

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE

WILSON WOLF MANUFACTURING :
CORPORATION, :
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 Plaintiff, :
 :
 v. : Civil Action No. 19-2315-RGA
 :
 BRAMMER BIO, LLC, :
 :
 :
 Defendant. :

ORDER GRANTING STAY

I address a motion to stay pending the outcome of Corning’s declaratory judgment action in the District of Minnesota. (D.I. 11). The motion is fully briefed. (D.I. 12, 16, 18).

Plaintiff Wilson Wolf (“WW”) sued Brammer Bio (“BB”) on December 20, 2019, alleging patent infringement relating to cell culture technology. WW asserts patents ‘192 (method claims), ‘317 (apparatus claims), and ‘443 (method claims). (D.I. 1). WW alleges BB “has infringed the patents in suit through its use of the Corning HYPERStack.” (Id. at ¶ 27). The complaint contains limitation-by-limitation allegations of infringement of at least one claim of each of the three patents. The HYPERStack is front and center in each of the charts.

At about the same time as the suit in this case was filed, WW also sued two other entities, one in Delaware and one in Ohio, alleging their infringement through the use of the HYPERStack. (*WW v. Sarepta Therapeutics*, No. 19-2316 (D.Del. filed 12/20/19) (asserting infringement of the ‘912 and ‘443 patents)); *WW v. Nationwide Children’s Hospital*, No. 20-192-MHW (S.D. Ohio filed 1/13/20) (asserting infringement of the ‘912, ‘317, and ‘443 patents)).

BB answered the complaint and moved to stay.

Corning manufactures the HYPERStack. Corning sued WW in the District of Minnesota at the same time as BB answered the complaint in this case, seeking a declaratory judgment of invalidity and non-infringement. *Corning v. WW*, No. 20-700-DWF-TNL (D.Minn. filed Mar. 9, 2020). WW is incorporated in Minnesota and has its principal place of business in Minnesota. (D.I. 1 at 1). Its lead counsel is from Minneapolis. WW and Corning have been litigating relating to the HYPERStack in Minnesota since 2013, albeit on other asserted patents and issues. The new case has been assigned to the same district judge who has been assigned to the 2013 case.¹

BB moves for a stay under the theories of “traditional stay analysis and the customer-suit exception to the first-filed rule.” (D.I. 12 at 3).² BB asserts that Corning has agreed to indemnify BB in this case. (*Id.* at 4 n.3). BB further asserts that it agrees to be bound by any findings relating to infringement and validity that are decided in the Minnesota case. (*Id.* at 12).

WW’s response concentrates on the arguments that BB directly infringes the two method patents (whereas Corning only indirectly infringes them) and that WW’s damages caused by BB’s infringement are distinct from any damages it could get from Corning. WW argues that the resolution of the Minnesota case will not necessarily completely resolve this case. WW notes that in the Minnesota case, it has not counterclaimed for patent infringement and does not seek damages.³ WW also notes that BB is not a “mere reseller” of the HYPERStack, but uses it

¹ I assume that for venue reasons, WW probably had no basis to file the lawsuit against BB—a Delaware corporation with a principal place of business in Massachusetts—in Minnesota.

² Nationwide Children’s Hospital has moved for a stay in the Ohio case. (D.I. 18 at 2). I reviewed the Ohio docket. As of December 8, 2020, the motion to stay is pending.

³ WW states that since it is not pursuing damages against Corning, there is no issue of patent exhaustion. (D.I. 16 at 12).

profitably in a method that creates added value. WW states, “Although a validity judgment in [the Minnesota case] might simplify the issues in this case, courts routinely deny application of the customer suit exception when the case share only that one overlapping issue.” (*Id.* at 14).

I think under either mode of stay analysis, this case should be stayed. Recent Federal Circuit decisions, under at least somewhat analogous facts, have emphasized the wastefulness of duplicative litigation of the same issues in two different district courts. *See In re Nintendo of America, Inc.*, 756 F.3d 1363, 1366 (Fed. Cir. 2014); *In re Google Inc.*, 588 F. App’x 988, 990-91 (Fed. Cir. 2014) (non-precedential).⁴ Here, the litigation already involves three different district courts, one of which has substantial experience with the technology and the parties before it. As WW concedes, the invalidity determination in Minnesota will simplify the BB case. If the patents are invalid, the case here will end. If the patents are not invalid, the case here may proceed but with invalidity issues resolved. In addition, it appears that the Minnesota case is probably a good vehicle for definitively resolving the issue of infringement for the apparatus patent, even though it is more speculative as to how much it would likely resolve about the two method patents.⁵ Either way, there will be simplification and reduction of duplicative effort. I expect any claim construction in Minnesota will not need to be repeated here. The case here is at the beginning. Litigating in Minnesota is certainly not inconvenient for a Minnesota company with Minnesota lawyers. Finally, I think the possibility that the Minnesota case will not resolve this case is very unlikely. Corning is indemnifying BB. It is thus incentivized to resolve this

⁴ Both these cases were cited in the Opening Brief. (D.I. 12 at 11-12). The Answering Brief does not mention them.

⁵ BB points out persuasively that the infringement allegations against the three customers (BB, Sarepta, and Nationwide Children’s Hospital) are essentially the same, as all three sets of allegations concentrate on the HYPERStack.

litigation at the same time as it resolves its own litigation.⁶ There will be some prejudice to WW from delay if the case is not resolved by the Minnesota litigation, but since WW's damages theory is based on a reasonable royalty, should that issue ever be reached, pre-judgment interest appears sufficient to compensate for the delay.⁷

Thus, whether the stay motion is looked at under the traditional stay analysis or through the lens of the customer-suit exception, staying this case makes sense upon a balancing of the interests involved. The motion to stay (D.I. 11) is **GRANTED**. The case is **STAYED** pending further order of the Court.

The Clerk is directed to administratively close this case. The parties are to submit brief status reports every six months until this case is either resolved or reopened.

IT IS SO ORDERED this 8th day of December 2020.

/s/ Richard G. Andrews
United States District Judge

⁶ I think it is extremely unlikely that WW will continue to not assert infringement counterclaims against Corning. In my experience, DJ defendants always assert counterclaims against the manufacturer when push comes to shove.

⁷ I note that it has become fairly routine to stay cases after IPRs have been instituted. In IPRs, the only likely simplification is an invalidity/validity resolution. The Minnesota litigation should accomplish at least that much, but, of course, the IPR process is faster than district court litigation. Thus, there may be cases that should be stayed while an IPR is pending but that should not be stayed while litigation with a manufacturer is pending. The extra delay could be prejudicial. But in this case, I do not think the likely extra delay is unfairly prejudicial.