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UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA
SAN JOSE DIVISION

WITHROW NETWORKS, INC.,

Plaintiff,

v.

GOOGLE, LLC and YOUTUBE, LLC,

Defendants.

Case No. 5:24-CV-03203-PCP

**DEFENDANTS GOOGLE LLC AND
YOUTUBE LLC'S NOTICE OF MOTION
AND MOTION TO STAY CASE
PENDING THE RESOLUTION OF
PETITION FOR *INTER PARTES*
REVIEW**

Date: May 1, 2025
Time: 10:00 a.m.
Dept.: 8, 4th Floor
Judge: Hon. P. Casey Pitts

Date Filed: May 28, 2024

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NOTICE OF MOTION

PLEASE TAKE NOTICE that at 10:00 a.m. on May 1, 2025 in Courtroom 8 on the Fourth Floor of the above-entitled Court, located at 280 South First Street, San Jose, CA 95113, Defendants Google LLC (“Google”) and YouTube, LLC (“YouTube”) (collectively, “Defendants”) will and hereby do move for an order staying this case pending resolution of Google’s petition for *inter partes* review.

Defendants respectfully move the Court to stay this action pending final resolution of the petition for *inter partes* review (“IPR”) filed by Defendant Google challenging the patentability of all claims of the asserted patent, U.S. Patent No. 10,771,849 (the “’849 Patent”). To best achieve judicial economies and for the reasons described in this motion, the case should be stayed.

As set forth in the accompanying Memorandum of Points and Authorities, all factors weigh in favor of a stay: the case is at a very early stage, Google’s IPR petition will likely significantly simplify or moot the issues before this Court, and a stay will not prejudice Plaintiff Withrow Networks, Inc. (“Withrow”).

Defendants’ Motion is based on this Notice and the accompanying Memorandum of Points and Authorities; the Declaration of Elizabeth H. Dinh filed concurrently herewith; other material which may properly come before the Court at or before the hearing on this Motion; and any oral argument the Court deems appropriate.

MEMORANDUM OF POINTS AND AUTHORITIES

I. INTRODUCTION

On March 24, 2025, Google filed a petition for *inter partes* review (“IPR”) challenging all claims of U.S. Patent No. 10,771,849 (“the ’849 patent”). This IPR has the potential to dispose of this case in its entirety. A stay pending resolution of Google’s IPR petition would conserve valuable judicial and party resources while the Patent Trial and Appeal Board (“PTAB”) considers whether to cancel or modify the patent claims at issue in this litigation. Even if this case were not entirely mooted by the IPR process, a stay could prevent the expense of litigating issues that are likely to become irrelevant to the case.

A stay is particularly appropriate here where the case is still in its early stages and where it would not unduly prejudice the plaintiff. Defendants only recently filed their answer. There has been little written discovery, no depositions, no exchanges or hearing on claim construction, and the trial has not yet been scheduled. Moreover, Plaintiff Withrow Networks, Inc. (“Withrow”) does not seek any injunctive relief and would not have any basis for doing so, and a temporary stay would not affect its request for monetary relief. Furthermore, Withrow is not a competitor of either defendant, and it has no product on the market. A mere delay in potential recovery is not enough to overcome the substantial benefits of waiting until the conclusion of the IPR process to resume this litigation—if there is anything left to resume at that point.

Thus, Defendants respectfully move the Court to stay the case to forestall potentially unnecessary litigation and avoid wasting the Court’s and the parties’ time and resources.

II. BACKGROUND

A. The litigation is in its early stages.

Withrow filed its complaint on May 28, 2024, alleging infringement of the ’849 patent. ECF No. 1. Withrow does not claim to offer any products or services purportedly covered by the ’849 patent, nor does it claim to be a competitor of either defendant. *See id.* Defendants filed a motion to dismiss on August 9, 2024 (ECF No. 35), which this Court denied on January 21, 2024 (ECF No. 44). Defendants answered the Complaint on February 4, 2025, less than two months ago. ECF No. 47. The initial case management conference was held on February 21, 2025. ECF No. 46. No case schedule has yet been set. Pursuant to the Parties’ proposed stipulated case

1 schedule, infringement contentions were served on March 7, and invalidity contentions are due
 2 April 21. ECF No. 48. Claim construction briefing has not begun, and the *Markman* hearing has
 3 not yet been scheduled. *Id.*

4 Meanwhile, discovery is in infancy. Withrow served its first requests for production and
 5 interrogatories on January 30, and Defendants timely served their responses. *See* Declaration of
 6 Elizabeth Dinh, ¶ 4. Withrow served a second set of requests for production on March 13. *Id.*, ¶
 7 6. No depositions have been noticed and other than the document production accompanying
 8 Withrow’s infringement contentions, no documents have been produced. *Id.* ¶ 7. Defendants have
 9 not yet served any discovery requests. *Id.* at ¶ 8. On March 14, the parties filed a stipulated ESI
 10 order and a discovery letter brief regarding certain disputed provisions of a proposed protective
 11 order. *See* ECF Nos. 55, 56. The letter brief is currently pending.

12 **B. The IPR review process is intended to limit the burden of unnecessary**
 13 **litigation.**

14 The IPR process was established in 2012 as part of the America Invents Act to “establish
 15 a more efficient and streamlined patent system that will improve patent quality and limit
 16 unnecessary and counterproductive litigation costs” by creating “a timely, cost-effective
 17 alternative to litigation.” Changes to Implement *Inter Partes* Review Proceedings, Post-Grant
 18 Review Proceedings, and Transitional Program for Covered Business Method Patents, 77 Fed.
 19 Reg. 48680-01, 48680 (Aug. 14, 2012) (codified at 37 C.F.R. §§ 42.100, *et seq.*)).

20 Under 35 U.S.C. § 311(a), any “person who is not the owner of a patent may file ... a
 21 petition to institute an *inter partes* review of the patent.” A petitioner “may request to cancel as
 22 unpatentable 1 or more claims of a patent only on a ground that could be raised under section 102
 23 or 103.” 35 U.S.C. § 311(b). Even pre-institution, courts routinely stay related patent litigation to
 24 avoid costly, duplicative litigation. *See, e.g., Largan Precision Co. v. Motorola Mobility LLC.*,
 25 No. 21-cv-09138-JSW, 2022 WL 2954935, at *4 (N.D. Cal. July 26, 2022); *Uniloc USA Inc. v.*
 26 *LG Elecs. U.S.A. Inc.*, No. 18-cv-06737-JST, 2019 WL 1905161 (N.D. Cal. Apr. 29, 2019).

27 **III. THE COURT SHOULD STAY THIS CASE PENDING IPR**

28 “Courts have inherent power to manage their dockets and stay proceedings, including the
 authority to order a stay pending conclusion of a PTO reexamination.” *Ethicon, Inc. v. Quigg*, 849

1 F.2d 1422, 1426-27 (Fed. Cir. 1988) (internal citation omitted). “While courts are ‘under no
 2 obligation to stay proceedings pending parallel litigation in the PTAB, ... judicial efficiency and
 3 the desire to avoid inconsistent results may, after a careful consideration of the relevant factors,
 4 counsel in favor of a limited stay, even before the PTAB has acted on a petition for IPR.’” *IXI*
 5 *Mobile (R & D) Ltd. v. Samsung Elecs. Co Ltd*, No. 15-cv-03752-HSG, 2015 WL 7015415, at *2
 6 (N.D. Cal. Nov. 12, 2015) (quoting *Delphix Corp. v. Actifio, Inc.*, No. 13-cv-04613-BLF, 2014
 7 WL 6068407, at *2 (N.D. Cal. Nov. 13, 2014)).

8 Here, Defendants seek a stay upon the filing of an IPR petition. As noted in *IXI Mobile*,
 9 courts regularly grant stays before institution of IPR to promote “judicial efficiency and the desire
 10 to avoid inconsistent results.” 2015 WL 7015415, at *2 (internal quotation marks omitted).
 11 “Indeed, some courts in this district have recognized ‘a liberal policy in favor of granting motions
 12 to stay proceedings pending the outcome of USPTO reexamination or reissuance proceedings.’”
 13 *Largan*, 2022 WL 2954935, at *1 (quoting *Pragmatus AV, LLC v. Facebook, Inc.*, No. 11-CV-
 14 02168-EJD, 2011 WL 4802958, at *2 (N.D. Cal. Oct. 11, 2011)); *see also, e.g., Topia Tech., Inc.*
 15 *v. Dropbox Inc.*, No. 23-CV-00062-JSC, 2023 WL 3437823, at *3 (N.D. Cal. May 12, 2023)
 16 (citation and internal quotation marks omitted) (“A stay is particularly appropriate for cases in the
 17 initial stages of litigation or in which there has been little discovery.”); *Viavi Sols. Inc. v.*
 18 *Platinum Optics Tech. Inc.*, No. 5:20-cv-05501-EJD, 2021 WL 1893142, at *1 (N.D. Cal. May
 19 11, 2021) (“[A] stay pending the PTAB’s decision on whether to institute IPR petitions will
 20 promote efficiency by avoiding the expenditure of limited judicial resources.”); *CF Traverse LLC*
 21 *v. Amprius, Inc.*, No. 20-cv-00484-RS, 2020 WL 6820942, at *1 (N.D. Cal. Nov. 6, 2020) (“[T]he
 22 mere specter of non-institution, unaccompanied by the risk of prejudice, is not dispositive.”).

23 Courts consider three factors when deciding whether to stay an action while the PTAB
 24 considers a petition for *inter partes* review: “(1) the stage of the litigation, including whether
 25 discovery is or will be almost completed and whether the matter has been marked for trial; (2)
 26 whether a stay will unduly prejudice or tactically disadvantage the nonmoving party; and (3)
 27 whether a stay will simplify the issues in question and streamline the trial, thereby reducing the
 28 burden of litigation on the parties and on the court.” *Largan*, 2022 WL 2954935, at *2.

1 **A. The pleadings were recently settled and discovery is in its infancy.**

2 The first factor considered in whether to grant a stay is “the progress already made in the
3 case, such as the completion of discovery, the setting of a trial date, and whether claim
4 construction has occurred.” *Symantec Corp. v. Zscaler, Inc.*, No. 17-cv-04426-JST, 2018 WL
5 3539267, at *2 (N.D. Cal. July 23, 2018). Here, this factor weighs strongly in favor of a stay
6 because the case has just begun. As noted above, the pleadings were settled just last month, when
7 Defendants filed their answer. ECF No. 47. Defendants have not yet served invalidity
8 contentions, and claim construction briefing has not begun. *See* ECF No. 48. No trial date has
9 been set. *Id.* Discovery has also just begun; Withrow has served two sets of requests for
10 production and one set of interrogatories. Dinh Decl. ¶¶ 4, 6. Just over a week ago, the parties
11 agreed to an ESI order and filed a joint discovery brief regarding a protective order. ECF Nos. 55,
12 56. No documents have been produced and no depositions have been noticed. Dinh Decl. ¶ 7.

13 This case is thus at a similar stage as in *Columbia Insurance*, where this Court granted a
14 stay when the parties had only recently served initial disclosures, neither had served any
15 discovery, and the scheduled trial date was nearly two years away. *Columbia Ins. Co. v. Simpson*
16 *Strong-Tie Co.*, No. 5:24-cv-01652-PCP, 2024 WL 4752133, at *3 (N.D. Cal. Nov. 12, 2024)
17 (“*Columbia IP*”). Likewise, in another case involving the same parties, this Court found this factor
18 weighed in favor of a stay where the pleadings were complete, but only the first set of
19 interrogatories and document requests had been served and no trial date had been set. *Columbia*
20 *Ins. Co. v. Simpson Strong-Tie Co.*, 703 F. Supp. 3d 1007, 1012 (N.D. Cal. 2023) (“*Columbia P*”).
21 Moreover, courts in this District routinely stay cases that are further along than this one. For
22 example, in *Synopsys*, a stay was granted “even though claim construction [was] complete and the
23 parties ha[d] already engaged in fact discovery.” *Synopsys, Inc. v. Siemens Indus. Software Inc.*,
24 No. 20-cv-04151-WHO, 2022 WL 20508655, at *2 (N.D. Cal. June 7, 2022) (granting post-
25 institution stay). And in *Largan*, the parties had “served mandatory disclosures under the Local
26 Patent Rules, answered initial discovery requests, and produced some documents.” 2022 WL
27 2954935, at *4 (granting pre-institution stay); *see also Trusted Knight Corp. v. Int’l Bus.*
28 *Machines Corp.*, No. 19-cv-01206-EMC, 2020 WL 5107611, at *2 (N.D. Cal. Aug. 31, 2020)
(granting post-institution stay where discovery was ongoing and “claim construction has already

1 occurred”).

2 In contrast, courts have declined to stay cases where the parties have done significantly
3 more work than has been done here. For example, in *Entangled Media*, this Court denied a stay
4 motion where “the parties had spent over fourteen months engaged in discovery, including
5 written discovery, the production of over 47,000 pages of documents, the issuance of subpoenas,
6 and extensive negotiation of a protective order.” *Entangled Media, LLC v. Dropbox Inc.*, 732 F.
7 Supp. 3d 1120, 1123 (N.D. Cal. 2024). In *Haptic, Inc. v. Apple, Inc.*, a stay motion was denied
8 where a “substantial amount of fact discovery has been completed: the parties have exchanged
9 infringement contentions, invalidity contentions, damages contentions, expert reports, several sets
10 of interrogatories and requests for production and have produced over 555,000 pages.” No. 3:24-
11 cv-02296-JSC, 2024 WL 4859080, at *5 (N.D. Cal. Nov. 20, 2024). None of those facts are
12 present here.

13 In sum, there can be no dispute that the vast majority of the work in this case remains to
14 be done. This factor thus strongly weighs in favor of a stay.

15 **B. A stay would simplify the issues and trial of the case.**

16 The second factor also weighs in favor of a stay. If the PTAB institutes Google’s IPR, that
17 IPR will at a minimum simplify issues for trial and could moot this case in its entirety. Should the
18 IPR not be instituted, the stay will be brief and this case can simply resume. For these reasons,
19 courts in this district have granted pre-institution stays where, as here, a case is in its early stages.

20 Google’s IPR petition challenges every claim of the patent-in-suit. Dinh Decl. ¶ 3. As
21 such, the petition has “significant potential to simplify this litigation” because the PTAB “may
22 cancel all of the asserted claims ... , thereby mooting” the case entirely. *Uniloc*, 2019 WL
23 1905161, at *3. Even pre-institution, “where all the asserted claims were challenged in the IPR
24 petitions, courts have found that this factor supports a stay.” *MindbaseHQ LLC v. Google LLC*,
25 No. 21-cv-03603-JST, 2021 WL 6882409, at *2 (N.D. Cal. Nov. 1, 2021). If the PTAB only
26 cancels or modifies some of the claims, “it would still narrow and simplify the scope of the case
27 involving that patent.” *Uniloc*, 2019 WL 1905161, at *3. Indeed, even if the PTAB declines to
28 cancel or modify any of the claims in the patent-in-suit, the IPR process would still simplify the

case. The “statements made by a patent owner during an IPR proceeding can be relied on to support a finding of prosecution disclaimer during claim construction.” *Id.* at *4 (internal quotation marks and citation omitted). Further, if this case is stayed and the PTAB institutes the IPR but some or all claims survive, Google will be estopped from asserting certain invalidity defenses under section 102 and 103 before this Court following the stay. *See* 35 U.S.C. § 315(e). This estoppel—which would apply even if the PTAB ultimately decides not to cancel or modify any of the patent’s claims—would narrow the case and simplify issues for trial. Thus, if instituted, the IPR process will necessarily shape and limit the arguments the parties can make in this Court regardless of the outcome.

Should the IPR not be instituted¹, the stay will be brief and this case can simply resume. As the *Uniloc* court explained, because the PTAB must decide whether or not to institute the IPR within several months, a temporary stay “will cause relatively little delay to this case or prejudice to the parties.” 2019 WL 1905161, at *4; *see also Topia*, 2023 WL 3437823, at *7 (“the potential stay length mitigates harm” because “[i]f the PTAB declines institution, the case will resume. If the PTAB institutes the petitions, at least one claim within the patents is likely invalid, further justifying a stay.”); *Netflix, Inc. v. CA, Inc.*, No. 21-cv-03649-EMC, 2022 WL 1144631, at *2 (N.D. Cal. Mar. 30, 2022) (finding third factor weighs in favor of a stay where PTAB’s IPR decisions were expected in eleven months). The same analysis applies in this case. Here, the PTAB is expected to decide on the IPR petition by the end of September 2025.² A stay at least until the PTAB makes its decision on institution will conserve judicial and party resources and likely simplify the case significantly, especially because Google is challenging all asserted claims in the IPR.

Because an IPR has the potential to greatly simplify issues for a trial, and a time to the

¹ As other courts have found, though, the high rate of IPR institutions also favors a stay. *See* Dinh Decl. ¶ 10, Ex. A (showing a 68% institution rate by petition); *see also Columbia II*, 2024 WL 4752133, at *3 (the “high rate of PGR institution at the PTAB generally” favors a stay); *Topia*, 2023 WL 3437823, at *4 (finding it likely that the PTAB would institute based on PTAB statistics regarding institution).

² *See* 37 CFR § 42.107(b) (patent owner has three months from notice of filing date to file preliminary response to IPR petition); 35 U.S.C. § 314(b) (patent office must make institution decision within three months of patent owner’s response or deadline to file such a response).

1 PTAB's institution decision is brief, courts in this district have granted pre-institution stays
2 where, as here, a case is in its early stages. For example, the *Uniloc* court granted a stay despite
3 the IPR not yet having been instituted for reasons that also exist here. 2019 WL 1905161, at *4-5.
4 First, as here, "all the asserted claims [were] challenged in the IPR petitions." *Id.* at *4. Second,
5 the Court found that because of the impact an IPR proceeding could have on the case, "it would
6 be particularly wasteful to require the parties to proceed with preparations and filings that may be
7 reshaped or entirely mooted a short while later." *Id.*

8 *Entangled Media*, where this Court denied a pre-institution stay, is distinguishable. 732 F.
9 Supp. 3d at 1124. There, the pre-institution stay could not save the parties the great efforts they
10 had *already* expended on discovery. *Id.* at 1123 ("fourteen months engaged in discovery ... the
11 production of over 47,000 pages of documents"). But the early stage of this case means that a pre-
12 institution stay could provide significant efficiency. Discovery, which has barely begun, could be
13 paused.

14 Moreover, claim construction proceedings (which here are expected to take place, in large
15 part, prior to an institution decision) could potentially be avoided by a pre-institution stay. *See*
16 ECF No. 48 (parties' scheduling proposals, largely tracking patent local rules, that contemplate
17 completing claim construction no later September 18, 2025 under either party's proposal). Should
18 the IPR be instituted, the IPR proceedings are very likely to shed light on the parties'
19 understandings of the claim terms, such as the terms "object parameters," "supplied host path
20 identification," and "decoding processes" that Withrow has already indicated will require
21 construction. *See* ECF 36, at 15-16. Withrow's characterization of the scope of these terms
22 (purportedly only for purposes of opposing the motion to dismiss) indicates an intent to construe
23 the terms as something beyond their plain meaning. *Cf.* ECF No. 44, at 8 (noting a claim
24 construction question as to whether certain terms present a specific method of implementing a
25 technical solution). The positions Withrow takes in the IPR on what these terms (and possibly
26 others) mean will necessarily lead to simplification of issues here. Even if Withrow does not
27 expressly propose construing any of these terms, the way it interprets them in responding to the
28 IPR petition will become part of the patent's file history and will inform this Court's decision on

claim construction, if any asserted claim survives the IPR. *See Aylus Networks, Inc. v. Apple Inc.*, 856 F.3d 1353, 1359 (Fed. Cir. 2017); *Evolutionary Intel., LLC v. Sprint Nextel Corp.*, No. C-13-04513, 2014 WL 4802426, at *4 (N.D. Cal. Sept. 26, 2014) (“The IPR proceedings will also add to the [patent’s] prosecution history. Prosecution history is an important part of the intrinsic record relevant to claim construction.”); *In re Cygnus Telecomms. Tech., LLC*, 385 F. Supp. 2d 1022, 1024 (N.D. Cal. 2005) (citation omitted) (“For those claims that survive the reexamination, this court may have a richer prosecution history upon which to base necessary claim construction determinations or reconsideration.”).

Thus, because the IPR has the potential to greatly simplify or even eliminate the issues in this case, and PTAB’s institution decision is expected by the end of September, this factor favors a stay.

C. A stay would not prejudice Withrow or offer Defendants a tactical advantage.

Finally, Withrow would not be prejudiced—and Defendants would gain no tactical advantage—if the Court were to stay this case in favor of the IPR proceeding. Courts consider four sub-factors in assessing potential prejudice to the non-moving party: “(i) the timing of the reexamination request; (ii) the timing of the request for a stay; (iii) the status of reexamination proceedings; and (iv) the relationship between the parties.” *Columbia II*, 2024 WL 4752133, at *3. Collectively, these factors strongly favor a stay.

1. The IPR request was made early in the case.

Google was diligent in filing its IPR petition for all claims of the patent-in-suit. IPR petitions may be filed within one year of service of a complaint alleging infringement of the patent. 35 U.S.C. § 315. Here, Google filed its petition less than 10 months after Withrow filed its complaint. Dinh Decl. ¶ 3. Further, Withrow cannot argue any undue prejudice based on its service of infringement contentions. A number of courts “have found that waiting until after receiving infringement contentions to analyze the claims alleged and then filing petitions for review does not cause undue prejudice.” *Karl Storz Endoscopy-Am., Inc. v. Stryker Corp.*, No. 14-cv-00876-RS, 2015 WL 13727876, at *3 (N.D. Cal. Mar. 30, 2015) (*quoting Cypress Semiconductor Corp. v. GSI Tech., Inc.*, No. 13-cv-02013-JST, 2014 WL 5021100, at *4 (N.D.

Cal. Oct. 7, 2014) (collecting cases)); *see also CF Traverse LLC v. Amprius, Inc.*, No. 20-cv-00484-RS, 2020 WL 6820942, at *1 (N.D. Cal. Nov. 6, 2020) (finding third factor favored pre-institution stay where “[u]pon receipt of [Plaintiff’s] infringement contentions, [Defendant] timely filed its IPR petitions”); *Sec. People, Inc. v. Ojmar US, LLC*, No. 14-cv-04968-HSG, 2015 WL 3453780, at *5 (N.D. Cal. May 29, 2015) (similar). Here, Google filed the petition 17 days after the infringement contentions were served and also notified the Court of its intention to file the petition and motion to stay at the CMC held on February 21. Dinh Decl. ¶ 9. In sum, Google moved with all deliberate speed in seeking PTAB review.

2. Defendants moved for a stay immediately after filing its IPR.

Defendants filed this motion to stay only one day after the IPR petition was filed. Thus, this sub-factor weighs strongly in favor of finding no prejudice to Withrow.

3. The fact that IPR proceedings have not yet been instituted should carry little weight.

Courts in this district regularly grant pre-institution stays. *See, e.g., Cortex MCP, Inc. v. Visa, Inc.*, No. 5:23-cv-05720-EJD, 2024 WL 3511637, at *3 (N.D. Cal. July 22, 2024); *Topia*, 2023 WL 3437823, at *9; *CF Traverse*, 2020 WL 6820942, at *1. This is because any prejudice or disadvantage posed by a pre-institution stay “is lessened” when a case is in its early stages, the potential for issue simplification is great, and the PTAB’s decision will issue soon. *Uniloc*, 2019 WL 1905161, at *6 (granting stay where petitions challenged every asserted claim); *see also MindbaseHQ LLC*, 2021 WL 6882409, at *4 (“the PTO has not yet instituted IPR, but decisions are expected by January 20, 2022 for both asserted patents. While this sub-factor weighs against a stay, [], its weight is lessened by the considerations articulated above.”) (citations omitted).

Again, *Entangled Media*, where this Court denied a pre-institution stay, is distinguishable. In arguing that a stay would cause prejudice, Entangled pointed to the possible loss of “potentially critical” documentary and testimonial evidence regarding the defendant’s pre-suit knowledge of the asserted patents, including specifically plaintiff’s need to secure reliable testimony from a former employee of the defendant. *See* No. 5:23-cv-03264-PCP, ECF No. 84 at 11. Entangled further pointed to its express request for injunctive relief. *Id.* The Court then found a pre-institution stay had “the potential to prejudice Entangled Media by delaying discovery and

the timely resolution of this action, including trial by jury.” *Entangled Media*, 732 F. Supp. 3d at 1125. Withrow cannot demonstrate any comparable prejudice here. Courts “have repeatedly found no undue prejudice unless the patentee makes a specific showing of prejudice beyond the delay necessarily inherent in any stay.” *Synthego Corp. v. Agilent Techs., Inc.*, No. 5:21-cv-07801-EJD, 2022 WL 2704121, at *3 (N.D. Cal. July 12, 2022) (quoting *PersonalWeb Techs., LLC v. Apple Inc.*, 69 F. Supp. 3d 1022, 1029 (N.D. Cal. 2014)); *see also Speir Techs. Ltd. v. Apple, Inc.*, No. 5:23-cv-00095-EJD, 2023 WL 2714931, at *2 (N.D. Cal. Mar. 30, 2023) (“Delay, however, does not result in undue prejudice unless [the patentee] makes a specific showing of prejudice beyond the delay necessarily inherent in any stay”) (quoting *Synthego*, 2022 WL 2704121, at *3) (internal quotation marks omitted); *MindbaseHQ LLC*, 2021 WL 6882409, at *4 (granting stay where patentee “identifie[d] no specific prejudice that a stay would impose”). Rather, Withrow must present evidence that a stay would cause it undue harm. *See Lighting Sci. Grp. Corp. v. Shenzhen Jiawei Photovoltaic Lighting Co.*, No. 16-cv-03886-BLF, 2017 WL 2633131, at *4 (N.D. Cal. June 19, 2017). Here, Withrow—which offers no products, cannot point to any pressing discovery issues, and has sought only monetary damages, ECF No. 1—can establish no such harm. Thus this factor should be given little weight.

4. Withrow is not a competitor and is not seeking an injunction.

The last sub-factor regarding the potential prejudice to Withrow—the relationship between the parties—weighs strongly in favor of a stay as there is no relationship between Defendants and Withrow.

Withrow does not claim to be a competitor of Google or YouTube and, indeed, does not even claim to offer any products. *See Compl.*, ECF No. 1. “Therefore, [Withrow] will not suffer ‘irreparable harm’ from [Defendants’] continued use of the accused technology, and ‘can be fully restored to the *status quo ante* with monetary relief.’” *Uniloc*, 2019 WL 1905161, at *6 (quoting *Software Rights Archive, LLC v. Facebook, Inc.*, No. C–12–3970 RMW, 2013 WL 5225522, at *6 (N.D. Cal. Sept. 17, 2013)); *see also Speir*, 2023 WL 2714931, at *2 (granting stay where patentee was “a non-practicing entity that ‘cannot be prejudiced by a stay because monetary damages provide adequate redress for infringement.’”) (citation omitted).

Further, Withrow does not seek injunctive relief. “[W]hile not dispositive, [a plaintiff’s] failure to pursue a preliminary injunction undermines any argument that it could not be made whole with monetary relief.” *Google LLC v. EcoFactor, Inc.*, No. 21-cv-03220-HSG, 2022 WL 6837715, at *3 (N.D. Cal. Oct. 11, 2022) (citation omitted); *see also Symantec*, 2018 WL 3539267, at *3 (“Failing to seek a preliminary injunction weighs against prejudice because it suggests that money damages would compensate any loss.”). All that Withrow can hope for is to extract monetary damages from Defendants. A stay that may resolve the case and moot this litigation more than makes up for any delay in Withrow’s hoped-for recovery.

All three factors weigh in favor of a stay. Google has challenged all the claims of the ’849 patent in its IPR petition—making it possible that this case will be mooted entirely. This litigation is in its early stages, meaning that a delay may prevent substantial unnecessary work from being undertaken by the Court and parties. And Withrow, a non-practicing entity without any products and that has not requested injunctive relief, will not be unduly prejudiced by a stay as it will only delay possible future money damages.

IV. CONCLUSION

Defendants respectfully request that the Court enter an order staying this case pending resolution of Google’s petition for *inter partes* review.

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