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**U.S. District Court**  
**District of Delaware (Wilmington)**  
**CIVIL DOCKET FOR CASE #: 1:20-cv-00361-JLH-CJB**

Speyside Medical, LLC v. Medtronic Corevalve, LLC et al  
Assigned to: Judge Jennifer L. Hall  
Referred to: Judge Christopher J. Burke  
Cause: 35:1 Patent Infringement

Date Filed: 03/13/2020  
Date Terminated: 09/05/2024  
Jury Demand: Plaintiff  
Nature of Suit: 830 Patent  
Jurisdiction: Federal Question

**Plaintiff****Speyside Medical, LLC**

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09/23/2021	<a href="#">145</a>	ORAL ORDER: The Court has reviewed the parties' letter briefs relating to Defendants' renewed motion to stay ("Motion"). (D.I. 134) The Motion presents a tough call, and the Court is still considering it. By no later than September 24, 2021, the parties shall jointly submit a one-page letter, in which they each provide their respective position (in a few sentences) on the following question: "Should the Court consider, when deciding the Motion, a third alternative: staying the case as to the '118, '897 and '708 patents (i.e., the patents in IPR), but allowing it to proceed forward as to the '941 and '040 patents (i.e., the patents not in IPR)? In other words, if the Court ultimately did not agree with Plaintiff that the entire case should move forward as to all five patents, would Plaintiff want the Court to consider the above alternative option? And if the Court did not ultimately agree with Defendants that the case should be stayed in its entirety, would Defendants want the Court to consider that alternative option? Ordered by Judge Christopher J. Burke on 9/23/2021. (dlb) (Entered: 09/23/2021)
09/23/2021	<a href="#">146</a>	NOTICE to Take Deposition of Mark Casley on October 29, 2021 filed by Speyside Medical, LLC.(Egan, Brian) (Entered: 09/23/2021)
09/23/2021	<a href="#">147</a>	NOTICE to Take Deposition of Niall Duffy on October 22, 2021 filed by Speyside Medical, LLC.(Egan, Brian) (Entered: 09/23/2021)
09/23/2021	<a href="#">148</a>	NOTICE to Take Deposition of Ben Lebow on October 21, 2021 filed by Speyside Medical, LLC.(Egan, Brian) (Entered: 09/23/2021)
09/23/2021	<a href="#">149</a>	NOTICE to Take Deposition of Brett Madden on November 5, 2021 filed by Speyside Medical, LLC.(Egan, Brian) (Entered: 09/23/2021)
09/23/2021	<a href="#">150</a>	NOTICE to Take Deposition of Neil Yanke on November 3, 2021 filed by Speyside Medical, LLC.(Egan, Brian) (Entered: 09/23/2021)
09/24/2021	<a href="#">151</a>	Joint Letter to The Honorable Christopher J. Burke from Brian P. Egan regarding Stay Motion - re 145 Oral Order,,,,, (Egan, Brian) (Entered: 09/24/2021)
09/29/2021	<a href="#">152</a>	NOTICE OF SERVICE of Defendants' Supplemental Responses to Plaintiff's First Set of Interrogatories (No. 7) filed by Medtronic Corevalve, LLC, Medtronic, Inc..(Biggs, Brian) (Entered: 09/29/2021)
09/30/2021	<a href="#">153</a>	MOTION to Amend/Correct <a href="#">81</a> Answer to Amended Complaint, <i>Defendants' Motion for Leave to Amend Answer</i> - filed by Medtronic Corevalve, LLC, Medtronic, Inc.. (Attachments: # <a href="#">1</a> Text of Proposed Order)Motions referred to Christopher J. Burke. (Biggs, Brian) (Entered: 09/30/2021)
09/30/2021	<a href="#">154</a>	[SEALED] Letter to The Honorable Christopher J. Burke from Brian A. Biggs regarding Leave to Amend Its Answer to the Second Amended Complaint - re <a href="#">153</a> MOTION to Amend/Correct <a href="#">81</a> Answer to Amended Complaint, <i>Defendants' Motion for Leave to Amend Answer</i> . (Attachments: # <a href="#">1</a> Exhibit A, # <a href="#">2</a> Exhibit B, # <a href="#">3</a> Exhibit C, # <a href="#">4</a> Exhibit D, # <a href="#">5</a> Exhibit E, # <a href="#">6</a> Certificate of Service)(Biggs, Brian) (Entered: 09/30/2021)
<b>09/30/2021</b>	<b><a href="#">155</a></b>	ORAL ORDER: The Court, having reviewed Defendants' motion to stay pending inter partes review ("IPR"), (D.I. 134 or "the Motion"), and having reviewed the parties' letter briefing, (D.I. 135; D.I. 138; D.I. 140; D.I. 151), and having considered the three stay-related factors, hereby ORDERS that the Motion is GRANTED and the entire case is STAYED. As the Court noted earlier, the Motion presents a tough call, (D.I. 145), and Plaintiff makes some understandable arguments in favor of denial of the Motion, (D.I. 138). But for the following reasons, the Court concludes that a stay is nevertheless appropriate: (1) If the case involved only three of the five patents-in-suit the '118 patent, the '897 patent and the '708 patent the decision to stay the case would be a fairly easy "yes." (D.I. 135 at 2) With regard to the simplification factor, it would favor Defendants, all asserted claims of those patents are being reviewed by the United States Patent Trial and Appeal Board, Ex. 1045

and Appeal Board ("PTAB"). More than that, in its institution decisions, the PTAB emphasized that the petitioner had raised strong grounds of invalidity as to all challenged claims of those patents (i.e., not just as to one claim per patent). (D.I. 130, ex. A at 20, 38-40; id., ex. B at 16, 26-29; id., ex. C at 35, 41) There is thus the very real possibility that any work done with regard to those patents in the District Court could be wasted if all or many of these asserted claims end up being invalidated. (D.I. 135 at 2-3; D.I. 140 at 2 (noting, for example, that the Court has been asked to construe 10 claim terms at an upcoming Markman hearing, seven of which relate to the three patents in the instituted IPRs)) Even if some claims from these three patents survive, efficiencies will be gained (via estoppel as to certain defenses, and for other reasons) from seeing the IPR processes through first. See *Ethicon LLC v. Intuitive Surgical, Inc.*, C.A. No. 17-871-LPS, 2019 WL 1276029, at \*2 (D. Del. Mar. 20, 2019). Plus, Final Written Decisions in these IPRs are due just weeks before trial is scheduled to start in October 2022 providing for the prospect of a hectic and disjointed pre-trial process if no stay was instituted and the PTAB issued its decisions on the eve of trial. As for the case status factor, it would slightly favor Defendants. While the case is not in its early stages, (D.I. 108), there is also still much to do (including taking all or nearly all of the depositions in the case, holding a Markman hearing and resolving claim construction, pursuing expert discovery, and resolving summary judgment and Daubert motions). See *IOENGINE, LLC v. PayPal Holdings, Inc.*, Civil Action No. 18-452-WCB, Civil Action No. 18-826-WCB, 2019 WL 3943058, at \*5 (D. Del. Aug. 21, 2019). And the undue prejudice factor would also favor Defendants, as the parties are not competitors, (D.I. 135 at 2), and Defendants timely sought a stay in this Court, (D.I. 85), and renewed it timely upon institution of the IPRs.;

(2) The wrinkle here is that the PTAB did not institute on two of the five patents-in-suit (the '941 patent and the '040 patent). The Court considered the prospect of permitting the case to move forward just as to those two patents, and staying the case only as to the other three. It asked the parties for their view on that. (D.I. 145) But neither side, including Plaintiff, indicated that they thought this would be a particularly positive outcome from an efficiency or an equity perspective. (D.I. 151 at 1) Thus, the Court will not consider that idea further, and will instead treat the Motion as an all-or-nothing proposition.;

(3) In the end, although the '941 patent and the '040 patent will not be at issue in the IPRs, and a trial would certainly be needed as to those patents at some point, the Court concludes that there are enough potential simplification gains to warrant staying the case as to these patents as well. The '941 patent and the '040 patent are very closely related to the '118 patent. The patents all share a common specification and similar claim language, certain original claims of the '941 patent were rejected by the Examiner on nonstatutory double-patenting grounds over a claim of the '118 patent, and some of the prior art at issue with regard to the '118 patent IPR is also asserted in this case against the '941 and '040 patents. (D.I. 135 at 3; id., at exs. C, E & F); see also *IOENGINE, LLC*, 2019 WL 3943058, at \*9. So, with regard to the three patents in IPR, the PTAB will likely be considering (and hearing argument from the parties about) a lot of the same claim language and overlapping prior art as the Court would be considering here as to the '941 and '040 patents. Although it will require some delay, it makes sense under the circumstances to have the PTAB's work be done first, and for the Court and the parties to benefit from that work in the District Court thereafter.;

(4) Within five business days of the issuance of a Final Written Decision in the last of the IPRs at issue to resolve, the parties shall jointly file a letter, of no more than three single-spaced pages, providing their views as to whether a case schedule should be entered. Ordered by Judge Christopher J. Burke on 9/30/2021. (dlb). (Entered: 09/30/2021)

09/30/2021

Case stayed per Oral Order issued today. (dlb) (Entered: 09/30/2021)

10/01/2021

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ORAL ORDER: The Court, having reviewed Defendants' September 30, 2021 letter, (D.I. 154), hereby ORDERS as follows: in light of the Court's recent order granting Defendants' motion to stay pending inter partes review, (D.I. 155), the Defendants' motion  
FreightCar America, Ex. 1045