

Judge Richard G. Stearns: ELECTRONIC ORDER entered granting 235 Motion to Stay. Defendants move to stay this case pending resolution of two inter partes review (IPR) proceedings recently instituted by the Patent Trial and Appeal Board (PTAB). After careful consideration of the parties' briefing, the court will allow the motion. "Courts customarily consider three factors in determining whether to stay an action pending [IPR]: 1) the stage of the litigation, including whether discovery is complete and a trial date has been set, 2) whether a stay will simplify the issues and 3) whether a stay will unduly prejudice or present a clear tactical disadvantage to the nonmoving party." *Mizuho Orthopedic Sys., Inc. v. Allen Med. Sys., Inc.*, 610 F. Supp. 3d 362, 365 (D. Mass. 2022). Here, as explained below, on balance these factors weigh in favor of entering a stay in this case.

**Stage of the Litigation:** The first factor weighs against a stay, although only just. "[S]ubstantial progress has been made in this action on several fronts." *Id.* at 365-366. A Markman order has already issued, for example, and fact discovery closed several months ago. A significant amount of work, however, remains to be done before any trial may occur, including resolution of dispositive and Daubert motions. See *ACQIS, LLC v. EMC Corp.*, 109 F. Supp. 3d 352, 357 (D. Mass. 2015).

**Simplification:** The second factor weighs slightly in favor of a stay. While it is true, as Moderna notes, that one of the asserted patents is not encompassed by the IPR proceedings, the outcome of those proceedings will nonetheless simplify the issues in this case. See *Serv. Solutions U.S., LLC v. Autel.US Inc.*, 2015 WL 401009, at \*3 (E.D. Mich. Jan. 28, 2015) ("[T]he Court is not convinced that a stay is inappropriate merely because only one patent is under review. Though a stay would have greater potential to simplify the issues if all seven patents were involved in the IPR proceeding, this does not mean that a more limited review would not help simplify the case."). If the PTAB was to cancel the '600 or '127 patents (or any subset of claims therein), for example, there would be no need to litigate infringement with respect to these claims. And if the PTAB was instead to uphold the claims, Pfizer and BioNTech would be estopped from raising any invalidity arguments which could have been presented in the IPR (as they themselves acknowledge, see *Mem. in Supp. of Mot. to Stay* [Dkt # 236] at 11).

**Prejudice:** The third factor weighs in favor of a stay. Moderna seeks only monetary damages. And although the parties are direct competitors, it is not clear to the court how continuing competition in the market during the pendency of the IPR will cause Moderna any harm. As for Moderna's degradation of evidence argument, because fact discovery and depositions have already been completed, the court is not convinced that any delay will prejudice Moderna's ability to present evidence at trial. Even if, as Moderna posits, a witness was to forget the relevant events or refuse to appear despite a court order, Moderna presumably could seek to enter their deposition testimony into evidence. During the pendency of the stay, the parties shall file status reports with the court every 90 days, beginning on August 1, 2024. (RGS, law3) (Entered: 04/12/2024)

As of April 15, 2024, PACER did not contain a publicly available document associated with this docket entry. The text of the docket entry is shown above.