

U.S. District Court
District of Delaware (Wilmington)
CIVIL DOCKET FOR CASE #: 1:19-cv-01334-CJB

Midwest Energy Emissions Corp. et al. v. Arthur J. Gallagher & Co., et al.
Assigned to: Judge Christopher J. Burke
Cause: 35:271 Patent Infringement

Date Filed: 07/17/2019
Jury Demand: Plaintiff
Nature of Suit: 830 Patent
Jurisdiction: Federal Question

Plaintiff

Midwest Energy Emissions Corp.

represented by **James Michael Lennon**
Devlin Law Firm
1526 Gilpin Avenue
19806
Wilmington, DE 19806
302-449-9010
Fax: 302-353-4251
Email: jlennon@devlinlawfirm.com
LEAD ATTORNEY
ATTORNEY TO BE NOTICED

Adrienne R. Dellinger
Email: adellinger@caldwellcc.com
PRO HAC VICE
ATTORNEY TO BE NOTICED

Aisha M. Haley
Email: ahaley@caldwellcc.com
PRO HAC VICE
ATTORNEY TO BE NOTICED

Daniel R. Pearson
Email: dpearson@caldwellcc.com
PRO HAC VICE
ATTORNEY TO BE NOTICED

Peter Akawie Mazur
Devlin Law Firm LLC
1526 Gilpin Avenue
Wilmington, DE 19806
302-203-0078
Fax: 302-353-4251
Email: pmazur@devlinlawfirm.com
ATTORNEY TO BE NOTICED

Richard A. Cochrane
Email: rcochrane@caldwellcc.com

12/01/2020	248	STIPULATION and Order of Dismissal with Prejudice as to Defendants AEP Generation Resources Inc., Southwestern Electric Power Co., AEP Texas Inc. and Cardinal Operating Co., LLC, by MES Inc., Midwest Energy Emissions Corp.. (Lennon, James) Modified on 12/1/2020 (nms). (Entered: 12/01/2020)
12/01/2020	249	SO ORDERED Granting 248 Stipulation and Order of Dismissal (*Party AEP Texas Inc., Southwestern Electric Power Co., and AEP Generation Resources Inc. terminated). Signed by Judge Richard G. Andrews on 12/1/2020. (nms) (Entered: 12/01/2020)
12/01/2020	250	NOTICE OF SERVICE of Plaintiffs' Second Amended Section 7.c Disclosures to NRG filed by MES Inc., Midwest Energy Emissions Corp..(Lennon, James) (Entered: 12/01/2020)
12/02/2020		REDACTION NOTICE: In accordance with section G of the Administrative Procedures Governing Filing and Service by Electronic Means, redacted versions of sealed documents shall be filed electronically within 7 days of the filing of the sealed document. The records of this case do not reflect the filing of a redacted version of DI # 243 . (nms) (Entered: 12/02/2020)
12/02/2020	251	REDACTED VERSION of 243 Exhibit 2, by MES Inc., Midwest Energy Emissions Corp.. (Lennon, James) Modified on 12/3/2020 (nms). (Entered: 12/02/2020)
12/02/2020	252	Submission of Subsequent Information re 234 MOTION to Stay the Case Pending Inter Partes Review, by Brandon Shores LLC, H. A. Wagner LLC, Midwest Generation EME, LLC, Midwest Generation, LLC, NRG Energy, Inc., NRG Texas Power LLC, Talen Energy Corporation, Talen Generation LLC (Attachments: # 1 Exhibit N, # 2 Exhibit O, # 3 Exhibit P, # 4 Exhibit Q, # 5 Exhibit R)(DiGiovanni, Francis) Modified on 12/3/2020 (nms). (Entered: 12/02/2020)
12/09/2020		Minute Entry for proceedings held before Judge Christopher J. Burke - Telephonic Motion Hearing held on 12/9/2020 regarding D.I. 234 MOTION to Stay the Case Pending Inter Partes Review filed by Midwest Generation EME, LLC, H. A. Wagner LLC, Midwest Generation, LLC, Southwestern Electric Power Co., NRG Energy, Inc., Brandon Shores LLC, AEP Generation Resources Inc., Talen Generation LLC, NRG Texas Power LLC, Talen Energy Corporation, AEP Texas Inc. The Court heard argument from the parties and took the motion under advisement. (Court Reporter Jennifer Guy. Clerk: M. Crawford) Appearances: V. Schad, J. Nemunaitis for Plaintiffs; F. DiGiovanni, S. Fareed, T. Rahmeier, D. Tobin for Talen Defendants; T. Cragg, E. Flannery, A. Dhanani, T. Carter for NRG Defendants;B. Egan, J. Evall and R. Mark for Refined Coal Defendants; and N. DiSalvo, D Nemec for CERT Defendants. (mlc) (Entered: 12/09/2020)
12/10/2020	253	ORAL ORDER: The Court, having reviewed the Talen and NRG Defendants' (the "Moving Defendants") Motion to Stay the Case Pending Inter Partes Review, ("motion"), (D.I. 234), and the parties' briefing and submission of subsequent information related thereto, (D.I. 235; D.I. 241; D.I. 246; D.I. 252), having heard argument on December 9, 2020, and having considered the three stay-related factors, hereby ORDERS that the Motion is GRANTED and Plaintiffs' patent infringement claims against the Moving Defendants with respect to the asserted patents (United States Patent Nos. 8,168,147 ("147 patent"), 10,343,114 ("114 patent"), 10,589,225 ("225 patent"), 10,596,517 ("517 patent") and 10,668,430 ("430 patent" and collectively with the '225 patent and the '417 patent, the "newly-asserted patents")) are STAYED until at least final written decisions have been entered regarding Moving Defendants' inter partes review ("IPR") petitions that have been instituted against the '114 patent and the '147 patent. As to the '114 patent and the '147 patent, the motion is not difficult. With respect to the "simplification" factor, nearly all asserted claims (but for two dependent claims asserted against the NRG Defendants) are at issue in the IPR proceedings. Thus, there is a very good chance that the

parties and the Court could engage in a significant amount of pre-trial work, only to have the PTAB end up invalidating nearly all asserted claims (or otherwise issuing decisions that will have a significant bearing on the patent infringement claims in this matter, including regarding the priority date of the '114 patent). (D.I. 235 at 9-11; D.I. 246 at 2-4) With respect to the "stage of the litigation" factor, this case is in its early stages. There have not yet been any depositions; claim construction briefing is not set to begin until March 2021 with the Markman hearing scheduled for July 2021; opening expert reports are due in April 2022 and a first trial is set for January 9, 2023. (D.I. 235 at 11-12; D.I. 246 at 4-6; see also D.I. 140) With respect to the "relationship between the parties" prong of the "undue prejudice" factor, the Moving Defendants do not directly compete with Plaintiffs, and the case is currently already stayed against the other Refined Coal Defendants (with the Court having previously found that Plaintiffs showing of harm with respect to those Defendants was "not robust"). (D.I. 235 at 13; D.I. 166) And the other subfactors with respect to "undue prejudice" also support a stay, with: (1) Moving Defendants' IPR petitions having been timely filed; (2) the instant motion having been filed promptly after the PTAB issued its institution decisions with respect to the '114 patent; and (3) the IPR proceedings now underway with respect to both the '114 patent and the '147 patent. (D.I. 235 at 12-14; D.I. 246 at 6-8) The only difficult wrinkle with respect to the motion is whether a stay of the entire case makes sense, in light of the fact that there are five asserted patents at play here, including the three newly-asserted patents for which IPR petitions have not yet been filed (in light of the applicable statutory waiting period of nine months from the date of the grant of a patent). (D.I. 235 at 12) But for the following reasons, a stay of the entire case as to the Moving Defendants makes sense, even though no IPR has yet been instituted on those three newly-asserted patents: (1) All five asserted patents are from the same patent family, share the same title, share the same inventors, relate to similar technology and are asserted against the same infringing conduct. (D.I. 130 at paragraphs 237, 270, 304, 333, 362; D.I. 235 at 7; D.I. 246 at 2-3); (2) Even Plaintiffs have acknowledged that, in light of this, there is significant overlap among the patents (i.e., with regard to relevant claim terminology, relevant witnesses, etc.). Indeed, during oral argument, Plaintiffs' counsel admitted that in light of such overlap, it would be complicated to stay the case only as to the '114 patent and the '147 patent but not as to the newly-asserted patents.; (3) Further, it is reasonable to expect that there will be arguments made and decisions issued regarding claim scope, claim construction, and invalidity issues in the IPR proceedings for the '114 patent and the '147 patent that will have an impact on the newly-asserted patents. (D.I. 235 at 9-10; D.I. 246 at 2-4); (4) Moreover, Moving Defendants have confirmed that they intend to promptly file IPR petitions with respect to the newly-asserted patents following the expiration of the statutory waiting periods, and that prior art that is at issue in the '114 patent and the '147 patent IPR proceedings will also be put at issue with regard to these to-be-filed IPR petitions; and (5) If it turns out that the PTAB does not institute IPR on some or all of the newly-asserted patents, Plaintiffs would of course be free to update the Court regarding that and to move to lift the stay, if they believe that is warranted. Accordingly, the case is STAYED as set out above. Additionally, the parties shall jointly notify the Court by letter within 10 days after any of the following events occurs: (1) Moving Defendants file IPR petitions with respect any of the newly-asserted patents; (2) the PTAB issues institution decisions with respect to any of those patents; and (3) the PTAB issues Final Written Decisions with respect to the IPR proceedings for either of the '114 and '147 patents. The parties shall also submit a joint status report on the IPR proceedings 90 days after entry of this order and every 90 days thereafter. (D.I. 235 at 15). Ordered by Judge Christopher J. Burke on 12/10/2020. (dlb) (Entered: 12/10/2020)

12/10/2020

254

ORAL ORDER: In light of the stay of the case entered as to the Talen Defendants and the NRG Defendants, the Court hereby ORDERS as follows: (1) By no later than December 16, 2020, Plaintiffs and the Defendants that did not move for a stay of the case pending