

**U.S. District Court**  
**District of Delaware (Wilmington)**  
**CIVIL DOCKET FOR CASE #: 1:21-cv-01484-MN-CJB**

ImmerVision, Inc. v. Apple, Inc.  
Assigned to: Judge Maryellen Noreika  
Referred to: Judge Christopher J. Burke  
Related Cases: [1:18-cv-01630-MN-CJB](#)  
[1:18-cv-01631-MN-CJB](#)  
[1:21-cv-01733-MN-CJB](#)  
[1:25-cv-00366-MN-CJB](#)  
[1:21-cv-01570-MN-CJB](#)  
[1:23-cv-01012-MN-CJB](#)

Date Filed: 10/22/2021  
Jury Demand: Plaintiff  
Nature of Suit: 830 Patent  
Jurisdiction: Federal Question

Cause: 35:271 Patent Infringement

**Plaintiff**

**ImmerVision, Inc.**

represented by **John David Simmons**  
Panitch Schwarze Belisario & Nadel LLP  
Delaware Corporate Center  
1 Righter Parkway  
Suite 220  
Wilmington, DE 19803  
215-965-1261  
Email: [jsimmons@panitchlaw.com](mailto:jsimmons@panitchlaw.com)  
*LEAD ATTORNEY*  
*ATTORNEY TO BE NOTICED*

**Dennis James Butler**  
Panitch Schwarze Belisario & Nadel LLP  
Delaware Corporate Center  
1 Righter Parkway  
Suite 220  
Wilmington, DE 19103  
302-394-6006  
Fax: 215-965-1331  
Email: [dbutler@panitchlaw.com](mailto:dbutler@panitchlaw.com)  
*ATTORNEY TO BE NOTICED*

**Keith A. Jones**  
Email: [kjones@panitchlaw.com](mailto:kjones@panitchlaw.com)  
*PRO HAC VICE*  
*ATTORNEY TO BE NOTICED*

**Keith Aaron Jones**  
Panitch Schwarze Belisario & Nadel LLP  
Delaware Corporate Center  
1 Righter Parkway

FreightCar America, Ex. 1042

		would need to be held. Ordered by Judge Christopher J. Burke on 10/16/2023. (mlc) (Entered: 10/16/2023)
10/16/2023		Minute Entry for proceedings held before Judge Christopher J. Burke - Hearing on Defendants Motion to Stay held on 10/16/2023. The Court heard the parties' arguments regarding Defendant's Motion to Stay. (D.I. 147) The Court took the matter under advisement. (Clerk: A. Herman)Appearances: D. Butler and K. Jones for Plaintiff; J. Hartjes, D. Moore, M. Pieja, T. Terhufen and S. Zhang for Defendant. (Court Reporter Deanna Warner) (dlb) (Entered: 10/17/2023)
10/17/2023	159	<p>ORAL ORDER: The Court, having reviewed Defendant's Motion to Stay Pending Inter Partes Review ("IPR") ("Motion"), (D.I. 147), and the briefing related thereto, (D.I. 148; D.I. 151; D.I. 155), having held a videoconference hearing on the Motion on October 16, 2023, and having considered the three stay-related factors, hereby ORDERS that the Motion is GRANTED and the case is STAYED pending completion of the instituted IPR proceeding related to the 990 patent (the "990 patent IPR"), for the reasons that follow: (1) The Motion comes to the Court in a somewhat unusual procedural posture. In this case, Plaintiff is asserting infringement solely of claim 21 of the 990 patent. In a separate case before this Court, Civil Action No. 21-1733-MN-CJB (the "1733 action"), Plaintiff is asserting infringement of other claims of the 990 patent. All of the claims of the 990 patent that are asserted in the 1733 action are at issue in the 990 patent IPR; as a result, the parties agreed that the 1733 action should be stayed. But claim 21 is not at issue in the 990 patent IPR; in light of that, and in light of the fact that claim 21 has been asserted on its own in a stand-alone civil action, Plaintiff resists a stay here.; (2) With regard to the simplification of issues factor, if the PTAB ultimately concludes that all asserted claims at issue in the 990 patent IPR are invalid (i.e., what Defendant thinks will happen), then it appears that staying the case in the interval will not have simplified much. That is in part because Plaintiff's counsel convinced the Court during the hearing that it is unlikely that the PTAB will address any claim construction or invalidity matter in the 990 patent IPR that is likely to be at play in this case as to claim 21. On the other hand, if the PTO does not invalidate the claims at issue in the 990 patent IPR (i.e., what Plaintiff thinks will happen), then staying this case in the interval will probably have simplified the proceedings here somewhat. That is because absent a stay, there will likely be some depositions of at least Defendant's personnel that would have been taken in this case and then would need to be taken again in the 1733 action (in light of the fact that different accused products are at issue in the 1733 action, as compared to this action). (D.I. 155 at 2) Additionally, absent a stay in this scenario, two rounds of summary judgment and Daubert briefing/hearings would need to be held (one in this action and one in the 1733 action) -- as opposed to one combined summary judgment/Daubert process. Plus, since the PTAB's Final Written Decision in the 990 patent IPR is due in late summer 2024 (prior to the October 2024 trial scheduled in this case), if the PTAB upheld the claims at issue in that IPR, then no doubt this case would need to then be paused anyway, so that the 1733 action could catch up to it. With the prospect for simplification wavering between "very little" (if one outcome occurs at the PTAB) and "some real amount" (if the other outcome occurs), the Court finds this factor to either slightly favor a stay, or to be neutral. Cf. Kaavo Inc. v. Cognizant Tech. Sols. Corp., Civil Action No. 14-1192-LPS-CJB, Civil Action No. 14-1193-LPS-CJB, 2015 WL 1737476, at *2-3 (D. Del. Apr. 9, 2015) (noting that a court must assess all of the possible outcomes of the proceeding that the case would be stayed in favor of, not just the potential outcome most favorable to the party seeking a stay).; (3) With regard to the second "status of the case" factor, at the time of the Motion's filing: (a) the case had proceeded through a good bit of document discovery, but no depositions had been taken; (b) a Markman hearing was held, but no Markman decision has issued; and (c) the expert discovery, summary judgment and pre-trial phases were still a ways away. Moreover, other than addressing a protective order dispute, (D.I. 136), and a discovery dispute, (D.I. 142), and holding the Markman</p>

		hearing, the Court has not had to expend significant resources on this case yet. Thus, with the case being in about the middle of its schedule, and with the Court having invested somewhat less time in it than in the typical patent case of this age, the status of the case factor is neutral. See WSOU Invs., LLC v. Netgear, Inc., Civil Action No. 21-1117-MN-CJB, Civil Action No. 21-1120-MN-CJB, 2022 WL 17337924, at *1 (D. Del. Nov. 30, 2022) (concluding the same, in a patent case at a similar stage to this one).; (4) Lastly, the undue prejudice factor surely favors a stay. It is undisputed that the parties are not competitors. (D.I. 148 at 3) Additionally, the 990 patent has expired, and so only money damages are at stake here regarding past alleged infringement; Plaintiff can capture those damages just as well in 2025 as it could in 2024. Indeed, Plaintiff did not even address this factor in its answering brief. (D.I. 151); and (5) In the end, with a stay allowing the Court and the parties to only have to address certain 990 patent-related issues one time (as opposed to potentially twice), and with no undue prejudice befalling Plaintiff in the event of a stay, Defendant's Motion should be granted. Ordered by Judge Christopher J. Burke on 10/17/2023. (dlb) (Entered: 10/17/2023)
10/17/2023	160	ORAL ORDER: In light of the Court's order to stay this case, the Court hereby ORDERS that each of the following pending motions is DENIED without prejudice to renew, if and when the stay is lifted: (1) Plaintiff's Motion for Claim Construction, (D.I. 117), (2) Defendant's Motion for Claim Construction, (D.I. 118), and (3) Defendants Motion for Judgment on the Pleadings, (D.I. 110). Ordered by Judge Christopher J. Burke on 10/17/2023. (dlb) (Entered: 10/17/2023)
11/01/2023	<a href="#">161</a>	Official Transcript of Motion to Stay held on 10/16/23 before Judge Christopher Burke. Court Reporter Deanna Warner, Email: deanna_warner@ded.uscourts.gov. Transcript may be viewed at the court public terminal or order/purchased through the Court Reporter before the deadline for Release of Transcript Restriction. After that date, it may be obtained through PACER. Redaction Request due 11/22/2023. Redacted Transcript Deadline set for 12/4/2023. Release of Transcript Restriction set for 1/30/2024. (Warner, Deanna) (Entered: 11/01/2023)
05/24/2024	<a href="#">162</a>	NOTICE requesting Clerk to remove Shaun Zhang as co-counsel. Reason for request: no longer with the firm of Goldman Ismail Tomaselli Brennan & Baum LLP. (Palapura, Bindu) (Entered: 05/24/2024)
08/14/2024	<a href="#">163</a>	Letter to The Honorable Christopher J. Burke from John D. Simmons regarding Request to Lift the Stay in Case No. 21-cv-1484-MN-CJB. (Simmons, John) (Entered: 08/14/2024)
08/15/2024	164	ORAL ORDER: The Court, having reviewed Plaintiff's August 14, 2024 letter, (D.I. <a href="#">163</a> ), seeking to lift the stay in this case, hereby ORDERS as follows: (1) By no later than August 22, 2024, Plaintiff shall file with the Court a one-page "Motion to Lift Stay."; and (2) By no later than August 22, 2024, Plaintiff shall file with the Court a letter, not to exceed two (2) single-spaced pages, in no less than 12-point font, outlining why the stay should be lifted. By no later than August 29, 2024, Defendant shall file with the Court a letter, not to exceed two (2) single-spaced pages, in no less than 12-point font, outlining the reasons for its opposition. By no later than September 5, 2024, Plaintiff shall file with the Court a reply letter brief, not to exceed one (1) single-spaced page, in no less than 12-point font. Ordered by Judge Christopher J. Burke on 8/15/2024. (smg) (Entered: 08/15/2024)
08/20/2024	<a href="#">165</a>	MOTION to Lift Stay - filed by ImmerVision, Inc.. (Attachments: # <a href="#">1</a> Text of Proposed Order)Motions referred to Christopher J. Burke.(Simmons, John) (Entered: 08/20/2024)