3 Results

Types of Document: Motion to Stay Pending Inter Partes Review **Judges:** Yvonne Gonzalez Rogers

Type of Document	Result of ...	Case	Date	Appeal Status
Motion to Stay Pending Inter Partes Review	Denied	Universal Connectivity Technologies Inc. v. HP Inc. 5-24-cv-04097 (NDCA)	Nov. 04, 2024	
Motion to Stay Pending Inter Partes Review	Granted	InfoExpress Inc. v. Cisco Systems, Inc. 4-23-cv-02698 (NDCA)	Jun. 03, 2024	
Motion to Stay Pending Inter Partes Review	Granted	InfoExpress Inc. v. Fortinet, Inc. 4-23-cv-04389 (NDCA)	Jun. 03, 2024	
Motion to Stay Pending Inter Partes Review	Granted	Gentex Corporation et al v. Meta Platforms, Inc. et al 4-22-cv-03892 (NDCA)	Mar. 31, 2023	
Motion to Stay Pending Inter Partes Review	Granted	Gesture Technology Partners, LLC v. Apple, Inc. 4-22-cv-04806 (NDCA)	Mar. 13, 2023	

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

The court extended the stay pending *inter partes* review and administratively closed the case. "[T]he Court understands related appeals are pending before the Patent Trial and Appeal Board and the Federal Circuit, and the case may be simplified by the resolution of those appeals. The Court finds it prudent to extend the stay until September. If the resolution of those appeals has not concluded, then the balance may shift to opening the case as to the one claim which will proceed in all events. The Court finds that given the various equities, one more six-month stay will not prejudice the plaintiff."

Motion to Stay Pending Inter Partes Review	Granted	BillJCo, LLC v. Apple, Inc. 4-22-cv-03201 (NDCA)	Sep. 08, 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 granted defendant's motion to stay pending *inter partes* review because the stage of the case, potential simplification of issues, and lack of undue prejudice favored a stay. "[N]o trial schedule has been set in this case, discovery prior to the case being transferred into this district was limited to jurisdictional issues, all of the asserted patents are already under IPR review, and a decision from the PTAB would simplify the issues before this Court and promote judicial economy. . . . [A] stay would not prejudice or tactically disadvantage the plaintiff since the IPR petitions were filed within eight months of the complaint being filed. . . . [G]iven the tone and nature of the plaintiff's briefing, the Court also notes that plaintiff sought a tactical advantage by filing the action in the Western District of Texas. That it took over a year for the Federal Circuit to redirect the action to the proper forum, is not the result of misconduct by the defendant and should not serve as a penalty."

Motion to Stay Pending Inter Partes Review	Granted	Zoho Corporation v. Sentius International, LLC 4-19-cv-00001 (NDCA)	May. 17, 2022	
Motion to Stay Pending Inter Partes Review	Granted	Omni MedSci, Inc. v. Apple Inc. 4-20-cv-00563 (NDCA)	Dec. 06, 2021	
Motion to Stay Pending Inter Partes Review	Granted	NextGen Innovations, LLC v. II-VI, Inc. et al 4-21-cv-07477 (NDCA)	Nov. 09, 2021	
Motion to Stay Pending Inter Partes Review	Denied without prejudice	10Tales, Inc. v. TikTok, Inc. 5-21-cv-03868 (NDCA)	Sep. 29, 2021	

Stay of Proceedings
└ Factors Considered
└ **Likelihood Of Success (Stay)**

The court denied without prejudice defendants' motion to stay pending their petition for *inter partes* review. "[T]he [PTAB] denied defendants' petition for *inter partes* review and that defendant is now seeking a rehearing of the PTAB's decision. Given the unlikelihood of the PTAB granting defendant's request for rehearing, the Court denies without prejudice defendants' motion to stay. Should the PTAB grant defendants' rehearing request, defendants may file an amended motion to stay within twenty-one days of the order."

Motion to Stay Pending Inter Partes Review	Granted	Cellspin Soft, Inc. v. Nikon Americas, Inc. et al 4-17-cv-05936 (NDCA)	Feb. 12, 2021	
Motion to Stay Pending Inter Partes Review	Granted	Zoho Corporation v. Sentius International, LLC 4-19-cv-00001 (NDCA)	Nov. 09, 2020	
Motion to Stay Pending Inter Partes Review	Granted	Sentius International, LLC v. Apple Inc. 4-20-cv-00477 (NDCA)	Nov. 05, 2020	
Motion to Stay Pending Inter Partes Review	Granted	Uniloc 2017 LLC v. Google LLC 4-20-cv-05346 (NDCA)	Oct. 28, 2020	

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Motion to Stay Pending Inter Partes Review	Granted	Uniloc 2017 LLC v. Google LLC 4-20-cv-05345 (NDCA)	Oct. 28, 2020	
Motion to Stay Pending Inter Partes Review	Granted	Uniloc 2017 LLC et al v. Google LLC 4-20-cv-05341 (NDCA)	Sep. 21, 2020	
Motion to Stay Pending Inter Partes Review	Granted	Uniloc 2017 LLC et al v. Google LLC 4-20-cv-05334 (NDCA)	Sep. 21, 2020	
Motion to Stay Pending Inter Partes Review	Granted	Uniloc 2017 LLC et al v. Google LLC 4-20-cv-05339 (NDCA)	Sep. 21, 2020	
Motion to Stay Pending Inter Partes Review	Granted	Uniloc 2017 LLC et al v. Google LLC 4-20-cv-05330 (NDCA)	Aug. 24, 2020	
Motion to Stay Pending Inter Partes Review	Denied in part granted in part	Uniloc 2017 LLC et al v. Google LLC 4-20-cv-04355 (NDCA)	Jul. 24, 2020	
Motion to Stay Pending Inter Partes Review	Granted	Cellspin Soft, Inc. v. Garmin International, Inc. et al 4-20-cv-03673 (NDCA)	Jul. 17, 2020	
Motion to Stay Pending Inter Partes Review	Granted	Impinj, Inc. v. NXP USA, Inc. 4-19-cv-03161 (NDCA)	Mar. 30, 2020	
Motion to Stay Pending Inter Partes Review	Granted	Cellspin Soft, Inc. v. Garmin International, Inc. et al 4-17-cv-05934 (NDCA)	Feb. 11, 2020	
Motion to Stay Pending Inter Partes Review	Granted	Omni MedSci, Inc. v. Apple Inc. 4-19-cv-05924 (NDCA)	Nov. 20, 2019	
Motion to Stay Pending Inter Partes Review	Granted	Omni MedSci, Inc. v. Apple Inc. 4-19-cv-05673 (NDCA)	Nov. 20, 2019	
Motion to Stay Pending Inter Partes Review	Denied as moot	Cellspin Soft, Inc. v. Garmin International, Inc. et al 4-17-cv-05934 (NDCA)	Sep. 30, 2019	
Motion to Stay Pending Inter Partes Review	Granted	Windy City Innovations, LLC v. Microsoft Corporation 4-16-cv-01729 (NDCA)	Dec. 28, 2016	
Motion to Stay Pending Inter Partes Review	Granted	Grecia v. DISH Network, LLC 4-16-cv-00588 (NDCA)	Jun. 13, 2016	
Motion to Stay Pending Inter Partes Review	Denied in part granted in part	Grecia v. DISH Network, LLC 4-16-cv-00588 (NDCA)	May. 03, 2016	

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

The court conditionally granted defendant's motion to stay pending *inter partes* review so long as defendant agreed to limited estoppel. "[Plaintiff] asks the Court to enter a stay pending IPR with the condition that [defendant] 'may not assert in this action that claim 1 of the [patent-in-suit] is invalid on any grounds that [the third party petitioner] raised or reasonably could have raised during the IPR proceeding.'. . . [Defendant] claims it has no involvement in the ongoing prosecution of the IPR by [the third party]. . . . Accordingly, the Court declines to subject [defendant] to the full estoppel provided in Section 315(e)(2), much less the broader language requested by [plaintiff]. . . . [Defendant] argues an immediate stay of this action absent estoppel would still simplify this case and thus estoppel is unnecessary. On this point the Court disagrees. Requiring a defendant who is not a party to the IPR proceedings 'to submit to a weaker estoppel foreclosing it from litigating claims made and finally determined in the IPR proceedings is necessary to effect the PTO's interest in protecting the integrity of PTO proceedings and in preventing parties from having a 'second bite at the apple.' The Court therefore grants the motion . . . conditioned on [defendant's] agreement to be estopped from asserting any invalidity contention that was actually raised and finally adjudicated in a written decision in [the third party's] IPR proceedings."

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Motion to Stay Pending Inter Partes Review	Granted	Netlist, Inc v. Smart Modular Technologies, Inc. et al 4-13-cv-05889 (NDCA)	Apr. 09, 2015	

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 defendant's renewed motion to stay pending *inter partes* review after the PTAB decision to grant the majority of the petitions regarding seven patents-in-suit because the potential simplification of issues, stage of the case, and lack of undue prejudice favored a stay. "[T]he change in circumstances here — namely, the PTAB's determination to proceed with review on the majority of claims — strongly indicates that a stay would simplify the case and avoid duplicative litigation. . . . The Court is mindful that direct competition between parties tends to favor granting a stay. However, the evidence of competition here is equivocal, at least, in light of the record and verdict in the related trade secrets and breach of contract action between [plaintiff] and [defendant]. Moreover, any potential prejudice to [plaintiff] is overshadowed by the number of issues as to which the PTAB now has granted review. With respect to those claims where review has not been granted, they are intertwined with the technology at issue in the sole alleged infringing product."

Motion to Stay Pending Inter Partes Review	Granted	PersonalWeb Technologies LLC et al v. Apple Inc. 5-14-cv-01683 (NDCA)	Sep. 24, 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 granted defendant's motion to stay pending *inter partes* review of 15 of 34 of plaintiff's asserted claims because the stage of the case, potential simplification of issues, and lack of undue prejudice weighed in favor of a stay. "[A]lready the parties have undertaken significant work, but the Court has not set a trial date and several costly stages of discovery remain. Moreover, the landscape of the litigation could change dramatically in light of any PTAB ruling and the parties should have the benefit of that change before making strategic choices for trial. . . . All seven patents claim priority to [the same application] and share a common specification. Moreover, all patents involve the same subject matter. . . . Thus, the PTAB's final decision regarding the claims subject to *inter partes* review may overlap with claims not subject to *inter partes* review. This overlap will further simplify the issues and trial of this case, thus increasing judicial economy and conserving both the parties' and the Court's resources. . . . [S]peculative harm to licensing efforts does not supply a reason to deny a stay."

Motion to Stay Pending Inter Partes Review	Granted	Affinity Labs of Texas, LLC v. Samsung Electronics Co., Ltd et al 4-14-cv-02717 (NDCA)	Aug. 14, 2014	
Motion to Stay Pending Inter Partes Review	Granted	Affinity Labs of Texas, LLC v. Samsung Electronics Co., Ltd. et al 4-14-cv-02966 (NDCA)	Aug. 01, 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 granted defendant's motion to stay pending *inter partes* review, *ex parte* reexamination, and *inter partes* reexamination because the stage of the case, potential simplification of issues, and lack of undue prejudice weighed in favor of a stay. "[S]ignificant work has been undertaken already in a different jurisdiction, but significant work remains, fact discovery is not yet closed, and no trial date has been set. . . . [W]here all the asserted patents are under review and a substantial portion of the asserted claims are under rejection, this factor weighs overwhelmingly in favor of a stay. . . . It is undisputed that, for each petition [defendants] filed, they waited until the last day of the statutory filing period. Extreme delay of that sort weighs unequivocally against a stay. Nevertheless, this is but one circumstance among many and, on balance, it does not outweigh the substantial likelihood that many of the claims asserted in this litigation will be mooted."

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