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**UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA**

WITHROW NETWORKS, INC.,
Plaintiff,

vs.

GOOGLE, LLC and YOUTUBE, LLC,
Defendants.

Case No. 5:24-CV-3203-PCP

**PLAINTIFF WITHROW NETWORKS,
INC.'S OPPOSITION TO DEFENDANTS'
MOTION TO STAY**

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

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MEMORANDUM OF POINTS AND AUTHORITIES

I. INTRODUCTION

On May 24, 2024, Plaintiff Withrow Networks, Inc. (“Withrow”), filed its complaint against Defendants Google LLC (“Google”) and YouTube, LLC (“YouTube”) (collectively, “Defendants”). Three hundred days later, and only after this Court denied their Motion to Dismiss for invalidity under 35 U.S.C. § 101, Google filed a Petition for *Inter Partes* Review (the “IPR Petition”) with the Patent Trial and Appeal Board (“PTAB”). The next day, on March 25, 2025, Defendants filed this Motion to Stay without even waiting to see whether the PTAB would institute the requested IPR.

Each of the three factors that courts consider in determining whether to grant a stay pending IPR—(1) the stage of the litigation; (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—weigh against the requested stay. **First**, this case has already progressed significantly, including through the Court’s resolution of Defendants’ Motion to Dismiss challenging the validity of U.S. Patent No. 10,771,849 (the “’849 Patent”), the service of Initial Disclosures, Withrow’s service of discovery requests on Defendants and third-parties Sony Music Entertainment (“Sony”), Warner Music Inc. (“Warner”), and Vevo LLC (“Vevo”), and Withrow’s service of infringement contentions. Moreover, the parties have jointly proposed a case schedule pursuant to which trial in this matter may reasonably be expected to conclude in the summer of 2026, before any final written decision by the PTAB, even if IPR is instituted. **Second**, even if the PTAB institutes Google’s IPR, the likelihood that all asserted claims would be invalidated is relatively low, meaning the Court will nonetheless have to address many, if not all, of Withrow’s claims, and adjudicate Google’s twelve (12) additional defenses that cannot be addressed in the IPR. (Dkt. No. 47, p. 13-15.) **Third**, Withrow would be unduly prejudiced by a stay, including through potential limitation on damages and the heightened risk of lost evidence—particularly the loss of evidence held by unknown third parties that assisted Defendants in adopting the ’849 Patent’s methodology, which may date back over 15 years.

Defendants’ tactical decisions attempting to delay litigation should not be rewarded: refusing to meet under Rule 26(f), thereby preventing discovery from moving forward until the resolution of their § 101 motion, procuring Withrow’s infringement contentions prior to filing an IPR, and continuing to refuse to produce responsive discovery while in parallel moving for a stay of litigation to postpone having to answer for their infringement. Defendants have failed to satisfy their burden justifying a stay, and the motion should be denied outright or, at minimum, denied without prejudice to Defendants’ right to refile the motion to stay in the event the PTAB ultimately decides to institute the IPR with respect to any claims, which could be five months away.

II. BACKGROUND

Since Withrow filed this case in May of 2024, Defendants have sought to delay the proceedings, beginning with requesting a 45-day extension¹ to respond to Withrow’s Complaint. (Dkt. No. 25.) In the meantime, this Court set an initial case management conference (“CMC”) for August 27, 2024 (Dkt. No. 28), making the deadline for the Parties’ 26(f) conference and discovery kick-off on August 6, 2024. This would also require the Parties to submit a proposed schedule for which trial would be set no later than August 27, 2026, according to this Court’s Standing Order.² On August 1, however, Google filed a motion to continue the case management conference, under the guise that its forthcoming motion to dismiss under 35 U.S.C. § 101 “may dispose of the case entirely,” “obviate the need for a CMC and for the parties to conduct a Rule 26(f) conference[.]” and “serve the interests of efficiency[.]” (Dkt. No. 31.) Withrow opposed Google’s motion, arguing that the anticipated motion to dismiss is not sufficient grounds to halt discovery in the case. (*See* Dkt. No. 32, p. 4.) On August 6, 2024, the Court granted Google’s motion to continue the CMC. (Dkt. No. 33.)

The Court ultimately denied Google’s motion to dismiss on January 21, 2025, holding that “the overall method taught in the patent involves a specific enough improvement in the functionality of multimedia streaming on multimedia mobile devices to satisfy the first step of

¹ Google initially requested a 60-day extension but eventually agreed to a 45-day extension.

² https://cand.uscourts.gov/wp-content/uploads/judges/pitts-pcp/PCP_Civil_Standing_Order.pdf

the *Alice* test.” (Dkt. No. 44, p. 8.) Thereafter, the parties finally held their Rule 26(f) conference on January 28, 2025, filed a Joint Case Management Statement on February 7, 2025 (Dkt. No. 48), and participated in the initial CMC on February 21, 2025 (Dkt. No. 46). Google filed its Answer on February 4, 2025. (Dkt. No. 47.)

The parties agreed on a quick time to trial. Claim construction briefing closes on September 18, 2025 (before the anticipated institution decision in the IPR). Dispositive and *Daubert* motion briefing is set roughly eight months from the claim construction ruling. (Dkt. No. 48, p. 12-13.) Moreover, the proposed schedule is consistent with this Court’s requirement to schedule trial within 24 months of the initial CMC.

On January 30, 2025, Withrow served on Google its First Set of Interrogatories and Requests for Production. On March 3, Google served its written responses to Withrow’s discovery requests, but did not serve any documents or provide substantive interrogatory responses, claiming they would do so only after Withrow served its infringement contentions. (Villegas Decl. ¶ 3, Ex. 1, p. 9.) Withrow served a second set of Requests for Production on March 12, 2025. And, on March 20, 2025, Withrow notified Defendants that documentary subpoenas had been sent for service to YouTube streamers Vevo, Sony, and Warner. (Villegas Decl. ¶ 4.)

To date, Google has not produced any documents, provided substantive responses to Withrow’s interrogatories, or served its own discovery requests. There is nothing, however, that would justify Defendants’ delay, especially after the Parties negotiated a Stipulated Protective Order and the Court disposed of all of the disputes therein. (Dkt. No. 61.) According to the Parties’ proposed schedule and Local Patent Rules, Withrow served its infringement contentions and produced over 3,600 pages of materials on March 7, 2025. (Villegas Decl. ¶ 5.) Then on March 24, 2025, Google filed its IPR Petition (*Id.* at ¶ 15.) and Motion to Stay (Dkt. No. 60).

III. THIS COURT SHOULD DECLINE TO STAY THIS CASE.

The circumstances in this case do not warrant a stay. “Courts consider three primary factors in determining whether to stay a case pending inter partes review: ‘(1) whether discovery in the case is complete and whether a trial date has been set; (2) whether a stay would simplify the issues

1 in question and trial of the case; and (3) whether a stay would unduly prejudice or present a clear
 2 tactical disadvantage to the non-moving party.” *Entangled Media, LLC v. Dropbox Inc.*, 732 F.
 3 Supp. 3d 1120, 1123 (N.D. Cal. 2024).

4 The circumstances in this case do not warrant a stay. Defendants’ timing of its Motion to
 5 Stay has little to do with efficiency. Defendants waited nearly a year after Withrow filed its detailed
 6 complaint alleging patent infringement to file its IPR and Motion to Stay. In that time, likely
 7 knowing it would file this IPR and seek a stay, Defendants used this litigation to challenge the
 8 ’849 Patent validity on §101 grounds and, when that failed, used this litigation to procure
 9 Withrow’s infringement contentions. Only then, did Google file its IPR and Motion to Stay—
 10 strategically hoping discovery obligations could be ignored sufficiently long to obtain a stay of
 11 litigation. This gamesmanship should not be tolerated. The Parties are well into this case, resolving
 12 a motion to dismiss and proposing a schedule that would lead to an **agreed upon** speedy time to
 13 trial that could be resolved before the PTAB’s final written decision is due. Any purported
 14 efficiencies from the IPR are purely speculative and, indeed, unlikely, given that the PTAB is
 15 unlikely to institute the IPR. The PTAB routinely denies institution where parallel litigation may
 16 resolve before the final written decision is due and where the IPR petition relies on references that
 17 the USPTO has already considered—both the case here. Moreover, a stay could limit Withrow’s
 18 damages for products Withrow learns infringe through discovery and seriously jeopardize damages
 19 evidence held by third parties involved in Defendants’ adoption of the inventive methodology of
 20 the ’849 Patent—the identity of such third parties likely contained within the documents that
 21 Defendants refuse to provide. Any further delay risks losing evidence that may already be over a
 22 decade old.

23 **A. A pre-institution stay would delay the speedy resolution of this matter.**

24 For the first stay factor, courts consider “whether the case has progressed significantly
 25 enough for a stay to be disfavored.” *Platform Inc. v. Aviagames Inc.*, Case No. 21-cv-02436-BLF,
 26 2022 U.S. Dist. LEXIS 73230 at *5 (N.D. Cal. Apr. 13, 2022). This applies here. Defendants would
 27 have the Court believe this case has “just begun” (*see* Dkt. No. 60, p. 5.), despite being nearly one-
 28 year old.

From the outset, Defendants have sought to halt discovery. Through a series of large chunks and small nibbles, Defendants have stalled this case. For example, Defendants refused to schedule a Rule 26(f) conference until August 6, 2024, the very last day for such a meeting. (Villegas Decl. ¶ 6.). As explained in Withrow’s opposition to continue the CMC, “Defendants hope this Court will issue a continuance [based on a §101 motion to dismiss] before the August 6, 2024 Rule 26(f) deadline, thereby establishing a *de facto* stay of all discovery.” (Dkt No. 32, p. 1). The same day the court continued the initial CMC, Defendants cancelled the Rule 26(f) conference. (Villegas Decl. ¶ 7.) On January 21, 2025, the Court issued an order denying Defendants’ §101 motion, whereupon the next day Withrow requested a Rule 26(f) conference. Only on January 28, 2025, the day Google agreed to finally hold a Rule 26(f) conference, was the *de facto* stay of discovery lifted.

Withrow has made significant efforts to move this case along. Withrow served and Defendants responded to a First Set of Interrogatories and Requests for Production. (Dkt. No. 60, p. 3.). On March 7, 2025, Withrow served extensive Infringement Contentions against three (3) Defendant instrumentalities (YouTube, Google Transcoder API, and Google Livestream API), many with multiple variants, totaling over 700 pages of analysis. (Villegas Decl., at ¶ 5.) Additionally, Withrow’s contentions were accompanied by over 3,600 pages of materials. (*Id.*) Withrow served on Defendants a Second Set of Requests for Production on March 13. (Dkt. No. 60, p. 3.). An ESI Order that required approximately four (4) weeks of negotiation was entered on March 24, 2025 (Dkt No. 59), and a heavily disputed Protective Order was resolved by Magistrate DeMarchi on March 28, 2025 (Dkt No. 61). Lastly, Withrow issued third-party subpoenas to three (3) of YouTube’s streaming partners. *Supra*, at 3.

In contrast, Defendants have used every trick in the book to avoid discovery. Conspicuously, they have issued no document requests or interrogatories of their own. Moreover, despite a meet-and-confer and several email exchanges, Defendants have refused to provide any information or documents on the improper basis that they are not required to produce *any* materials due to alleged “deficiencies” in Withrow’s infringement contentions. (Villegas Decl. ¶ 3.) While Defendants’ allegations are baseless, they serve a critical role in their overall litigation strategy: to

1 provide enough delay to obtain a full stay of litigation without producing a single page of paper.
 2 Thus, Defendants’ self-serving claim that the case should be stayed because “[n]o documents have
 3 been produced” should carry no weight, as this is only true because Defendants have refused to
 4 participate in discovery. (Dkt. No. 60, p. 5.)

5 The Parties and Court have also invested meaningful resources to investigate the eligibility
 6 of the ’849 Patent claims, resulting in a full round of briefing and a hearing that consumed the
 7 entire allotted time for argument. (Dkt. No. 44.)

8 Finally, by the time the PTAB issues its institution decision (expected around October 8,
 9 2025), the Parties will have completed claim construction briefing. (*See* Dkt. No. 48, Ex. 1, p. 12.)

10 Because this case is well underway and the Parties and this Court have invested significant
 11 time and resources for a speedy resolution, there is no reason to derail the Parties’ progress at this
 12 point in time.

13 This Court has previously found similar circumstances weighed against a stay in *Entangled*
 14 *Media, LLC v. Dropbox Inc.*, 732 F. Supp. 3d 1120, 1123 (N.D. Cal. 2024) (J. Pitts). In *Entangled*
 15 *Media*, this Court found that the parties had engaged in “written discovery, the production of over
 16 47,000 pages of documents, the issuance of subpoenas, and extensive negotiation of a protective
 17 order” and “[t]he Court has already heard and issued a decision on [the defendant’s] motion to
 18 dismiss.” *Id.* This rationale applies with equal force here. The Parties have engaged in written
 19 discovery, issued subpoenas, negotiated a protective order, the Court has denied Google’s motion
 20 to dismiss, and the Parties have submitted a schedule that could resolve this case in short order.
 21 Furthermore, Defendants’ claim that “the parties [in *Entangled Media*] have done significantly
 22 more work than has been done here” (Dkt. No. 60, p. 6), plainly seeks to exploit Defendants’ own
 23 self-serving refusal to engage in discovery, which should not be rewarded.

24 The cases Defendants rely on are inapposite. The reasoning in *Columbia Ins. Co. v.*
 25 *Simpson Strong-Tie Co., Inc. I* and *II* was based on unique facts not applicable here. 703 F. Supp.
 26 3d 1007 (N.D. Cal. 2023) (“*Columbia I*”); No. 5:24-cv-01652-PCP, 2024 WL 4752133 (N.D. Cal.
 27 Nov. 12, 2024) (“*Columbia II*”). There, the defendant had successfully challenged at the PTAB
 28 several *related* patents that stemmed from the same parent application, making it “high[ly] likely”

that the PTAB would institute the proceedings and “weigh[ed] heavily in favor of a stay.” *Columbia II*, 2024 U.S. Dist. 205394, at *8. Notably, there was little analysis of the stage of litigation. In *Synopsys, Inc. v. Siemens Indus. Software Inc.*, the court analyzed the factors in light of the fact that the PTAB had *already* instituted three of the four IPRs at issue. 2022 U.S. Dist. LEXIS 244276, at *3. And in *Largan Precision Co. v. Motorola Mobility LLC*, the defendant had stipulated that “if the IPRs are instituted, it will not pursue in this litigation any ground raised, or that could have been reasonably raised, in the IPRs,” increasing the chances the PTAB would institute the IPR petition in view of the parallel litigation. 2022 U.S. Dist. LEXIS 132610, at *2. Defendants have not so stipulated here. As explained below, Google’s IPR has not been and is unlikely to be instituted.

Accordingly, the first factor weighs in favor of denying Defendants’ Motion to Stay.

B. A pre-institution stay would not simplify the issues.

“The second factor courts consider is whether a stay will simplify the issues in question and trial of the case.” *Platform*, 2022 U.S. Dist. LEXIS 73230, at *7 (internal quotations omitted). The PTAB has not instituted Google’s IPR and is unlikely to do so, making Defendants’ claim that the IPR “has the potential to greatly simplify issues” unlikely and speculative at this stage. “[C]ourts regularly deny stays prior to institution of IPRs, since any simplification is speculative.” *Id.* at *7-8. “A court is under no obligation to stay proceedings pending parallel litigation in the PTAB.” *Dicon Fiber optics, Inc. v. Preciseley Microtechnology Corp.*, No. 15-cv-01362-BLF, 2015 U.S. Dist. LEXIS 188626, at *2 (N.D. Cal. Oct. 13, 2015) (citing *Aylus Networks, Inc. v. Apple, Inc.*, No. C-13-4700 EMC, 2014 U.S. Dist. LEXIS 157228, at *1 (N.D. Cal. Nov. 6, 2014)). “This is especially true when the Patent Office has yet to decide whether to institute IPR proceedings.” *Aylus Networks*, 2014 U.S. Dist. LEXIS 157228 at *2; *see also Nat’l Prods. Inc. v. Innovative Intelligent Prods., LLC*, No. C20-428, 2021 U.S. Dist. LEXIS 119122, at *2 (W.D. Wash. June 25, 2021) (“Without knowing whether the PTAB will institute the requested [IPR] reviews, the Court, consistent with other courts deciding such motions under the same timeframe, finds the request to be premature.”). Moreover, in *Loyalty Conversion Sys. Corp. v. Am. Airlines, Inc.*, the court observed, “[T]he majority of courts that have addressed the issue have postponed

1 ruling on stay requests or have denied stay requests when the PTAB has not yet acted on the
 2 petition for review,” referencing an extensive survey of stays pending IPRs and reexaminations,
 3 including those for the District of Delaware, Eastern District of Virginia., District of Minnesota,
 4 Western District of Wisconsin., Middle District of Florida., and Northern District of California.
 5 No. 2:13-CV-655, 2014 U.S. Dist. LEXIS 102978, at *5 (E.D. Tex. July 29, 2014). Here, this
 6 Court should follow the majority approach and deny Defendants’ pre-institution Motion to Stay.

7 The premise that Google’s IPR might simplify issues is based on the assumption that the
 8 PTAB will institute the IPR in the first place. But that is unlikely. **First**, the PTAB is unlikely to
 9 institute the IPR under 35 U.S.C. § 314(a) because there is a reasonable chance that this case could
 10 resolve before the PTAB would issue a final written decision in the IPR, meaning “efficiency is
 11 best served by denying institution.” *Apple Inc. v. Fintiv*, IPR2020-00019, Paper 15, p. 17 (PTAB
 12 May 13, 2020) (Villegas Decl. ¶ 8). Pursuant to a preceding precedential order, setting forth the
 13 proper analysis for assessing how parallel proceedings impact discretionary denials under 35
 14 U.S.C. § 314(a) (setting forth the “*Fintiv* factors”)³ the PTAB in *Apple Inc. v. Fintiv*, confirmed
 15 that “[i]n exercising the Director’s discretion under 35 U.S.C. § 314(a), the Board may consider
 16 ‘events in other proceedings related to the same patent, either at the Office, in district courts, or
 17 the ITC’” and denied institution where trial was scheduled to begin before the PTAB would reach
 18 a final decision. *Id.* After the *Fintiv* decision, the PTAB regularly denied institution where the trial
 19 date was scheduled before the IPR final written decision would issue. *See e.g., Samsung Elecs.*
 20 *Co., Ltd. v. Bell Northern Research, LLC*, IPR2020-00717, Paper 12 (PTAB Oct. 6, 2020)
 21 (Villegas Decl. ¶ 9); *Google LLC v. AGIS Software Development, LLC*, IPR2020-00871, Paper 16
 22 (PTAB Nov. 25, 2020) (Villegas Decl. ¶ 10); *Cisco Systems, Inc. v. Monarch Networking Solutions*
 23 *LLC*, IPR2020-01227, Paper 11 (PTAB Mar. 4, 2021) (Villegas Decl. ¶ 11). On March 24, 2025,
 24 the Chief Administrative Patent Judge issued a memorandum confirming that the PTAB was to
 25 consider the *Fintiv* factors on deciding institution where there was a parallel litigation. (Villegas
 26

27
 28 ³ See Villegas Decl. ¶ 14.

Decl. ¶ 12.) Withrow intends to file a request with the PTAB to deny institution based on the *Fintiv* factors.⁴

The PTAB will consider the following five factors in deciding whether to deny institution under *Fintiv*:

1. Whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted;
2. Proximity of the court’s trial date to the Board’s projected statutory deadline for a final written decision;
3. Investment in the parallel proceeding by the court and the parties;
4. Overlap between the issues raised in the petition and in the parallel proceeding;
5. Whether the petitioner and the defendant in the parallel proceeding are the same party; and
6. Other circumstances that impact the Board’s exercise of discretion, including the merits.

Fintiv, at pp. 6–7, (Villegas Decl. ¶ 8). Setting aside factor 1, as this Court has not, of course, issued a stay in this case as of the date of this filing, the remaining factors all weigh against institution. As to the **second factor**, the Parties have jointly proposed a speedy schedule on which trial could occur by the summer of 2026. (Dkt. No. 48, Exhibit 1.) Under that schedule, claim construction briefing would be finished by September 18, 2025, which is before the PTAB’s institution decision would even be due. And assuming a claim construction ruling issues within two months,⁵ the Parties would finish *Daubert* and dispositive motion briefing by July 2026. On the other hand, Google filed its IPR petition on March 24, 2024, but the PTAB has not yet given notice of a filing date. Once that notice has been issued, Withrow will have three months from that date to file its preliminary response, and the PTAB will have three months from that date to issue

⁴ On March 26, 2025, a memorandum was issued under the Secretary of Commerce and Director of the USPTO, reenforcing the discretionary authority of the PTAB to deny institution as a discretionary matter, and now permitting separate briefing of discretionary denials under, for example, the *Fintiv* factors to “maintain its capacity to conduct AIA proceedings[.]” Villegas Decl. at ¶ 13 (Interim Processes for PTAB).

⁵ Given that this case involves one patent and nine claims, a two-month estimate seems reasonable. *See Trove Brands, LLC v. CamelBak Products, LLC*, 5:23-cv-04267 (N.D. Cal.) (J. Pitts) (claim construction order issued 45 days after *Markman* hearing).

an institution decision. Thus, if notice is provided today, the PTAB’s institution decision would be due October 8, 2025, and, assuming the IPR is instituted on that date, a final written decision due October 8, 2026.⁶ As to the *third factor*, the Parties and Court have expended significant resources to get where they are in this case. *Supra* at 4-7. And by the time the PTAB issues an institution decision, claim construction briefing will be finished, and an order may have issued. Further, this Court has resolved substantive issues in this case, including invalidity under § 101. *See Fintiv*, Villegas Decl. ¶ 8, Ex. 6, p. 17 (denying institution, reasoning that “the District Court has expended effort resolving substantive issues in the case”). As to the *fourth factor*, the overlap of issues in this case are complete: the same patent and claims are at issue in this case and in the IPR petition, and Defendants have asserted an invalidity defense in its Answer, including obviousness under § 103—the same basis for Google’s IPR petition. (Dkt. No. 47, Third Defense.) As Google has not yet provided its Invalidity Contentions, thereby preventing Withrow from a full analysis of this factor, at worst this point is neutral. As to the *fifth factor*, Google is both the petitioner and a defendant in this case. Finally, as to the *sixth factor*, as explained more below, the merits of Google’s IPR petition are weak, as its primary reference is a prior art patent that the USPTO has **already considered** when it examined the patent application that led to the ’849 Patent. Specifically, the IPR is based on five (5) § 103 grounds of alleged invalidity, all premised on a single primary piece of prior art. The PTAB is also likely to deny Google’s petition under 35 U.S.C. § 325(d), because the USPTO has already considered and issued the ’849 Patent over that same prior art. Under § 325(d), “the Director may take into account whether, and reject the petition or request because, the same or substantially the same prior art or arguments previously were presented to the Office.” “Previously presented art includes art made of record by the Examiner, and art provided to the Office by an application, such as on an Information Disclosure Statement (IDS), in the prosecution history of the challenged patent.” *Ivantis v. Sight*, IPR2022-01530 (PTAB), p. 9 (internal quotation omitted) (Villegas Decl. ¶ 14). This is the case here. Google’s primary reference for its obviousness arguments in its petition is U.S. Patent No. 6,389,473 to

⁶ See <https://www.uspto.gov/patents/ptab/trials/aia-trial-types>.

Carmel. (Villegas Decl. ¶ 15, Ex. 13, p. 3.) The USPTO examiner already considered this reference and nevertheless issued the '849 Patent, as seen on the cover of the Patent (Dkt. No. 1-1):

(56)

References Cited

U.S. PATENT DOCUMENTS

5,434,678	A	7/1995	Abecassis
5,434,860	A	7/1995	Riddle
5,579,239	A	11/1996	Freeman et al.
5,610,841	A	3/1997	Tanaka et al.
5,612,742	A	3/1997	Krause et al.
5,751,883	A	5/1998	Ottesen et al.
5,751,968	A	5/1998	Cohen
5,819,160	A	10/1998	Foladare et al.
5,821,986	A	10/1998	Yuan et al.
5,841,432	A	11/1998	Carmel et al.
5,892,915	A	4/1999	Duso et al.
5,903,673	A	5/1999	Wang et al.
5,928,330	A	7/1999	Goetz et al.
5,933,603	A	8/1999	Vahalia et al.
5,953,506	A	9/1999	Kalra et al.
5,974,503	A	10/1999	Venkatesh et al.
5,987,510	A	11/1999	Imai et al.
5,996,015	A	11/1999	Day et al.
6,014,694	A	1/2000	Aharoni et al.
6,014,706	A	1/2000	Cannon et al.
6,032,193	A	2/2000	Sullivan
6,112,226	A	8/2000	Weaver et al.
6,119,154	A	9/2000	Weaver et al.
6,138,147	A	10/2000	Weaver et al.
6,151,632	A	11/2000	Chaddha et al.
6,195,352	B1	2/2001	Cushman et al.
6,292,834	B1	9/2001	Ravi et al.
6,385,596	B1	5/2002	Wiser et al.
6,389,473	B1	5/2002	Carmel et al.

This is grounds for the PTAB to deny Google's petition, both under the language of § 325 and because this is evidence that Carmel is not a sound basis to invalidate the '849 Patent. For example, in *Ivantis v. Sight*, IPR2022-01530, the PTAB denied institution where the primary reference in the petition was simply a *family member* of a reference cited on the cover of the patent at issue, reasoning that “the Examiner considered many similar prior art references, including references containing the same figures that Petitioner asserts here, during the prosecution leading to the [challenged] patent.” *Id.* at p. 14. Here, not only is the prior art similar, but it is *identical*. Accordingly, for this separate reason, the PTAB is unlikely to institute the IPR.

1 Finally, the PTAB's capacity to institute IPRs has recently been diminished due to the
 2 USPTO's announcement that it would be laying off administrative judges. Indeed, many anticipate
 3 that the rate of discretionary denials of IPRs may increase for this reason.⁷

4 Accordingly, this Court should deny Defendants' Motion for Stay and at least wait to see
 5 if Google's petition is instituted, which is questionable at best.

6 Moreover, even assuming that Defendants' IPR is instituted, the scope of that proceeding
 7 will be limited to patentability of the patent's nine claims. *See* § 35 U.S.C. 311(b). As a result, if
 8 even a single asserted claim is upheld through the IPR process, numerous issues including
 9 infringement, damages, and other validity grounds will still need to be resolved through this Court.
 10 And, here, the likelihood of Withrow's patent claims being upheld through the IPR process is
 11 especially great because: (i) the '849 Patent claims priority back to 2005; (ii) the primary reference
 12 in Defendants' IPR petition was considered by the patent examiner during the prosecution of the
 13 '849 Patent; (iii) Google's IPR petition does not allege a single 35 U.S.C. § 102 reference
 14 containing all of the claim elements; and (iv) the '849 Patent includes nine separate claims, each
 15 of which may survive. *See* '849 Patent. Simply put, the grounds Google asserts in its petition are
 16 weak and the '849 Patent is likely to survive an IPR—in the unlikely event that the PTAB even
 17 decides to institute an IPR proceeding.

18 As a result, the second factor weighs in favor of denying Defendants' Motion to Stay.

19 **C. Plaintiff would suffer undue prejudice if a pre-institution stay is entered.**

20 "The third factor courts consider in assessing whether a stay is appropriate is whether a
 21 stay would unduly prejudice or present a clear tactical disadvantage to the nonmoving party."
 22 *Platform Inc.*, 2022 U.S. Dist. LEXIS 73230 at *10. When evaluating this factor, "[c]ourts
 23 typically consider four subfactors: (1) the timing of the petition for review; (2) the timing of the
 24 request for the stay; (3) the status of review proceedings; and (4) the relationship of the parties."
 25 *Id.* Courts also consider whether a stay will increase the likelihood of loss of evidence. *Sorensen*

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 27 ⁷ [https://www.bakerlaw.com/insights/will-fewer-ptab-judges-increase-the-rate-of-discretionary-](https://www.bakerlaw.com/insights/will-fewer-ptab-judges-increase-the-rate-of-discretionary-denials-of-iprs-and-pgrs/)
 28 [denials-of-iprs-and-pgrs/](https://www.bakerlaw.com/insights/will-fewer-ptab-judges-increase-the-rate-of-discretionary-denials-of-iprs-and-pgrs/)

1 *v. AmPro Tools Corp.*, 2009 U.S. Dist. LEXIS 21627, at *6 (N.D. Cal. Mar. 9, 2009) (citing
 2 *Telemac Corp. v. Teledigital, Inc.*, 450 F. Supp. 2d 1107, 1111 (N.D. Cal. 2006) (concluding that
 3 staying the case could lead to "further loss of information" and a "tactical advantage.")).

4 The first two subfactors, assessing the timing of the petition and motion to stay, weigh
 5 against a stay. Defendants waited nearly a year after this action commenced to file its petition and
 6 move for a stay. In that time, while likely knowing it intended to file an IPR petition, Defendants
 7 moved this Court to dismiss Withrow’s claims, arguing that the ’849 Patent was invalid under §
 8 101 *and* jointly proposed an aggressive schedule to get this case to trial. Where the defendant has
 9 been “less than expedient in requesting a stay, courts have focused their inquiry on whether there
 10 has been dispositive motion practice.” *Int’l Test Solutions, Inc. v. Mipox Int’l Corp.*, Case No. 16-
 11 cv-00791-RS, 2017 U.S. Dist. LEXIS 54627, at *4 (N.D. Cal. Apr. 10, 2017) (denying motion for
 12 stay). Google timed its IPR petition just *after* it extracted what it could out of this litigation for its
 13 own purposes—an early attempt to invalidate the ’849 Patent which delayed discovery, and
 14 Withrow’s infringement contentions. In other words, Defendants timed its motion to stay and IPR
 15 petition to its tactical advantage. Only after the Court denied their motion to dismiss and Withrow
 16 expended considerable time and resources preparing and serving its extensive infringement
 17 contentions, did Defendants announce their intention to stay this case to “prevent the expense[—
 18 apparently only *Defendants’ own*—]of litigating issues[.]” (Dkt. No. 60, p. 2.) In *Entangled Media*,
 19 this Court found that a stay would unduly prejudice the plaintiff where the defendant “waited
 20 almost one year after this action commenced and only a few days before the one-year statute of
 21 limitations ran.” 732 F. Supp. 3d at 1125. This rationale applies here as well.

22 Defendants’ suggestion that it somehow needed Withrow’s infringement contentions
 23 before filing its IPR has no basis in logic or patent law. Even if the PTAB institutes the IPR, the
 24 issue will be whether Google’s proposed combinations of *prior art*—not Google’s accused
 25 instrumentalities—disclose each claim element in the ’849 Patent. Withrow’s analysis of how
 26 Defendants’ accused instrumentalities infringe the ’849 Patent will play no part in the PTAB’s
 27 analysis or Google’s invalidity arguments—unsurprisingly, Withrow’s infringement contentions
 28 play no role in Google’s invalidity assessment in its IPR petition.

1 “Under the third subfactor, the Court considers whether the status of [the] IPR proceedings
 2 indicates that a stay would prejudice [the plaintiff].” *Platform Inc.*, 2022 U.S. Dist. LEXIS 73230
 3 at *13. Importantly, Defendants’ request is pre-institution, and “since the PTAB may decide not
 4 to institute IPR, there is a possibility that a 5-month stay would only delay the case without any
 5 benefit to the Court or the parties.” *Id.* This risk is exacerbated here by the several reasons outlined
 6 above that make it unlikely that the PTAB will institute Google’s petition.

7 A stay could also unduly prejudice Withrow by substantially limiting its potential damages
 8 with respect to Google TV—a streaming service that is likely an Accused Instrumentality. That
 9 service was identified in Withrow’s Patent Rule 3-1 disclosures. (Decl. of Villegas, at ¶ 5, Ex. 3,
 10 p. 3.) More specifically, Google TV will require extensive third-party discovery as it relies on the
 11 HLS and MPEG-DASH streams of third-party providers, channeled through Google’s own
 12 streaming platform and mobile device applications. As Withrow could not chart Google TV due
 13 to its encryption, that service is not yet in the case. However, the ’849 Patent expires on April 26,
 14 2025, meaning Withrow’s damages will be eroded for **every day** a stay remains in place beyond
 15 the ’849 Patent’s expiration date. This would result in damages limited to six years prior to the
 16 filing of an amendment (unless this Court were to hold otherwise, *see, e.g. Anza Tech., Inc. v.*
 17 *Mushkin, Inc.*, 934 F.3d 1359, 1365 (Fed. Cir. 2019)), which as described further below, could
 18 take three (3) years to fully resolve an IPR, meaning half of Withrow’s six (6) years of statutory
 19 damages as to Google TV could be imperiled.

20 Additionally, a lengthy stay in this matter would unduly prejudice Withrow, as it would
 21 increase the risk of losing critical evidence. This litigation presents a unique fact pattern given the
 22 early date of the invention’s constructive reduction to practice (2005), the date on which Google
 23 likely began using the infringing method (2009), and the issuance date of the ’849 Patent (2020).
 24 This unique timeline suggests critical evidence may date to over a decade ago.

25 The ’849 Patent relates back to a parent application filed in 2005. (Dkt. No. 1-1.) By 2007,
 26 Withrow’s predecessor company had launched an Adaptive Bitrate (“ABR”) mobile streaming site
 27 (Movy.tv) that was years ahead of Google’s rudimentary RTSP streaming based technologies.
 28 (Dkt. No. 1 at ¶ 17-19.) In 2009, Google finally realized that a better and more efficient manner of

streaming was necessary, rather than “delivering video in giant loaves of bread.” (*Id.* at ¶ 23.) It needed to employ ABR to remain competitive in “the new world” of streaming. (*Id.*) However, Google at the time was a newcomer to streaming and could not develop its own ABR system. Instead, it relied on Adobe and at least four years of hard work to make the technology work. (*Id.* at ¶ 23-24.) This, however, was only the start of Google’s streaming evolution. Eventually, Google adopted industry standards that coopted the ’849 Patent’s technology, including HTTP Live Streaming (“HLS”) (published in 2009) and Dynamic Adaptive Streaming over HTTP (“MPEG-DASH”) (ratified in 2011)—the streaming standards at issue in this case. As used by Defendants, these standards provide solutions to the problem of fluid video playback on mobile devices—the same problem that Withrow’s technology solved years earlier (*id.* at ¶ 26) and issued as a patent in 2020 (Dkt. No. 1-1).

This long history of the ’849 Patent and Google’s infringing technology means relevant evidence in this case involves documents and memories from long ago. A stay however, that within the PTAB could last as long as 18 months, could unfairly jeopardized evidence in this case. For example, third-party documents, created around the time of Google’s initial 2009 partnership with Adobe, which coincided with the publishing of some of the first HTTP based streaming standards, would demonstrate the market’s need to move away from server-driven streaming solutions, to HTTP-based architectures that now dominate streaming. Such documents and testimony would be highly relevant to demonstrate the utility and advantages of the patent over prior streaming modes and the extent to which the market (including Google) made use of the invention—factors under the *Georgia Pacific* reasonable royalty analysis. *Georgia-Pac. Corp. v. U.S. Plywood Corp.*, 318 F. Supp. 1116, 1120 (S.D.N.Y. 1970) (cleaned up).

Moreover, Withrow may elect to present a cost-avoidance damages model, where monies due Withrow are measured in view of costs and revenues foregone if at the hypothetical negotiation (issuance of the ’849 Patent), the Accused Instrumentalities were forced to shut down, due to a lack of feasible non-infringing alternative. Thus, the historical evolution of streaming, which will require third-party discovery, is critical to demonstrate the existence, or not, of alternatives streaming solutions. *See, e.g., Kalman v. Berlyn Corp.*, 914 F.2d 1473, 1484 (Fed. Cir. 1990),

opinion clarified, No. 89-1371, 1991 WL 345039 (Fed. Cir. Mar. 4, 1991) (“It is clear that “[a] product lacking the advantages of [the] patented [device] can hardly be termed a substitute “acceptable” to the customer who wants those advantages.”) (citations omitted).

While some of the above information may be held by Google, many items will solely be in the possession of third parties—none of whom have any duty to preserve evidence. And although Withrow has served discovery requests to learn about Google’s streaming evolution, Google has not meaningfully responded or produced any documents. Critically, these materials would identify parties, other than Adobe, with whom Google has had contact concerning ABR technology, or any alternatives. Whereas Withrow intends to issue a subpoena to Adobe within a week that should preserve that specific material, nothing prevents third parties from destroying critical evidence, absent a duty to preserve. *Bright Solutions for Dyslexia, Inc. v. Doe 1*, No. 15-CV-01618-JSC, 2015 WL 5159125, at *3 (N.D. Cal. Sep. 2, 2015) (“[t]he need for [a preservation] order is all the more pressing here, where the entities that have the information Plaintiffs need are not parties and thus have no duty to preserve absent a court order.”).

To date, Defendants have refused to produce any documents, including those that would identify technology collaborators, thereby preventing Withrow from issuing subpoenas directed to critical damages information, among other topics. This delay is not mere garden variety recalcitrance. By impeding discovery in conjunction with a stay of litigation, Defendants unfairly exploit the erosion of evidence due to the passage of time. **First**, through a tactical series of delays (refusing to hold a Rule 26 conference, thereby creating a de facto stay of litigation until the motion to dismiss was resolved (*see*, Dkt. No. 32, at 1), and now alleging they do not understand the infringement contentions and for that reason cannot proceed with discovery (Villegas Decl. at ¶ 3). **Second**, a stay of litigation could result in an over 3-year delay. The PTAB attempts to limit the time from petition to final written decision to around 18 months, but the time could be longer depending on how long it takes the PTAB to give notice of a filing date, which triggers the patent owner preliminary response date (for example, Google filed its IPR on March 24, but the PTAB has not given a filing date as of the date of this filing). In addition, for good cause, the PTAB may extend the final written decision deadline another six months. 35 U.S.C. §§ 316(a)(11). Moreover,

1 if an appeal is required, that could add over a year.⁸ Given that highly relevant third-party
2 discovery in this case may already be over fifteen (15) years old, additional delay creates
3 unjustified evidentiary risk.

4 Finally, Defendants' argument that a stay is warranted because Withrow did not seek
5 injunctive relief should bear little weight here in light of the undue prejudice Withrow faces. (Dkt.
6 No. 60, p. 17.) Notably, several courts have rejected this argument, noting that "[a] party may
7 decide to forego seeking a preliminary injunction for a variety of reasons having nothing to do
8 with its view of the merits." *Verinata Health, Inc. v. Ariosa Diagnostics, Inc.*, No. C 12-05501 SI,
9 2014 U.S. Dist. LEXIS 4025, at *10 (N.D. Cal. Jan. 13, 2014). Although Plaintiff has not sought
10 injunctive relief, it will nevertheless suffer the undue prejudice set forth above. For these reasons,
11 the third factor weighs in favor of denying Google's Motion to Stay.

12 **IV. CONCLUSION**

13 In the instant matter, Defendants have moved for a stay before any IPR institution
14 decision, and Withrow will suffer undue prejudice if Defendants' pre-institution request to stay
15 this proceeding is granted. Moreover, any potential benefits of a stay in simplifying the issues in
16 this case are both speculative and unlikely. Accordingly, Withrow respectfully requests that this
17 Court deny Defendants' pre-institution Motion to Stay, enter the proposed schedule that was
18 jointly requested by the parties less than two months ago in their Joint Case Management
19 Statement, and allow this matter to proceed, at least until the IPR renders its institution decision.

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27 ⁸ [https://www.sterneckessler.com/news-insights/publications/data-and-trends-aia-ptab-appeals-](https://www.sterneckessler.com/news-insights/publications/data-and-trends-aia-ptab-appeals-federal-circuit-2/)
28 [federal-circuit-2/](https://www.sterneckessler.com/news-insights/publications/data-and-trends-aia-ptab-appeals-federal-circuit-2/).

1 Dated: April 8, 2025

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CERTIFICATE OF SERVICE

The undersigned attorney certifies that on April 8, 2025, I directed electronic filing of the foregoing with the Clerk of Courts using the CM/ECF system, which will send notification of such filing to all counsel on record in this matter.

/s/ Mark McDougall