## Documents Search

141 Results

Types of Document: Motion to Stay Pending Inter Partes Review Judges: Rodney Gilstrap

| Type of Document | Result of ... | Case | Date | Appeal Status |
|---|---|---|---|---|
| Motion to Stay Pending Inter Partes Review | Denied | General Access Solutions, Ltd. v. Cellco Partnership d/b/a Verizon Wireless et al<br>2-22-cv-00394 (EDTX) | May. 22, 2024 | |

Stay of Proceedings
└ Factors Considered
└ **Prejudice From Stay/Tactical Advantage**
Stay of Proceedings
└ Factors Considered
└ **Stage of Litigation**

The court denied defendant's motion to stay pending *inter partes* review and found that the potential for undue prejudice and stage of the case disfavored a stay. "Granting a stay in this case could delay its resolution by more than two years, as the PTAB decision is not due until over six months after jury trial is set to begin. Such a delay would prejudice Plaintiff's ability to vindicate its patent rights. . . . At the time the Motion to Stay was filed, this case had been pending for over a year and three months and the Court had already conducted a Claim Construction hearing. Jury selection was a mere five months away. By the time the Motion was fully briefed, the parties had exchanged thousands of documents, taken numerous depositions, and served opening expert reports. As Plaintiff notes, the deadline for the PTAB's final written decision is six months after trial is set to begin in this case."

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| Motion to Stay Pending Inter Partes Review | Denied | Force MOS Technology Co., Ltd. v. ASUSTeK Computer, Inc.<br>2-22-cv-00460 (EDTX) | Apr. 11, 2024 | |

Stay of Proceedings
└ Factors Considered
└ **Prejudice From Stay/Tactical Advantage**
Stay of Proceedings
└ Factors Considered
└ **Simplification of Issues**
Stay of Proceedings
└ Factors Considered
└ **Stage of Litigation**

The court denied defendant's motion to stay pending institution of *inter partes* review and found that the potential for prejudice, stage of the case, and lack of simplification of the issues disfavored a stay. "'[T]he failure to seek an injunction does not amount to an admission by plaintiff that it will not be prejudiced by a stay.' . . . [T]he original complaint had been filed (1) over a year before Defendant filed the Motion and (2) nearly a year before Petitioner filed the IPR petitions. Critically, Defendant received Plaintiff's infringement contentions on May 16, 2023. Defendant thus had notice of Plaintiff's positions with respect to the scope of the claims for over five months before the IPR petitions were filed. . . . [W]hen a party files such a premature motion to stay, this Court will deny the motion without prejudice to refile the same following the PTAB's institution decision regarding the last of the patents-in-suit to be acted upon by the PTAB. However, here, the Court finds that the Motion should be denied *with* prejudice given that only two of the three Asserted Patents have been challenged at the PTAB."

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| Motion to Stay Pending Inter Partes Review | Denied without prejudice | Fendgo LLC v. Samsung Electronics Co., Ltd. et al<br>2-23-cv-00221 (EDTX) | Apr. 11, 2024 | |
| Motion to Stay Pending Inter Partes Review | Denied without prejudice | Advanced Coding Technologies LLC v. LG Electronics, Inc. et al<br>2-22-cv-00501 (EDTX) | Apr. 11, 2024 | |
| Motion to Stay Pending Inter Partes Review | Denied | Polaris PowerLED Technologies, LLC v. Samsung Electronics America, Inc. f/k/a Samsung Telecommunications America LLC et al<br>2-22-cv-00469 (EDTX) | Mar. 15, 2024 | |

Stay of Proceedings
└ Factors Considered
└ **Prejudice From Stay/Tactical Advantage**
Stay of Proceedings
└ Factors Considered
└ **Simplification of Issues**

The court denied defendant's motion to sever one count of plaintiff's patent infringement suit and stay it pending *inter partes* review and found that the lack of simplification of the issues and the potential for undue prejudice disfavored a stay. "Given that the PTAB has indicated a likelihood of success only for asserted claims 1, 2, and 7—not asserted claims 3 and 5—and especially in light of the PTAB's skepticism regarding Ground 4, it seems possible, and in fact likely, that claim 5 (if not other asserted claims) will survive the IPR proceedings. . . . Doing as [Defendant] requests would ensure that if any claims survived the IPR proceeding . . . the Court and the parties would have to undertake duplicative actions, including redundant damages and technical discovery on overlapping accused products, two separate claim construction hearings, two pre-trial conferences, and two trials. Such a multiplication of this proceeding would unnecessarily drive up the costs and efforts required to adjudicate [Plaintiff's] patent rights, resulting in undue prejudice to [Plaintiff]."

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| Motion to Stay Pending Inter Partes Review | Denied | Netlist, Inc. v. Micron Technology Texas, LLC et al<br>2-22-cv-00294 (EDTX) | Mar. 12, 2024 | |

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| Motion to Stay Pending Inter Partes Review | Denied | Netlist, Inc. v. Samsung Electronics Co., Ltd. et al<br>2-22-cv-00293 (EDTX) | Mar. 11, 2024 | |

Stay of Proceedings
└ Factors Considered
└ **Prejudice From Stay/Tactical Advantage**

Stay of Proceedings
└ Factors Considered
└ **Stage of Litigation**

The court denied defendant's renewed motion to stay pending *inter partes* review and found that the lack of undue prejudice and stage of the case disfavored a stay. "A delay in the proceedings would be prejudicial to [Plaintiff] as a competitor to [Defendant], and any stay could be further extended if either party appeals the PTAB's findings to the Federal Circuit. Further, the Court is convinced that timely resolution of [Plaintiff's] patent claims are warranted given that the next generation DIMMs will soon make the allegedly infringing accused DIMMs obsolete. The fact that [Plaintiff] is seeking solely monetary damages does not mean that [Plaintiff] cannot be prejudiced by a significant delay of an imminent trial date. . . . The parties have engaged in substantial discovery, claim construction, and have served expert reports. Further, the trial is only a few months away."

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| Motion to Stay Pending Inter Partes Review | Denied as moot | NorthStar Systems LLC v. Volkswagen AG<br>2-22-cv-00486 (EDTX) | Mar. 08, 2024 | |
| Motion to Stay Pending Inter Partes Review | Granted | Resonant Systems, Inc. v. Samsung Electronics Co., Ltd. et al<br>2-22-cv-00423 (EDTX) | Mar. 08, 2024 | |

Stay of Proceedings
└ Factors Considered
└ **Simplification of Issues**

The court granted defendants' motion to stay pending *inter partes* review and found that the potential simplification of the issues favored a stay. "If the PTAB were to find some or all of the claims under review to be valid, Defendants would be estopped from asserting invalidity defenses on any grounds they raised or reasonably could have raised during inter partes review. Further, the cancellation of some or all of the claims could result in simplification of issues in this case. This Court declines [Plaintiff's] invitation to hold that the PTAB must expressly comment that the grounds for institution are particularly 'strong' as to every claim to find that there is a likelihood of issue simplification. . . . To adopt this posture would essentially allow the PTAB to decide the stay issue by making or withholding early evaluating comments."

Stay of Proceedings
└ Factors Considered
└ **Stage of Litigation**

The court granted defendants' motion to stay pending *inter partes* review and found that the stage of the case favored a stay. "[T]his case has not yet had a Markman hearing. At the time of the filing of the present Motion, the parties had only conducted 8 two depositions. [Defendant] alleges (and [Plaintiff] does not dispute) that the parties still have the bulk of depositions ahead of them, including depositions in Korea. . . . While [Defendant] could have acted sooner in initially filing its petitions for *inter partes* review, it filed its Motion to Stay with reasonable dispatch and at an early stage of the case[.]"

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| Motion to Stay Pending Inter Partes Review | Granted | NorthStar Systems LLC v. Volkswagen AG<br>2-22-cv-00486 (EDTX) | Mar. 08, 2024 | |
| Motion to Stay Pending Inter Partes Review | Granted | Netlist, Inc. v. Micron Technology, Inc. et al<br>2-22-cv-00203 (EDTX) | Feb. 10, 2024 | |

Stay of Proceedings
└ Factors Considered
└ **Reduction of Litigation Burden**

Stay of Proceedings
└ Factors Considered
└ **Simplification of Issues**

District Court Procedural Issues
└ Motion Practice in General
└ **Reconsideration**

The court *sua sponte* reconsidered an earlier order declining to stay the case pending *inter partes* review and instead instituted a stay. "This case began with six asserted patents.1 All of these patents have been instituted for review by the Patent Trial and Appeal Board (PTAB). Four of these six patents have been invalidated by the PTAB. These decisions are being appealed. The remaining two patents . . . have been instituted for review by the PTAB but no decision has been issued to date. However, it is expected that the decisions from the PTAB will issue by or before [two months from now]. To put this particular case to trial before a jury in this Court before the PTAB issues its decision on the two remaining patents risks an inefficient consumption of limited judicial resources that makes imposing a targeted stay, until that ruling is received, advisable."

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| Motion to Stay Pending Inter Partes Review | Granted | Netlist, Inc. v. Micron Technology, Inc. et al<br>2-22-cv-00203 (EDTX) | Feb. 10, 2024 | |
| Motion to Stay Pending Inter Partes Review | Denied | Netlist, Inc. v. Micron Technology, Inc. et al<br>2-22-cv-00203 (EDTX) | Jan. 31, 2024 | |
| Motion to Stay Pending Inter Partes Review | Objection overruled / report adopted | Netlist, Inc. v. Micron Technology, Inc. et al<br>2-22-cv-00203 (EDTX) | Jan. 31, 2024 | |

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| Motion to Stay Pending Inter Partes Review | Denied without prejudice | Netlist, Inc. v. Samsung Electronics Co., Ltd. et al<br>2-22-cv-00293 (EDTX) | Oct. 17, 2023 | |

District Court Procedural Issues
└ **Stay of Proceedings**

The court denied without prejudice as premature defendant's motion to stay pending *inter partes* review. "Considering these circumstances, the Court concludes that [Defendant's] Motion is premature in that only three out of the four Asserted Patents has had a decision instituting IPRs. A stay of these proceedings in advance of the PTAB's decision on whether or not to institute *inter partes* review as to all 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 PTAB's institution decision regarding the last of the patents-in-suit to be acted upon by the PTAB."

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| Motion to Stay Pending Inter Partes Review | Denied without prejudice | Liberty Access Technologies Licensing LLC v. Marriott International, Inc.<br>2-22-cv-00318 (EDTX) | Aug. 24, 2023 | |
| Motion to Stay Pending Inter Partes Review | Denied without prejudice | Polaris PowerLED Technologies, LLC v. Samsung Electronics America, Inc. f/k/a Samsung Telecommunications America LLC et al<br>2-22-cv-00469 (EDTX) | Aug. 18, 2023 | |
| Motion to Stay Pending Inter Partes Review | Denied without prejudice | Liberty Access Technologies Licensing LLC v. ASSA ABLOY AB et al<br>2-22-cv-00507 (EDTX) | Aug. 11, 2023 | |
| Motion to Stay Pending Inter Partes Review | Denied without prejudice | Resonant Systems, Inc. v. Samsung Electronics Co., Ltd. et al<br>2-22-cv-00423 (EDTX) | Aug. 09, 2023 | |
| Motion to Stay Pending Inter Partes Review | Denied | MyPort, Inc. v. Samsung Electronics Co., Ltd. et al<br>2-22-cv-00114 (EDTX) | Jun. 13, 2023 | |

Stay of Proceedings
└ Factors Considered
└ **Prejudice From Stay/Tactical Advantage**

Stay of Proceedings
└ Factors Considered
└ **Stage of Litigation**

The court denied defendants' motion to stay pending *inter partes* review and found that the potential for undue prejudice, stage of the case, and lack of simplification of the issues disfavored a stay. "[Plaintiff] has an interest in the timely enforcement of its patent rights. Granting a stay in this case could delay the case by nearly two years . . . . There was no unreasonable delay in filing suit on part of [Plaintiff]. . . . [T]he Court is persuaded by [Plaintiff's] argument that because [Defendant] is receiving the benefit of post-motion facts—the PTAB decision instituting IPR—[Plaintiff] should receive the same regarding the stage of litigation. . . . [T]he deadline for the PTAB's final written decision is . . . over two and a half months after trial is set to begin in this case. Given the substantial amount of work and financial resources already poured into this case, this factor does not favor a stay. . . . The Court is reluctant to grant a stay, thereby delaying timely enforcement of [Plaintiff's] patent rights for months (and possibly years), where the PTAB has not found that [Defendant] is likely to succeed on most, if not all, of the asserted claims."

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| Motion to Stay Pending Inter Partes Review | Denied | Scorpcast, LLC d/b/a HaulStars v. Webtwo BV<br>2-20-cv-00209 (EDTX) | Apr. 28, 2023 | |
| Motion to Stay Pending Inter Partes Review | Denied | Scorpcast, LLC d/b/a HaulStars v. Miriskana Limited<br>2-20-cv-00202 (EDTX) | Apr. 28, 2023 | |
| Motion to Stay Pending Inter Partes Review | Denied | Scorpcast, LLC d/b/a HaulStars v. Hot G Vibe<br>2-20-cv-00197 (EDTX) | Apr. 28, 2023 | |
| Motion to Stay Pending Inter Partes Review | Denied | Scorpcast, LLC d/b/a HaulStars v. Logical Int. BV<br>2-20-cv-00199 (EDTX) | Apr. 28, 2023 | |
| Motion to Stay Pending Inter Partes Review | Denied | Scorpcast, LLC d/b/a HaulStars v. Pioneer Stream Technologies Ltd.<br>2-20-cv-00205 (EDTX) | Apr. 28, 2023 | |
| Motion to Stay Pending Inter Partes Review | Denied | Scorpcast, LLC d/b/a HaulStars v. Quicksol GmbH<br>2-20-cv-00207 (EDTX) | Apr. 28, 2023 | |
| Motion to Stay Pending Inter Partes Review | Granted | BoxCast Inc. v. Resi Media LLC<br>2-21-cv-00217 (EDTX) | Apr. 28, 2023 | |
| Motion to Stay Pending Inter Partes Review | Denied | Scorpcast, LLC d/b/a HaulStars v. HMZ Investments Ltd.<br>2-20-cv-00196 (EDTX) | Apr. 27, 2023 | |

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| Motion to Stay Pending Inter Partes Review | Denied | Scorpcast, LLC d/b/a HaulStars v. Straplezz Inc.<br>2-20-cv-00208 (EDTX) | Apr. 27, 2023 | |
| Motion to Stay Pending Inter Partes Review | Denied | Scorpcast, LLC d/b/a HaulStars v. Panda Hosting Limited<br>2-20-cv-00204 (EDTX) | Apr. 27, 2023 | |
| Motion to Stay Pending Inter Partes Review | Denied | Scorpcast, LLC dba HaulStars v. Media Solutions Canarias<br>2-20-cv-00201 (EDTX) | Apr. 27, 2023 | |
| Motion to Stay Pending Inter Partes Review | Denied | Scorpcast, LLC d/b/a HaulStars v. FUSEE BVBA<br>2-20-cv-00195 (EDTX) | Apr. 27, 2023 | |
| Motion to Stay Pending Inter Partes Review | Granted | Arigna Technology Limited v. Porsche AG et al<br>2-21-cv-00173 (EDTX) | Feb. 28, 2023 | |
| Motion to Stay Pending Inter Partes Review | Granted | Luminati Networks Ltd. v. Teso LT, UAB a/k/a UAB Teso LT et al<br>2-19-cv-00395 (EDTX) | Feb. 28, 2023 | |
| Motion to Stay Pending Inter Partes Review | Denied | Netlist, Inc. v. Samsung Electronics Co., Ltd. et al<br>2-21-cv-00463 (EDTX) | Feb. 03, 2023 | |
| Motion to Stay Pending Inter Partes Review | Granted | Communication Technologies, Inc. v. Samsung Electronics America, Inc. et al<br>2-21-cv-00444 (EDTX) | Feb. 02, 2023 | |

Stay of Proceedings
└ Factors Considered
└ **Prejudice From Stay/Tactical Advantage**

Stay of Proceedings
└ Factors Considered
└ **Simplification of Issues**

Stay of Proceedings
└ Factors Considered
└ **Stage of Litigation**

The court granted defendants' motion to stay pending *inter partes* review and determined that the lack of undue prejudice, the stage of the proceedings, and the potential simplification of the issues favored a stay. "Plaintiff fails to establish that monetary damages are inadequate to remedy any harm caused by Defendants. Indeed, Plaintiff's concerns of delay are undermined by the fact that a final written decision on the patentability of the claims must be issued within one year of institution. . . . Defendants could have acted sooner in filing their petitions for *inter partes* review. However, with the close of discovery, the claim construction hearing, and the trial setting all in the future, the Court concludes that this factor weighs in favor of a stay, but only slightly. . . . [G]iven that *inter partes* review has been instituted on all claims of the '444 Patent and on multiple grounds, the likelihood of simplification of issues is material."

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| Motion to Stay Pending Inter Partes Review | Granted | Village Green Technologies, LLC v. Samsung Electronics Co LTD et al<br>2-22-cv-00099 (EDTX) | Jan. 25, 2023 | |

Stay of Proceedings
└ Factors Considered
└ **Simplification of Issues**

Stay of Proceedings
└ Factors Considered
└ **Stage of Litigation**

The court granted defendants' motion to stay pending *inter partes* review and determined that the stage of the case and potential simplification of the issues favored a stay. "Significantly, even though the IPR petitions were filed two months after this lawsuit was initiated, Plaintiff had yet to serve Defendants by the time the IPR petitions were filed . . . . The Court finds that Defendants acted with reasonable dispatch in filing their petitions for *inter partes* review and their Motion. . . . The PTAB found that Defendants established a reasonable likelihood that they would prevail as to least one of their challenged claims and instituted *inter partes* review as to all of the challenged claims on all of the grounds of unpatentability asserted in the petitions. . . . [T]he Court finds that the likelihood of simplification of issues is high."

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| Motion to Stay Pending Inter Partes Review | Denied | California Institute of Technology v. Samsung Electronics Co., Ltd. et al<br>2-21-cv-00446 (EDTX) | Jan. 20, 2023 | |

Stay of Proceedings
└ Factors Considered
└ **Prejudice From Stay/Tactical Advantage**

Stay of Proceedings
└ Factors Considered
└ **Simplification of Issues**

Stay of Proceedings
└ Factors Considered
└ **Stage of Litigation**

The court denied defendants' motion to stay pending institution of *inter partes* review and determined that the potential for prejudice, stage of the case, and lack of simplification of the issues disfavored a stay. "The IPR proceedings at the PTAB are currently in their infancy (having been requested almost a year after the filing of the present action), and therefore granting a stay would require both [parties] to conduct the entire *inter partes* review proceeding from its initial stages. By contrast, the present case is approximately eight months from jury selection, and the parties have behind them a large portion of the expense related to discovery and claim construction. . . . [Defendant] waited ten months after this case was initiated to file its IPRs and to seek a stay from the Court. . . . [Defendant] cites to generic statistics that 'the PTAB instituted 66% of trial petitions' in 2022 to conclude that it is likely that the PTAB will likewise institute [Defendant's] IPRs. The Court is not persuaded by such speculation."

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| Motion to Stay Pending Inter Partes Review | Denied | Viavi Solutions Inc. v. Zhejiang Crystal-Optech Co Ltd.<br>2-21-cv-00378 (EDTX) | Nov. 10, 2022 | |

Stay of Proceedings
└ Factors Considered
└ **Simplification of Issues**

The court denied defendant's motion to stay pending institution of *inter partes* review based on the lack of simplification of the issues. "[T]he petitions discussed in the IPR Motion have not been instituted upon by the PTAB. It is the Court's established practice to consider that motions to stay pending IPR proceedings which have not been instituted are inherently premature and should be denied as such. At this nascent stage of the PTAB proceedings, it is impossible for the Court to determine 'whether the stay will likely result in simplifying the case before the court.' Indeed, if the PTAB denies institution of the IPRs, there will be no simplification of the case before the Court at all."

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| Motion to Stay Pending Inter Partes Review | Denied | TQ Delta, LLC v. CommScope Holding Company, Inc. et al<br>2-21-cv-00310 (EDTX) | Nov. 04, 2022 | |

Stay of Proceedings
└ Factors Considered
└ **Prejudice From Stay/Tactical Advantage**

Stay of Proceedings
└ Factors Considered
└ **Simplification of Issues**

Stay of Proceedings
└ Factors Considered
└ **Stage of Litigation**

The court denied defendants' motion to stay pending *inter partes* review and concluded that the potential for undue prejudice, stage of the case, and lack of potential simplification of the issues disfavored a stay. "[A]lthough the PTAB found a 'reasonable likelihood' that claim 10 of the [patent-at-issue] will be determined unpatentable under all asserted grounds of unpatentability, there remains a relative possibility that the PTAB concludes otherwise. In such a scenario, Claim 10 . . . would remain and result in a second trial. . . . Significant deadlines, such as claim construction and fact discovery, have already passed. Other important dates, such as the pretrial conference and trial, have been extended by up to three months but are quickly approaching. . . . A partial stay could divide this case into two cases and require two trials, significantly complicating matters."

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| Motion to Stay Pending Inter Partes Review | Denied | Koninklijke KPN NV v. Telefonaktiebolaget LM Ericsson et al<br>2-21-cv-00113 (EDTX) | Jul. 07, 2022 | |

Stay of Proceedings
└ Factors Considered
└ **Prejudice From Stay/Tactical Advantage**

Stay of Proceedings
└ Factors Considered
└ **Stage of Litigation**

The court denied defendant's motion to stay pending *inter partes* review of two of three patents-in-suit because the undue prejudice to plaintiff and advanced stage of the case weighed against a stay. "Here, where fact discovery, expert discovery, and pre-trial motion practice are complete and [plaintiff] has already incurred the majority of its expenses associated with this litigation, a delay of the imminent trial date and the assertion of its patent rights unduly prejudices [plaintiff]. . . . This case is in a particularly advanced stage, and a jury trial on the current schedule will have long concluded before the PTAB is likely to issue final written decisions."

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| Motion to Stay Pending Inter Partes Review | Granted | BoxCast Inc. v. Resi Media LLC<br>2-21-cv-00217 (EDTX) | May. 25, 2022 | |
| Motion to Stay Pending Inter Partes Review | Granted | K.Mizra LLC v. AT&T Corp. et al<br>2-21-cv-00241 (EDTX) | May. 12, 2022 | |
| Motion to Stay Pending Inter Partes Review | Denied | Packet Intelligence LLC v. NetScout Systems, Inc. et al<br>2-16-cv-00230 (EDTX) | May. 04, 2022 | |

Stay of Proceedings
└ Factors Considered
└ **Prejudice From Stay/Tactical Advantage**

Stay of Proceedings
└ Factors Considered
└ **Simplification of Issues**

Stay of Proceedings
└ Factors Considered
└ **Stage of Litigation**

Following a jury trial and a judgment that was affirmed in part on appeal, the court denied defendant's motion to stay pending *inter partes* review plaintiff's appeal of final written decisions finding the patents-in-suit to be unpatentable. "[Plaintiff] tried this case [5 years ago] and has yet to recover monetary relief despite successfully defending its finding of infringement and pre-suit damages on appeal -- delaying this case further in the face of its advanced stage only increases the prejudice on PI and places it at a tactical disadvantage. . . . These proceedings are at an unquestionably advanced stage -- the Court and the parties have expended substantial resources in adjudicating the parties' issues. . . . Given that the only issues remaining are discrete damages-related issues that do not overlap with the previously-affirmed issues of validity, [defendant's] arguments related to estoppel are misplaced and this factor strongly weighs against granting a stay."

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| Motion to Stay Pending Inter Partes Review | Granted | VARTA Microbattery GmbH v. Guangdong Mic-Power New Energy Co., Ltd.<br>2-21-cv-00036 (EDTX) | Jan. 26, 2022 | |

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| Motion to Stay Pending Inter Partes Review | Denied | Gesture Technology Partners, LLC v. Huawei Device Co., Ltd. et al<br>2-21-cv-00040 (EDTX) | Jan. 19, 2022 | |

Stay of Proceedings
└ Factors Considered
└ **Simplification of Issues**

The court denied defendant's motion to stay pending *inter partes* review and *ex parte* reexamination because the lack of potential simplification of issues weighed against a stay. "With regard to the IPR proceedings, [plaintiff] is correct that the absence of any estoppel binding on [defendant] as a result of those proceedings renders the issue simplification factor either neutral or slightly against a stay. Likewise, for the EPR proceedings, [defendant's] motion is at best premature. While [defendant] has informed the Court that EPR requests were granted as to all four Asserted Patents, it does not report that any Office Actions have issued rejecting any of the asserted claims. . . . It is the movant's burden to demonstrate that a stay is warranted, and the Court concludes that [defendant's] Motion fails to meet that burden in this case."

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| Motion to Stay Pending Inter Partes Review | Denied | VARTA Microbattery GmbH v. Guangdong Mic-Power New Energy Co., Ltd.<br>2-21-cv-00036 (EDTX) | Jan. 07, 2022 | |

Stay of Proceedings
└ Factors Considered
└ **Simplification of Issues**

The court denied defendant's motion to stay pending *inter partes* review because a lack of potential simplification of issues weighed against a stay. " [T]he PTAB has declined to institute review regarding two of the six Asserted Patents. . . . [A] stay will not simplify any issues with respect to the instituted [four] Patents because the PTAB granted [plaintiff's] motions to amend, allowing substitute claims to issue rather than cancelling the claims altogether. The PTAB's decisions thus did not narrow the remaining validity issues -- and in fact made them more complex -- as the amended claims may require [defendant] to assert additional prior art references and combinations. . . . Regardless of how the case ultimately proceeds, there has been no simplification -- nor is such reasonably foreseeable -- as a result of the IPRs that have been filed."

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| Motion to Stay Pending Inter Partes Review | Denied | RFCyber Corp. v. Google LLC f/k/a Google Inc. et al<br>2-20-cv-00274 (EDTX) | Jan. 04, 2022 | |

Stay of Proceedings
└ Factors Considered
└ **Prejudice From Stay/Tactical Advantage**
Stay of Proceedings
└ Factors Considered
└ **Simplification of Issues**
Stay of Proceedings
└ Factors Considered
└ **Stage of Litigation**

The court denied defendants' motion to stay pending *inter partes* and post-grant review proceedings because the lack of potential simplification of issues, stage of the case, and undue prejudice to plaintiff weighed against a stay. "[T]he PTAB has declined to institute regarding two of the four remaining Asserted Patents. Thus, a stay will not simplify the case with respect to the non-instituted [two patents]. Although a stay could in theory simplify the remaining validity issues with respect to the instituted [two patents], the PTAB would not render its final written decision until approximately. . . 9 months after this Court's . . . trial date. [Defendant's] offer to withdraw its Motion to Stay with respect to the non-instituted [patents] would in effect require the Court to hold two entirely separate trials -- potentially more than a year apart. . . . Such an approach would create significant inefficiencies that would more than offset any simplification gained through the IPR process."

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| Motion to Stay Pending Inter Partes Review | Granted | K.Mizra LLC v. Broadcom Incorporated<br>2-21-cv-00247 (EDTX) | Dec. 02, 2021 | |
| Motion to Stay Pending Inter Partes Review | Denied without prejudice | BoxCast Inc. v. Resi Media LLC<br>2-21-cv-00217 (EDTX) | Dec. 01, 2021 | |

Stay of Proceedings
└ Factors Considered
└ **Simplification of Issues**

The court denied without prejudice defendant's motion to stay pending its petitions for *inter partes* review. "Where a motion to stay is filed before the PTAB institutes any 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. Indeed, this Court has a consistent practice of denying motions to stay when the PTAB has yet to institute post-grant proceedings."

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| Motion to Stay Pending Inter Partes Review | Granted | K.Mizra LLC v. Broadcom Incorporated<br>2-21-cv-00247 (EDTX) | Nov. 22, 2021 | |
| Motion to Stay Pending Inter Partes Review | Granted | K.Mizra LLC v. Hewlett Packard Enterprise Co. et al<br>2-21-cv-00305 (EDTX) | Nov. 17, 2021 | |
| Motion to Stay Pending Inter Partes Review | Denied | ACQIS LLC v. Samsung Electronics Co., Ltd. et al<br>2-20-cv-00295 (EDTX) | Oct. 12, 2021 | |

Stay of Proceedings
└ Factors Considered
└ **Simplification of Issues**

The court denied defendant's motion to stay pending *inter partes* review after the PTAB denied all ten of its petitions for review. "After [defendant] filed the Motion to Stay, the PTAB denied all ten petitions for IPR regarding the Asserted Patents. . . . Here, the PTAB has declined to institute an IPR trial regarding any of the asserted claims. Accordingly, a stay will not simplify the case."

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| Motion to Stay Pending Inter Partes Review | Granted | Nanoco Technologies, Ltd. v. Samsung Electronics Co., Ltd. et al<br>2-20-cv-00038 (EDTX) | Jul. 01, 2021 | |

Stay of Proceedings
└ Factors Considered
└ **Simplification of Issues**

Stay of Proceedings
└ Factors Considered
└ **Stage of Litigation**

The court granted the parties' joint motion to stay pending *inter partes* review. "The Court, having considered the relevant factors, is hesitant to stay this case. Discovery is complete. . . . A firm trial date is set. Although a stay could simplify issues for trial in the abstract and on paper, it does so at the expense of delaying the speedy and efficient adjudication of the other issues in controversy. [Defendant] filed its IPR petitions roughly nine months after [plaintiff] filed its complaint. Given the fairly predictable timelines in this Court and the statutory timelines at the PTAB, [defendant] could have anticipated that institution decisions would occur in the shadow of pre-trial briefing, with the potential date for final written decisions from the PTAB far exceeding the scheduled trial date in this Court. . . . In fact, it is increasingly common for the PTAB to decline to institute *inter partes* review in view of parallel district court proceedings if the district court will reach trial on the merits more efficiently and expeditiously. . . . But for the parties' agreement on the Motion, the Court would likely have denied this Motion."

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| Motion to Stay Pending Inter Partes Review | Denied | Acorn Semi, LLC v. Samsung Electronics Co., Ltd. et al<br>2-19-cv-00347 (EDTX) | Mar. 22, 2021 | |

Stay of Proceedings
└ Factors Considered
└ **Simplification of Issues**

Stay of Proceedings
└ Factors Considered
└ **Stage of Litigation**

The court denied defendant's renewed motion to stay pending *inter partes* review because the stage of the case and lack of simplification of issues favored a stay. "This case is in a particularly advanced stage, and a jury trial on the current schedule will have long concluded before the PTAB is likely to issue final written decisions. . . . Given the complexity of the legal issues before the PTAB (including a prior art challenge pendent on application of 35 U.S.C. § 112), the possibility of further delays due to appeal is almost certain. . . . [I]ssue simplification . . . also weighs against granting a stay, given [the parties'] respective narrowing of their asserted claims and defenses. The Court and the PTAB are presented with separate issues, and there is no reason those issues cannot be adjudicated in parallel."

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| Motion to Stay Pending Inter Partes Review | Denied without prejudice | Garrity Power Services LLC v. Samsung Electronics Co., Ltd. et al<br>2-20-cv-00269 (EDTX) | Feb. 17, 2021 | |

Stay of Proceedings
└ Factors Considered
└ **Simplification of Issues**

The court denied without prejudice defendant's motion to stay pending its petition for *inter partes* review. "[T]his Court has a consistent practice of denying motions to stay when the PTAB has yet to institute post-grant proceedings. . . . [T]he Court concludes that [defendants'] motion is premature, and a stay of these proceedings in advance of the PTAB's decision on whether or not to institute *inter partes* review of the Asserted Patent should be denied."

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| Motion to Stay Pending Inter Partes Review | Objection overruled / report adopted | Arbor Global Strategies LLC v. Samsung Electronics Co., Ltd. et al<br>2-19-cv-00333 (EDTX) | Feb. 09, 2021 | |
| Motion to Stay Pending Inter Partes Review | Granted | VARTA Microbattery GmbH v. Costco Wholesale Corporation<br>2-20-cv-00051 (EDTX) | Jan. 12, 2021 | |
| Motion to Stay Pending Inter Partes Review | Denied without prejudice | Nanoco Technologies, Ltd. v. Samsung Electronics Co., Ltd. et al<br>2-20-cv-00038 (EDTX) | Jan. 08, 2021 | |

Stay of Proceedings
└ Factors Considered
└ **Simplification of Issues**

The court denied without prejudice defendants' motion to stay pending their petitions for *inter partes* review. "[T]his Court has a consistent practice of denying motions to stay when the PTAB has yet to institute post-grant proceedings. . . . [T]he Court concludes that [defendants'] motion is premature, and a stay of these proceedings in advance of the PTAB's decision on whether or not to institute inter partes review of any of the Asserted Patents should be denied."

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| Motion to Stay Pending Inter Partes Review | Denied without prejudice | Clear Imaging Research, LLC v. Samsung Electronics Co., Ltd. et al<br>2-19-cv-00326 (EDTX) | Dec. 21, 2020 | |

Stay of Proceedings
└ Factors Considered
└ **Prejudice From Stay/Tactical Advantage**

Stay of Proceedings
└ Factors Considered
└ **Simplification of Issues**

Stay of Proceedings
└ Factors Considered
└ **Stage of Litigation**

The court denied without prejudice defendants' motion to stay pending their petitions for *inter partes* review because the undue prejudice to plaintiff, late stage of the case, and lack of potential simplification of issues weighed against a stay. "[B]oth parties have already expended significant time and resources into discovery, claim construction, and motion practice over the nearly fifteen months this case has been pending. Any further delay would require the parties to sink additional resources into the case, all the while postponing [plaintiff's] vindication of its patent rights. . . . [Defendant] waited ten months after this case was initiated to file its IPRs and to seek a stay from the Court. . . . [A]t this stage, a stay would do nothing more than draw out the time to trial. . . . [I]t is the Court's established policy that motions to stay pending IPR proceedings that have not been instituted are inherently premature."

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| Motion to Stay Pending Inter Partes Review | Denied without prejudice | Intertrust Technologies Corporation v. Cinemark Holdings, Inc. 2-19-cv-00266 (EDTX) | Dec. 04, 2020 | |

Stay of Proceedings
└ Factors Considered
└ **Simplification of Issues**

The court denied without prejudice defendants' motion to stay pending a third-party's petitions for *inter partes* review. "Between [3-5 months ago], a [third-party] filed seven IPR petitions with the [PTO], challenging the patentability of all asserted claims of all seven patents-in-suit in the above-captioned cases. In all seven of the IPR petitions relevant to this case, [the petitioner] listed the Defendants' as real parties in interest. . . . Defendants' motion is premature, and a stay of these proceedings in advance of the PTAB's decision on whether or not to grant the petition for *inter partes* review as to most or all of the patents-in-suit should be denied."

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| Motion to Stay Pending Inter Partes Review | Denied without prejudice | Huawei Technologies Co. Ltd. v. Verizon Communications, Inc. et al 2-20-cv-00030 (EDTX) | Nov. 10, 2020 | |

Stay of Proceedings
└ Factors Considered
└ **Simplification of Issues**

The court denied without prejudice defendants' motion to stay pending their petitions for *inter partes* review. "[Defendants'] petitions cover every asserted claim of the IPR Patents and five of the seven patents asserted by [plaintiff]. . . . [T]his Court has a consistent practice of denying motions to stay when the PTAB has yet to institute post-grant proceedings. . . . Defendants' motion is premature, and a stay of these proceedings in advance of the PTAB's decision on whether or not to grant the petition for inter partes review should be denied."

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| Motion to Stay Pending Inter Partes Review | Denied without prejudice | Luminati Networks Ltd. v. Teso LT, UAB a/k/a UAB Teso LT et al 2-19-cv-00395 (EDTX) | Oct. 30, 2020 | |

Stay of Proceedings
└ Factors Considered
└ **Simplification of Issues**

The court denied without prejudice defendants' motion to stay pending their petitions for *inter partes* review. "Where a motion to stay is filed before the PTAB institutes any 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. . . . [T]his Court has a consistent practice of denying motions to stay when the PTAB has yet to institute post-grant proceedings. . . . Defendants' motion is premature[.]"

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| Motion to Stay Pending Inter Partes Review | Denied without prejudice | VARTA Microbattery GmbH v. Costco Wholesale Corporation 2-20-cv-00051 (EDTX) | Oct. 06, 2020 | |

Stay of Proceedings
└ Factors Considered
└ **Simplification of Issues**

The court denied without prejudice defendants' motion to stay pending their petitions for *inter partes* review. "[T]his Court has a consistent practice of denying motions to stay when the PTAB has yet to institute post-grant proceedings. . . . Defendants' motion is premature, and a stay of these proceedings in advance of the PTAB's decision on whether or not to grant the petition for inter partes review is not appropriate."

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| Motion to Stay Pending Inter Partes Review | Denied without prejudice | Snik LLC v. Samsung Electronics Co., Ltd. et al 2-19-cv-00387 (EDTX) | Oct. 05, 2020 | |

Stay of Proceedings
└ Factors Considered
└ **Simplification of Issues**

The court denied without prejudice defendants' motion to stay pending their petitions for *inter partes* review. "[T]his Court has a consistent practice of denying motions to stay when the PTAB has yet to institute post-grant proceedings. . . . [Defendants'] motion is premature, and a stay of these proceedings in advance of the PTAB's decision on whether or not to institute *inter partes* review of any of the Asserted Patents should be denied."

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| Motion to Stay Pending Inter Partes Review | Denied without prejudice | SpaceTime3D, Inc. v. Samsung Electronics Co., Ltd. et al 2-19-cv-00372 (EDTX) | Sep. 23, 2020 | |

Stay of Proceedings
└ Factors Considered
└ **Simplification of Issues**

The court denied without prejudice defendants' motion to stay pending their petitions for *inter partes* review. "[T]his Court has a consistent practice of denying motions to stay when the PTAB has yet to institute post-grant proceedings. Considering these circumstances, the Court concludes that [defendants'] motion is premature, and a stay of these proceedings in advance of the PTAB's decision on whether or not to institute inter partes review of any of the Asserted Patents should be denied."

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| Motion to Stay Pending Inter Partes Review | Denied as moot | SEVEN Networks, LLC v. Apple Inc 2-19-cv-00115 (EDTX) | Sep. 22, 2020 | |

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| Motion to Stay Pending Inter Partes Review | Granted | SEVEN Networks, LLC v. Apple Inc<br>2-19-cv-00115 (EDTX) | Sep. 22, 2020 | |

District Court Procedural Issues
└ **Severing, Consolidating & Relating**
Stay of Proceedings
└ Factors Considered
└ **Stage of Litigation**

The court denied as moot defendant's motion to stay pending *inter partes* review proceedings, *sua sponte* severed the five asserted claims that were not subject to IPR, and stayed the action as to the remaining claims. "In light of the extensive progression of this case -- the pretrial conference is less than a month away and jury selection is less than six weeks away -- the remaining claims will continue to be active in the above-captioned case[.]"

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| Motion to Stay Pending Inter Partes Review | Denied without prejudice | Acorn Semi, LLC v. Samsung Electronics Co., Ltd. et al<br>2-19-cv-00347 (EDTX) | Sep. 14, 2020 | |

Stay of Proceedings
└ Factors Considered
└ **Simplification of Issues**

The court denied without prejudice defendant's motion to stay pending their petitions for *inter partes* review. "[Defendant] has filed ten IPR petitions, effectively challenging the patentability of all claims asserted in this case. . . . The PTAB is expected to begin issuing institution decisions in [4 months], and is expected to issue institution decisions on the last of the petitions in [6 months]. . . . [T]his Court has a consistent practice of denying motions to stay when the PTAB has yet to institute post-grant proceedings. . . . [Defendants'] motion is premature, and a stay of these proceedings in advance of the PTAB's decision on whether or not to institute *inter partes* review of any of the Asserted Patents should be denied."

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|---|---|---|---|---|
| Motion to Stay Pending Inter Partes Review | Denied without prejudice | AGIS Software Development LLC v. Google LLC<br>2-19-cv-00361 (EDTX) | Jul. 30, 2020 | Mandamus Denied (Apr. 15, 2022) |

### TARGETED ANNOTATIONS

Stay of Proceedings
└ Factors Considered
└ **Simplification of Issues**

The court denied without prejudice as premature defendants' motion to stay pending their petitions for *inter partes* review and *ex parte* reexamination. "Where a motion to stay is filed before the PTAB institutes any 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. Indeed, this Court has a consistent practice of denying motions to stay when the PTAB has yet to institute post-grant proceedings."

### EXPANDED APPEAL STATUS

| Case | Appealed Case | Status | Type of Document | Judge | Date | Profile | PDF Link |
|---|---|---|---|---|---|---|---|
| 22-126 | 2-19-cv-00361 | Mandamus Denied | CAFC Order on Petition for Writ of Mandamus | Tiffany P. Cunningham | Apr. 15, 2022 | | |

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| Motion to Stay Pending Inter Partes Review | Denied | Solas OLED Ltd. v. Samsung Display Co., Ltd. et al<br>2-19-cv-00152 (EDTX) | Jul. 17, 2020 | |

Stay of Proceedings
└ Factors Considered
└ **Prejudice From Stay/Tactical Advantage**
Stay of Proceedings
└ Factors Considered
└ **Stage of Litigation**

The court denied defendants' renewed motion to stay pending *inter partes* review because the undue prejudice to plaintiff and advanced stage of the case weighed against a stay. "In [the case cited by defendants] to argue that a delay will not cause a non-practicing entity prejudice, the court stated that the plaintiff 'makes no specific allegations of prejudice in this case other than the natural delay that would occur when a stay is granted in any case.' Here, [plaintiff] has made specific allegations of prejudice. . . . The Court is not persuaded by [defendants'] argument that because [plaintiff] is not a competitor of [defendants], a delay to this litigation will result in no prejudice to [plaintiff]. . . . [Plaintiff] points out that with fact and expert discovery completed, it has already incurred the majority of the expenses associated with this litigation."

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| Motion to Stay Pending Inter Partes Review | Denied | Oyster Optics, LLC v. Infinera Corporation et al<br>2-19-cv-00257 (EDTX) | Jul. 17, 2020 | |

Stay of Proceedings
└ Factors Considered
└ **Prejudice From Stay/Tactical Advantage**
Stay of Proceedings
└ Factors Considered
└ **Simplification of Issues**
Stay of Proceedings
└ Factors Considered
└ **Stage of Litigation**

The court denied defendants' renewed motion to stay pending *inter partes* review following institution of review on most of the asserted claims because the undue prejudice to plaintiff, late stage of the case, and lack of potential simplification of issues weighed against a stay. "The Court is not persuaded by [defendants'] argument that because [plaintiff] is not a competitor of [defendants], a delay to this litigation will result in no prejudice to [plaintiff]. . . . [T]he PTAB would not issue its Final Written Decision until at least three months after the current trial date for this case. . . . Fact discovery is closing in about a month and trial is only six months away. . . . The fact that one claim in the [patent-in-suit] was not instituted means that no matter the outcome of the IPR, the [patent] will remain in this case, and this will remain on this Court's active docket."

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| Motion to Stay Pending Inter Partes Review | Granted | Uniloc 2017 LLC v. AT&T Services, Inc. et al<br>2-19-cv-00102 (EDTX) | Jun. 22, 2020 | |

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| Motion to Stay Pending Inter Partes Review | Denied without prejudice | Lighthouse Consulting Group, LLC v. Independent Financial<br>2-19-cv-00373 (EDTX) | May. 05, 2020 | |
| Motion to Stay Pending Inter Partes Review | Denied without prejudice | NCR Corporation v. Lighthouse Consulting Group, LLC<br>2-19-cv-00392 (EDTX) | Apr. 27, 2020 | |
| Motion to Stay Pending Inter Partes Review | Denied without prejudice | Solas OLED Ltd. v. Samsung Display Co., Ltd. et al<br>2-19-cv-00152 (EDTX) | Feb. 04, 2020 | |
| Stay of Proceedings<br>└ Factors Considered<br>└ **Simplification of Issues** | | The court denied without prejudice defendants' motion to stay pending their petitions for *inter partes* review because the lack of potential simplification of issues weighed against a stay. "At this nascent stage, it is impossible for the Court to determine 'whether the stay will likely result in simplifying the case before the court.' Indeed, if the PTAB denies institution of the IPRs, there will be no simplification of the case before the Court at all." | | |
| Motion to Stay Pending Inter Partes Review | Denied without prejudice | Ramot at Tel Aviv University Ltd. v. Cisco Systems, Inc.<br>2-19-cv-00225 (EDTX) | Feb. 04, 2020 | |
| Stay of Proceedings<br>└ Factors Considered<br>└ **Simplification of Issues** | | The court denied without prejudice defendants' motion to stay pending their petitions for *inter partes* review because the lack of potential simplification of issues weighed against a stay. "At this nascent stage, it is impossible for the Court to determine 'whether the stay will likely result in simplifying the case before the court.' If the PTAB denies institution of the IPRs, there will be no simplification of the case." | | |
| Motion to Stay Pending Inter Partes Review | Denied without prejudice | Oyster Optics, LLC v. Infinera Corporation et al<br>2-19-cv-00257 (EDTX) | Feb. 04, 2020 | |
| Stay of Proceedings<br>└ Factors Considered<br>└ **Simplification of Issues** | | The court denied without prejudice defendants' motion to stay pending their petitions for *inter partes* review because of the lack of potential simplification of issues weighed against a stay. "At this nascent stage, it is impossible for the Court to determine 'whether the stay will likely result in simplifying the case before the court.' Indeed, if the PTAB denies institution of the IPRs, there will be no simplification of the case before the Court at all." | | |
| Motion to Stay Pending Inter Partes Review | Denied without prejudice | Uniloc 2017 LLC v. Samsung Electronics America, Inc. et al<br>2-19-cv-00125 (EDTX) | Feb. 04, 2020 | |
| Stay of Proceedings<br>└ Factors Considered<br>└ **Simplification of Issues** | | The court denied without prejudice defendants' motion to stay pending their petitions for *inter partes* review because the lack of potential simplification of issues weighed against a stay. "At this nascent stage, it is impossible for the Court to determine 'whether the stay will likely result in simplifying the case before the court.' Indeed, if the PTAB denies institution of the IPRs, there will be no simplification of the case before the Court at all." | | |
| Motion to Stay Pending Inter Partes Review | Denied without prejudice | Greenthread, LLC v. Samsung Electronics Co., Ltd.. et al<br>2-19-cv-00147 (EDTX) | Feb. 04, 2020 | |
| Stay of Proceedings<br>└ Factors Considered<br>└ **Simplification of Issues** | | The court denied without prejudice defendants' motion to stay pending their petitions for *inter partes* review because the lack of potential simplification of issues weighed against a stay. "At this nascent stage, it is impossible for the Court to determine 'whether the stay will likely result in simplifying the case before the court.' Indeed, if the PTAB denies institution of the IPRs, there will be no simplification of the case before the Court at all." | | |
| Motion to Stay Pending Inter Partes Review | Granted | Uniloc 2017 LLC v. AT&T Services, Inc. et al<br>2-18-cv-00514 (EDTX) | Jan. 03, 2020 | |
| Motion to Stay Pending Inter Partes Review | Granted | Uniloc 2017 LLC v. Verizon Communications Inc. et al<br>2-18-cv-00513 (EDTX) | Jan. 01, 2020 | |
| Motion to Stay Pending Inter Partes Review | Granted | Uniloc 2017 LLC v. AT&T Services, Inc. et al<br>2-19-cv-00102 (EDTX) | Dec. 04, 2019 | |

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| Motion to Stay Pending Inter Partes Review | Denied without prejudice | Uniloc 2017 LLC v. Samsung Electronics America, Inc. et al<br>2-18-cv-00508 (EDTX) | Jul. 25, 2019 | |

District Court Procedural Issues
└ **Stay of Proceedings**

The court denied without prejudice as premature defendants' motion to stay pending their petitions for *inter partes* review. "[T]he [PTAB] has not yet acted on [defendants'] petitions and may not provide a decision regarding whether or not to institute review [for 5 months]. . . . [T]his Court has a consistent practice of denying motions to stay when the PTAB has yet to institute post-grant proceedings."

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| Motion to Stay Pending Inter Partes Review | Granted | Uniloc 2017 LLC v. Google LLC<br>2-18-cv-00549 (EDTX) | Jul. 11, 2019 | |
| Motion to Stay Pending Inter Partes Review | Granted | Uniloc USA, Inc. et al v. Telegram Messenger, LLP<br>2-16-cv-00892 (EDTX) | Jun. 13, 2019 | |
| Motion to Stay Pending Inter Partes Review | Granted | Uniloc USA, Inc. et al v. Avaya Inc.<br>6-15-cv-01168 (EDTX) | May. 07, 2019 | |
| Motion to Stay Pending Inter Partes Review | Granted | Uniloc USA, Inc. et al v. Motorola Mobility LLC<br>2-16-cv-00992 (EDTX) | May. 02, 2019 | |
| Motion to Stay Pending Inter Partes Review | Denied without prejudice | Barkan Wireless IP Holdings, LP v. Samsung Electronics Co., Ltd. et al<br>2-18-cv-00028 (EDTX) | Mar. 15, 2019 | |

District Court Procedural Issues
└ **Stay of Proceedings**

The court denied without prejudice defendants' motion to stay pending their five petitions for *inter partes* review. "[T]his Court has a consistent practice of denying motions to stay when the PTAB has yet to institute post-grant proceedings. . . . Defendants' Motion is premature, and a stay of these proceedings in advance of the PTAB's decision on whether or not to grant Defendants' petitions for *inter partes* review should be denied."

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| Motion to Stay Pending Inter Partes Review | Denied | Intellectual Ventures I LLC v. T-Mobile USA, Inc. et al<br>2-17-cv-00577 (EDTX) | Dec. 13, 2018 | |

Stay of Proceedings
└ Factors Considered
└ **Prejudice From Stay/Tactical Advantage**
Stay of Proceedings
└ Factors Considered
└ **Stage of Litigation**

The court denied defendant's renewed motion to stay pending *inter partes* review after the PTAB instituted review because the undue prejudice to plaintiff and advanced stage of the case weighed against a stay. "It is well established that Plaintiff's timely enforcement of its patent rights is entitled to some weight, even if that factor is not dispositive. . . . While this Court has previously held that delay in filing of IPR petitions of seven months from the filing of the Complaint is not inherently unreasonable, Defendants' choice to do so put it firmly at the mercy of the PTAB's institution timing. . . . Having elected to engage in parallel proceedings before the PTAB and engaged in conduct that elongated the institution proceedings, Defendants must now accept the consequences. . . . Dispositive and *Daubert* motions have been filed, and the Court has expended material judicial resources to prepare for the [pretrial in 3 weeks]."

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| Motion to Stay Pending Inter Partes Review | Denied without prejudice | Intellectual Ventures I LLC v. T-Mobile USA, Inc. et al<br>2-17-cv-00577 (EDTX) | Oct. 02, 2018 | |

District Court Procedural Issues
└ **Stay of Proceedings**

The court denied without prejudice as premature defendants' motion to stay pending their petitions for *inter partes* review. "Where a motion to stay is filed before the PTAB institutes any 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. Indeed, this Court has a consistent practice of denying motions to stay when the PTAB has yet to institute post-grant proceedings."

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| Motion to Stay Pending Inter Partes Review | Denied without prejudice | Polaris PowerLED Technologies, LLC v. Samsung Electronics America, Inc.<br>2-17-cv-00715 (EDTX) | Sep. 05, 2018 | |

District Court Procedural Issues
└ **Stay of Proceedings**

The court denied without prejudice as premature defendants' motion to stay pending their petitions for *inter partes* review. "The [PTAB] should provide a decision regarding whether or not to institute review [within 5 months]. Where a motion to stay is filed before the PTAB institutes any 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. Indeed, this Court has a consistent practice of denying motions to stay when the PTAB has yet to institute post-grant proceedings."

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| Motion to Stay Pending Inter Partes Review | Granted | Uniloc USA, Inc. et al v. Samsung Electronics America, Inc. et al<br>2-17-cv-00650 (EDTX) | Aug. 24, 2018 | |

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| Motion to Stay Pending Inter Partes Review | Granted | Uniloc USA, Inc. et al v. Amazon.com, Inc. 2-18-cv-00123 (EDTX) | Aug. 07, 2018 | |
| Motion to Stay Pending Inter Partes Review | Denied | Tessera Advanced Technologies, Inc. v. Samsung Electronics Co., Ltd. et al 2-17-cv-00671 (EDTX) | Jul. 19, 2018 | |

Stay of Proceedings
└ Factors Considered
└ **Simplification of Issues**

Stay of Proceedings
└ Factors Considered
└ **Stage of Litigation**

The court denied defendant's motion to stay pending its petitions for *inter partes* review because the stage of the case and lack of potential simplification of issues weighed against a stay. "While [defendant] has the right to delay filing its IPRs for a year under 35 U.S.C. § 315, the choice of when to bring such IPRs is still at [defendant's] discretion. . . . [Defendant] waited nine months from the initiation of these proceedings and five months after service of infringement contentions to move for a stay. . . . [T]his factor weighs strongly against a stay. . . . [T]he proper course is to follow the approach employed by a majority of the district court decisions (and all of the decisions in this district) and deny the motion for a stay pending a determination by the PTAB as to whether to grant the petition for *inter partes* review. "

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| Motion to Stay Pending Inter Partes Review | Granted | Uniloc USA, Inc. et al v. Samsung Electronics America, Inc. et al 2-17-cv-00650 (EDTX) | Jul. 03, 2018 | |
| Motion to Stay Pending Inter Partes Review | Granted | VoltStar Technologies, Inc. v. AT&T Mobility LLC et al 2-16-cv-01181 (EDTX) | Jul. 03, 2018 | |
| Motion to Stay Pending Inter Partes Review | Denied | Intellectual Ventures II LLC v. Kemper Corporation et al 6-16-cv-00081 (EDTX) | Jun. 29, 2018 | |

Stay of Proceedings
└ Factors Considered
└ **Prejudice From Stay/Tactical Advantage**

Stay of Proceedings
└ Factors Considered
└ **Simplification of Issues**

The court denied defendants' motion to stay pending appeals of *inter partes* review proceedings because the undue prejudice to plaintiff and potential simplification of issues weighed against a continued stay. "While not much weight is given to a delay in the initial prejudice analysis, the additional delay pending appeal is considerable and holds weight. The Court also finds that the PTAB's decision upholding the validity of Claim 14 constitutes a material change in the facts. Further, [plaintiff] is certainly prejudiced by not being able to assert a valid claim while the IPR judgments are being appealed. . . . [Plaintiff] responds that Claim 14 has already survived six attempts to invalidate it before the PTAB. . . . The Court notes that the issues have already been simplified down to a single claim, and there are no further IPRs pending as to Claim 14."

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| Motion to Stay Pending Inter Partes Review | Granted | Uniloc USA, Inc. et al v. Apple Inc. 2-17-cv-00708 (EDTX) | Jun. 06, 2018 | |
| Motion to Stay Pending Inter Partes Review | Denied | Blitzsafe Texas, LLC v. Mitsubishi Electric Corporation et al 2-17-cv-00430 (EDTX) | Mar. 26, 2018 | |

District Court Procedural Issues
└ **Stay of Proceedings**

The court denied defendants' motions to stay pending *inter partes* review. "[T]his Court generally denies motions to stay pending institution of an *inter partes* review. No reason exists in this context to deviate from such practice. Here, no *inter partes* review petition against [one patent-in-suit] has been instituted. Additionally, no *inter partes* review petition has been filed against [a second] Patent. . . . Even as to the [third] Patent's IPR proceeding, the fact that '[t]wo of the three Administrative Panel [sic] Judges who instituted [a prior] IPR [on the that patent] are assigned to [another] IPR,' does not, as Defendants suggest, provide any support for such a stay. This Court will not join the Defendants in apparently presuming that the PTAB prejudges petitions or does not otherwise independently address every matter presented on its own merit."

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| Motion to Stay Pending Inter Partes Review | Granted | Uniloc USA, Inc. et al v. RingCentral, Inc. 2-17-cv-00354 (EDTX) | Feb. 12, 2018 | |

Stay of Proceedings
└ Factors Considered
└ **Prejudice From Stay/Tactical Advantage**

Stay of Proceedings
└ Factors Considered
└ **Simplification of Issues**

Stay of Proceedings
└ Factors Considered
└ **Stage of Litigation**

The court granted plaintiffs' motion to stay two of their own patent infringement actions pending *inter partes* review because the lack of undue prejudice, stage of the case, and potential simplification of issues favored a stay. "[T]he [PTAB] has instituted review of every asserted claim of all patents asserted against the Defendants. . . . [T]he Court is persuaded that the benefits of a stay outweigh the costs of postponing resolution of the litigation in this case. Here, the patent claims have not yet been construed by the Court, and discovery is not yet complete. Moreover, even if the PTAB does not invalidate every claim on which it has instituted IPR, there is a significant likelihood that the outcome of the IPR proceedings will streamline the scope of this case to an appreciable extent. . . . This stay is effective, but without prejudice, to [one defendant's] pending challenge to venue based on a forum selection clause."

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| Motion to Stay Pending Inter Partes Review | Granted | Uniloc USA, Inc. et al v. RingCentral, Inc. 2-17-cv-00354 (EDTX) | Feb. 09, 2018 | |

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| Motion to Stay Pending Inter Partes Review | Denied without prejudice | Uniloc USA, Inc. et al v. Apple Inc. 2-17-cv-00708 (EDTX) | Jan. 31, 2018 | |

District Court Procedural Issues
└ **Stay of Proceedings**

The court denied without prejudice defendant's motion to stay pending its petition for *inter partes* review. "Where a motion to stay is filed before the PTAB institutes any 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. . . . [T]he Court concludes that [defendant's] motion is premature, and a stay of these proceedings in advance of the PTAB's decision on whether or not to grant the petition for inter partes review should be denied."

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| Motion to Stay Pending Inter Partes Review | Denied without prejudice | Oyster Optics, LLC v. Coriant America Inc. et al 2-16-cv-01302 (EDTX) | Dec. 21, 2017 | |

District Court Procedural Issues
└ **Stay of Proceedings**

The court denied without prejudice defendants' motion to stay pending their petitions for *inter partes* review. "To the Court's knowledge the [PTAB] has not yet acted on Defendants' petitions, but should provide decisions regarding whether or not to institute review on the earliest of the Petitions soon; however, due to the most recent IPR petition being filed a mere nineteen days ago, there is little chance that all of the IPR petitions will be acted upon until early summer of next year. . . . [T]his Court has a consistent practice of denying motions to stay when the PTAB has yet to institute post-grant proceedings."

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| Motion to Stay Pending Inter Partes Review | Granted | DSS Technology Management, Inc. v. Qualcomm Incorporated 6-15-cv-00692 (EDTX) | Dec. 15, 2017 | |
| Motion to Stay Pending Inter Partes Review | Denied as moot | Uniloc USA, Inc. et al v. Atlassian Corporation PLC et al 2-17-cv-00352 (EDTX) | Nov. 27, 2017 | |
| Motion to Stay Pending Inter Partes Review | Granted | Image Processing Technologies, LLC v. Samsung Electronics Co., Ltd. et al 2-16-cv-00505 (EDTX) | Oct. 25, 2017 | |

Stay of Proceedings
└ Factors Considered
└ **Simplification of Issues**

The court granted defendant's renewed motion to stay pending *inter partes* review after the PTAB instituted review because the potential simplification of issues favored a stay. "Potential costs, delay, or prejudice resulting from postponing the resolution of the case are outweighed by the benefits of a stay in this case, Since only one asserted claim is not currently under a simultaneous IPR review, there is a material possibility that the outcome of all IPR proceedings will streamline the scope and resolution of this case."

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| Motion to Stay Pending Inter Partes Review | Denied | Intellectual Ventures II LLC v. FedEx Corporation et al 2-16-cv-00980 (EDTX) | Oct. 24, 2017 | |

Stay of Proceedings
└ Factors Considered
└ **Prejudice From Stay/Tactical Advantage**
Stay of Proceedings
└ Factors Considered
└ **Simplification of Issues**
Stay of Proceedings
└ Factors Considered
└ **Stage of Litigation**

The court denied defendants' motion to stay pending *inter partes* review because the lack of potential simplification of issues, prejudice to plaintiff, and stage of the case weighed against transfer. "[A] stay would do little to simplify the issues here. Indeed, the PTAB has declined to institute on a majority of the Asserted Claims. . . . Additionally, the instituted IPRs only cover a narrow slice of the invalidity arguments Defendants have raised in this case. . . . Defendants argue that Plaintiff will suffer no prejudice because [plaintiff] 'does not produce or sell any products' and thus it can be compensated, if infringement were eventually found, through damages, including for the period covered by the stay. However . . . 'a plaintiff has a right to timely enforcement of its patent rights.'. . . [T]he Parties have already invested substantial effort and resources during discovery and in preparing claim construction briefing. These circumstances weigh against staying this case. This is particularly true with respect to Defendants' 'follow-on' petitions, which were filed well after this case was underway."

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| Motion to Stay Pending Inter Partes Review | Granted | Uniloc USA, Inc. et al v. Google, LLC 2-17-cv-00231 (EDTX) | Oct. 03, 2017 | |

Stay of Proceedings
└ Factors Considered
└ **Simplification of Issues**
Stay of Proceedings
└ Factors Considered
└ **Stage of Litigation**

The court granted defendant's motion to stay six consolidated cases pending *inter partes* review because the stage of the case and potential simplification of issues favored a stay. "[T]he [PTAB] has instituted *Inter Partes* Review on [two patents-in-suit]. [Defendant] also has pending requests for IPRs on [two other patents-in-suit]. . . . No patent claims have been construed by the Court in these cases and discovery has barely begun. Moreover, there is a significant likelihood that the outcome of the IPR proceedings will streamline the scope and resolution of these cases because they all involve related patents and products. Indeed, the [two patents in the pending petition] are continuations of [a patent already under review] and all the patents share a common specification as well as numerous overlapping terms."

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| Motion to Stay Pending Inter Partes Review | Denied without prejudice | Uniloc USA, Inc. et al v. Apple Inc. 2-17-cv-00258 (EDTX) | Sep. 11, 2017 | |

District Court Procedural Issues
└ **Stay of Proceedings**

The court denied without prejudice defendant's motion to stay pending its petition for *inter partes* review because the motion was premature. "The [PTAB] has not yet acted on [defendant's] petitions, but should provide decisions regarding whether or not to institute review [within 6 months]. . . . [T]his Court has a consistent practice of denying motions to stay when the PTAB has yet to institute post-grant proceedings."

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| Motion to Stay Pending Inter Partes Review | Granted | Customedia Technologies, LLC v. DISH Network Corporation et al 2-16-cv-00129 (EDTX) | Aug. 09, 2017 | |
| Motion to Stay Pending Inter Partes Review | Granted | Uniloc USA, Inc. et al v. Google LLC 2-16-cv-00566 (EDTX) | Jul. 26, 2017 | |
| Motion to Stay Pending Inter Partes Review | Denied without prejudice | Saint Lawrence Communications LLC v. Apple Inc. et al 2-16-cv-00082 (EDTX) | Jul. 12, 2017 | |

District Court Procedural Issues
└ **Stay of Proceedings**

The court denied without prejudice as premature defendant's motion to stay pending its petitions for *inter partes* review. "[T]his Court has a consistent practice of denying motions to stay when the PTAB has yet to institute post-grant proceedings. Based on these circumstances, the Court concludes that [defendant's] Motion is premature, and a stay of these proceedings in advance of the PTAB's decision on whether or not to grant the petitions for IPR should be denied."

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| Motion to Stay Pending Inter Partes Review | Granted | Uniloc USA, Inc. et al v. Motorola Mobility LLC 2-16-cv-00992 (EDTX) | Jun. 30, 2017 | |
| Motion to Stay Pending Inter Partes Review | Granted | Uniloc USA, Inc. et al v. Apple Inc. 2-16-cv-00638 (EDTX) | Jun. 13, 2017 | |

Stay of Proceedings
└ Factors Considered
└ **Simplification of Issues**

Stay of Proceedings
└ Factors Considered
└ **Stage of Litigation**

The court granted defendant's motion to stay pending *inter partes* review because the potential simplification of issues and stage of the case favored a stay. "[Defendant's] Motion explains that the [PTAB] has instituted review of every asserted claim of three of the four patents asserted against [movant]. . . . [One of the instituted patents] is the parent of the other three patents asserted against Apple, including the patent on which the PTAB has not instituted review. . . . [T]he patent claims have not yet been construed by the Court, and discovery is not yet complete. Moreover, even if the PTAB does not invalidate every claim on which it has instituted IPR, there is a significant likelihood that the outcome of the IPR proceedings will streamline the scope of this case to an appreciable extent."

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| Motion to Stay Pending Inter Partes Review | Denied without prejudice | Customedia Technologies, LLC v. DISH Network Corporation et al 2-16-cv-00129 (EDTX) | Apr. 27, 2017 | |

District Court Procedural Issues
└ **Stay of Proceedings**

The court denied without prejudice defendant's motion to stay pending its petitions for *inter partes* and CBM review. "[T]his Court has a consistent practice of denying motions to stay when the PTAB has yet to institute post-grant proceedings. . . . [Defendant's] motion is premature, and a stay of these proceedings in advance of the PTAB's decision on whether or not to grant the petitions for CBM and IPR review should be denied."

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| Motion to Stay Pending Inter Partes Review | Granted | Uniloc USA, Inc. et al v. Avaya Inc. 6-15-cv-01168 (EDTX) | Apr. 19, 2017 | |

Stay of Proceedings
└ Factors Considered
└ **Simplification of Issues**

The court granted defendants' motion to stay pending *inter partes* review because the potential simplification of issues favored a stay. "This Court has previously reasoned that 'it is unwilling to adopt a per se rule that patent cases should be stayed during reexamination because some of the relevant claims may be affected. . . .' However, in this case, the PTAB has instituted review on all claims asserted against [defendants]. This is a distinction with a difference. . . .As [defendants] correctly note, the [patent] IPR proceeding has the potential to be entirely case dispositive, which would be the 'ultimate simplification of issues.'"

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| Motion to Stay Pending Inter Partes Review | Denied without prejudice | Uniloc USA, Inc. et al v. Motorola Mobility LLC 2-16-cv-00992 (EDTX) | Apr. 05, 2017 | |

District Court Procedural Issues
└ **Stay of Proceedings**

The court denied without prejudice defendant's motion to stay pending a third party's petitions for *inter partes* review of 3 of the 4 patents-in-suit. "[T]his Court has a consistent practice of denying motions to stay when the PTAB has yet to institute post-grant proceedings. . . . [T]he Court concludes that a stay of these proceedings in advance of the PTAB's decision on whether or not to grant the petitions for *inter partes* review is not warranted. This is especially so, given that the pending IPR petitions do not challenge every patent asserted in this case."

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| Motion to Stay Pending Inter Partes Review | Denied without prejudice | Uniloc USA, Inc. et al v. Samsung Electronics America, Inc. 2-16-cv-00642 (EDTX) | Apr. 04, 2017 | |

District Court Procedural Issues
└ **Stay of Proceedings**

The court denied without prejudice defendant's motion to stay pending its petitions for *inter partes* review. "[T]his Court has a consistent practice of denying motions to stay when the PTAB has yet to institute post-grant proceedings. . . . [T]he Court concludes that [defendant's] motion is premature, and a stay of these proceedings in advance of the PTAB's decision on whether or not to grant the petitions for inter partes review should be denied."

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| Motion to Stay Pending Inter Partes Review | Denied without prejudice | Image Processing Technologies, LLC v. Samsung Electronics Co., Ltd. et al 2-16-cv-00505 (EDTX) | Feb. 17, 2017 | |

District Court Procedural Issues
└ **Stay of Proceedings**

The court denied without prejudice defendants' motion to stay pending their petitions for *inter partes* review. "[T]his Court has a consistent practice of denying motions to stay when the PTAB has yet to institute post-grant proceedings. Based on these circumstances, the Court concludes that [defendants'] motion is premature, and a stay of these proceedings in advance of the PTAB's decision on whether or not to grant the petitions for *inter partes* review should be denied. . . . If the PTAB issues separate institution decisions, [defendant] is permitted to refile its motion within 14 days following the last institution decision regarding [the five petitions]."

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| Motion to Stay Pending Inter Partes Review | Granted | Intellectual Ventures II LLC v. Kemper Corporation et al 6-16-cv-00081 (EDTX) | Feb. 16, 2017 | |
| Motion to Stay Pending Inter Partes Review | Granted | VoltStar Technologies, Inc. v. AT&T Mobility LLC et al 2-16-cv-01181 (EDTX) | Jan. 26, 2017 | |
| Motion to Stay Pending Inter Partes Review | Denied | Saint Lawrence Communications, LLC v. ZTE Corporation et al 2-15-cv-00349 (EDTX) | Jan. 17, 2017 | |

Stay of Proceedings
└ Factors Considered
└ **Prejudice From Stay/Tactical Advantage**

Stay of Proceedings
└ Factors Considered
└ **Simplification of Issues**

Stay of Proceedings
└ Factors Considered
└ **Stage of Litigation**

The court denied defendants' renewed motion to stay pending *inter partes* review because the lack of potential simplification of issues, late stage of the case, and undue prejudice to plaintiff weighed against a stay. "[T]he Court observes that [defendants'] invalidity theories far exceed the limited scope of the pending IPR. Here, the PTAB has instituted IPR on only one of five asserted patents, which amounts to 6 of 38 asserted claims. Further, IPR on the [patent] was instituted for only two prior art references. The scope of this IPR is very narrow and targeted. . . . Even considering the possibility that the [one] patent could be invalidated or, if not, that [defendants] would be estopped from asserting certain prior references (2 out of 30), the pending IPR will have a negligible impact on potentially streamlining this case. . . . [J]ury trial in this case is currently set to begin in less than two months. . . . [T]he Court specifically notes that although [defendant] did timely file its petitions for IPR (avoiding the statutory deadline by one day), it could have filed them earlier in order to avoid the present result."

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| Motion to Stay Pending Inter Partes Review | Denied | Chrimar Systems, Inc. d/b/a CMS Technologies et al v. ADTRAN, Inc. 6-15-cv-00618 (EDTX) | Dec. 28, 2016 | |
| Motion to Stay Pending Inter Partes Review | Objection overruled / report adopted | Chrimar Systems, Inc. d/b/a CMS Technologies et al v. ADTRAN, Inc. 6-15-cv-00618 (EDTX) | Dec. 28, 2016 | |
| Motion to Stay Pending Inter Partes Review | Denied | Intellectual Ventures II LLC v. Kemper Corporation et al 6-16-cv-00081 (EDTX) | Nov. 07, 2016 | |

Stay of Proceedings
└ Factors Considered
└ **Prejudice From Stay/Tactical Advantage**

Stay of Proceedings
└ Factors Considered
└ **Simplification of Issues**

District Court Procedural Issues
└ Stay of Proceedings
└ **Conditions of Stay**

The court denied defendant's motion to stay pending *inter partes* review initiated by third parties in one of plaintiff's other actions because the lack of potential simplification of issues and undue prejudice did not favor a stay. "In this case, the [PTO] has not instituted review on all of the asserted claims nor have defendants agreed to be bound by the estoppel provisions of 35 U.S.C. § 315 as would the petitioner. . . . [T]he limited estoppel proposed by Defendants may not actually simplify the issues at all. . . . [U]nder the limited estoppel proposed here, Defendants could raise new obvious combinations using old prior art the PTO considered, provided at least one new (perhaps inane) reference not previously considered by the PTO is used to meet one claim element. This would not simplify the case; rather, it very well might complicate the case, by precipitating a dispute as to whether such a combination fell within the carefully worded limited estoppel, i.e., whether such combination fell within 'a specific ground(s) upon which those IPRs were instituted'. . . [A] full statutory estoppel would avoid such disputes, but, as some have called it, 'estoppel light' would not. The absence of a full statutory estoppel not only increases the ability of litigants to 'game the system' and devise an unfair second bite at the apple, it also has the potential to increase rather than reduce the complexity of the validity issues that may come before the Court."

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| Motion to Stay Pending Inter Partes Review | Granted | Parthenon Unified Memory Architecture LLC v. Apple Inc.<br>2-15-cv-00621 (EDTX) | Oct. 25, 2016 | |
| Motion to Stay Pending Inter Partes Review | Denied in part granted in part | Parthenon Unified Memory Architecture LLC v. Apple Inc.<br>2-15-cv-00621 (EDTX) | Oct. 05, 2016 | |

District Court Procedural Issues
└ **Severing, Consolidating & Relating**
District Court Procedural Issues
└ **Stay of Proceedings**

The court granted in part defendant's motion to stay pending conclusion of *inter partes* review proceedings and severed the claims under review into a separate action. "As to the remaining claims which are not severed (principally concerning [one patent-in-suit]), the Court orders that Jury Selection for trial in this case is now set [in one month]. . . . [Defendant] argues for a stay of the entire case because the [PTAB] has instituted *Inter Partes* Review proceedings on all patents asserted in this case, specifically, 53 out of 58 asserted claims. . . . In view of the changed status of this case and the forthcoming date for the final written decisions covering all the asserted claims regarding two of the patents-in-suit [in 3 months], the Court is of the opinion that it is in the best interest of judicial economy to sever Plaintiff's claims concerning the stayed patents into a new action. Such new action shall be stayed until further order of this Court."

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| Motion to Stay Pending Inter Partes Review | Ruling deferred | Intellectual Ventures II LLC v. Kemper Corporation et al<br>6-16-cv-00081 (EDTX) | Oct. 05, 2016 | |
| Motion to Stay Pending Inter Partes Review | Denied without prejudice | Saint Lawrence Communications, LLC v. ZTE Corporation et al<br>2-15-cv-00349 (EDTX) | Jul. 15, 2016 | |

District Court Procedural Issues
└ **Stay of Proceedings**

The court denied without prejudice as premature defendants' motion to stay pending their petitions for *inter partes* review. "[T]his Court has a consistent practice of denying motions to stay when the PTAB has yet to institute post-grant proceedings. . . . [I]t would be speculative for the Court to extrapolate from the cited statistics and conclude that the PTAB will institute inter partes review in this case and then go further to invalidate some or all of the claims of the challenged patents. The likelihood of institution and invalidation 'depends entirely on the particulars of the patents and claims in dispute.'"

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| Motion to Stay Pending Inter Partes Review | Granted | Camfil USA, Inc. v. Imperial Systems, Inc. et al<br>2-15-cv-01755 (EDTX) | Jun. 22, 2016 | |
| Motion to Stay Pending Inter Partes Review | Denied in part granted in part | Intellectual Ventures II LLC v. BITCO General Insurance Corporation f/k/a Bituminous Casualty Corporation et al<br>6-15-cv-00059 (EDTX) | May. 12, 2016 | |

Stay of Proceedings
└ Factors Considered
└ **Prejudice From Stay/Tactical Advantage**
Stay of Proceedings
└ Factors Considered
└ **Simplification of Issues**

The court granted in part defendants' motion to stay a pending *inter partes* review and stayed the case until the PTAB issued its rulings on both of Defendants' petitions for *inter partes* review because the undue prejudice to plaintiff was neutral and the potential simplification of issues favored a stay. "Plaintiff alleges that it will likely take years for the *inter partes* review proceedings to become final through appeal and argues that a 'three-year stay' will unduly prejudice its rights as a patent owner. However, Defendants have not requested a three-year stay. Instead, Defendants ask the Court to stay the present litigation only until the PTAB has completed its review and issued final written decisions. . . . Plaintiff additionally notes that Defendants have raised other invalidity arguments that are outside the purview of *inter parties* review. However, the Court finds that the likelihood of simplification of issues is high since the PTAB has instituted review of almost all of the claims at issue in this case."

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| Motion to Stay Pending Inter Partes Review | Granted | DSS Technology Management, Inc. v. Samsung Electronics Co., Ltd. et al<br>6-15-cv-00690 (EDTX) | Apr. 05, 2016 | |
| Motion to Stay Pending Inter Partes Review | Denied | PersonalWeb Technologies LLC et al v. International Business Machines Corporation<br>6-12-cv-00661 (EDTX) | Jan. 28, 2016 | |

Stay of Proceedings
└ Factors Considered
└ **Prejudice From Stay/Tactical Advantage**
Stay of Proceedings
└ Factors Considered
└ **Simplification of Issues**

The court denied defendants' motions to stay pending *inter partes* review and *ex parte* reexamination because the undue prejudice to plaintiff, lack of potential simplification of issues weighed against a stay. "[Plaintiff's] complaint against [one defendant] is over three years old and its complaint against [another] is over two years old. . . . Defendants argue that the case should be stayed once more because there are patents related to the patents-in-suit — but not actually at issue in this case — that are before the PTO in post-grant proceedings. . . . A further stay on that basis would be for an indeterminate amount of time and would therefore unduly prejudice [plaintiff] by throwing its effort to adjudicate its claims back into limbo. . . . This case will require a trial regardless of what happens at the PTO. . . . [D]iscovery is very nearly complete and a trial date has already been set and is approaching quickly."

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| Motion to Stay Pending Inter Partes Review | Granted | MemSmart Semiconductor Corporation v. AAC Technologies Pte. Ltd. et al<br>2-14-cv-01107 (EDTX) | Jul. 13, 2015 | |

Stay of Proceedings
└ Factors Considered
└ **Prejudice From Stay/Tactical Advantage**

The court granted defendant's motion to stay pending *inter partes* review because the lack of undue prejudice and the relatively early stage of the case weighed in favor of a stay. "[I]n this case, [defendant] is seeking a 9-month (from filing) stay . . . rather than the two to four years identified by [plaintiff]. . . . The Court also observes that [defendant] filed its petition more than four months before [plaintiff] filed suit. Importantly, there is no indication here that [defendant] has gamed the system created by the Leahy–Smith America Invents Act by treating the IPR process as a 'second bite at the apple' rather than the alternative to district court litigation that Congress intended."

Stay of Proceedings
└ Factors Considered
└ **Stage of Litigation**

Stay of Proceedings
└ Factors Considered
└ **Simplification of Issues**

The court granted defendant's motion to stay pending *inter partes* review even though the potential simplification of issues factor was neutral because there was a related case involving the same patent in suit. "[Plaintiff] . . . argu[es] that the IPR will not meaningfully reduce the issues before the Court because of the existence of a related case filed recently against [a voluntarily dismissed defendant in this action] involving the asserted patent. . . . [Plaintiff] appears to assume that the cases will be consolidated and argues that the IPR will not simplify the issues because 'a substantial number of claims in all but one asserted patent will inevitably survive.'. . . The Court notes that the 'related case' [plaintiff] refers to has not been consolidated into the present case, nor has any request for consolidation been made by any of the parties in either case. . . . [T]his factor is neutral."

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| Motion to Stay Pending Inter Partes Review | Granted | Personal Audio, LLC v. CBS Corporation<br>2-13-cv-00270 (EDTX) | Apr. 30, 2015 | |
| Motion to Stay Pending Inter Partes Review | Denied without prejudice | ContentGuard Holdings, Inc. v. Apple, Inc.<br>2-13-cv-01112 (EDTX) | Apr. 27, 2015 | |

District Court Procedural Issues
└ **Stay of Proceedings**

The court denied without prejudice defendant's motion to stay pending its petitions for *inter partes* and CBM review. "[Defendant's] twenty-nine IPR and CBM petitions were filed . . . approximately one year after the case was filed. . . . [T]he record does not reflect that the PTAB has acted on [defendant's] petitions to institute, and it is not apparent that a grant of the petition will be forthcoming. As no petition has yet been granted, [defendant] is, in effect, asking the Court to stay this action based solely on the possibility of a hypothetical future occurrence. At such time that the basis for its request becomes concrete, [defendant] is free to re-urge its request."

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| Motion to Stay Pending Inter Partes Review | Denied as moot | Better Mouse Company, LLC v. SteelSeries ApS et al<br>2-14-cv-00198 (EDTX) | Apr. 23, 2015 | |
| Motion to Stay Pending Inter Partes Review | Denied | Lennon Image Technologies, LLC v. Macy's, Inc. et al<br>2-13-cv-00235 (EDTX) | Sep. 18, 2014 | |

Stay of Proceedings
└ Factors Considered
└ **Prejudice From Stay/Tactical Advantage**

Stay of Proceedings
└ Factors Considered
└ **Simplification of Issues**

Stay of Proceedings
└ Factors Considered
└ **Stage of Litigation**

The court denied defendant's motion to stay pending a potential *inter partes* review and an ongoing reexamination because the undue prejudice to plaintiff, lack of potential simplification of issues, and stage of the case weighed against a stay. "Staying the action for such an indefinite period of time would essentially remove the Court's discretion regarding control of its own docket and hold the Court in limbo awaiting determinations that could take years to reach an absolute resolution. . . . Although the Defendants contend that PTAB is virtually guaranteed to grant the IPR, this is no guarantee that the claims will be amended or cancelled during the IPR. . . . Given the sizable resources that the parties and the Court have already invested in this case, staying the case, 'based solely on speculation of what might possibly happen during reexamination' or based upon a possible IPR, 'would be inefficient and inappropriate.'"

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| Motion to Stay Pending Inter Partes Review | Denied without prejudice | MPHJ Technology Investments, LLC et al v. Research Now, Inc.<br>2-13-cv-00962 (EDTX) | Jun. 10, 2014 | |

Stay of Proceedings
└ Factors Considered
└ **Simplification of Issues**

The court denied without prejudice defendant's unopposed motion to stay pending *inter partes* review. "Third parties . . . have filed a petition for *inter partes* review of the [patents-in-suit]. . . . [T]he PTAB proceeding is at an even earlier stage than this litigation – it will take the PTAB up to three months from now to determine whether or not to institute the *inter partes* review at all. Whether a stay will simplify the issues in question and trial of the case is wholly unpredictable, if not completely speculative, at this time. . . . Even assuming the PTAB does institute the *inter partes* review, that [defendant] is not a party to the PTAB proceeding casts doubt on the extent, if any, a stay will simplify the issues in this case by way of the estoppel effect of the administrative proceeding."

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| Motion to Stay Pending Inter Partes Review | Denied | Lennon Image Technologies, LLC v. Lumondi Inc.<br>2-13-cv-00238 (EDTX) | Jan. 06, 2014 | |

Stay of Proceedings
└ Factors Considered
└ **Prejudice From Stay/Tactical Advantage**

Stay of Proceedings
└ Factors Considered
└ **Simplification of Issues**

Stay of Proceedings
└ Factors Considered
└ **Stage of Litigation**

The court denied defendant's motion to stay pending *inter partes* review filed in one of five consolidated actions because the undue prejudice to plaintiff, lack of potential simplification of issues, and stage of the case weighed against a stay. "If a stay in this case should apply to the consolidated action as a whole, it would unduly prejudice both the other defendants' interests as well as the plaintiff's enforcement of its patent rights. If it does not apply to the other four cases, the incongruent schedule caused by granting a stay in a single case must be considered against its impact on the Court's docket. . . . Notably, none of the other defendants have joined in [defendant's] request. . . . A stay pending final determination and appeal of the IPR may double the length of time to trial in this case if the *inter partes* review does not result in invalidating the asserted claims."