

IN THE UNITED STATES DISTRICT COURT
FOR THE SOUTHERN DISTRICT OF FLORIDA
MIAMI DIVISION

AIR ESSSENTIALS, INC.,)	
)	
Plaintiff,)	
)	
v.)	Case No. 24-cv-20594-KMW
)	
AROMA360, LLC,)	
)	
Defendants.)	

JOINT MOTION TO STAY
PENDING INTER PARTES REVIEW

Plaintiff Air Essentials, Inc., together with Defendant Aomra360, LLC, hereby jointly request that this action should be stayed pending *inter partes* review of the asserted patents by the U.S. Patent and Trademark Office (USPTO). The parties believe it would be appropriate to refer this motion to Magistrate Judge Goodman under 28 U.S.C. 636(b)(1) and Local Magistrate Rule 1, given that the claim construction hearing scheduled for April 17 has also been referred to Magistrate Judge Goodman, and the hearing may be cancelled in light of the present motion. In support thereof, the parties state as follows:

On February 15, 2024, Air Essentials, Inc. (Plaintiff) filed a complaint against Aroma360, LLC (Defendant) alleging infringement of U.S. Patent Nos. 10,583,449 ('449 patent) and 10,092,918 ('918 patent). On June 11, 2024, Plaintiff filed an amended complaint against Defendant additionally alleging infringement of U.S. Patent No. 9,527,094 ('094 patent). On March 18, 2025, Defendant filed petitions at the Patent Trial and Appeal Board (PTAB) seeking *inter partes* review (IPR) of all asserted claims of the '449, '918, and '094 patents.¹

¹ The IPR petitions are IPR2025-00705, IPR2025-00706, IPR2025-00707.

Courts consider three factors in determining the appropriateness of a stay pending PTAB review: (1) whether the stay will unduly prejudice or present a clear tactical disadvantage to the nonmoving party; (2) whether the stay will simplify issues in question and trial of the case; and (3) whether discovery is complete and whether a trial date has been set. See, e.g., *Payrange, Inc. v. Kiosoft Techs.*, No. 20-CV-24342-SCOLA/GOODMAN, 2022 U.S. Dist. LEXIS 48938, *8-9 (S.D. Fla. Mar. 18, 2022).

With regard to the first factor, while the parties are competitors, and Plaintiff would prefer to seek relief at the earliest possible juncture, the Plaintiff has considered that, on balance of the totality of the circumstances, the resources of both the parties and the Court will be more effectively utilized if a stay is entered. Parallel litigation and PTAB review could lead to duplicative efforts and inconsistent outcomes. Courts "routinely" grant stays pending PTAB review "in order to avoid inconsistent results, obtain guidance from the PTAB, or avoid needless waste of judicial resources." *Id.* (referring to *Targus Int'l LLC v. Grp. III Int'l, Inc.*, 2021 U.S. Dist. LEXIS 3297, at *2 (S.D. Fla. Jan. 8, 2021) and quoting *Evolutionary Intel., LLC v. Apple, Inc.*, 2014 U.S. Dist. LEXIS 2763, 2014 WL 93954, at *2 (N.D. Cal. Jan. 9, 2014)). Defendant has asserted that no prejudice will arise. Moreover, this being a joint motion, there is no "nonmoving" party. The parties agree the above-captioned action should be stayed until the PTAB has issued final written decisions in IPR2025-00705, IPR2025-00706, IPR2025-00707, or declined to institute the IPR proceedings, and request that the Court stay the proceedings in this action accordingly.

On the second factor, all asserted patent claims are challenged by the IPR petitions. The Southern District of Florida has recognized that PTAB review of the asserted claims will likely narrow the issues because the PTAB will provide its interpretation of the claims. *Id.*

With respect to the final factor, while the parties have invested time and resources in preliminary discovery, infringement and invalidity contentions, as well as claim construction briefing, both Plaintiff and Defendant having outstanding discovery due one another and no depositions having been scheduled. Regardless of the precise stage of litigation, the parties agree that discovery is not complete and that a stay will benefit the parties despite the investment in discovery made to date. The *Payrange* Court found a similarly advanced stage of litigation to be a neutral factor, or perhaps only marginally in favor of denial, but not enough to tip the other factors. *Id* at *16. Trial is currently scheduled during the Court's two-week trial calendar beginning on March 9, 2026.

In summary, the parties have conferred and agree a stay at this stage of the proceedings would narrow the issues, promote judicial efficiency, preserve judicial resources, and avoid inconsistent results as the PTAB's final written decision for the subject IPRs will likely be issued subsequent to the trial to be scheduled in this case, and thus a stay may avoid duplicative proceedings.

WHEREFORE, the parties jointly pray that the Court grant the instant motion and enter an Order (1) staying the above-captioned action until the PTAB has issued final written decisions in IPR2025-00705, IPR2025-00706, IPR2025-00707, or declined to institute the IPR proceedings; and (2) requiring the parties to submit a joint status report and request for status conference within 10 days after the PTAB has issued a final written decision in the IPRs, or declined to institute the IPR proceedings, whichever comes sooner.

Dated: April 7, 2025.

Respectfully submitted,

/s/ W. John Eagan

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