entire IPR proceedings would be rendered moot, wasting both judicial and financial resources. *See Farstone*, 2015 WL 14094881, at *1 (Wright, J.) ("A finding of indefiniteness would be dispositive as to the entire case; therefore, the Court finds the issue appropriate for consideration at this time.").

Thus, the most efficient path is to deny the motion for a stay and proceed with claim construction to determine indefiniteness. The Markman hearing is scheduled for August 22, 2025, the same month the PTAB's institution decisions are expected, allowing informed decisions based on the Court's and PTAB's findings. In contrast, granting a stay would enable Defendants to argue broadly for invalidity during IPRs

and narrowly for infringement in Court, which is contrary to Federal Circuit law. As stated in *Southwall Techs., Inc. v. Cardinal IG Co.*, 54 F.3d 1570, 1576 (Fed. Cir. 1995), "Claims may not be construed one way in order to obtain their allowance and in a different way against accused infringers." Resolving indefiniteness now ensures consistent construction and mitigates prejudice to Polaris. And the PTAB will benefit from the Court's construction of disputed terms, ensuring uniformity for both infringement and invalidity, consistent with Federal Circuit law.

3. Polaris is Unduly Prejudiced By the Delay Due to Loss of Evidence.

Polaris would be prejudiced by a stay that could last years due to the loss of evidence relevant to its case. If instituted, the final written decisions would be due in August 2026. However, this date can be extended by up to 6 months to March 2027. 35 U.S.C. § 316(a)(11). A Federal Circuit appeal would add an additional 1-1.5 years. Then the case would need to begin again in district court, which could likely take another year to get to trial. A stay could thus present a 3 to 4-year delay from now delaying the resolution of Polaris' infringement claims for many years.

However, a multi-year stay could result in significant prejudice to Polaris in proving its case. Witnesses, like the third-party inventors and developers of the accused products, could become unavailable and their memories could fade. Other evidence, such as documents, may similarly be lost over time. This would severely prejudice Polaris in proving its case after a multi-year stay. *Pinn, Inc. v. Apple, Inc.*, No. 8:19-cv-01805-DOC-JDE, 2020 WL 6064642, at *2 (C.D. Cal. Aug. 27, 2020) (denying motion to stay holding that "the Court finds that the increased difficulty of proving its case after the stay is lifted will be especially prejudicial to Plaintiff."). Accordingly, because Polaris will be prejudiced by a stay, the Court should deny the motion to stay.

4. The Status of Proceedings Does Not Warrant a Stay, But Instead Just Causes Prejudice to Polaris.

The PTAB has not yet decided whether to institute the IPRs and thus the

proceedings before the PTAB are at their earliest stage. As explained above, this alone counsels against granting a stay. *DMF*, 2019 WL 13378212, at *1 ("The Court will not entertain any motions to stay the case until the PTAB has granted defendants' IPR petition."); *Polaris Innovations*, 2016 WL 7496740, at *2 ("The Court finds that a stay is not warranted. . . . [Defendant] has only petitioned for IPR. Decisions whether to grant review on those petitions may not be reached [for six months]."); *see also California Inst. of Tech*., 2017 WL 11835427, at *2. The early stage of the IPRs particularly counsels against a stay because the trial in this case is set for June 2026, two months before the statutory deadline for final written decisions from the PTAB. *Toshiba Tec Corp. v. Katun Corp.*, No. 8:15-cv-01979-SJO-JCx, 2016 WL 9137646, at *5 (C.D. Cal. Sept. 21, 2016) ("[T]he PTAB must still decide [whether] to review, and would then have an additional twelve months to make a final determination. . . . This means the parties' dispute will be resolved more quickly and efficiently by proceeding to trial[.]").

5. Defendants' Purported Hardship Due to Defense Costs is Irrelevant.

Although Defendants argue that the cost of defense is a hardship, legal authority establishes that does not constitute sufficient prejudice or hardship in the context of a motion to stay. *See, e.g., Intell. Ventures I LLC v. Toshiba Corp.*, No. 1:13-cv-453-SLR-SRF, 2015 WL 3773779, at *2 (D. Del. May 15, 2015) ("Toshiba has not demonstrated a clear case of hardship or inequity if the motion for stay is denied. Toshiba chose to contest validity through the IPR process and, therefore, cannot complain that it is being prejudiced by the dual track proceedings it initiated."); *SenoRx, Inc. v. Hologic, Inc.*, No. 1:12-cv-173-LPS, 2013 WL 144255, at *9 (D. Del. Jan. 11, 2013) ("[I]n attempting to articulate the hardship or prejudice it might face, [defendant] has cited to the added litigation costs that it might incur were reexamination to proceed in tandem with this case. This type of economic harm has been deemed not to amount to the kind of 'undue' hardship or inequity referenced

in the case law."); *Personalized User Model, L.L.P. v. Google, Inc.*, No. 1:09-cv-525-LPS, 2012 WL 5379106, at *2 (D. Del. Oct. 31, 2012) (noting that moving party had made no such showing of clear hardship or inequity when the only prejudice it argued it would incur in proceeding with the litigation was added litigation cost).

Therefore, because Polaris would be unduly prejudiced by a stay under the facts of this case, this factor weighs against a stay.

V. CONCLUSION

Defendants' motion to stay should be denied as it was filed prematurely before the institution of the IPR petitions, which disregards this District's established practice of denying pre-institution motions. Defendants have not provided a compelling reason or unique circumstances to justify deviating from this practice. Filing the IPR petitions close to the one-year deadline appears to be a tactic to delay litigation, and the PTAB's decision will not significantly simplify the issues at hand, but will instead unduly prejudice Polaris. Given these factors and the speculative impact on claim construction, the Court should deny the motion.

Dated: February 10, 2025

By: */s/ Robert F. Kramer*

KRAMER ALBERTI LIM & TONKOVICH LLP

Attorneys for Plaintiff
Polaris PowerLED Technologies, LLC

CERTIFICATE OF COMPLIANCE

The undersigned counsel of record for Plaintiff certifies that this brief contains 6,760 words, which complies with the 7,000 word limit of L.R. 11-6.1.

By: */s/ Robert F. Kramer*