

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

BOXCAST INC.,

Plaintiff,

v.

RESI MEDIA LLC, PUSHPAY, INC.,
PUSHPAY HOLDINGS LTD.,

Defendants.

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CIVIL ACTION NO. 2:21-CV-00217-JRG

ORDER

Before the Court is Defendant Resi Media LLC’s (“Resi”) Motion to Stay Proceedings Pending *Inter Partes* Review (the “Motion”). (Dkt. No. 40). In the Motion, Resi asks the Court to stay all proceedings in the above-captioned matter pending the Patent Trial and Appeal Board’s (“PTAB”) *inter partes* review (“IPR”) of the patent-in-suit.

Plaintiff BoxCast Inc. (“BoxCast”) has asserted two patents against Resi: U.S. Patent Nos. 9,686,574 (the “574 Patent”) and 10,154,317 (the “317 Patent”) (collectively, “the Asserted Patents”). (Dkt. No. 28). Resi has filed IPR petitions, challenging the patentability of all claims of the Asserted Patents. (Dkt. No. 40 at 1). The petitions challenging the Asserted Patents were filed on October 15, 2021.¹ (*Id.*). The PTAB has not yet decided whether to institute *inter partes* review of the Asserted Patents.

The district court has the inherent power to control its own docket, including the power to stay proceedings. *Clinton v. Jones*, 520 U.S. 681, 706 (1997). How to best manage the court’s docket “calls for the exercise of judgment, which must weigh competing interests and maintain an even balance.” *Landis v. N. Am. Co.*, 299 U.S. 248, 254–55 (1936).

¹ IPR2022-66 and IPR2022-67.

“District courts typically consider three factors when determining whether to grant a stay pending *inter partes* review of a patent in suit: (1) whether the stay will unduly prejudice the nonmoving party, (2) whether the proceedings before the court have reached an advanced stage, including whether discovery is complete and a trial date has been set, and (3) whether the stay will likely result in simplifying the case before the court.” *NFC Techs. LLC v. HTC Am., Inc.*, Case No. 2:13-cv-1058-WCB, 2015 WL 1069111, at *2 (E.D. Tex. Mar. 11, 2015) (Bryson, J.). “Based on th[ese] factors, courts determine whether the benefits of a stay outweigh the inherent costs of postponing resolution of the litigation.” *Id.*

Where a motion to stay is filed before the PTAB institutes any proceeding, courts often withhold a ruling pending action on the petition by the PTAB or deny the motion without prejudice to refiling in the event that the PTAB institutes a proceeding. *VirtualAgility Inc. v. Salesforce.com, Inc.*, 759 F.3d 1307, 1316 (Fed. Cir. 2014) (citing *Checkfree Corp. v. Metavante Corp.*, No. 12-cv-15, 2014 WL 466023, at *1 (M.D. Fla. Jan. 17, 2014)); *see also NFC Techs.*, 2015 WL 1069111, at *6. Indeed, this Court has a consistent practice of denying motions to stay when the PTAB has yet to institute post-grant proceedings. *Trover Group, Inc. v. Dedicated Micros USA*, No. 2:13-cv-1047-WCB, 2015 WL 1069179, at *6 (E.D. Tex. Mar. 11, 2015) (Bryson, J.) (“This Court’s survey of cases from the Eastern District of Texas shows that when the PTAB has not yet acted on a petition for *inter partes* review, the courts have uniformly denied motions for a stay.”).

Considering these circumstances, the Court concludes that Resi’s motion is premature, and a stay of these proceedings in advance of the PTAB’s decision on whether or not to institute *inter partes* review of the Asserted Patents should be denied. Accordingly, the Motion is **DENIED WITHOUT PREJUDICE** to refiling of the same, which shall be permitted within fourteen (14) days following the PTAB’s institution decision.

So Ordered this

Dec 1, 2021

A handwritten signature in black ink that reads "Rodney Gilstrap". The signature is written in a cursive style with a large initial 'R' and 'G'.

RODNEY GILSTRAP
UNITED STATES DISTRICT JUDGE