IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF TEXAS
MARSHALL DIVISION

ACTIVE WIRELESS TECHNOLOGIES LLC,	§	
	§	
Plaintiff,	§	
	§	
v.	§	
	§	
T-MOBILE USA, INC., and T-MOBILE US, INC.	§	CIVIL ACTION NO. 2:23-CV-00261-JRG
	§	
Defendants,	§	
	§	
NOKIA OF AMERICA CORPORATION and ERICSSON INC.	§	
	§	
Intervenors.	§	

ORDER

Before the Court is Defendants'/Intervenors' Opposed Motion to Stay Proceedings Pending *Inter Partes* Review (the "Motion") filed by Defendants T-Mobile USA, Inc. and T-Mobile US, Inc. (collectively, "Defendants"), and Intervenors Ericsson Inc. ("Ericsson") and Nokia of America Corporation ("Nokia" and with Ericsson, "Intervenors") (collectively, "Defendants/Intervenors"). (Dkt. No. 67.) In the Motion, Defendants/Intervenors request "an immediate stay until the Patent Trial and Appeal Board ('Board') concludes its *inter partes* review of U.S. Patent Nos. 10,531,443 ('the '443 Patent'), 10,785,764 ('the '764 Patent'), 11,019,557 ('the '557 Patent'), and 10,601,566 ('the '566 Patent')." (*Id*. at 1.)

Plaintiff Active Wireless Technologies LLC ("Plaintiff") has accused Defendants of infringing the '443, '764, '557, and '566 Patents (collectively, the "Asserted Patents"). (Dkt. No. 1 ¶¶ 19–68.) Intervenors recently filed petitions for *inter partes* review challenging claims from each of these patents. (Dkt. No. 67 at 3–4.) The Board has not instituted *inter partes* review

proceedings based on any of these petitions. (*Id*.) By Defendants'/Intervenors' own admission, the earliest institution decision is not due until October 1, 2024. (*Id*. at 4.)

The district court has the inherent power to control its own docket, including the power to stay proceedings. *Clinton v. Jones*, 520 U.S. 681, 706 (1997). How to best manage the court's docket "calls for the exercise of judgment, which must weigh competing interests and maintain an even balance." *Landis v. N. Am. Co.*, 299 U.S. 248, 254–55 (1936).

"District courts typically consider three factors when determining whether to grant a stay pending inter partes review of a patent in suit: (1) whether the stay will unduly prejudice the nonmoving party, (2) whether the proceedings before the court have reached an advanced stage, including whether discovery is complete and a trial date has been set, and (3) whether the stay will likely result in simplifying the case before the court." *NFC Tech. LLC v. HTC Am., Inc.*, No. 2:13-cv-1058-WCB, 2015 WL 1069111, at *2 (E.D. Tex. Mar. 11, 2015) (Bryson, J.). "Based on th[ese] factors, courts determine whether the benefits of a stay outweigh the inherent costs of postponing resolution of the litigation." *Id.*

Where a motion to stay is filed before the PTAB institutes a proceeding, courts often withhold a ruling pending action on the petition by the PTAB or deny the motion without prejudice to refiling in the event that the PTAB institutes a proceeding. *VirtualAgility Inc. v. Salesforce.com, Inc.*, 759 F.3d 1307, 1316 (Fed. Cir. 2014) (citing *Checkfree Corp. v. Metavante Corp.*, No. 12-cv-15, 2014 WL 466023, at *1 (M.D. Fla. Jan. 17, 2014)); *see also NFC Techs.*, 2015 WL 1069111, at *6. Indeed, this Court has a consistent practice of denying motions to stay when the PTAB has yet to institute post-grant proceedings. *Trover Group, Inc. v. Dedicated Micros USA*, No. 2:13-cv-1047-WCB, 2015 WL 1069179, at *6 (E.D. Tex. Mar. 11, 2015) (Bryson, J.) ("This

Court's survey of cases from the Eastern District of Texas shows that when the PTAB has not yet acted on a petition for *inter partes* review, the courts have uniformly denied motions for a stay.").

Considering these circumstances, the Court concludes that the Motion is premature, and a stay of these proceedings in advance of the Board's decision on whether or not to institute *inter partes* reviews of the Asserted Patents should be denied. Accordingly, the Motion is **DENIED WITHOUT PREJUDICE** to refiling of the same, which shall be permitted within fourteen (14) days following the Board's last institution decision.

So ORDERED and SIGNED this 24th day of July, 2024.

RODNEY GILSTRAP
UNITED STATES DISTRICT JUDGE