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12  
13 IN THE UNITED STATES DISTRICT COURT  
14 NORTHERN DISTRICT OF CALIFORNIA  
15 SAN FRANCISCO DIVISION

16 SAMSUNG SEMICONDUCTOR, INC.,  
SAMSUNG ELECTRONICS CO. LTD., and  
17 SAMSUNG ELECTRONICS AMERICA,  
INC.,

18 Plaintiffs,

19 vs.

20 BiTMICRO, LLC and BiTMICRO  
21 NETWORKS, INC.,

22 Defendants.

Case No. 3:18-cv-3502 EMC

**STIPULATION AND ~~PROPOSED~~ ORDER  
TO STAY CASE PENDING ITC  
INVESTIGATION**

23  
24 Pursuant to Civil Local Rule 7-12, Plaintiffs Samsung Semiconductor, Inc., Samsung  
25 Electronics Co., Ltd., And Samsung Electronics America, Inc.’s (collectively, “Samsung”), and  
26 Defendants BiTMICRO, LLC (“BiTMICRO”) and BiTMICRO Networks, Inc. (“BNI”), by and  
27 through their undersigned counsel, hereby submit the following stipulation and proposed order:  
28

1 WHEREAS, on December 21, 2017, BiTMICRO filed a Complaint under 19 U.S.C. § 1337  
2 at the ITC (*Certain Solid State Storage Devices, Stacked Electronics, and Products Containing the*  
3 *Same*, Inv. No. 337-TA-1097) against SK hynix, Inc. and SK hynix America, Inc. (collectively “SK  
4 hynix”) and Samsung, among others, alleging unlawful importation into the United States, sale for  
5 importation into the United States, or sale within the United States after importation, of certain solid  
6 state storage drives and stacked electronics components, and products containing them, by way of  
7 alleged infringement of U.S. Patent Nos. 6,529,416 (the “’416 patent”), 7,826,243 (the “’243  
8 patent”), 8,093,103 (the “’103 patent”), and 9,135,190 (the “’190 patent”);

9 WHEREAS, on January 19, 2018, the ITC instituted the investigation;

10 WHEREAS, on May 11, 2018, the ITC issued an Initial Determination concluding that  
11 BiTMICRO had satisfied the economic prong of the domestic industry requirement with respect to  
12 the ’416, ’103, and ’243 patents, but terminated the ’190 patent from the investigation,

13 WHEREAS, on June 12, 2018, Samsung and SK hynix each filed a Complaint seeking a  
14 Declaratory Judgement of Non-Infringement of each of the ’416, ’103, ’243, and ’190 patents, with  
15 the Samsung action numbered 3:18-cv-3502 and currently assigned to Judge Chen in the San  
16 Francisco division and the SK hynix action number 4:18-cv-3505 and currently assigned to Judge  
17 Gilliam in the Oakland division;

18 WHEREAS, on June 20, 2018, the ITC issued a Decision affirming the Initial Determination,  
19 with certain modifications that do not impact this stipulation;

20 WHEREAS, the ITC set a target date of September 13, 2019 for completion of the  
21 investigation;

22 WHEREAS, 28 U.S.C. § 1659(a) states that, at the request of a party to a civil action that is  
23 also a respondent to a proceeding before the ITC, a district court shall stay, until the determination of  
24 the ITC becomes final, proceedings in a civil action with respect to any claim that involves the same  
25 issues involved before the ITC if such request is made within the later of 30 days after the party is  
26 named as a respondent in a proceeding before the ITC or 30 days after the district court action is filed;

27 WHEREAS, § 1659(a) requires a stay of district court proceedings until the ITC proceedings  
28 involving the same issues are no longer subject to judicial review. *See In re Princo Corp.*, 478 F.3d

1 1345, 1355 (Fed. Cir. 2007); *FormFactor, Inc. v. Micronics Japan Co.*, Case No. CV-06-07159, 2008  
2 WL 361128 (N.D. Cal. Feb. 11, 2008) (In circumstances where 28 U.S.C. § 1659 applies, “a court  
3 must stay a civil action in favor of ITC proceedings.”); *Micron Tech., Inc. v. Mosel Vitelec Corp.*,  
4 Case No. CIV-98-0293, 1999 WL 458168, \*2 (D. Idaho Mar. 31, 1999) (“[T]he Court is statutorily  
5 required to stay” those claims that are also before the ITC where the ITC respondent timely moved to  
6 stay the district court action.); *Universal Tool & Stamping Co. v. Ventra Group, Inc.*, 46 U.S.P.Q.2d  
7 1799, 1800 (N.D. Ind. 1998) (stating that “such a stay (again in the words of the statute) shall be of  
8 the ‘proceedings in the civil action’ and hence the Court will not fashion an exemption to the stay by  
9 requiring the defendant to file an answer or make any order relating to discovery”).

10 WHEREAS, the alleged infringement by Samsung and SK hynix of the ’416, ’103, and ’243  
11 patents raises the “same issues” before the ITC, and July 12, 2018 is the 30<sup>th</sup> day after the Complaints  
12 were filed;

13 WHEREAS, the allegations in the Complaints relating to the ’190 patent arguably raise the  
14 “same issues” presented by the allegations on the other three patents. The parties, the technology,  
15 and much of the fact discovery will overlap among the patents. For this reason, the Court arguably  
16 has the authority to stay the entire Action under the mandatory stay provision of 28 U.S.C. § 1659,  
17 and at minimum, has the authority to grant a discretionary stay based on factors of judicial  
18 efficiency given the same parties, same overlapping technology, and overlapping discovery with the  
19 other patents.

20 WHEREAS, Samsung, BiTMICRO and BNI agree that staying this case as to all patents will  
21 conserve judicial and party resources;

22 WHEREAS, Samsung, BiTMICRO and BNI, as part of their discussions on whether and  
23 how to stay this case, have agreed that Samsung will dismiss BNI without prejudice, BiTMICRO  
24 will agree to discovery directed to BNI as discussed more specifically below, BiTMICRO will not  
25 contest jurisdiction and venue in this action, Samsung will file a Notice of Pendency of Other  
26 Action Involving Same Patent(s) pursuant to Local Patent Rule 2-1(a)(2) (thus providing basis for  
27 the Clerk to reassign and relate the Samsung and SK hynix actions pursuant to Local Patent Rule 2-  
28

1 1(a)(3)), and that BiTMICRO will file an answer, affirmative defenses and counterclaims before the  
2 stay is entered;

3 WHEREAS, SK hynix, BiTMICRO and BNI have reached the same agreement and are  
4 filing the same stipulation and proposed order in the SK hynix action;

5 NOW, THEREFORE, Samsung, BiTMICRO and BNI respectfully request:

- 6 1. That BNI be dismissed from this case, without prejudice. For the purposes of  
7 discovery in these cases, upon entry of this order dismissing BNI, information,  
8 witnesses, and documents in the possession, custody, or control of BNI shall be  
9 deemed in the possession, custody, or control of BiTMICRO, but only to the extent  
10 they may be relevant to this litigation and to the extent that Samsung or SK hynix  
11 issues a request for them to BiTMICRO.
- 12 2. That BiTMICRO will file an answer, affirmative defenses and any counterclaims  
13 within 14 days of the entry of this proposed order by the Court.
- 14 3. That Samsung shall file Notice of Pendency of Other Action Involving Same  
15 Patent(s) pursuant to Local Patent Rule 2-1(a) (2) within 14 days of this proposed  
16 order by the Court.
- 17 4. That BiTMICRO agrees that it does not contest jurisdiction or venue in the Northern  
18 District of California for this case. BiTMICRO's agreement is for these cases only to  
19 facilitate the stipulated stay, and does not constitute an admission that jurisdiction or  
20 venue would be proper in the Northern District of California in any other matter.
- 21 5. That, following BiTMICRO's filing of an answer, affirmative defenses and any  
22 counterclaims, these cases shall be stayed until the determination of the ITC in  
23 Investigation No. 337-TA-1097 becomes final, including all appeals.

24  
25 **IT IS SO STIPULATED.**

26 Dated: July 12, 2018

GREENFIELD DRAA & HARRINGTON LLP

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28 By: /s/ David C. Bohrer  
DAVID C. BOHRER

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Attorneys for Defendants  
BiTMICRO LLC and BiTMICRO NETWORKS, INC.

Dated: July 12, 2018

KIRKLAND & ELLIS LLP

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