

UNITED STATES DISTRICT COURT FOR THE WESTERN DISTRICT OF
WASHINGTON

Godox Photo Equipment Co. Ltd. v. Profoto Aktiebolag

Godox · No. C25-0502-KKE · Decided December 22, 2025

SUMMARY

The United States District Court for the Western District of Washington granted Godox Photo Equipment Co. Ltd.’s motion to stay patent litigation pending ex parte reexamination of Profoto Aktiebolag’s U.S. Patent No. 11,630,375. The court concluded that the reexamination was likely to simplify the issues, the case was at an early stage, and the stay would not unduly prejudice Profoto. The court vacated most scheduling deadlines pending completion of the reexamination and directed the parties to file a joint status report afterward.

CASE DETAILS

COURT	United States District Court for the Western District of Washington
WRITING FOR THE COURT	Kymberly K. Evanson
JURISDICTION	United States District Court for the Western District of Washington
DECIDED	December 22, 2025
DOCKET	C25-0502-KKE
DISPOSITION	other
PROCEDURAL POSTURE	Godox moved to stay its patent and related tortious-interference action pending the PTO's ex parte reexamination of Profoto's patent. The court granted the motion and separately granted leave to supplement the record, while denying as moot Godox's request for a protective order.
STANDARD OF REVIEW	Abuse-of-discretion framework; the decision whether to stay litigation pending patent reexamination rests in the sound discretion of the district court.
PRECEDENTIAL VALUE	unpublished district-court order
PARTIES	Godox Photo Equipment Co. Ltd. v. Profoto Aktiebolag

TOPICS

- civil procedure
- patent law
- patent infringement
- patent prosecution
- commercial litigation

PRACTICE AREAS

civil procedure

patent law

patent infringement

patent prosecution

commercial litigation

QUESTIONS PRESENTED

1. Whether the court should stay the patent litigation pending the PTO's ex parte reexamination of the patent.
2. Whether the factors of issue simplification, stage of litigation, and prejudice to the nonmoving party favored a stay.
3. Whether Godox should be permitted to supplement the record with the PTO's Final Office Action.
4. Whether Godox's request for a protective order should be denied as moot.

HOLDINGS

1. The court may stay the litigation pending the PTO's reexamination, and all three applicable factors favored granting a stay.
2. Good cause supported permitting Godox to supplement the record with the PTO's Final Office Action issued after the motion to stay was filed.
3. All deadlines in the scheduling order, except the deadline for Godox's response to Profoto's answer and counterclaims, were vacated pending completion of the PTO reexamination.

KEY QUOTATIONS

"Courts often grant stays pending reexamination of a patent if the lawsuit is at an early stage, the PTO's decision would simplify the issues to be tried, and a stay would not unduly prejudice the non-moving party." (at 2)

"The decision to grant or deny a stay "rests with the sound discretion of the court."" (at 2)

"Thus, staying the case avoids expending resources litigating the validity and scope of patent claims that may be amended or cancelled while also providing the court and the parties "with the benefit of the USPTO's expert analysis[.]'" (at 3)

"Because all three factors favor a stay, the Court will grant Godox's motion." (at 8)

FACTUAL BACKGROUND

Godox, a Chinese photography and video-equipment company, sued Profoto, a Swedish company and owner of U.S. Patent No. 11,630,375, seeking a declaration that certain Godox products do not infringe the patent. Profoto had sent infringement notices to Godox distributors, and some Godox product listings were removed from Amazon through the APEX process. The PTO granted an ex parte reexamination request concerning the patent, rejected all claims in a non-final decision, and later issued a Final Office Action rejecting all claims after Profoto proposed amendments. The litigation remained at an early stage, with no depositions, claim-construction briefing, Markman hearing, or trial scheduled.

PROCEDURAL HISTORY

Godox filed the action in March 2025 seeking a declaration of noninfringement and related relief. After the court denied Godox's requests for a temporary restraining order and preliminary injunction, the parties filed pleadings and counterclaims concerning infringement, invalidity, unenforceability, and inequitable conduct. Godox then moved to stay after the PTO rejected the patent claims in a non-final decision and Profoto proposed amendments; while the motion was pending, the PTO issued a Final Office Action rejecting all claims.

DISPOSITION

other

REMAND INSTRUCTIONS

No remand. The case is stayed pending the PTO's reexamination of the '375 Patent. The parties must file a joint status report within 14 days after the reexamination concludes, informing the court of the outcome and proposing an amended case schedule.

CASES CITED

- Procter & Gamble Co. v. Kraft Foods Glob., Inc., 549 F.3d 842, 849 (Fed. Cir. 2008)
- Viskase Corp. v. Am. Nat'l Can Co., 261 F.3d 1316, 1328 (Fed. Cir. 2001)
- ASCII Corp. v. STD Ent. USA, Inc., 844 F. Supp. 1378, 1380 (N.D. Cal. 1994)
- Nat'l Prods., Inc. v. Gamber-Johnson LLC, No. 2:12-CV-00840, 2012 WL 3527938, at *1 (W.D. Wash. Aug. 14, 2012)
- Polaris PowerLED Techs., LLC v. Nintendo Co., No. C22-0386JLR, 2023 WL 12134477, at *2-4 (W.D. Wash. Jan. 31, 2023)
- Implicit Networks, Inc. v. Adv. Micro Devices, Inc., No. C08-184J, 2009 WL 357902, at *2 (W.D. Wash. Feb. 9, 2009)
- Fresenius USA, Inc. v. Baxter Int'l, Inc., 721 F.3d 1330, 1340 (Fed. Cir. 2013)
- SenoRx, Inc. v. Hologic, Inc., No. CIV.A. 12-173-LPS, 2013 WL 144255, at *4 (D. Del. Jan. 11, 2013)
- Gould v. Control Laser Corp., 705 F.2d 1340, 1342 (Fed. Cir. 1983)
- Nat'l Prods. v. Innovative Intelligent Prods., LLC, No. 2:20-CV-00428-RAJ, 2021 WL 2636101, at *2 (W.D. Wash. June 25, 2021)
- IMAX Corp. v. In-Three, Inc., 385 F. Supp. 2d 1030, 1033 (C.D. Cal. 2005)
- Globetrotter Software, Inc. v. Elan Comput. Grp., Inc., 362 F.3d 1367, 1375, 1377 (Fed. Cir. 2004)
- Therasense Inc. v. Becton, Dickinson & Co., 649 F.3d 1276, 1285, 1290-91 (Fed. Cir. 2011) (en banc)
- Bloom Eng'g Co. v. N. Am. Mfg. Co., 129 F.3d 1247, 1250 (Fed. Cir. 1997)
- R+L Carriers, Inc. v. Qualcomm, Inc., 801 F.3d 1346, 1350 (Fed. Cir. 2015)
- Versata Software, Inc. v. Callidus Software, Inc., 771 F.3d 1368, 1373-74 (Fed. Cir. 2014), vacated on other grounds, 780 F.3d 1134 (Fed. Cir. 2015)

- WAG Acquisition, LLC v. Flying Crocodile, Inc., No. 2:19-CV-1278-BJR, 2021 WL 6693829, at *3 (W.D. Wash. Dec. 28, 2021)
- Ceiva Logic Inc. v. Frame Media Inc., No. SACV-08-00636-JVS, 2009 WL 7844245, at *2-3 (C.D. Cal. June 9, 2009), *aff'd*, 374 F. App'x 959 (Fed. Cir. 2010)
- Medicis Pharm. Corp. v. Upsher-Smith Lab'ys, Inc., 486 F. Supp. 2d 990, 994 (D. Ariz. 2007)
- Tesco Corp. v. Weatherford Int'l, Inc., 2009 WL 529212, at *3 (S.D. Tex. 2009)
- Polymer Techs., Inc. v. Bridwell, 103 F.3d 970, 975-76 (Fed. Cir. 1996)

OPINION

1 2 3 4 5 UNITED STATES DISTRICT COURT 6 WESTERN DISTRICT OF WASHINGTON
AT SEATTLE 7 GODOX PHOTO EQUIPMENT CO. LTD., CASE NO. C25-0502-KKE 8
Plaintiff(s), ORDER GRANTING PLAINTIFF'S 9 v. MOTION TO STAY 10 PROFOTO
AKTIEBOLAG, 11 Defendant(s). 12 Plaintiff Godox Photo Equipment Co. Ltd. ("Godox") filed
this patent case against 13 Defendant Profoto Aktiebolag ("Profoto") seeking declaratory and
related relief.

In particular, 14 Godox seeks a declaration that certain Godox photography and video lighting
products do not 15 infringe U.S. Patent No. 11,630,375 ("‘375 Patent"). Godox now moves to stay
the case pending 16 the U.S. Patent and Trademark Office's ("PTO") reexamination of the ‘375
Patent. Dkt. No. 57. 17 Courts often grant stays pending reexamination of a patent if the lawsuit is
at an early stage, the 18 PTO's decision would simplify the issues to be tried, and a stay would not
unduly prejudice the 19 non-moving party.

Finding these factors favor a stay here, the Court will grant Godox's motion. 20 I.
BACKGROUND 21 The facts of this case are set forth more fully in the Court's order denying
Godox's motion 22 for preliminary injunction. Dkt. No. 52. This order recounts only the factual
and procedural 23 background relevant to the pending motion to stay. 24 1 Godox is a Chinese
company that produces photography and video equipment.

Dkt. No. 1 2 ¶¶ 1, 45. Profoto is a Swedish company that describes itself as "dominat[ing] the
premium-flash 3 segment of photographic lighting." Dkt. No. 37 ¶ 4. Profoto is the assignee and
owner of the ‘375 4 Patent. Dkt. No. 1 ¶¶ 46–47. 5 The PTO issued the ‘375 Patent in April 2023.
Dkt. No. 1-2. By that time, Profoto and 6 Godox had been in a patent dispute since at least
November 2019, when Profoto first sent Godox 7 an infringement notice in China, alleging that
certain Godox products infringed a Chinese 8 counterpart to the ‘375 Patent.

See Dkt. No. 7-3 ¶ 13. By early 2024, Godox began receiving 9 reports from its U.S. distributors
that Profoto had sent cease-and-desist letters warning them that 10 Godox's products violated the
‘375 Patent. Dkt. No 7-2 ¶ 7. 11 In October 2024, Profoto first initiated an Amazon Patent
Evaluation Express ("APEX") 12 proceeding against a Godox distributor. Dkt.

No. 7-3 ¶ 20. The APEX process allows participating 13 patent owners to notify Amazon about listed products that potentially infringe on their patents, 14 after which Amazon contacts the accused sellers and asks whether they would like to opt in or out 15 of the APEX program. Dkt. No. 38 ¶ 16. If the seller opts out, then the accused product listings 16 (identified by Amazon Standard Identification Numbers, known as “ASINs”) are removed.

Id. If 17 the seller opts in, the challenged ASINs remain on Amazon’s storefront unless Amazon’s neutral 18 evaluator finds likely infringement. Id. ¶¶ 16–17. Several Godox distributors opted into the APEX 19 proceeding, and Amazon’s evaluator began reviewing the accused products for infringement of 20 the ‘375 Patent. Dkt. No. 37 ¶ 8. 21 Amazon’s neutral evaluator concluded Profoto “is likely to be able to prove that [certain 22 Godox products listed on Amazon] fall within the scope of [the ‘375 Patent].” Dkt.

No. 37-5 at 2 23 (identifying 17 ASINs). Accordingly, those ASINs were removed from Amazon’s storefront. Id. 24 Profoto then submitted two additional APEX requests alleging infringement of the ‘375 Patent by 1 other Godox products, but Amazon decided to pause those proceedings pending resolution of this 2 litigation. Dkt. No. 37 ¶ 16, Dkt. No. 37-8 at 2. 3 In November 2024, an anonymous third party requested an ex parte reexamination of the 4 ‘375 Patent, and the PTO granted the request.

Dkt. No. 7-13 at 3. Ex parte reexamination is a 5 process involving the PTO and patent holder in which the PTO reexamines the validity of a patent 6 that has been called into question. 35 U.S.C. §§ 301–307. At the reexamination’s conclusion, the 7 PTO will cancel invalid patent claims, confirm valid claims, or issue amended claims to cure 8 invalidity. 35 U.S.C. § 307.

9 Godox sued Profoto in March 2025, seeking a declaration of non-infringement of the ‘375 10 Patent and alleging tortious interference with prospective business expectancy under Washington 11 law. Dkt. No. 1. Godox moved for a temporary restraining order (“TRO”) requiring Profoto to 12 retract its infringement notices to Godox’s distributors and enjoining it from sending any more 13 notices.

Dkt. No. 7. After Profoto responded, the Court denied the motion. Dkt. No. 13. 14 Godox then moved for a preliminary injunction seeking substantially the same relief. Dkt. 15 No. 26. Before the Court issued its decision on the motion, Profoto filed an answer to the 16 complaint and asserted counterclaims alleging that Godox’s products directly and indirectly 17 infringe the ‘375 Patent.

Dkt. No. 35 at 13–26. Godox answered Profoto’s counterclaims and 18 asserted two counter-counterclaims, seeking declarations of unenforceability and invalidity of the 19 ‘375 Patent. Dkt. No. 43 at 30–37. Following supplemental briefing and a hearing, the Court 20 denied Godox’s motion for preliminary injunction. Dkt. Nos. 45, 46, 48, 50, 52. 21 In June 2025, the PTO issued a

non-final decision in the reexamination rejecting all claims 22 of the ‘375 Patent as anticipated and obvious in light of “prior art”—i.e., existing knowledge at 23 the time the patent was issued.

Dkt. No. 40-1 at 4, 6–8, 16–37; Art, Black’s Law Dictionary (12th 24 1 ed. 2024). In September 2025, to overcome the prior art, Profoto filed proposed amendments to 2 all independent claims of the ‘375 Patent as well as eleven new dependent claims. Dkt. No. 57-6. 3 A few weeks later, Godox filed this motion to stay litigation pending the outcome of the 4 reexamination.

Dkt. No. 57. On November 25, 2025, while the motion to stay was pending, the 5 PTO issued a Final Office Action rejecting all claims of the ‘375 Patent.¹ Dkt. No. 63-1 at 40. A 6 final office action does not effectively cancel the patent at issue but, instead, raises validity 7 problems initially identified in a nonfinal office action for a final time.² Profoto states that it has 8 several options for responding to the rejection decision, including “providing a response to the 9 final Office action,” “seeking an examiner interview,” and “filing an appeal to the Patent Trial and 10 Appeal Board.” Dkt.

65 at 5; see also 35 U.S.C. § 134; 37 C.F.R. § 41.31. Profoto must respond 11 to the Final Office Action within two months, which may be extended for two additional months 12 or, if supported by sufficient cause, even longer. Dkt. No. 63-1 at 37. 13 In its motion to stay, Godox contends that Profoto’s decision to amend all independent 14 claims of the patent makes it unlikely “the claims identified in the Complaint will ultimately be 15 litigated in their current form[.]” Dkt.

No. 57 at 5. Profoto opposes the motion, contending a stay 16 would cause undue prejudice without simplifying the issues in the litigation (Dkt. No. 60 at 6), and 17 instead proposes an extension of the current claim construction deadlines “by at least 60 days” 18 (Dkt. No 65 at 5). Godox filed a reply. Dkt. No. 62. Following the PTO’s Final Office Action, 19 the parties also filed a joint status report presenting their positions on the impact of the final 20 rejection decision on both the stay motion and the litigation as a whole.

Dkt. No. 65. Neither 21 party has requested oral argument, and Godox’s motion to stay is now ripe for consideration. 22 1 Godox moved for leave to supplement the record with the PTO’s Final Office Action (Dkt. No. 63) and Profoto 23 does not oppose the motion (Dkt. No. 66). Given that the PTO issued its decision after Godox filed its motion to stay, the Court finds good cause to supplement the record and will grant Godox’s motion to supplement.

2 Responding to office actions, U.S. PAT. & TRADEMARK OFF., 24 <https://www.uspto.gov/trademarks/maintain/responding-office-actions> (last visited Dec. 16, 2025).

1 II. DISCUSSION 2 A. Legal Standard 3 The Court’s inherent power to control its docket includes the authority to stay litigation 4 pending the outcome of a reexamination proceeding. *Procter & Gamble Co. v. Kraft Foods Glob., 5 Inc.*, 549 F.3d 842, 849 (Fed.

Cir. 2008). Such a stay is not mandatory, however. *Viskase Corp. v. Am. Nat'l Can Co.*, 261 F.3d 1316, 1328 (Fed. Cir. 2001). The decision to grant or deny a stay “rests with the sound discretion of the court.” *ASCII Corp. v. STD Ent. USA, Inc.*, 844 F. Supp. 8 1378, 1380 (N.D. Cal. 1994). 9 In deciding whether to stay a patent case in view of a reexamination, courts generally 10 consider three factors: (1) “whether a stay will simplify the issues in question”; (2) “the stage of 11 litigation, i.e. whether discovery is complete and whether a trial date has been set”; and (3) 12 “whether a stay would unduly prejudice the non-moving party.” *Nat'l Prods., Inc. v. Gamber- 13 Johnson LLC*, No. 2:12-CV-00840, 2012 WL 3527938, at *1 (W.D.

Wash. Aug. 14, 2012). The 14 Court addresses each of these factors below. 15 B. Simplification 16 Godox contends that a stay would simplify the issues by avoiding wasteful efforts litigating 17 the scope and validity of patent claims that are likely to be cancelled or amended. Dkt. No. 57 at 18 8–10. According to Godox, cancellation or amendment is likely because, rather than standing on 19 the validity of the ‘375 Patent, Profoto has proposed claim amendments to overcome the prior art 20 at issue in the reexamination.

Id. Godox further contends that the PTO’s final rejection makes it 21 even less likely the ‘375 Patent will emerge from the reexamination in its current, unamended 22 form. Dkt. No. 65 at 2–5. Staying litigation until the PTO determines what form the ‘375 Patent 23 will take avoids duplicative efforts and gives the Court the benefit of the PTO’s expertise. Dkt.

24 No. 57 at 8–10. 1 The Court agrees that a stay would simplify the issues in this case. Courts in this district 2 have typically found this factor favors a stay when the reexamination proceeding implicates all 3 claims in the patent at issue. See, e.g., *Polaris PowerLED Techs., LLC v. Nintendo Co.*, No. C22- 4 0386JLR, 2023 WL 12134477, at *2–3 (W.D. Wash. Jan.

31, 2023) (finding simplification favored 5 a stay where “all of the claims ... at issue in this litigation are subject to the USPTO’s pending” 6 reexamination); *Implicit Networks, Inc. v. Adv. Micro Devices, Inc.*, No. C08-184JLR, 2009 WL 7 357902, at *2 (W.D. Wash. Feb. 9, 2009) (same). This makes sense because, unless a patent claim 8 emerges from reexamination “in identical form,” it becomes unenforceable at least as to acts 9 predating the final reexamination decision.

Fresenius USA, Inc. v. Baxter Int’l, Inc., 721 F.3d 10 1330, 1340 (Fed. Cir. 2013). Thus, staying the case avoids expending resources litigating the 11 validity and scope of patent claims that may be amended or cancelled while also providing the 12 court and the parties “with the benefit of the USPTO’s expert analysis[.]” *Implicit Networks, Inc.*, 13 2009 WL 357902, at *2.

14 Given Profoto’s proposal to amend the ‘375 Patent’s claims and the PTO’s final action 15 rejecting the claims nonetheless, there is a substantial likelihood the PTO will ultimately modify 16 the ‘375 Patent, at least to some extent. See *SenoRx, Inc. v. Hologic, Inc.*, No. CIV.A. 12-173-

17 LPS, 2013 WL 144255, at *4 (D. Del. Jan. 11, 2013) (finding “a significant statistical chance that 18 one or more of [the patent’s] claims [would] be cancelled” or “modified” in reexamination where 19 “nearly all of the asserted claims [were] ... subject to a non-final rejection”).

Moving forward 20 with this case despite the reexamination would likely “render some of the parties’ and the Court’s 21 resources wasted (if, for example, the Court construes certain claim terms that are subsequently 22 eliminated or altered via the reexamination process).” *Id.* Awaiting the results of the 23 reexamination would eliminate, clarify, or limit the claims at issue and—if any claims survive 24 reexamination—would “provid[e] the district court with the expert view of the PTO[.]” *Gould v. 1 Control Laser Corp.*, 705 F.2d 1340, 1342 (Fed.

Cir. 1983). 2 Profoto resists this conclusion, contending the benefits of a stay would be small for several 3 reasons. For instance, it argues a stay would not lessen the burdens of litigation because Profoto 4 expects the PTO to “imminently” issue a new patent, U.S. Application No. 18/301,587 (the “‘587 5 Patent”), at which time Profoto will amend its counterclaims “to allege infringement by the same 6 Godox products already accused of infringing the ‘375 Patent.” Dkt.

No. 60 at 9. Profoto’s 7 forthcoming ‘587 Patent, however, does not currently exist, so the Court has no way to assess its 8 impact on this litigation. Profoto cites decisions in which courts have denied stays because the 9 pending reexamination would “not resolve all issues in the litigation[.]” Dkt. No. 60 at 9; see *Nat’l 10 Prods. v. Innovative Intelligent Prods., LLC*, No. 2:20-CV-00428-RAJ, 2021 WL 2636101, at *2 11 (W.D.

Wash. June 25, 2021) (holding that stay would not simplify issues where “only three of the 12 four patents in dispute [were] involved in” the reexamination); *IMAX Corp. v. In-Three, Inc.*, 385 13 F. Supp. 2d 1030, 1033 (C.D. Cal. 2005) (same where reexamination only concerned one of several 14 patents at issue). But none involved yet-to-be-issued patents. While Profoto could move to lift 15 the stay if the PTO issues the new ‘587 Patent, the Court will not deny a stay based on an unissued 16 patent.

17 Next, Profoto contends the reexamination will not affect Godox’s claim for tortious 18 interference with prospective business expectancy (Dkt. No. 1 at 16–17) or Godox’s affirmative 19 defense of inequitable conduct (Dkt. No. 43 at 24, 30–36). Dkt. No. 60 at 10. Neither issue 20 warrants proceeding with litigation despite the reexamination. Indeed, both issues are tertiary to 21 the principal dispute in this case: whether Godox’s products infringe the ‘375 Patent and whether 22 that patent is invalid.

And, in any event, both are intertwined with issues in the reexamination. 23 The tortious interference claim, for instance, turns, in part, on whether Profoto’s cease- 24 and-desist letters to Godox distributors were “objectively baseless[.]” *Globetrotter Software, Inc. 1 v. Elan Comput. Grp., Inc.*, 362 F.3d 1367, 1377 (Fed. Cir. 2004). That, in turn, depends on 2 whether the ‘375

Patent was “obviously invalid or plainly not infringed” (id. at 1375)—issues on 3 which the reexamination will shed light.

The reexamination is also relevant to inequitable conduct, 4 which “is an equitable defense to patent infringement that, if proved, bars enforcement of [the] 5 patent.” *Therasense Inc. v. Becton, Dickinson & Co.*, 649 F.3d 1276, 1285 (Fed. Cir. 2011) (en banc).

To prove the defense, Godox will need to show that Profoto deliberately withheld “a known 7 material reference” (i.e., prior art) from the PTO during the patent prosecution. Id. at 1290; see 8 also Dkt. No. 43 ¶ 139 (alleging Profoto and others “intentionally withheld” a prior reference 9 despite its “clear relevance and materiality”). A prior reference is “material if the PTO would not 10 have allowed a claim had it been aware of the undisclosed prior art.” *Therasense Inc.*, 649 F.3d at 11 1291.

At minimum, the reexamination will be probative of materiality because the PTO is 12 currently considering the very reference Godox claims Profoto withheld. See Dkt. No. 43 ¶¶ 91, 13 139 (alleging Profoto failed to disclose “Chen” reference); Dkt. No. 57-4 at 4 (identifying “Chen” 14 as “prior art discussed” in reexamination interview). 15 Finally, Profoto contends that its proposed amendments to the ‘375 Patent were “minimal” 16 such that, if adopted by the PTO, the impact on this case would be small.

Dkt. No. 60 at 10. But 17 even a small amendment could have significant effects on this case. “Unless a claim granted or 18 confirmed upon reexamination is identical to an original claim, the patent [cannot] be enforced 19 against infringing activity that occurred before issuance of the reexamination certificate.” *Bloom 20 Eng’g Co. v. N. Am. Mfg. Co.*, 129 F.3d 1247, 1250 (Fed.

Cir. 1997) (emphasis added) (citing 35 21 U.S.C. § 252). And while seemingly modest, Profoto apparently drafted its amendments to avoid 22 prior art identified by the PTO as possibly problematic to the ‘375 Patent’s validity. See Dkt. No. 23 57-4 at 5 (summarizing amendments and stating PTO examiner “agreed [such] amendments ... 24 would overcome the current rejections based on” prior art).

Where the original claim is “amended 1 to cure invalidity, the patentee’s cause of action [for infringement based on pre-amendment acts] 2 is extinguished and the suit fails.” *Fresenius USA, Inc.*, 721 F.3d at 1340; see also *R+L Carriers, 3 Inc. v. Qualcomm, Inc.*, 801 F.3d 1346, 1350 (Fed. Cir. 2015) (“[I]n determining whether an 4 amended claim is narrower, we determine whether there is any product or process that would 5 infringe the original claim, but not infringe the amended claim.”).

Even if Profoto’s amendments 6 are indeed minor, the “reexamination will have a significant impact on the issues in this case, 7 regardless of the outcome.”³ *Polaris PowerLED Techs.*, 2023 WL 12134477, at *3. 8 Accordingly, the simplification factor weighs in favor of a stay. 9 C. Stage

of Litigation 10 Godox contends that this factor also favors a stay because the Court has not set dates for a 11 trial or Markman hearing and the parties have yet to propound written discovery, notice 12 depositions, or produce records beyond certain core technical documents.

Dkt. No. 57 at 10–11. 13 Profoto counters that the case “has sufficiently advanced to weigh slightly against a stay,” pointing 14 to Profoto’s preparation of infringement contentions and the parties’ briefing on Godox’s TRO 15 and preliminary injunction motions. Dkt. No. 60 at 12.

The Court finds Godox has the better 16 argument. 17 The Federal Circuit has found “the timing factor [to] strongly favor[] a stay” at similar, if 18 not later, stages of litigation. *Versata Software, Inc. v. Callidus Software, Inc.*, 771 F.3d 1368, 19 1373–74 (Fed. Cir. 2014), vacated on other grounds, 780 F.3d 1134 (Fed. Cir. 2015).

In *Versata* 20 Software, for instance, “discovery was still ongoing” although “many documents and discovery 21 requests had been exchanged[,]” the parties had not deposed witnesses or filed expert reports, and 22 the Markman hearing and trial were still two years away. *Id.* 23 3 Moreover, the PTO’s Final Office Action rejecting Profoto’s proposed amendments suggests that the 24 reexamination may result in more substantial changes to the ‘375 Patent.

Dkt. No. 63-1 at 8–36. 1 Here, the parties have not noticed depositions, filed claim construction briefs, or engaged 2 in any discovery beyond initial exchanges. The Markman hearing and trial have not been 3 scheduled.

As in *Versata Software*, the most burdensome and costly stages lie ahead. Many other 4 courts have found the timing factor to favor a stay under similar circumstances. See, e.g., *Polaris 5 PowerLED Techs.*, 2023 WL 12134477, at *4 (timing favored a stay where the parties had 6 “engaged in limited discovery” and had not noticed depositions or filed claim construction briefs); 7 *WAG Acquisition, LLC v. Flying Crocodile, Inc.*, No. 2:19-CV-1278-BJR, 2021 WL 6693829, at 8 *3 (W.D.

Wash. Dec. 28, 2021) (same where parties had completed “fact discovery related to 9 liability” but not as to damages and had not “conducted expert discovery”). Although the parties 10 have briefed TRO and preliminary injunction motions, the case is still in its infancy. *Ceiva Logic 11 Inc. v. Frame Media Inc.*, No. SACV-08-00636-JVS, 2009 WL 7844245, at *2 (C.D.

Cal. June 9, 12 2009) (finding case to be “at an early stage of development” notwithstanding preliminary 13 injunction motion), *aff’d*, 374 F. App’x 959 (Fed. Cir. 2010); *Medicis Pharm. Corp. v. Upsher- 14 Smith Lab’ys, Inc.*, 486 F. Supp. 2d 990, 994 (D. Ariz. 2007) (same). 15 Accordingly, the timing factor weighs also in favor of a stay. 16 D. Prejudice 17 Profoto contends that a stay would cause undue prejudice and put it at a tactical 18 disadvantage.

First, it claims that, despite knowing about the reexamination all along, “Godox 19 strategically chose to” seek a stay only after the Court denied its TRO and preliminary injunction 20 motions, thus rejecting Godox’s “early attempts to prevail[.]” Dkt. No. 60 at 13. Profoto is correct 21 that the reexamination was underway when Godox filed this case. But the timing of Godox’s 22 motion does not suggest gamesmanship.

When Godox sued, it was not clear that the scope of the 23 ‘375 Patent was likely to change as a result of the reexamination. The PTO had not yet rejected 24 any of the ‘375 Patent’s claims. Dkt. No. 40-1 at 4. And Profoto did not submit proposed claim 1 amendments until September 2025. Dkt. Nos. 57-1 ¶ 6, 57-6. Once that happened, Godox 2 promptly moved to stay just weeks later.

3 Profoto also claims that a stay would be unduly prejudicial because “the parties are direct 4 competitors[.]” Dkt. No. 60 at 13. According to Profoto, “delaying the resolution of [its] 5 infringement [counter-]claims” would harm Profoto’s reputation and customer goodwill by 6 enabling Godox to continue selling infringing products while the case is stayed.

Id. at 13–14. 7 Indeed, courts have held that “[w]here the parties are direct competitors, a stay would likely 8 prejudice the non-movant.” *Ceiva Logic Inc.*, 2009 WL 7844245, at *3 (quoting *Tesco Corp. v. 9 Weatherford Int’l, Inc.*, 2009 WL 529212, * 3 (S.D. Tex. 2009)). This is because continued 10 infringement during litigation can alter the market for a product, making it difficult or impossible 11 to remedy the intrusion on the patent holder’s exclusive position.

See *Polymer Techs, Inc. v. 12 Bridwell*, 103 F.3d 970, 975–76 (Fed. Cir. 1996) (“Years after infringement has begun, it may be 13 impossible to restore a patentee’s ... exclusive position by an award of damages and a permanent 14 injunction.”). 15 The circumstances of this case, however, diminish this concern somewhat.

First, Profoto 16 or its distributors have successfully removed some allegedly infringing products from Amazon via 17 the APEX proceedings. See Dkt. No. 37-5 at 2–11. Those products are thus already unable to 18 compete with Profoto products on that platform.

Second, Profoto does not dispute Godox’s claim 19 that the cease-and-desist letters have caused many distributors to stop selling the allegedly 20 infringing Godox products. See Dkt. No. 7-2 ¶ 8–9. Indeed, Godox states that “more than 100” 21 of its “product listings ha[ve] been taken down and remain[] delisted across numerous independent 22 resellers” and that the cease-and-desist letters have impacted “more than 70% of [Godox’s] entire 23 distribution network on Amazon[.]” Id. Because the Court denied Godox’s TRO and preliminary 24 injunction motions, Profoto remains free to continue notifying distributors of its infringement 1 allegations against Godox products.

Finally, Profoto initially anticipated the reexamination would 2 “conclude around the end of 2025[.]” Dkt. No. 60 at 11. And while that timeframe now appears 3 unlikely, Profoto states that a

limited 60-day extension of case deadlines will give the Court “the 4 benefit of a complete intrinsic record from the reexamination”—indicating Profoto still 5 understands the reexamination will conclude relatively soon.

Dkt. No. 65 at 6. A stay of 6 proceedings pending that conclusion, however, is preferable to a 60-day extension of deadlines 7 that may simply have to be re-extended again depending on the course of the reexamination. While 8 Profoto may suffer some small amount of prejudice for a short time, the prejudice does not 9 outweigh the benefits of awaiting the reexamination outcome Profoto understands to be near at 10 hand.

11 Because all three factors favor a stay, the Court will grant Godox’s motion. 12 III. CONCLUSION 13 Accordingly, the Court GRANTS Godox’s motion to stay (Dkt. No. 57). All deadlines in 14 the Court’s scheduling order (Dkt. No. 42) except the deadline for Plaintiff’s Response to 15 Defendant’s Answer and Counterclaims are VACATED pending the PTO’s reexamination of the 16 ‘375 Patent.

The parties shall file a joint status report no later than 14 days after the conclusion of 17 the reexamination informing the Court of the outcome and proposing an amended case schedule. 18 The Court further GRANTS Godox’s motion for leave to supplement the record (Dkt. No. 19 63), and DENIES Godox’s request for a protective order (Dkt. No. 57 at 12–13) as moot.

20 Dated this 22nd day of December, 2025. 21 A 22 Kymberly K. Evanson 23 United States District Judge 24