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Attorneys for Plaintiff
MOBILE DATA TECHNOLOGIES LLC

IN THE UNITED STATES DISTRICT COURT

FOR THE NORTHERN DISTRICT OF CALIFORNIA

SAN FRANCISCO DIVISION

MOBILE DATA TECHNOLOGIES LLC, Plaintiff, v. META PLATFORMS, INC., Defendant.	Case No. 3:24-CV-00896-WHA **PLAINTIFF'S UNOPPOSED MOTION TO STAY PROCEEDINGS PENDING INTER PARTES REVIEW** Date: May 23, 2024 Time: 8:00 a.m. Place: Courtroom 12 Jud. Officer: William H. Alsup

EX-1051
U.S. Patent 9,619,578

NOTICE OF MOTION

In accordance with Local Rules 7-2(b) PLEASE TAKE NOTICE that on Thursday, May 23, 2024 at 8:00 a.m., or as soon thereafter as the Court permits, this matter will be heard before the Honorable William Alsup of the above-identified court, located at San Francisco Courthouse, Courtroom 12, 19th Floor, 450 Golden Gate Avenue, San Franciso, CA 94102.

Plaintiff Mobile Data Technologies, LLC ("MDT" or "Plaintiff") will and hereby does move the Court to stay this case until the Patent Trial and Appeal Board ("PTAB") either (1) declines to institute trial on the Petitions for Inter Partes Review ("IPRs") involving the Patents-in-Suit or (2) issues Final Written Decisions ("FWDs") in those IPRs that may be instituted.

STATEMENT OF ISSUES TO BE DECIDED

In accordance with Local Rule 7-4, the sole issue to be decided on this unopposed motion is whether these proceedings should be stayed pending PTAB's consideration of whether to institute IPRs of the Patents in Suit, and if all IPRs are instituted, stayed until PTAB issues FWDs.

I. INTRODUCTION

Plaintiff Mobile Data Technologies, LLC, ("MDT" or "Plaintiff"), without opposition from Defendant Meta Platforms, Inc. ("Meta" or "Defendant"), respectfully moves this Court to stay the instant proceedings pending non-institution and/or FWDs related to the Petitions for Inter Partes Review ("IPRs") that Meta filed against each of the Patents-in-Suit. Plaintiff seeks this stay to conserve the parties' resources and streamline the instant case, which was recently transferred from the Western District of Texas ("WDTX") to this Court. Prior to filing this motion, counsel for Plaintiff met and conferred with Defendant's counsel over the telephone and provided a draft copy of this motion. Opposing counsel indicated that Defendant did not oppose this motion.

In support, MDT incorporates the contemporaneously filed written declaration by MDT's counsel affirming the facts set forth in this motion pursuant to Local Rule 7-5 (Ex. 1). A proposed order is attached pursuant to Local Rule 7-2(c). Further MDT states as follows:

II. FACTS RELATED TO PROCEDURAL POSTURE

The following facts are affirmed by counsel's declaration filed with the instant motion (EX. 1). WDTX recently transferred this matter to this Court in response to Defendant's contested Sec. 1404 Motion which sought transfer based on forum convenience. Prior to transfer, the parties had engaged in venue-related discovery, served initial infringement and invalidity contentions, and fully briefed, but did not argue, the *Markman* hearing. The Parties had also exchanged Rule 26 disclosures and made initial merits discovery requests; however, this matter was transferred prior to the date in which the Parties were to respond to their respective requests. As such, the Parties have not exchanged any merits discovery as of the date of this motion. Effectively, this case comes before this Court with significant work to be done for the Parties to prepare for trial.

Prior to the transfer, Meta filed six Petitions for Inter Partes Review seeking to invalidate each of the Patents-in-Suit and all claims that have been asserted in this proceeding. As part of each of the Petitions, Meta filed a *Soltera* stipulation, which is an assurance with the Patent and Trademark Office that it would forgo any invalidity argument in this action that it could have brought before PTAB should the matter be instituted.[1] Identification of the relevant IPR petitions,

[1] For example, Meta stated in its initial Petition in IPR2024-00246 at 4:

> Nor do the Fintiv factors support discretionary denial under §314(a). The pending litigation against Petitioner is in relatively early stages, with no substantive discovery having taken place to date. Nevertheless, to allay concerns over duplication of efforts, **Petitioner represents that, in the event of institution, it will not pursue in litigation any invalidity defense that was or could have been raised in IPR.**

the respective institution decision dates, and if instituted, the expected Final Written Decision dates, are set forth in the below table:

IPR	Patent	Petition Filed	Patent Owner Preliminary Response Filed	Estimated Institution Decision Deadline[2]	Estimated Final Written Decision Deadline[3]
IPR2024-00246	8793336	Dec. 6, 2023	Mar. 13, 2024	June 13, 2024	June 13, 2025
IPR2024-00247	8825801	Dec. 6, 2023	Mar. 13, 2024	June 13, 2024	June 13, 2025
IPR2024-00248	9032039	Dec. 6, 2023	Mar. 13, 2024	June 13, 2024	June 13, 2025
IPR2024-00249	9619578	Dec. 6, 2023	Mar. 13, 2024	June 13, 2024	June 13, 2025
IPR2024-00250	9922348	Dec. 6, 2023	Mar. 13, 2024	June 13, 2024	June 13, 2025
IPR2024-00251	10839427	Dec. 6, 2023	Mar. 13, 2024	June 13, 2024	June 13, 2025

III. STANDARD FOR GRANTING A STAY

"Courts have inherent power to manage their dockets and stay proceedings, including the authority to order a stay pending conclusion of a PTO reexamination." *Evolutionary Intel., LLC v. Apple, Inc.*, No. C 13-04201 WHA, 2014 WL 93954, at *2 (N.D. Cal. Jan. 9, 2014) (Alsup, J.) (citing *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1426–27 (Fed. Cir. 1988) (citation omitted). "In determining whether to grant a stay pending reexamination, courts consider: (1) whether discovery is complete and whether a trial date has been set; (2) whether a stay will simplify the issues in question and trial of the case; and (3) whether a stay would unduly prejudice or present a clear tactical disadvantage to the non-moving party." *Evolutionary Intel., LLC,* 2014 WL 93954, at *2.

IV. EACH FACTOR FAVORS GRANTING A LIMITED STAY IN THIS PROCEEDING

As this Court may appreciate, this motion comes before it with Plaintiff, not Defendant, affirmatively seeking a stay. This oddity is due to the unique posture in which this case comes

[2] Due within three months after filing of Patent Owner's Preliminary Response. 35 U.S.C. §314(b)(1).

[3] Due within one year from institution. 5 U.S.C. § 316(a)(11); 37 C.F.R. § 42.100(c).

before the Court. When this matter was in WDTX, that court had set an aggressive trial date set, which would have concluded prior to any final written decisions ("FWD") before the Patent and Trademark Appeal Board ("PTAB"). Plaintiff is cognizant that any trial date assigned here would be well-after the PTAB institution decisions in the IPRs in two months, and likely, after the expected issuance of any FWDs in 14 months. Moreover, as set forth above, no merits discovery, other than serving initial Rule 26 disclosures, was conducted in the preceding forum. As such, the first factor flows in favor of granting a stay—merits discovery has not effectively started, and any trial date that would be set would almost certainly be set well-after any FWDs are handed down by PTAB.

As to the second factor, Plaintiff believes that the institution decisions and any FWDs will simply the issues in the case whether the IPRs are instituted, not instituted, or partially instituted. In other words, any outcome from PTAB will streamline the relevant issues in this proceeding.

First, if instituted, Defendant will be required as part of their *Soltera* stipulation to abandon several of its invalidity theories set forth in its existing invalidity contentions. For Plaintiff, in a situation where all petitions are instituted, MDT would prefer to expend its resources contesting the PTAB proceedings rather than committing resources to litigating—through a *Markman* hearing, merits discovery, and dispositive motions—a patent which PTAB has indicated a likelihood of partial or total invalidity.

Second, if none of the petitions are instituted, the written decision from PTAB declining institution would be in hand by June 13, 2024, the same day as the CMC. PTAB's written decisions electing to not institute the petition may provide helpful analysis regarding claim construction and the prior art which may cause the parties to amend their infringement or invalidity contention. Given that the decision would on the same day or sooner than the CMC, the tradeoff in delay for the parties is nonexistent while the utility in having refined infringement and invalidity theories

before engaging in merits discovery is high. Moreover, if none of the IPRs are instituted, this is motion itself becomes a nullity.

Third, if only some of the IPRs are instituted, Plaintiff will likely seek to streamline this proceeding to only assert patents which are not subject to PTAB's review, which would yield the same benefits as stated above.

As to the third factor, prejudice to the non-moving party, most motions to stay come to this Court by Defendants, and so almost universally, the concept of "prejudice" from a stay are from the perspective of a patent plaintiff resisting a stay. In most cases, undersigned counsel would contest the need for a stay, but given the posture outline above, this is a rare instance where it makes sense for a plaintiff to acquiesce to a stay. Given that Meta's is not opposed to this motion, there is no prejudice to the non-moving party in granting the stay.

V. CONCLUSION

For these reasons, MDT respectfully asks that this Court stay this matter pending either (1) a decision from PTAB declining to not institute proceeding as to at least one of the patents in suit, or (2) PTAB issuing final written decisions for the above proceedings.

Dated: April 18, 2024

SPENCER FANE LLP

By: */s/ Erick S. Robinson*

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