

**IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE**

MED-EL ELEKTROMEDIZINISCHE GERÄTE GES.M.B.H., et al.,	: Case No. 1:18-cv-01530-JDW
	:
	:
<i>Plaintiffs,</i>	:
	:
v.	:
	:
ADVANCED BIONICS, LLC,	:
	:
<i>Defendant.</i>	:

ORDER

AND NOW, this 1st day of March, 2021, upon consideration of Plaintiffs MED-EL Elektromedizinische Geräte Ges.m.b.H.’s and MED-EL Corporation, USA’s Motion For Partial Stay Pending Resolution Of The MED-EL IPRs (D.I. 139), the Court notes as follows.

1. “Courts have inherent power to manage their dockets and stay proceedings, including the authority to order a stay pending conclusion of a PTO [proceeding].” *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1426-27 (Fed. Cir. 1988) (citations omitted). “This Court has typically considered three factors when deciding a motion to stay: (1) whether granting the stay will simplify the issues for trial; (2) the status of the litigation, particularly whether discovery is complete and a trial date has been set; and (3) whether a stay would cause the non-movant to suffer undue prejudice from any delay, or allow the movant to gain a clear tactical advantage.” *Toshiba Samsung Storage Tech. Korea Corp. v. LG Elecs., Inc.*, 193 F. Supp. 3d 345, 348 (D. Del. 2016).

2. Having considered these factors, as well as the particular facts of this case, the Court will deny MED-EL’s motion. The Court determines that this is the better approach here, for the reasons set forth below.

3. The PTAB has not instituted IPR proceedings as to MED-EL’s second petition concerning the ‘746 Patent or as to the ‘847 Patent. Thus, any expected simplification of issues related to the challenged claims therein “rests on speculation that such institution will occur.” *Universal Secure Registry, LLC v. Apple Inc.*, No. 17-cv-585, 2018 WL 4486379, at *2 (D. Del. Sept. 19, 2018); *see also Advanced Microscopy Inc. v. Carl Zeiss Microscopy, LLC*, No. 15-cv-516, 2016 WL 558615, at *2 (D. Del. Feb. 11, 2016) (“If no review is instituted, the asserted basis for a stay will fall away.”); *Copy Prot. LLC v. Netflix, Inc.*, No. 14-cv-365, 2015 WL 3799363, at *1 (D. Del. June 17, 2015). Thus, this factor does not weigh in favor of a stay.

4. The PTAB’s final decisions on the pending IPR proceedings could simplify the issues for trial, but MED-EL waited too long to seek a stay pending those proceedings. “[T]he ideal time’ to file a motion to stay is ‘shortly after the PTAB issue[s] its decision to proceed with a validity trial on all of the Asserted Claims.’” *Universal*, 2018 WL 4486379 at *2 (quotation omitted). MED-EL waited nearly eight months after the PTAB instituted the IPR proceedings for the ‘681 Patent and the ‘747 Patent to seek a stay.

5. MED-EL claims it waited until “there was a critical mass of asserted claims under review” in an effort to avoid seeking “piecemeal relief” (D.I. 144 at 8), but MED-EL created the present piecemeal situation by filing staggered IPR petitions. The Court does not agree that now, with two IPR proceedings almost at their end and two others uncertain as to whether they even will begin, demonstrates the type of inflection point that MED-EL claims. In addition, AB’s counterclaims had been pending for over a year by the time MED-EL sought a partial stay of this matter. The Court had already conducted a *Markman* hearing and construed the Parties’ disputed claim terms, discovery was underway, and the Court had handled various discovery-related issues. While it is true that much work still remains to be done in this matter, “this case is no longer in an early stage of proceedings[.]” *See Space Data Corp. v. Alphabet Inc.*, No. 16-cv-3260, 2019 WL

1131420, at *3 (N.D. Cal. Mar. 12, 2019) (quotation omitted). Given the fact that the PTAB’s decisions on the ‘681 and ‘747 Patents are due little more than three months from now, the Court sees no significant efficiency to be gained by granting a partial stay of the case until the PTAB issues its remaining IPR decision in December 2021. Indeed, that decision will implicate only one of the six patents at issue in AB’s counterclaims. *See id.* (denying partial stay where IPR claim represented “a relatively small portion of the overall case”). Thus, the status of this matter weighs against the entry of a partial stay at this time.

6. Finally, due to current pandemic-related restrictions, AB will be prejudiced if a window of opportunity arises to depose MED-EL’s Austrian-based witnesses (perhaps in the spring and summer months), and it cannot question them about patents subject to a stay. Aside from the uncertainty about when another deposition opportunity would arise (given the ever-evolving nature of COVID-19 restrictions), AB would suffer undue prejudice by having to depose the same witnesses a second time, whenever that may be. Thus, the prejudice factor also weighs against a partial stay of this matter.

Therefore, for the reasons stated above, MED-EL’s Motion For Partial Stay Pending Resolution Of The MED-EL IPRs (D.I. 139) is **DENIED**.

BY THE COURT:

/s/ Joshua D. Wolson
JOSHUA D. WOLSON, J.