

**UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF NEW JERSEY**

NASDAQ, INC.; NASDAQ ISE, LLC; AND FTEN, INC.,	:	
	:	
Plaintiffs,	:	Civil Action No. 17-6664 (BRM) (DEA)
	:	
v.	:	
	:	
	:	MEMORANDUM OPINION AND ORDER
MIAMI INTERNATIONAL HOLDINGS, INC.; MIAMI INTERNATIONAL SECURITIES EXCHANGE, LLC; MIA PEARL, LLC; AND MIAMI INTERNATIONAL TECHNOLOGIES, LLC,	:	
	:	
Defendants.	:	
	:	

This matter comes before the Court on a Motion by Plaintiffs for leave to file an Amended Complaint [ECF No. 138]. Defendants filed a Brief in Opposition [ECF No. 139] and Plaintiffs filed a Reply Brief [ECF No. 145]. Plaintiffs also filed a Notice of Supplemental Authority [ECF No. 146]. The Court conducted oral argument on September 23, 2020.

The issue presented by Plaintiffs' Motion is whether the Court should lift the existing stay of this action and allow Plaintiffs to file the proposed Amended Complaint, which removes all of Plaintiffs' patent infringement claims from the operative pleading and restates the trade secret misappropriation claims against Defendants.

I. FACTUAL BACKGROUND AND PROCEDURAL HISTORY

Plaintiffs initiated this action on September 1, 2017 by filing a Complaint against Defendants alleging both patent infringement and trade secret misappropriation claims. *See* ECF

No. 1. Defendants filed a Motion to Dismiss Plaintiffs' Complaint on December 4, 2017. *See* ECF No. 28.

On April 12, 2018, Defendants filed a Motion to Stay this action, after filing petitions for Covered Business Method Patent Review ("CBMR") of the patents in suit with the United States Patent and Trademark Office ("USPTO"). *See* ECF No. 72. On August 10, 2018, U.S. District Judge Brian R. Martinotti denied Defendants' Motion reasoning, "it would be wise for the Court to wait to stay the case until the PTAB has instituted review of the challenged petitions." ECF No. 103 at 7.

On October 10, 2018, Defendants submitted a letter request for permission to file another Motion to Stay pending the CBMR of the patents-in-suit. *See* ECF No. 114. Plaintiffs opposed that request as premature. *See* ECF No. 117. Judge Martinotti agreed stating, "[a] renewed motion to stay would still be premature" because at that time the Patent Trial and Appeal Board ("PTAB") had not yet instituted the CBMR of all of the patents-in-suit. ECF No. 119 at 1.

On November 14, 2018, Defendants submitted a second request for leave to file a Motion to Stay. *See* ECF No. 123. Plaintiffs again opposed Defendants' request. *See* ECF No. 129. This time, on December 3, 2018, Judge Martinotti entered an Order finding that a stay was appropriate because the PTAB had instituted CBMR on *all* of the patents-in-suit. ECF No. 130 at 1.

On December 7, 2018, Plaintiffs submitted a request to Judge Martinotti for reconsideration of the Order [ECF No. 130] "on the limited issue of the scope of the stay." ECF No. 131. Specifically, Plaintiffs asked the Court to modify the "December 3, 2018 Order to limit the stay to the six patents-in-suit (counts I, II, and IV-VII) and allow discovery to proceed on Plaintiffs' three trade secret claims (counts VII-X)". *Id.* Defendants opposed Plaintiffs' request to limit the scope of the stay arguing, *inter alia*, "that both the patent claims and trade secret claims

involve the same areas of technology, the same accused products, and overlapping witnesses. If the stay is lifted on the trade secret claims, it will have the effect of no stay at all on the patent claims.” ECF No. 132. On December 13, 2018, Judge Martinotti denied Plaintiffs’ request to modify the stay stating, “[t]his matter is stayed in its entirety.” ECF No. 133.

Eleven months later, on November 18, 2019 Plaintiffs informed the Court that the PTAB had issued decisions regarding the validity of the patents-in-suit. ECF No. 135. The PTAB found that the patents-in-suit were invalid. *Id.* Plaintiffs explained that these decisions were subject to motion practice seeking reconsideration as well as appellate remedies. *Id.* Plaintiffs then requested the same relief they now seek – to lift the stay of this action in order to proceed solely with Plaintiffs’ trade secret claims. *Id.*

On November 19, 2019, Defendants responded that it would not be efficient to lift the stay when Plaintiffs had not exhausted their appellate remedies with the PTAB or the Federal Circuit. ECF No. 136 at 1. Defendants argued that courts have held in similar circumstances that the court should not lift a stay before the party dissatisfied with the PTAB’s decision exhausts its appellate remedies. *Id.* at 2 (citing *Depomed, Inc. v. Purdue Pharma L.P.*, 2016 WL 50505, at *1-2 (D.N.J. Jan. 4, 2016); *Andrea Electronics Corp. v. Apple Inc.*, C/A No. 16-cv-5220-JMA-SIL (E.D.N.Y. Aug. 6, 2019); *Realtime Data LLC v. Silver Peak Systems, Inc.*, 2018 WL 3744223, at *2 (N.D. Cal. 2018). After considering the parties’ submissions, on November 20, 2019 Judge Martinotti denied Plaintiffs’ application and continued the stay. *See* ECF No. 137.

Plaintiffs filed the instant Motion on February 11, 2020, seeking leave to file an Amended Complaint which removes all patent infringement claims and related allegations from the operative pleading while maintaining the trade secret claims against Defendants – essentially the same relief sought in their November 18, 2019 Letter to Judge Martinotti. ECF No. 138-2 at 3.

As an initial matter, Defendants contend that Plaintiffs' Motion is improper because it disregards the existing Stay Orders, will unnecessarily increase the cost of litigation, and provides grounds for sanctions. ECF No. 139 at 4. Defendants also contend that Plaintiffs' proposed Amended Complaint further necessitates the Stay. *Id.* at 6. Defendants explain that it would be unfair to allow Plaintiffs to drop the patent claims without eliminating the risk of future assertion of these claims in this action or elsewhere, or against Defendants' affiliates, successors, licensee, and customers. *Id.* Further, lifting the stay will not end the ongoing proceedings before the PTAB. *Id.* at 9.

Lastly, Defendants argue that justice requires this Motion be denied according to Rule 15. *Id.* at 11. Defendants submit that allowing Plaintiffs to proceed with the proposed Amended Complaint potentially enables Plaintiffs to argue that Defendants no longer have standing to pursue the CBMR of the patents-in-suit. As a result, Defendants explain, Plaintiffs could reassert their patent claims against Defendants or their affiliates, successor, licensees, or customers when the CBMR remedy expires. *Id.* at 9, 11-12. Thus, Defendants assert, lifting the stay to permit the proposed Amended Complaint would afford Plaintiffs an unfair tactical advantage. *Id.* at 7-8.

Plaintiffs filed a Reply Memorandum, primarily arguing that justice requires allowing the proposed amendment "because there is still no end in sight" to the PTAB proceedings due to the *Arthrex* decision. ECF No. 145 at 1. Plaintiffs also maintain that actions they may take or consequences occurring if the proposed Amended Complaint is permitted are speculative and should not be weighed in the Court's consideration of the proposed amendment's prejudice to Defendants. *Id.* at 3.

After filing the Reply, Plaintiffs filed a Notice of Supplemental Authority informing the Court of the PTAB's General Order in Cases Involving Requests for Rehearing Under *Arthrex*,

Inc. v. Smith & Nephew, Inc., 941 F.3d 1320 (Fed. Cir. 2019) (“General Order”). See ECF No. 146. Plaintiffs explain that the General Order impacts the instant Motion because the General Order further affirms its argument that “[j]ustice requires allowing the amendment because there is still no end in sight to the procedural morass created by *Arthrex*.” *Id.* at 2.

II. LEGAL STANDARDS

It is well-settled that the power to stay proceedings before the Court -- or, as is the case here, continue a stay -- “is incidental to the power inherent in every court to control the disposition of the causes on its docket with economy of time and effort for itself, for counsel, and for litigants. How this can best be done calls for the exercise of judgment, which must weigh competing interests and maintain an even balance.” *Landis v. North Am. Co.*, 299 U.S. 248, 254-55, 57 S.Ct. 163, 81 L.Ed. 153 (1936)(citing *Kansas City Southern Ry. Co. v. U.S.*, 282 U.S. 760, 763, 51 S.Ct. 304, 75 L.Ed. 684 (1931); *Enelow v. New York Life Ins. Co.*, 293 U.S. 379, 382, 55 S.Ct. 310, 79 L.Ed. 440 (1935)). Consequently, “a United States district court has broad power to stay proceedings.” *Bechtel Corp. v. Laborers’ Int’l Union*, 544 F.2d 1207, 1215 (3d. Cir. 1976). “In the exercise of its sound discretion, a court may hold one lawsuit in abeyance to abide by the outcome of another which may substantially affect it or be dispositive of the issues.” *Id.*; see also *Am. Life Ins. Co. v. Stewart*, 300 U.S. 203, 215, 57 S.Ct. 377, 81 L.Ed. 605 (1937). Particularly with respect to patent cases, courts have “consistently recognized the inherent power of the district courts to grant a stay pending reexamination of a patent”. *P&G v. Kraft Foods Global, Inc.*, 549 F.3d 842, 849 (Fed. Cir. 2008); see also *Gould v. Control Laser Corp.*, 705 F.2d 1340, 1341 (Fed. Cir.), cert. denied, 464 U.S. 935, 104 S.Ct. 343, 78 L.Ed.2d 310 (1983); *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1426 (Fed. Cir. 1988).

III. ARGUMENTS

a. Plaintiffs' Arguments in Support of Amendment

Plaintiffs seek leave to amend the Complaint to remove all of their patent infringement claims and related allegations and to “revive” the trade secret claims against Defendants. ECF No. 138-2 at 3. In so doing, Plaintiffs would also remove Nasdaq ISE, LLC and FTEN, Inc. as parties to this action because these Plaintiffs have never asserted claims for trade secret misappropriation against Defendants. *Id.*

Plaintiffs propose to proceed in this fashion to avoid further delay of this action while separately pursuing their appellate remedies in the PTAB and Federal Circuit. *Id.* at 4. Plaintiffs submit that they seek leave of Court to amend their pleadings because they cannot agree to the terms which Defendants insist must accompany Plaintiffs' voluntary dismissal of the patent claims. *Id.*

Decisions regarding the validity of all patent claims asserted in this action were rendered in Defendants' favor by panels of the PTAB. *Id.* at 2. However, Plaintiffs explain that those decisions are subject to further review by the Federal Circuit on the ground that “administrative judges who rendered such decision were appointed in violation of the Appointments Clause.” *Id.*; citing *Arthrex, Inc. v. Smith & Nephew, Inc.*, 941 F.3d 1320, 1325 (Fed. Cir. 2019). Plaintiffs assert that under *Arthrex* the PTAB panels' decisions on validity are themselves invalid. ECF No. 138-2 at 2. Plaintiffs contend the procedural uncertainty that has resulted further supports Plaintiffs' request to amend the Complaint to remove the patent claims and that new procedural impediments and issues continue to develop in the wake of the *Arthrex* decision. *See* ECF No. 146.

Plaintiffs argue that there is no undue delay or dilatory motive on their part in seeking leave to amend the Complaint. ECF No. 138-2 at 4. Rather, Plaintiffs contend they filed the instant

Motion shortly after the *Arthrex* ruling, which made clear to Plaintiffs that the PTAB proceedings might take longer than expected to be resolved. *Id.* Further, Plaintiffs maintain, removing claims from this action that would otherwise cause this matter to remain stayed for years awaiting the resolution of the PTAB proceedings, will ultimately lead to a swifter resolution of this action. *Id.* For these reasons, Plaintiffs assert that this Motion was timely filed, for good reason and not in bad faith. *Id.*

Plaintiffs contend that the remaining trade secret claims are timely and viable and thus not futile. *Id.* Plaintiffs incorporate by reference arguments related to the trade secret claims from the pending Motion to Dismiss briefing. *Id.* In Plaintiffs' Brief in Opposition [ECF No. 38] to Defendants' Motion to Dismiss [ECF No. 28], Plaintiffs argue that the trade secrets claims are viable because they are not time-barred, common law trade secrets claims should be allowed, the NJTSA claim is plausibly stated, and the DTSA trade secret claim was sufficiently alleged. *See* ECF No. 38 at 5-17.

In their Reply, Plaintiffs present arguments countering Defendants' assertion that the instant motion was filed in violation of the Court's Stay Orders [ECF Nos. 130 and 137] and that Defendants will be unfairly prejudiced by the proposed Amended Complaint. *Id.*

Plaintiffs argue that no federal or local rule requires a formal application to lift a stay before other forms of relief may be sought from the Court and that it would be impractical at this point to require Plaintiffs to formally apply to lift the stay. *Id.* at 2. Plaintiffs contend that there is no authority for Defendants' contention that parties are prohibited from filing motions while a case is stayed. *Id.* Plaintiff also distinguishes the circumstances of this action from the cases cited by Defendants in support of their argument that Plaintiffs have violated the stay. *See Id.* The Court,

construing the Plaintiffs' Motion as incorporating an implicit request to lift the stay, need not further detail Plaintiffs' arguments on this point.

Lastly, Plaintiffs argue that Defendants will not be prejudiced by the proposed amendment because narrowing the issues before this Court simplifies this litigation for all parties as well as the Court. *Id.* at 3. Plaintiffs claim that Defendants' arguments regarding prejudice are speculative and unfounded. *Id.* Plaintiffs claim that actions they may take after the proposed Amended Complaint is filed or any potential consequences of eliminating their patent claims from this litigation should not weigh on the consideration of prejudice by the amendment. *Id.*

Plaintiffs filed a Notice of Supplemental Authority on May 22, 2020, asserting that the PTAB's General Order further justifies the request to allow Plaintiffs to eliminate the patent claims and to proceed solely on the trade secret claims in this matter. ECF No. 146 at 2. Plaintiffs contend that the General Order demonstrates that the PTAB proceedings will not be swiftly resolved. *Id.*

b. Defendants' Arguments Opposing Plaintiffs' Motion to Amend

As an initial matter, Defendants argue that Plaintiffs' Motion should be denied because it violates the Court's existing Order staying this case in its entirety. ECF No. 139 at 4. Defendants argue that not only have Plaintiffs violated the Court's Stay Order but have ignored the purpose of the stay. *Id.* Defendants explain that the stay was entered because Defendants are an emerging market entrant and competitor of Plaintiffs. *Id.* at 5. As such, the stay was required to reduce the costs of litigation while the CBMR proceedings were resolved. *Id.* Defendants ponder why Plaintiffs now complain of the "years of protracted PTAB [proceedings]" even though this was the reality in November 2019 when the Court found good cause to continue the stay. *Id.* Essentially, Defendants argue that the circumstances surrounding this action have not changed since the Court entered the original stay Order and its subsequent Orders maintaining the stay. As a result,

Defendants contend that this Motion is “procedurally baseless and substantively meritless” warranting sanctions. *Id.* at 6.

Defendants contend that the proposed amendment does not lessen the need for a stay but instead provides greater reason to maintain the stay of this action. *Id.* at 9. Defendants argue that the four factors the Court considered when initially determining a stay was appropriate still weigh in favor of continuing the stay. First, permitting Plaintiffs to drop the patent infringement claims and to proceed on the trade secret claims will not simplify this litigation. Defendants believe that Plaintiffs seek to proceed with the trade secret claims to “conduct the intertwined discovery related to the ‘dropped’ patent claims in the event that [Plaintiffs are] successful in overturning the PTAB decisions.” *Id.* 10-11. Defendants claim that this does not simplify the issues presented but would result in piecemeal litigation. *Id.* at 14. Thus, Defendants argue, the burden of litigation would not be reduced by permitting the amendment because the parties would be proceeding in two forums, in varying stages of litigation, on the same subject matter. *Id.* Defendants also argue that this action is still in its infancy – discovery was in its early stages when the case was stayed, the Court has not set a trial date or entered a Scheduling Order. *Id.* at 11. Lastly, Defendants argue that they would be unfairly prejudiced by the Court lifting the stay and permitting Plaintiffs to file the proposed Amended Complaint. *Id.* Defendants assert that upon a favorable decision, Plaintiffs may seek further amendment to add the dropped patent claims or file a new action against Defendants. *Id.* at 11. Defendants argue that uncertainty regarding future threats of litigation on the patent claims is prejudicial to Defendants. *Id.* at 12. Further, Defendants contend that:

[b]y seeking to amend its complaint to drop the patent infringement claims, Nasdaq may be trying to set up an argument that, if the PTAB grants new trials, the proceedings should be dismissed because the petitioner, MIAX, is no longer being ‘sued for infringement of the patent’ and thus it has lost standing to pursue its [CBMR] challenges, and the PTAB has lost its jurisdiction. If that ploy succeeded, then Nasdaq would simply have to wait until after the expiration date of the CBMR remedy – September 15, 2020 – to reinstitute

its infringement claims against MIA X and/or its affiliates, successors, customers and licensees to deprive them of this statutory remedy that, to date, has successfully invalidated all asserted claims.

Id. at 12. Defendants argue that this tactic would unfairly prejudice Defendants, provide an unfair advantage to Plaintiffs, and is a “manipulative and [an] improper attempt to manufacture jurisdictional defect...” *Id.* at 13. Finally, Defendants argue that Plaintiffs attempt to drop the patent claims rather than dismiss them before the PTAB proceedings are final interferes with Defendants’ ability to recover fees as a prevailing party under 35 U.S.C. § 285. *Id.* In sum, Defendants argue that Plaintiffs cannot show that any of the relevant factors warrant lifting the stay. *Id.* at 14.

While the Court should grant leave to amend when justice so requires, Defendants explain that if the Court permits Plaintiffs to file the proposed Amended Complaint, and the patents-in-suit are revived at the PTAB or Federal Circuit levels, Plaintiffs are not barred from asserting their patent claims against Defendants’ “affiliates, successors, licensees and customers” thus posing a significant risk of undue prejudice to Defendants. *Id.* at 15 (citing *Weinberger v. Retail Credit Co.*, 498 F.2d 552, 554 n.4 (4th Cir. 1974)(finding undue prejudice to the opposing party where “the actual effect would have left [movant] free to assert claims again, putting [non-movant through] the expense of re-litigation”)).¹

To assuage the risk of prejudice, Defendants argue that this Motion should not be granted absent an Order requiring Plaintiffs to: “(1) dismiss with prejudice all patent infringement claims; (2) stipulate not to sue [Defendants’] affiliates, successors, licensees and customers, e.g., users of [Defendants’] exchange platforms and licensees of [Defendants’] exchange platform technology,

¹ In the Reply Brief, Plaintiffs argue that *Weinberger* has not been cited in the last 25 years by the Fourth Circuit and appears to have been superseded by *Davis v. USX Corp.*, 819 F.2d 1270, 1274 (4th Cir. 1987). ECF No. 145 at 3 (citing *McCoy v. Erie Ins. Co.*, 204 F.R.D. 80, 82 n.3 (S.D. W. Va. 2001)).

under the patents-in-suit; and (3) stipulate that Defendants are a prevailing party for the purpose of seeking attorneys' fees and costs under 35 U.S.C. § 285." *Id.* (quoting *Garfield v. NDC Health Corp.*, 466 F.3d 1255, 1271 (11th Cir. 2006)("[T]he granting of leave to amend can be conditioned in order to avoid prejudice to the opposing party.")(internal quotations marks and citations omitted))).

IV. ANALYSIS

Plaintiffs did not seek permission from the Court to file this Motion while the stay is in effect or request that the stay be lifted before filing this Motion. Nonetheless, the Court, in its broad discretion regarding stays, will construe Plaintiffs' Motion as incorporating an implied request to lift the stay. Judge Martinotti previously denied Plaintiffs' request to modify or lift the stay to permit Plaintiffs to proceed on their trade secret claims separately. *See* ECF No. 133 and 137. Plaintiffs have not presented a significant change in circumstances demonstrating that lifting the stay is now warranted. Accordingly, the Court need not reach Plaintiffs' Motion for leave to amend because the Court finds that the stay in this action should not be lifted and that the stay of this case "in its entirety" by Judge Martinotti bars the Plaintiffs' Motion.

As previously noted, Judge Martinotti continued the stay in this action after considering a letter request by Plaintiffs asking for the same relief sought by the instant Motion. As Defendants note, the circumstances warranting a stay in this action have not changed since November 2019. Rather, it appears that Plaintiffs' Motion and the proposed withdrawal of the patent claims from this litigation is another in a series of attempts to avoid the impediment the stay imposes on the pursuit of Plaintiffs' trade secret claims while the PTAB proceedings are pending, an approach Judge Martinotti has twice rejected.

The Court need not engage in a detailed stay analysis because Judge Martinotti has already evaluated the factors for determining whether a stay is appropriate under the same circumstances presented here. *See* ECF Nos. 130 and 137. The only thing that has changed since Judge Martinotti last continued the stay of this action is that the PTAB issued the General Order which states:

The United States Patent and Trademark Office (“Office”) has received from the United States Court of Appeals for the Federal Circuit (“Federal Circuit”) numerous Orders that rely on the Federal Circuit’s decision in [*Arthrex*]. Those Orders instruct the Patent Trial and Appeal Board (“Board”) to conduct further proceedings on remand before newly-designated Board panels. The Office also has received several timely requests for rehearing of Board decisions citing *Arthrex* and seeking a decision by a newly-designated Board panel.

Several parties in Board matters that have been subject to such Federal Circuit Orders have informed the Office that they intend to seek review of the pertinent Order by the Supreme Court of the United States (“Supreme Court”). To avoid burdening the Office and the parties until all appellate rights of those challenging the *Arthrex* decision or related decisions have been exhausted, [Chief Administrative Patent Judge Scott R. Boalick] exercise[s] [his] discretion to hold all cases with timely-filed rehearing request citing *Arthrex* and seeking a decision by a newly-designated Board panel in administrative abeyance until the Supreme Court acts on a petition for certiorari or the time for filing such petitions expires.

ECF No. 146-1 at 2.

Plaintiffs claim there is “no end in sight” to the procedural complications resulting from the *Arthrex* decision. This is not entirely true. The General Order sets out the time during which rehearing requests will be held in abeyance. The PTAB proceedings will not be pending indefinitely as Plaintiffs claim.

Further, Plaintiffs have repeatedly sought to proceed with the trade secret claims separately² and Judge Martinotti has specifically considered the issue of whether to enter a stay of the entire case or a partial stay. Judge Martinotti determined that a stay of the entire case was appropriate pending resolution of the PTAB proceedings. *See* ECF Nos. 130 and 137. Because the

² *See* ECF Nos. 131 and 135.

proceedings at the PTAB are not final, the Court will not disturb Judge Martinotti's Stay Orders [ECF Nos. 130 and 137].

In *Depomed*, the Court affirmed the Magistrate Judge's Order "refusing to lift stay after the PTO issued a final decision in the IPRs favorable to the patentee" because the Federal Circuit set an expedited briefing schedule for appeal. *Depomed, Inc. v. Purdue Pharma L.P.*, 2016 WL 50505, at *1-2 (D.N.J. Jan. 4, 2016). Further, the Court in *Straight Path IP Group* cited *Depomed* for the assertion that "[c]ourts have recognized that [the power to stay proceedings] extends to staying infringement actions while final PTAB IPR decisions are appealed to the Federal Circuit. *Straight Path IP Group, Inc. v. Verizon Comms. Inc.* No. 16-CV-4236(AJN) 2016 WL 6094114 at *2 (D.N.J. Oct. 18, 2016).

Other Courts have distinguished the *Depomed* Court's finding. In *Acqis*, the U.S. District Court for the District of Massachusetts distinguished *Depomed* by noting that the expedited briefing schedule in *Depomed* allowed the appeal process to be completed in 191 days. In contrast, the stay in *Acqis* would be indefinite, causing prejudice to ACQIS because its patents were expiring soon. *Acqis, LLC v. EMC Corp.*, No. 14-cv-13560 2016 WL 4250245 at *2-3 (D. Mass. Aug. 10, 2016). The U.S. District Court for the Eastern District of Wisconsin cited *Acqis*, in its reasoning that "the Court cannot wait indefinitely to resolve Plaintiffs' claims." *Milwaukee Electric Tool Corp. v. Hilti, Inc.* 2016 WL 7495808 at *1 (E.D. Wisc. Dec. 30, 2016). In *Milwaukee*, the Court distinguished *Straight Path* by explaining that that case "was only 'in its infancy' when the court found that a continued stay during appeal of an IPR decision was warranted." *Id.* at *3. The *Milwaukee* Court found that the case at bar was more like *Zoll Medical Corp. v. Respironics, Inc.* C.A. No. 12-1778-LPS, 2015 WL 4126741 (D. Del. July 8, 2015)(denying the motion to stay because the patent infringement case had been stalled for two and a half years "despite the claims

of the patent-in-suit having been confirmed in the IPR and despite the accused infringer being estopped from raising the invalidity grounds it raised or reasonably could have raised in the IPR.”) Further, the Court in *Milwaukee* took issue with the fact that “only a speculative possibility” remains that “the Federal Circuit will reverse the PTAB and invalidate [the patents]. *Milwaukee*, 2016 WL 7495808 at *2 (citing *Network-1 Security Solns., Inc. v. Alcatel-Lucent USA Inc.*, No. 11-cv-492, 2015 W: 11439060, at *3 (E.D. Tex. Jan. 5, 2015)).

Here, the Court finds that the circumstances presented here are most analogous, and most aptly guided by, *Depomed* and *Straight Path*. This action has been stayed pending resolution of the PTAB proceedings, which Judge Martinotti made clear included pursuit of Plaintiffs’ appellate remedies. *See* ECF Nos. 130 and 137. The appeal timeline here is more like that of *Depomed* than *Acqis*. In *Depomed*, the Federal Circuit set forth an expedited briefing schedule, and in *Acqis* the appellate process appeared indefinite. Here, the PTAB, through the General Order, set forth a definite time for which rehearing proceedings would be held in abeyance. Also, like *Straight Path*, this case was in its infancy when the Judge Martinotti continued the stay through appeal of the PTAB decisions. *See* ECF No. 130 at 2 (“Even though three motions have been fully briefed by the parties, the Court has yet to decide all motions, the parties have not had their initial Rule 16 conference, discovery has not yet begun, and a trial date has not been set”). Lastly, here there is more than a speculative possibility that the Federal Circuit will reverse the PTAB’s decisions. *See Arthrex*, 941 F.3d at 1325 (Administrative Patent Judges who render final written decisions were appointed in violation of the Appointments Clause). Because the validity decisions themselves may be considered invalid, there is more uncertainty in relation to Plaintiffs’ appellate remedies and a greater risk that the issues will not be simplified if the stay is lifted and for piecemeal litigation of the Plaintiffs’ claims.

V. CONCLUSION

Because Judge Martinotti has determined that it is appropriate to continue the stay of this action while the PTAB proceedings proceed, the Court declines lift the stay in order to consider Plaintiffs' Motion for leave to amend. Thus, the Court will deny Plaintiffs' Motion to Amend [ECF No. 138] without prejudice.

IT IS on this 30th day of September 2020,

ORDERED that Plaintiffs' Motion to Amend [ECF No. 138] is **DENIED**; and it is further

ORDERED that this Order terminates ECF No. 138.

s/ Douglas E. Arpert

DOUGLAS E. ARPERT

UNITED STATES MAGISTRATE JUDGE