

**IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF TEXAS
TEXARKANA DIVISION**

MAXELL, LTD.,

Plaintiff,

vs.

APPLE INC.,

Defendant.

Civil Action No. 5:19-cv-00036-RWS



JURY TRIAL DEMANDED

**APPLE INC.'S RENEWED MOTION TO STAY PENDING DETERMINATION OF
INTER PARTES REVIEW OF THE PATENTS-IN-SUIT**

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I. INTRODUCTION

The Patent Trial and Appeal Board (“PTAB”) has now instituted review for four of the 10 petitions for *inter partes* review (“IPR”) that Apple filed. The PTAB has denied two petitions, and Apple expects decisions on three more by August 12 and on the tenth and final one by September 25. In view of the fact that the IPRs, including those that were not instituted, have already demonstrably simplified this case and will continue to do so, Apple respectfully moves the Court to stay this litigation at least until the PTAB issues final written decisions in the pending IPRs involving the Patents-in-Suit.

Proceeding with this litigation while several IPRs continue in parallel could risk the finality of judgments rendered in this case and could prove extraordinarily wasteful of both the Court’s and the parties’ resources. And because a stay will simplify the litigation, including by resolving all issues related to the challenged claims if they are held invalid or by estopping Apple from presenting certain invalidity defenses if the Federal Circuit affirms the patentability of those claims; because costly and time-consuming pre-trial and trial activities have not yet occurred; and because Maxell will not be unduly prejudiced by the requested stay, the Court should grant this motion and stay this case.

It is counterproductive to try patent claims that the PTAB will likely invalidate: the PTAB cancels at least some challenged claims 80% of the time, and cancels all challenged claims 62% of the time. Ex. A at 11.¹ Apple’s success rate in the PTAB is even better. For IPR petitions of Apple’s that reached final decision, the PTAB cancelled or amended claims in 90% of them (191/215 decisions), and cancelled all challenged claims nearly 75% of the time (157/215 decisions). *Id.*, Ex. B at 1.

¹ All Exhibits are to the accompanying Declaration of Luann Simmons (“Simmons Decl.”).

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