

UNITED STATES DISTRICT COURT
WESTERN DISTRICT OF TEXAS
AUSTIN DIVISION

AVIEL D. RUBIN, an individual	§	No. 1:23-CV-31
person,	§	
	§	
Plaintiff,	§	
	§	
vs.	§	
	§	
KAHOOT! ASA and KAHOOT	§	
EDU, Inc.,	§	
	§	
Defendants.	§	

ORDER GRANTING DEFENDANTS’ MOTION TO STAY PENDING
INTER PARTES REVIEW

Before the Court is an Opposed Motion to Stay Pending *Inter Partes* Review (“IPR”) filed by Defendants Kahoot! ASA and Kahoot! Edu, Inc. (together, “Kahoot!” or “Defendants”) on March 17, 2023. (Dkt. # 36.) Kahoot! has since filed a notice to the Court requesting that the Motion be granted as unopposed pursuant to Local Court Rule CV-7(d)(2) because Plaintiff Aviel Rubin (“Rubin”) has failed to respond. (Dkt. # 41.)

The Court finds this matter suitable for disposition without a hearing. After careful consideration, the Court—for the reasons that follow—**GRANTS** Defendants’ Motion to Stay Pending *Inter Partes* Review. (Dkt. # 36.)

BACKGROUND

Rubin brought suit against Kahoot! on March 3, 2022, for infringing United States Patent No. 9,064,376 (the “’376 Patent”).¹ (Dkt. # 1 at 1.) Rubin owns the ’376 Patent and is named as the inventor. (Id. at 4–5.)

Kahoot! filed an IPR petition on March 10, 2023, seeking review of claims 1-5, 9, 10, 12-17, and 23-25 of the ’376 Patent. (Dkt. # 36 at 2.) One week later, Kahoot! filed a motion with this Court to stay the case pending resolution of Kahoot!’s IPR proceeding. (See id.) The estimated date for the Patent Trial and Appeal Board (“PTAB”) to issue its institution decision on Kahoot!’s petition is September 16, 2023. (Id. at 2.)

APPLICABLE LAW

Courts have the inherent power to manage their dockets, including the authority to order a stay. Ethicon, Inc. v. Quigg, 849 F.2d 1422, 1426–27 (Fed. Cir. 1988). The party seeking a stay bears the burden of showing that a stay is appropriate. MiMedx Grp., Inc. v. Tissue Transplant Tech. Ltd., No. SA-14-CV-719, 2015 WL 11573771, at *2 (W.D. Tex. Jan. 5, 2015). Courts generally consider three factors when determining whether to stay patent litigation in light of

¹ The case was originally filed in the Waco division, but an unopposed motion to transfer venue to the Austin division was granted on November 18, 2022. (Dkt. # 27.) Judge Yeakel transferred this case to the undersigned on March 30, 2023. (Dkt. # 42.)

IPR proceedings: (1) whether a stay would unduly prejudice or present a clear tactical disadvantage to the nonmoving party; (2) whether a stay will simplify the issues in question; and (3) the status of the litigation at the time a stay is requested.

Id. In determining whether to stay court proceedings pending resolution of IPR proceedings, courts usually evaluate the totality of the circumstances in the particular case before them. Landis v. North Am. Co., 299 U.S. 248, 254 (1936) (“The power to stay proceedings is incidental to the power inherent in every court to control the disposition of the causes on its docket with economy of time and effort for itself, for counsel, and for litigants.”).

I. Undue Prejudice or Tactical Disadvantage

As to the first factor—whether a stay would unduly prejudice or present a clear tactical disadvantage to the nonmoving party—Kahoot! notes that Rubin, a computer science professor, does not claim to market any products or services related to the ’376 Patent or license it to anyone who does. (Dkt. # 36 at 5.) Rubin thus does not compete with Kahoot! and is not at risk of losing market share or revenue. (Id. at 5.) Kahoot! further notes that Rubin exclusively seeks monetary damages. (Id. at 5–6.) Finally, Kahoot! contends that Rubin “has shown little interest in the speedy resolution of this action.” (Id. at 7.)

The Court agrees with Kahoot! that a stay in these circumstances is unlikely to unduly prejudice or disadvantage Rubin. See Software Rts. Archive,

LLC v. Facebook, Inc., No. C-12-3970 RMW, 2013 WL 5225522, at *6 (N.D. Cal. Sept. 17, 2013) (finding that a non-practicing plaintiff’s lack of competition with the defendants “strongly favors granting the stay”); Crossroads Sys., Inc. v. Dot Hill Sys. Corp., No. A-13-CA-1025-SS, 2015 WL 3773014, at *2 (W.D. Tex. June 16, 2015) (“The fact of the matter is [the plaintiff] seeks exclusively monetary damages, and mere delay in collecting those damages does not constitute undue prejudice.”) The Court concludes that the first factor weighs in favor of a stay.

II. Streamlining of Issues

For the second factor—whether a stay will simplify the issues in question—Kahoot! argues that because all of the patent claims at issue in this case are being challenged in the pending IPR petition, the IPR will significantly streamline the litigation or resolve it entirely. (Dkt. # 36 at 4.) Kahoot! also notes that any determinations made by the PTAB may be relied upon as intrinsic evidence by this Court. (Id.)

Of course, until the PTAB issues its institution decision, this Court “can only speculate about whether or not a stay would simplify the issues.” Audatex N. Am. Inc. v. Mitchell Int’l Inc., 46 F. Supp. 3d 1019, 1024 (S.D. Cal. 2014). But a brief stay to await the PTAB’s decision promotes judicial efficiency and would not unduly prejudice Rubin. See Delphix Corp. v. Actifio, Inc., No. 13-CV-04613-BLF, 2014 WL 6068407, at *2 (N.D. Cal. Nov. 13, 2014) (a five-month

stay to await the PTAB’s institution decision “conserve[s] judicial efficiency and avoid[s] inconsistent results”); Anza Tech., Inc. v. Avant Tech., Inc., No. A-17-CV-01193-LY, 2018 WL 11314191, at *2 (W.D. Tex. Nov. 15, 2018) (finding that a short stay of proceedings in advance of the PTAB’s institution decision would not cause undue prejudice). The Court thus concludes that the second factor tips in favor of a stay.

III. Progress of the Case

For the third factor—the status of the litigation at the time a stay is requested—Kahoot! notes that “the opening of fact discovery is at least six months away” and there is no trial date for this case. (Dkt. # 36 at 7.)

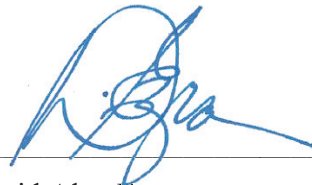
Although this case has been pending for over a year, it is still in the early stages of litigation. See VirtualAgility Inc. v. Salesforce.com, Inc., 759 F.3d 1307, 1317 (Fed. Cir. 2014) (noting that a case “was still at its infancy” when “discovery had not yet begun and no trial date had been set,” which favors granting a stay); Norman IP Holdings, LLC v. TP-Link Techs., Co., No. 6:13-CV-384-JDL, 2014 WL 5035718, at *3 (E.D. Tex. Oct. 8, 2014) (observing that courts more often grant stays when “there remains a significant amount of work ahead for the parties and the court”). The Court concludes that the third factor weighs in favor of a stay.

CONCLUSION

Having considered the totality of the circumstances, the Court concludes that a stay is appropriate in this case. Defendants' Motion to Stay Pending *Inter Partes* Review (Dkt. # 36) is **GRANTED**. This action is **STAYED** pending further order of the Court. Any outstanding deadlines and court settings in this case are **CANCELLED**. The parties are instructed to file a status report with the Court no later than **ten (10) days** after any significant action in IPR2023-00693.

IT IS SO ORDERED.

DATED: Austin, Texas, April 14, 2023.



David Alan Ezra
Senior United States District Judge