

**IN THE UNITED STATES DISTRICT COURT
FOR THE WESTERN DISTRICT OF TEXAS
WACO DIVISION**

SONRAI MEMORY LIMITED,

Plaintiff,

v.

TEXAS INSTRUMENTS INC.,

Defendant.

Case No. 6:21-cv-1066-ADA-DTG

JURY TRIAL DEMANDED

ORDER

Before the Court is Defendant Texas Instruments Incorporated's ("TI") Opposed Motion to Stay Pending Resolution of *Inter Partes* Review (the "Motion"). ECF No. 22. The Court held a hearing and heard argument on the Motion on May 12, 2022. ECF No. 32.

The relevant facts are as follows. Plaintiff Sonrai Memory Limited ("Sonrai") filed several lawsuits in this District on February 23, 2021 alleging infringement of U.S. Patent No. 6,874,014 ("the '014 Patent") including a suit against Google LLC ("Google"). *Sonrai Memory Limited v. Google LLC*, Case No. 6:21-cv-00167-ADA (W.D. Tex.). Google filed a petition for *inter partes* review against claims 1–3, 5–9, 11–13, and 15–19 on August 30, 2021. PTAB-IPR2021-01454, Paper 1. On October 13, 2021, Sonrai filed suit against TI alleging infringement of at least claim 1 of the '014 Patent. ECF No. 1. Sonrai served TI with a copy of the complaint on October 15, 2021. Sonrai served TI with infringement contentions on January 17, 2022, identifying that, along with independent claim 1, dependent claims 3 and 5 were being asserted.

On March 4, 2022, the Patent Trial and Appeal Board instituted Google's petition for *inter*

its preliminary invalidity contentions on March 15, 2022. ECF No. 23. The PTAB found that the invalidity arguments Google made in the IPR were “persuasive” for the purposes of institution for at least claim 1. ECF No. 22-3. Sonrai choose not to file a preliminary patent owner response to Google’s petition for *inter partes* review. ECF No. 25. TI contends that had it filed its own IPR petition on October 13, 2021, the PTAB would not have instituted that IPR sooner than the Google IPR was instituted. ECF No. 26. On April 1, 2022, TI filed a copycat petition and moved to join the Google IPR. ECF No. 22-3, 22-4. That motion is still pending before the PTAB. *See* PTAB-IPR2022-00801. On April 5, 2022, TI filed the present Motion and requested that the Court stay this case through the issuance of a Final Written Decision in the Google IPR. ECF No. 22.

In this case, fact discovery will not open until June 13, 2022. ECF No. 23 at 2. The parties had not started *Markman* briefing as of the hearing on TI’s motion to stay. *Id.* A *Markman* Hearing is tentatively set for July 12, 2022. *Id.* A Final Written Decision in the Google IPR is expected by March 4, 2023. Under the current schedule, fact discovery will have closed and expert discovery will be underway, but the parties in this case will not have completed expert discovery or served rebuttal expert reports at that time. *Id.* Additionally, the parties will begin dispositive motion briefing on April 18, 2023, and the placeholder date for trial is set several months later for July 2023. *Id.*

Furthermore, the Google District Court case is well into discovery at this point. A *Markman* hearing was held on February 25, 2022, the Court is already familiar with the patents, and a trial is expected in early 2023.

“District courts typically consider three factors when determining whether to grant a stay pending inter partes review of a patent in suit: (1) whether the stay will unduly prejudice the nonmoving party, (2) whether the proceedings before the court have reached an advanced stage,

including whether discovery is complete and a trial date has been set, and (3) whether the stay will likely result in simplifying the case before the court.” *NFC Tech. LLC v. HTC Am., Inc.*, No. 2:13-cv-1058, 2015 WL 1069111, at *2 (E.D. Tex. Mar. 11, 2015); *see also CyWee Grp. Ltd. V. Samsung Elecs. Co.*, No. 2:17-CV-00140-WCB-RSP, 2019 WL 11023976, at *2 (E.D. Tex. Feb. 14, 2019) (Bryson, J.).

The Court finds that any likelihood that a stay will result in simplifying the case before the Court is too speculative. In the Court’s experience and because the IPR proceedings add to the intrinsic record of a patent, IPR proceedings do not simplify issues in district court cases. The Court further finds that whether TI will be allowed to join the Google IPR proceeding is similarly speculative. The Court further notes that statutorily defined estoppel under 35 U.S.C. § 315(e)(2) is potentially narrow because TI is a joining party to Google’s IPR. At the hearing, TI made a qualified offer to be estopped as if it were the petitioner under 35 U.S.C. § 315(e)(1), but confirmed the limited nature of any such estoppel. Accordingly, the Court finds estoppel would not simplify the issues in this case. Accordingly, TI’s request that the Court stay this case through the issuance of a Final Written Decision in the Google IPR is **DENIED**.

SO ORDERED this 18th day of May, 2022


DEREK T. GILLILAND
UNITED STATES MAGISTRATE JUDGE