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Subject: Activity in Case 1:24-cv-21226-RAR Hernandez v. Stingray Digital Group Inc. et al Order on Motion to Stay
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U.S. District Court

Southern District of Florida

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Case Name: Hernandez v. Stingray Digital Group Inc. et al
Case Number: 1:24-cv-21226-RAR
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Docket Text:
PAPERLESS ORDER *denying* [184] Motion to Stay Pending *Inter Partes* Review ("Motion"). Defendants argue that this case should be stayed pending Defendants' appeal of Plaintiffs' three asserted patents before the Patent Trial and Appeal Board ("PTAB"). *See* [184] at 4. Defendants contend that a stay would conserve resources and preserve judicial economy. Plaintiffs disagree, stating that six of the nine claims against Defendants do not depend on the validity of Plaintiffs' patents, and further noting that a stay would frustrate judicial economy and unduly burden Plaintiffs in the pursuit of their claims. *See* [185] at 2. Upon careful review, the Court DENIES the Motion.

Defendants bear the burden of showing why a stay is warranted, and a court evaluates a motion for a stay holistically. *See DataQuill Ltd. v. BLU Prods., Inc.*, No. 20-20760, [ECF No. 21], at 3 (S.D. Fla. Apr. 10, 2020); *see also Advanced Bodycare Sols., LLC v. Thione Int'l, Inc.*, 524 F.3d 1235, 1241 (11th Cir. 2008) (noting that district courts possess inherent, discretionary authority to issue stays in many circumstances). In evaluating a motion to stay pending *inter partes* review, the Court considers whether (1) the stay would unduly prejudice Plaintiffs; (2) whether the stay would simplify issues in question and trial of the

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case; and (3) whether discovery is complete and a trial date has been set. *See Targus Int'l LLC v. Grp. III Int'l, Inc.*, No. 20-21435, 2021 WL 542675, at *1 (S.D. Fla. Jan. 8, 2021).

Here, a stay would unduly prejudice Plaintiffs given that the PTAB will only resolve three of the nine claims that Plaintiffs have brought against Defendants. None of the six remaining claims depend on the validity of the patents that the PTAB will review. *See InVue Sec. Prods. Inc. v. Vanguard Prods. Grp., Inc.*, No. 18-2548, 2019 WL 3958272, at *2 (M.D. Fla. Aug. 22, 2019) ("[A] party may be prejudiced when it has other claims pending that do not depend on the validity of the patent involved in the *inter partes* review and would nevertheless be put on hold during the stay."). The timing of the Motion also weighs against granting a stay, given that Defendants have petitioned for *inter partes* review three years after receiving notice of potentially infringing activity and nine months *after* Plaintiffs filed their suit. *See MiMedx Grp., Inc. v. Liventa Bioscience, Inc.*, No. 14-1178, 2015 WL 13907479, at *4-5 (N.D. Ga. Apr. 6, 2015) (finding that a nine-month period between filing a complaint and a petition for *inter partes* review would weigh against granting a stay). And in any event, granting a stay would prejudice Plaintiffs--and the Court's judicial efficiency--because Defendants have only submitted a *petition* for *inter partes* review without the PTAB ruling on a post-grant review petition. *See VirtualAgility Inc. v. Salesforce.com, Inc.*, 759 F.3d 1307, 1315-16 (Fed. Cir. 2014) ("While a motion to stay could be granted even before the PTAB rules on a post-grant review petition, no doubt the case for a stay is stronger after post-grant review has been instituted."). Staying the case, and precluding Plaintiffs from litigating their claims based on the *possible expectation* that the PTAB will grant review, is no sensible way for the parties to fairly litigate their case or for the Court to efficiently adjudicate this matter.

As mentioned, two-thirds of Plaintiffs' claims are unrelated to the patent claims the PTAB would resolve. Simplifying Defendants' defenses as to one-third of Plaintiffs' claims would not resolve most of the causes of action asserted in the Complaint; even if *inter partes* proceedings began, the Court would still have to resolve the remainder of Plaintiffs' claims. The weight of authority does not support the suggestion that courts should grant stays pending *inter partes* review where there are non-patent claims unaffected by that proceeding. *See, e.g.*, *MiMedx Grp.*, 2015 WL 13907479, at *4 (finding that that IPR would not streamline issues because plaintiff brought patent infringement, trademark, and unfair competition claims against defendant); *DataQuill Ltd.*, [ECF No. 21], at 4 ("Courts generally deny a stay when not all the patents-at-issue have been challenged and the unchallenged patents would 'languish.'") (citation omitted); *Payrange, Inc. v. Kiosoft Techs., LLC*, No. 20-20970, 2020 WL 9158402, at *2 (S.D. Fla. Nov. 23, 2020) (denying motion to stay because "[r]eview will only resolve issues relating to the '296 Patent" and "claims relating to the '996 Patent will still have to be litigated").

A trial date has already been set, and staying the case would hinder an efficacious resolution of this matter. If the Court grants a stay of the whole case

in order for the PTAB to adjudicate *three* of Plaintiffs' nine claims, it risks delaying the current trial date of October 2025 to an indeterminate date, given that, if the PTAB hears the case, it will have until July 2026 to issue a final decision on the validity of the at-issue patents. *See* 37 C.F.R. § 42.100(c). And if the PTAB extends its own deadline, a final decision may not arise until December 2026. *See id.*. Given that the parties have begun filing claim-construction briefs, *see* [188], [189], and given that the existing trial date is set for October 2025, it makes little sense to delay litigation through a stay for a limited set of issues that may take months to resolve.

Thus, for the foregoing reasons, the Court DENIES Defendants' [184] Motion to Stay Pending *Inter Partes* Review.

Signed by Judge Rodolfo A. Ruiz, II on 2/12/2025. (nn00)

1:24-cv-21226-RAR Notice has been electronically mailed to:

Alice E. Snedeker aesnedeker@duanemorris.com

Allison Nicole Henry ahenry@riveromestre.com, Hslater@aatriallaw.com, paralegals@riveromestre.com

Amir H. Alavi aalavi@aatriallaw.com

Celine Ohanian COhanian@jmbm.com

Connie Flores Jones cfloresjones@aatriallaw.com

David C. Banker dbanker@bushross.com, aflowers@bushross.com, lfowler@bushross.com

Demetrios Anaipakos danaipakos@aatriallaw.com

Elio F. Martinez , Jr elio.martinez@gray-robinson.com, Jessica.Santana@gray-robinson.com

Francesca Russo francesca.russo@gray-robinson.com, Jessica.Santana@gray-robinson.com

Gregory S. Cordrey GCordrey@jmbm.com

Harvey W. Gurland , Jr hwgurland@duanemorris.com, AMJoshua@duanemorris.com, AutoDocketATL@duanemorris.com, AutoDocketMIA@duanemorris.com, BVinci@duanemorris.com, ESanford@duanemorris.com, HWong@duanemorris.com, JMagarin@duanemorris.com, pnmendoza@duanemorris.com

Jonathan Tuminaro jtuminar@sternekessler.com

Jorge Alejandro Mestre jmestre@riveromestre.com, dtenjido@riveromestre.com, npuentes@riveromestre.com, paralegals@riveromestre.com, receptionist@riveromestre.com

Justin Y. Chen jchen@aatriallaw.com

Lena Streisand lStreisand@jmbm.com

Matthew Sean Yungwirth MSYungwirth@duanemorris.com

Michael McBride mmcbride@aatriallaw.com

Michael Specht mspecht@sternekessler.com

Stanley M. Gibson sgibson@jmbm.com

Steven Jugle sjugle@aatriallaw.com

Uma Everett ueverett@sternekessler.com

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