

UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA

JENAM TECH, LLC,
Plaintiff,

v.

GOOGLE LLC,
Defendant.

Case No. 4:22-cv-02836-JST

ORDER DENYING MOTION TO STAY

Re: ECF No. 27

JENAM TECH, LLC,
Plaintiff,

v.

GOOGLE LLC,
Defendant.

Case. No. 4:22-cv-02837-JST

Re: ECF No. 24

JENAM TECH, LLC,
Plaintiff,

v.

GOOGLE LLC,
Defendant.

Case No. 4:22-cv-02838-JST

Re: ECF No. 24

JENAM TECH, LLC,
Plaintiff,

v.

GOOGLE LLC,
Defendant.

Case No. 4:22-cv-02839-JST

Re: ECF No. 25

Before the Court is Plaintiff Jenam Tech, LLC’s motion to stay four related cases pending *inter partes* review (“IPR”) of related patents. ECF No. 27.¹ Defendant Google LLC argues that a stay is premature until Jenam discloses which of the 433 patent claims it intends to assert and asks that the Court limit Jenam to 20 claims asserted across the four cases. ECF No. 29 at 3. Jenam argues that the stay factors are met and that it would be prejudiced by having to select claims at this stage of litigation. ECF No. 27 at 5-6. The Court will deny Jenam’s motion to stay.

I. BACKGROUND

Jenam’s motion presents an unusual procedural posture. Jenam previously asserted nine patents against Google before this Court.² During discovery in that dispute, Google produced over 13,000 pages of technical documents and allowed Jenam to examine the source code for the accused QUIC technology. ECF No. 29-1 ¶ 3. On March 27, 2022, this Court stayed the case pending IPR on six of the asserted patents. Order Granting Motion to Stay, No. 21-cv-07994-JST, ECF No. 137. Forty-seven days later, Jenam filed these four cases asserting four additional patents against Google’s QUIC technology. ECF No. 1. These patents are related to those asserted in the prior case, including the patents currently before the Patent Trial and Appeals Board (“PTAB”) under IPR. ECF No. 27 at 5.

On July 11, 2022, shortly after initiating these four cases, Jenam filed the instant motion to stay. ECF No. 27. Jenam’s motion is predicated on the same PTAB IPR proceeding for which this Court stayed the prior case. *Id.*

II. JURISDICTION

The Court has jurisdiction pursuant to 28 U.S.C. § 1331.

III. LEGAL STANDARD

“Courts have inherent power to manage their dockets and stay proceedings, including the

¹ Jenam filed identical motions in all four related cases: *Jenam Tech, LLC v. Google LLC*, 22-cv-02836-JST; *Jenam Tech, LLC v. Google LLC*, 22-cv-02837-JST; *Jenam Tech, LLC v. Google LLC*, 22-cv-02838-JST; and *Jenam Tech, LLC v. Google LLC*, 22-cv-02839-JST. All docket numbers in this order refer to the lowest-numbered case.

² Jenam originally filed two suits: *Jenam Tech, LLC v. Google LLC*, 4:21-cv-07994-JST and *Jenam Tech, LLC v. Google, LLC*, 4:21-cv-09318-JST. The cases were consolidated on January 7, 2022. Order Granting Stipulated Motion to Consolidate, No. 21-cv-07994-JST, ECF No. 119.

authority to order a stay pending conclusion of a [Patent and Trademark Office] reexamination.”
Ethicon, Inc. v. Quigg, 849 F.2d 1422, 1426-27 (Fed. Cir. 1988) (internal citation omitted).
“Courts consider three factors when determining whether to grant a stay pending IPR: ‘(1) whether
discovery is complete and whether a trial date has been set; (2) whether a stay will simplify the
issues in question and trial of the case; and (3) whether a stay would unduly prejudice or present a
clear tactical disadvantage to the non-moving party.’” *Finjan, Inc. v. Symantec Corp.*, 139 F.
Supp. 3d 1032, 1035 (N.D. Cal. Oct. 9, 2015) (quoting *Evolutionary Intel., LLC v. Facebook, Inc.*,
No. 13-cv-04202-SI, 2014 WL 261837, at *1 (N.D. Cal. Jan. 23, 2014)). “The moving party bears
the burden of demonstrating that a stay is appropriate.” *Zomm, LLC v. Apple Inc.*, 391 F. Supp. 3d
946, 956 (N.D. Cal. June 17, 2019).

“While the case law states several general considerations that are helpful in determining
whether to order a stay, ultimately the Court must decide stay requests on a case-by-case basis.”
PersonalWeb Techs., LLC v. Apple Inc., 69 F. Supp. 3d 1022, 1025 (N.D. Cal. Sept. 24, 2014)
(quoting *TPK Touch Solutions, Inc. v. Wintek Electro-Optics Corp.*, No. 13-cv-02218-JST, 2013
WL 6021324, at *1 (N.D. Cal. Nov. 13, 2013)).

IV. DISCUSSION

A. Stage of the Proceedings

Under the first factor, the Court evaluates the stage of the case against key milestones such
as whether the parties have engaged in costly expert discovery and dispositive motion practice,
whether the court has issued a claim construction order, and whether the court has set a trial date.
PersonalWeb Techs., 69 F. Supp. 3d at 1025-26. Jenam argues – and Google does not dispute –
that discovery has not begun, a trial date has not been set, and no claim construction has occurred.
ECF No. 27 at 7. The first factor thus favors a stay.

B. Simplification of the Issues

The second factor asks the Court to determine whether a stay will simplify the issues in
question and trial of the case. *Finjan*, 139 F. Supp. 3d at 1035. Here, the parties both contend that
a stay will simplify the issues. ECF No. 27 at 7; ECF No. 29 at 3-4.

Although the Court agrees that there is significant potential for simplification,³ it is not yet clear to what degree a stay would actually simplify the issues. Because Jenam has moved to stay before the disclosure deadline of Patent Local Rule 3-1, it has not been required to disclose which claims it plans to assert in these four lawsuits. See Patent L.R. 3-1 (requiring disclosure of asserted claims no later than 14 days after the initial case management conference). Thus, the Court is unable to perform the analysis typical of other decisions addressing motions to stay. See, e.g., Order Granting Motion to Stay, 21-cv-07994-JST, ECF No. 137 at 1 (granting a stay where PTAB review encompassed all asserted claims on six patents); *Evolutionary Intel.*, 2014 WL 261837 at *2 (suggesting simplification is particularly likely where all asserted claims are challenged); *Symantec Corp. v. Zscaler, Inc.*, No. 17-cv-04426-JST, 2018 WL 3539267, at *6 (finding simplification where the “non-instituted claims overlap[ped] to a great degree with the instituted claims”); *Williamson v. Google Inc.*, No. 15-cv-00966-BLF, 2015 WL 10890658, at *6 (N.D. Cal. Oct. 8, 2015) (finding simplification favored a stay where the PTAB instituted review on 62 of 110 asserted claims). An understanding of the asserted claims will aid the Court in weighing simplification against the other stay factors because the four patents in these cases are not before the PTAB. Thus, simplification will depend on the degree of similarity between the claims before the PTAB and the claims asserted in these cases.

As the Court cannot assess whether a stay will simplify the issues in question and trial of these four cases, the Court finds the second factor is neutral.

C. Undue Prejudice or Clear Tactical Disadvantage to Non-Moving Party

The final factor is “whether a stay would unduly prejudice or present a clear tactical

³ The four asserted patents are related to six patents recently before the PTAB. On Sep. 16, 2022, the PTAB issued final written decisions on U.S. Patent Nos. 10,075,564, 10,075,565, and 10,375,215. Notice by Google LLC (Second Notice) of PTAB Rulings on Pending IPR Petitions, No. 21-cv-07994-JST, ECF No. 142. Review of U.S. Patent Nos. 10,306,026 and 10,069,945 is ongoing and there is a pending appeal on the PTAB’s decision regarding U.S. Patent No. 9,923,995. *Id.* The patents share substantially the same specification, claim priority to the same application, and have the same inventor. ECF No. 27 at 7; ECF No. 29 at 4. Some claims have overlapping language with identical or similar terms. ECF No. 27 at 7. Jenam correctly notes that, regardless of the outcome at the PTAB, the Court will receive the benefit of the PTAB’s expertise and guidance on the challenged claims. ECF No. 27 at 8.

disadvantage to the *non-moving party*.”⁴ *TPK Touch Solutions*, 2013 WL 6021324, at *4 (emphasis added). Google argues it would be unduly prejudiced because a stay would hinder its ability to file IPR petitions on the newly asserted patents. ECF No. 29 at 6. Google contends that its statutory deadline to file IPR petitions on the patents is May 2023. *Id.* A stay is unlikely to be lifted before that date, given that IPR and subsequent appeals may last up to three years. *Id.*; Order Granting Motion to Stay, 21-cv-07994-JST, ECF No. 137 at 7. Thus, a stay would force Google to file its IPR petitions without knowing which of the 433 possible claims are asserted against it in these four cases. ECF No. 29 at 6. In that scenario, Google argues that it would be left with two choices: (1) challenge all 433 claims or (2) challenge a “random” subset of claims. ECF No. 29 at 7. Jenam does not contest these numbers. It responds that a stay would not deprive Google of any right. ECF No. 27 at 10. Jenam argues that Google is still free to file IPR petitions or request reexamination of the asserted patents and that, regardless of PTAB involvement, Google will be free to defend itself by raising invalidity defenses before this Court. ECF No. 30 at 7. Finally, Jenam argues that Google can determine which claims to challenge via IPR based on its sophistication and familiarity with the patents. *Id.*

The Court agrees that a stay would not deprive Google of any right. The parties have not provided, nor is the Court aware of, any opinion holding that a patent defendant is entitled to know the asserted claims before filing an IPR petition.⁵ Nonetheless, the Court finds that a stay would

⁴ The parties dispute whether Jenam is prejudiced absent a stay. ECF No. 27 at 9; ECF No. 29 at 4; ECF No. 30 at 8. In fact, Jenam explicitly argues that it is more prejudiced by an adverse ruling than Google. ECF No. 30 at 8. But prejudice to Jenam is not relevant under the third factor. Instead, the Court discusses possible prejudice to Jenam as a case-specific consideration. *See infra* Section D.

⁵ Google cites *Bonutti Skeletal Innovations, LLC v. Zimmer Holdings, Inc.*, No. 12-cv-1107 (GMS), 2014 WL 1369721 (D. Del. Apr. 7, 2014) and *Semiconductor Energy Lab’y Co. v. Chimei Innolux Corp.*, No. SACV 12-21-JST (JPRx), 2012 WL 7170593 (C.D. Cal. Dec. 19, 2012) to argue it would be unduly prejudiced by a stay. ECF No. 29 at 7. But neither case stands for the proposition that a defendant has a right to know a plaintiff’s asserted claims before filing an IPR petition. The cases merely hold that it is *reasonable* for a defendant to wait to file IPR petitions until the asserted claims are known. *See Bonutti Skeletal*, 2014 WL 1369721, at *3 (“Under the circumstances, the Defendants’ use of the year-long period to attempt to determine exactly which claims [Plaintiff] would ultimately assert was reasonable”); *Semiconductor Energy Lab’y*, 2012 WL 7170593, at *3 (“[T]he Court cannot say [Defendant’s] delay in filing its IPR petitions until October and November—a mere three to four months from receiving the claim contentions and

put Google at a clear tactical disadvantage.

First, if Google were to challenge all 433 claims or a random subset of them – as it argues it would be forced to do – it would be placed at a clear tactical disadvantage. As Jenam concedes, it is not feasible to present 433 claims to a jury. ECF No. 30 at 8. It is similarly infeasible to challenge 433 claims at the PTAB. And challenging a random subset of claims is not likely to yield meaningful review of the key claims in these four cases.

Second, if Google were to simply defend itself before this Court – as Jenam proposes – it would be placed at a clear tactical disadvantage. Unlike a jury, the PTAB reviews patentability under a preponderance of the evidence standard. *In re Baxter Int’l, Inc.*, 678 F.3d 1357, 1364 (Fed. Cir. 2012) (comparing the clear and convincing evidence standard of the district court with the preponderance of the evidence standard of the PTAB). Google would be tactically disadvantaged by a higher burden of proof if it simply defends itself before this Court.

Finally, even if Google were successful in identifying a strategic subset of claims, based on its “sophistication and familiarity with the related patents,” as Jenam argues, ECF No. 30 at 7, it would still be tactically disadvantaged. Jenam suggests that it intends to replace cancelled claims from the ongoing IPR with live claims from the four newly asserted patents. ECF No. 27 at 9 (“The PTAB’s decisions and findings will factor heavily into Jenam’s selection of claims to assert across the related cases.... [I]f asserted claims are found unpatentable, Jenam may select more from the new cases.”). Thus, if Google successfully challenges a subset of claims from the newly asserted patents in an IPR, Jenam will not assert those cancelled claims when the stay is lifted. Instead, Jenam will be free to supplement any battle-hardened claims that survive IPR with claims Google did not challenge. This would leave Google to defend against the new claims without the option of IPR given the statutory deadline. *See* 35 U.S.C. § 315(b) (barring parties served with a complaint alleging infringement from filing IPR petitions after one year).

Therefore, a stay prior to disclosure of asserted claims would put Google at a clear tactical disadvantage. The third factor weighs against a stay at this time.

voluminous documents from Plaintiff—was unreasonable”).

D. Case-Specific Considerations

Courts ultimately decide whether to grant a stay on a case-by-case basis. The following additional considerations also counsel against granting a stay.

1. Prejudice to Jenam

Jenam claims it would be prejudiced if forced to disclose its asserted claims at this “premature” stage of the litigation. ECF No. 27 at 9; ECF No. 30 at 8. This argument is unpersuasive; Jenam is not prejudiced by having to proceed with the lawsuits it filed. Jenam is correct that it will not have the benefit of PTAB decisions on claim construction and patentability when selecting claims to assert, but litigants rarely do. Patent Local Rule 3-1 requires disclosure of asserted claims no later than 14 days after the initial case management conference. The challenges described by Jenam are thus common to all patent litigation in this district.

Nor is Jenam prejudiced by having to defend its patents in multiple jurisdictions.⁶ Jenam cannot file four new lawsuits in federal court, then credibly claim that it is prejudiced by concurrent litigation.

2. Gamesmanship

Jenam contends that it is not motivated by gamesmanship, ECF No. 30 at 6, but it is difficult not to see its position in that light. A party does not often come before the Court to vindicate its rights, claim imminent or actual injury, pray for relief, then seek to “pause” its own lawsuits. And granting a plaintiff’s motion to stay before disclosure of asserted claims risks

⁶ Jenam relies on *Nippon Shinyaku Co. v. Sarepta Therapeutics, Inc.*, 25 F.4th 998 (Fed. Cir. 2022) and *Dodocase VR, Inc. v. MerchSource, LLC*, 767 F. App’x 930 (Fed. Cir. 2019) (unpublished) to argue it is prejudiced. ECF No. 30 at 8. Both cases are distinguishable. As a threshold matter, both cases concern preliminary injunctions, not motions to stay. *Nippon Shinyaku*, 25 F.4th at 1003; *Dodocase VR*, 767 F. App’x at 935. And while patentees in both cases may have been irreparably harmed if forced to litigate in multiple forums, each had a contract-based right to litigate in a single forum due to a forum selection clause. *Nippon Shinyaku*, 25 F.4th at 1007 (“[A]bsent a preliminary injunction, [the patent owner] will be deprived of its bargained-for choice of forum and forced to litigate its patent rights in multiple jurisdictions.”); *Dodocase VR*, 767 F. App’x at 935 (finding no abuse of discretion where the trial court found irreparable harm because the patent owner “would be forced to litigate on multiple fronts...and would be deprived of its bargained-for forum”). Here, denying a stay would not deprive Jenam of the benefit of any bargain because Jenam is not entitled to litigate exclusively at the PTAB based on contract or any other right. Moreover, here it is Jenam – the party that initiated litigation in the allegedly impermissible forum – that claims to be harmed by the forum. *Cf. Nippon Shinyaku*, 25 F.4th at 1002; *Dodocase VR*, 767 F. App’x at 932.

incentivizing future gamesmanship. A party with a portfolio of related patents could circumvent the disclosure requirements of Patent Local Rule 3-1 by filing successive suits. For example, a patentee might assert a single patent, drawing an IPR and a stay. The patentee could then file suit with the remaining patents and immediately move to stay its own lawsuits. The defendant would then be left in the unenviable position of filing IPR petitions without knowing which claims are asserted against it. After the stay was lifted, the patentee would be free to choose which claims to assert based on the PTAB's decisions without having to show good cause to amend under Patent Local Rule 3-6.

Such gamesmanship would conflict with the spirit of the Patent Local Rules, which exist "to ensure early crystallization of the parties' theories, and specifically, to place the burden on the plaintiff to quickly decide on and disclose the contours of its case." *Trusted Knight Corp. v. Int'l Bus. Machines Corp. (IBM)*, No. 19-cv-01206-EMC, 2021 WL 5205522, at *2 (N.D. Cal. Nov. 9, 2021) (quoting *OpenTV, Inc. v. Apple Inc.*, No. 15-cv-02008-EJD-NC, 2016 WL 3196643, at *3 (N.D. Cal. June 9, 2016)). Granting a motion to stay before the disclosure deadline of Rule 3-1 would exempt a patentee from those responsibilities.

3. *Inter Partes* Review

Finally, staying a case before disclosure of asserted claims would undermine the purpose of the IPR process. Congress implemented IPR to create a "more efficient and streamlined patent system that will improve patent quality and limit unnecessary and counterproductive litigation costs." *In re Cuozzo Speed Techs., LLC*, 793 F.3d 1297, 1300 (Fed. Cir. 2015) (Prost, J., Newman, J., Moore, J., O'Malley, J., and Reyna, J., dissenting from denial of petition for rehearing en banc) (quoting H.R. Rep. No. 112-98, pt. 1, at 40 (2011)). These efficiency goals are best accomplished when the PTAB reviews claims that are actually at issue or else the estoppel provision has little benefit.⁷ See 35 U.S.C. § 315(e) (barring petitioners from relitigating a claim's validity in a civil action based on any ground that was raised or reasonably could have been raised

⁷ Jenam argues a stay would reduce efficiency because Jenam "likely would have good cause to amend its selection of asserted claims" after the PTAB decisions, resulting in additional motion practice. ECF No. 30 at 9. The Court takes no position on that issue now.

1 during IPR if the PTAB reached a final written decision).

2 To aid in these goals, Congress created a process that generally permits IPR petitioners to
3 know the patent claims at issue. Explaining the rationale for the one-year statutory filing deadline,
4 Senator Jon Kyl, a cosponsor of the Leahy-Smith America Invents Act, stated:

5 “High-technology companies . . . are often sued by [plaintiffs]
6 asserting multiple patents with large numbers of vague claims,
7 making it difficult to determine in the first few months of litigation
8 which claims will be relevant and how those claims are alleged to
9 read on the defendant’s products. . . . [I]t is important that the
10 section 315(b) deadline afford defendants a reasonable opportunity
11 to identify and understand the patent claims that are relevant to the
12 litigation.” 157 Cong. Rec. S5429 (statement of Sen. Jon Kyl).

13 Granting a patentee’s motion to stay before disclosure of asserted claims would subvert this
14 purpose and undermine efficiency.

15 CONCLUSION

16 For the foregoing reasons, Jenam’s motion to stay is denied without prejudice.

17 **IT IS SO ORDERED.**

18 Dated: September 26, 2022

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20 JON S. TIGAR
21 United States District Judge
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