

IN THE UNITED STATES DISTRICT COURT  
FOR THE EASTERN DISTRICT OF TEXAS  
MARSHALL DIVISION

BELL NORTHERN RESEARCH, LLC,

Plaintiff,

v.

ASUSTEK COMPUTER INC. and ASUS  
COMPUTER INTERNATIONAL,

Defendants.

Case No. 4:23-cv-00573

**DEFENDANTS' UNOPPOSED MOTION TO STAY ACTION PENDING ITC  
DETERMINATION**

Defendants ASUSTeK Computer Inc. (“ASUSTeK Computer”) and ASUS Computer International (“ACI”) (collectively, “ASUS” or “Defendants”) appear specially to move this Court pursuant to 28 U.S.C. § 1659 to stay all proceedings in the above-captioned case until the determination of the United States International Trade Commission (“ITC”) in the parallel proceeding titled *In the Matter of Certain Electronic Devices and Semiconductor Devices Having Wireless Communication Capabilities and Components Thereof*, Investigation No. 337-TA-1367 becomes final, including during any appeals and until the Commission proceedings are no longer subject to judicial review. Counsel for the ASUS Defendants contacted counsel for Plaintiff Bell Northern Research, LLC (“BNR”), who indicated that BNR did not oppose the stay request.

On June 20, 2023, BNR filed the Complaint in this action against ASUS alleging infringement of U.S. Patent Nos. RE 48,629 (the “’629 patent”), 8,416,862 (the “’862 patent”), 7,564,914 (the “’914 patent”), patent”). (Dkt. No. 1). On June 21, 2023, BNR filed a complaint with the ITC under Section 337 of the Tariff Act of 1930, as amended, against ASUS and several other respondents, requesting that the ITC institute an investigation based on alleged infringement

of the same three patents. (*See* Ex. A, ITC Complaint, Public Version). BNR’s ITC complaint alleges that ASUS infringes the same ’629, ’862, and ’914 patents. (*See id.* at ¶¶ 48-57, 85-94). On July 21, 2023, the ITC instituted an investigation based on BNR’s complaint, naming ASUS Defendants as among the respondents to the proceeding titled *In the Matter of Certain Electronic Devices and Semiconductor Devices Having Wireless Communication Capabilities and Components Thereof*, Investigation No. 337-TA-1367 (*See* Ex. B, Notice of Institution of Inv. No. 337-TA-1367).

Pursuant to 28 U.S.C. § 1659(a), District Court claims that involve the same issues as a parallel ITC proceeding are subject to a mandatory stay. Specifically, the statute provides:

In a civil action involving parties that are also parties to a proceeding before the United States International Trade Commission under section 337 of the Tariff Act of 1930, at the request of a party to the civil action that is also a respondent in the proceeding before the Commission, the district court shall stay, until the determination of the Commission becomes final, proceedings in the civil action with respect to any claim that involves the same issues involved in the proceeding before the Commission, but only if such request is made within –

- (1) 30 days after the party is named as a respondent in the proceeding before the Commission, or
- (2) 30 days after the district court action is filed, whichever is later.

28 U.S.C. § 1659(a). A stay issued under this statute must remain in effect during any appeal(s) and must continue “until the Commission proceedings are no longer subject to judicial review.” *In re Princo Corp.*, 478 F.3d 1345, 1355 (Fed. Cir. 2007).

The requirements of 28 U.S.C. § 1659 are satisfied here. The ASUS Defendants “are also parties to a proceeding before the United States International Trade Commission under section 337” because they are respondents in the ITC investigation. The claims asserted in this action also involve the same issues as the claims in the ITC investigation. Indeed, in both, BNR asserts the

same patents and alleges infringement of many of the same patent claims. (See Dkt. No. 1 ¶¶ 20-43, 45-97; Ex. A ¶¶ 48-57, 85-94). This motion is timely under 28 U.S.C. § 1659(a)(1) because it was filed within 30 days after the ASUS Defendants were named as respondents in the ITC Investigation pursuant to the Commission's July 21, 2023, notice of institution. See, e.g., *Evolved Wireless, LLC v. Samsung Elecs. Co.*, No. 21-033, 2021 WL 7161368, at \*1 (E.D. Tex. Mar. 10, 2021) (deadline for filing motion to stay occurs thirty days after ITC's notice of institution). A stay is, therefore, mandatory under § 1659(a).

For the foregoing reasons, ASUS respectfully requests that the Court enter the attached proposed order staying all proceedings in this action until the determination of the 337-TA-1367 Investigation becomes final, including any appeals and until the ITC proceedings are no longer subject to judicial review.

ASUS appears specially to make this motion because BNR has not yet served process on ASUS.

ASUS's special appearance does not waive any of its objections and defenses to BNR's Complaint, including, but not limited to, any defenses based on lack of jurisdiction, improper venue, inconvenient venue, insufficiency of process, and insufficiency of service of process and does not waive ASUS's rights to seek appropriate relief, including dismissal of the Complaint or venue transfer. See, e.g., *Mann v. Castiel*, 681 F.3d 368, 373-74 (D.C. Cir. 2012) (holding that a motion to stay does not waive an objection to sufficiency of service of process); *Lane v. XYZ Venture Partners, L.L.C.*, 322 F.App'x 675, 678 (11th Cir. 2009) (holding that defendants "did not waive their defense of lack of personal jurisdiction by moving to stay the proceedings"). Thus, ASUS expressly reserves all objections, defenses, and rights in response to BNR's Complaint

allegations. Requesting a stay at this juncture without resolution of such objections and defenses will conserve judicial resources consistent with FRCP 1.

**CONCLUSION**

For all the foregoing reasons, ASUS respectfully requests that the Court enter the attached proposed order staying all proceedings in this action until the determination of the 337-TA-1367 Investigation becomes final, including any appeals, and until the Commission proceedings are no longer subject to judicial review.

Date: August 4, 2023

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**CERTIFICATE OF CONFERENCE**

The undersigned counsel hereby certifies that, pursuant to Local Court Rule CV-7(i), he conferred with counsel for Plaintiff Bell Northern Research LLC who confirmed that Plaintiff is unopposed to the relief requested herein.

/s/ Chris R. Schmidt  
Chris R. Schmidt

**CERTIFICATE OF SERVICE**

Pursuant to the Federal Rules of Civil Procedure and Local Rule CV-5, I hereby certify that, on August 4, 2023, all counsel of record who have appeared in this case are being served with a copy of the foregoing via the Court's CM/ECF system.

/s/ Chris R. Schmidt  
Chris R. Schmidt