

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

NEODRON LTD.,

Plaintiff,

v.

APPLE INC.,

Defendant.

CASE NO. 6:20-CV-00116-ADA

UNOPPOSED MOTION TO STAY ACTION PENDING ITC DETERMINATION

Defendant Apple Inc. (“Apple”) respectfully moves this Court pursuant to 28 U.S.C. § 1659 and its inherent powers to control its docket for a stay of all proceedings in the above-captioned case until the determination of the United States International Trade Commission (“ITC”) in a parallel proceeding becomes final.

On February 14, 2020, Neodron Ltd. (“Neodron”) filed a complaint against Apple, and other proposed Respondents, with the ITC (“the ITC action”) alleging infringement of United States Patent Nos. 7,821,425 (“425 patent”); 7,903,092 (“092 patent”); 8,749,251 (“251 patent”); and 9,411,472 (“472 patent”) (collectively, “the patents-in-suit”). On the same day Neodron Ltd. filed its complaint against Apple in this action (“the Texas action”) asserting the patents-in-suit. The ITC instituted the investigation on March 16, 2020, as Investigation No. 337-TA-1193. Pursuant to 28 U.S.C. § 1659, district court patent claims that involve the same issues as a parallel ITC proceeding are subject to a mandatory stay. Specifically, 28 U.S.C. § 1659(a) provides:

(a) Stay. 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 remains in effect during any appeals and “until the Commission proceedings are no longer subject to judicial review.” *In re Princo Corp.*, 478 F.3d 1345, 1355 (Fed. Cir. 2007). Here, because the same patents asserted in this action are also asserted against Apple in the ITC action, and because the parties and the accused products are also the same, a stay of this case is mandatory upon timely request by Apple. The mandatory stay of Section 1659 applies where a request is made: (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*. As such, Apple’s request is timely under § 1659(a) because this request is being made within 30 days of the publication in the *Federal Register*, ITC’s Notice of Institution of Investigation, which names Apple as a respondent in the ITC action. 84 Fed. Reg. 29545 (March 20, 2020).

For the foregoing reasons, Apple respectfully requests that the Court enter the attached proposed order and stay all proceedings in the Texas action until the determination of the ITC action becomes final, including any appeals and until the Commission proceedings are no longer subject to judicial review.

Dated: March 30, 2020

Respectfully submitted,

/s/ John M. Guaragna

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ATTORNEY FOR DEFENDANT
APPLE INC.

CERTIFICATE OF CONFERENCE

I hereby certify that the undersigned counsel for Defendant, Apple Inc. conferred with Plaintiffs' counsel. Plaintiff has agreed to Defendant's request sought in this motion.

/s/ John M. Guaragna

John M. Guaragna

CERTIFICATE OF SERVICE

I hereby certify that on the 30th day of March 2020, I electronically filed the foregoing with the Clerk of Court using the CM/ECF system which will send notification of such filing via electronic mail to all counsel of record. Any other counsel of record will be served by first class U.S. mail.

/s/ John M. Guaragna

John M. Guaragna