

**IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF TEXAS
MARSHALL DIVISION**

UNILOC USA, INC. et al

Plaintiffs,

v.

RINGCENTRAL, INC.

Defendant.

AMAZON.COM, INC. et al,

RINGCENTRAL, INC.,

Defendants.

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CIVIL ACTION NO. 2:17-cv-354-JRG

CONSOLIDATED LEAD CASE

JURY TRIAL DEMANDED

CIVIL ACTION NO. 2:17-cv-228-JRG

CIVIL ACTION NO. 2:17-cv-355-JRG

UNOPPOSED MOTION TO STAY PENDING IPR

Plaintiffs Uniloc USA, Inc. and Uniloc Luxembourg, S.A. request that the Court stay the above-captioned RingCentral cases pending resolution of IPR proceedings involving the patents-in-suit. This motion is similar to an opposed motion previously filed (See Dkt. Nos. 93 and 94). Uniloc and Defendant RingCentral, Inc. (“RingCentral”) have reached an agreement regarding a stay with the clarification that such a stay would be without prejudice to, or waiver of, RingCentral’s fully-briefed and pending challenge to venue. As such, RingCentral is unopposed to this request.

BACKGROUND

Recently, three new *inter-parts review* trials have been instituted, one for each of the patents-in-suit: U.S. Patent Nos. 7,804,948 (the ‘948 Patent); 7,853,000 (‘the 000 Patent); and (the ‘194 Patent) (together the “Patents-in-Suit”). See IPR2017-01683 for U.S. Patent No. 8,571,194 (the ‘194 Patent); IPR2017-01684 U.S. Patent No. 7,853,000 (the ‘000 Patent); and IPR2017-01685 U.S. Patent No. 7,804,948 (the ‘948 Patent). Earlier in 2017, several other IPRs were also instituted. See *table below*.

The table below tabulates all currently pending IPR trials on the three Patents-in-Suit.

IPR Trial Instituted

IPR2016-01756	Turner - '194 patent	16-Mar-17
IPR2017-00058	Turner - '948 patent	11-Apr-17
IPR2017-00198	Turner - '000 patent	21-Apr-17
IPR2017-00597	Turner - '194 patent	26-Jun-17
IPR2017-01685	Turner - '948 patent	16-Jan-18
IPR2017-1683	Turner - '194 patent	17-Jan-18
IPR2017-1684	Turner - '000 patent	18-Jan-18

Courts have stayed the following cases involving the Patents-in-suit pending resolution of one or more of these instituted IPRs:

- *Uniloc USA, Inc. et al v. Kik Interactive, Inc.* (consolidated) E.D. TX 2-17-cv-00346
- *Uniloc USA, Inc. et al v. Avaya Inc.* (consolidated) E.D. TX 6-15-cv-01168
- *Uniloc USA, Inc. et al v. Google LLC* (consolidated) E.D. TX 2-16-cv-00566
- *Uniloc USA, Inc. et al v. Cisco Systems, Inc.*, W.D. WA 2-17-cv-00527

Seven IPRs have now been instituted collectively involving the Patents-in-Suit. A stay pending a PTAB decision on the IPR Trial has been entered in every other case involving the Patents-in-Suit, including in *Uniloc USA, Inc. v. Kik Interactive, Inc.*, where Uniloc in good faith reconsidered its position and withdrew its opposition to a stay after institution of the most recent IPRs. See *Uniloc USA, Inc. v. Kik Interactive, Inc.*, Case No. 2:17-cv-00346-JRG-RSP (E.D. Tex. January 30, 2018); *Uniloc USA, Inc. v. Samsung Electronics Am., Inc.*, 2:16-cv-642-JRG, Dkt. No. 268 (E.D. Tex. June 13, 2017); *Uniloc USA, Inc. v. Avaya*, 6:15-cv-01168-JRG, Dkt. No. 231 (E.D. Tex. June 13, 2017). On January 30, 2018, in the *Kik* case, this Court granted a stay “[b]ecause a stay would simplify if not resolve the issues and because a stay pending IPR has previously been entered in cases involving the same [patents-in-suit].”

ARGUMENT

District courts have inherent power to manage their dockets by staying proceedings pending the conclusion of *inter partes* review. See *Landis v. N. Am. Co.*, 299 U.S. 248, 254-55 (1936); *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1426-27 (Fed. Cir. 1988); *NFC Tech. LLC v. HTC Am., Inc.*, No. 2:13-cv-1058, 2015 WL 1069111, at *4 (E.D. Tex. Mar. 11, 2015) (Bryson, J., sitting by designation). Courts consider three factors when deciding whether to grant a stay pending IPR: (1) “[W]hether the proceedings before the court have reached an advanced stage, including whether discovery is complete and a trial date has been set,” (2) “whether the stay will likely result in simplifying the case before the court,” and (3) “whether the stay will unduly prejudice the nonmoving party.” *NFC Tech.*, 2015 WL 1069111, at *2.

“A stay is particularly justified when the outcome of a [PTAB] proceeding is likely to assist the court in determining patent validity.” *Id.* at *1 (internal quotations omitted). As the Federal Circuit and this Court have acknowledged, “an auxiliary function [of the proceeding] is to free the court from any need to consider prior art without the benefit of the [PTAB]’s consideration.” *Norman IP Holdings, LLC v. TP-Link Techs. Co.*, No. 6:13-cv-384, 2014 WL 5035718, at *2 (E.D. Tex. Oct. 8, 2014) (quoting *In re Etter*, 756 F.2d 852, 857 (Fed. Cir. 1985)).

Here, the cases have not reached an advanced stage (there has been no claim construction hearing or order), a stay will likely result in simplifying the case (as this Court already determined under identical circumstances in *Kik*), and the stay will not prejudice the nonmoving parties. Specifically, staying determination of defendants’ pending transfer motions until after resolution of the IPRs will cause no prejudice to defendants (as these cases would likely be immediately stayed by the transferee court if they were transferred during the IPRs) and will avoid burdening this Court with determining transfer motions that may become unnecessary depending on the

outcome of the IPRs.

Uniloc has filed Motions to Compel against both Amazon and Ring Central to comply with the local rules and produce documents. Briefing on the Amazon motion is still underway. Additionally, both Amazon and Ring Central have filed Motions to Transfer venue.

Uniloc therefore respectfully requests that this Court enter an order staying the above-captioned RingCentral cases pending resolution of IPR2016-01756; IPR2017-00058; IPR2017-00198; IPR2017-00597; IPR2017-01683; IPR2017-01684; and IPR2017-01685.

Dated: February 8, 2018

Respectfully submitted,

/s/ Ryan S. Loveless

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ATTORNEYS FOR UNILOC

CERTIFICATE OF SERVICE

I certify that on February 8, 2018 the foregoing document was served upon all counsel of record via the court's electronic filing system in accordance with the Federal Rules of Civil Procedure.

/s/ Ryan S. Loveless
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