

tactical disadvantage to the Plaintiff (who consents to the motion); 2) both parties will benefit from an early determination regarding invalidity, as conducted by the U.S. Patent & Trademark Office; 3) this early determination will simplify the issues in this case; 4) Defendant's *inter partes* reexamination request will be binding on the Defendant; and 5) discovery in the case has just begun and no trial date has been set.

District courts have broad discretionary power to grant stays in patent cases. See, e.g., Procter & Gamble Co. v. Kraft Foods Global, Inc., 549 F.3d 842, 849 (Fed. Cir. 2008); eCOMSYSTEMS, Inc. v. Shared Marketing Services, Inc., Slip Copy, 2011 WL 280942 (M.D. Fla. Jan. 26, 2011). “There is no *per se* rule requiring that patent cases be stayed pending reexaminations because such a rule ‘would invite parties to unilaterally derail’ litigation.” eCOMSYSTEMS, 2011 WL 280942, *2 (citations omitted). When requested, courts generally examine: 1) whether a stay will unduly prejudice or tactically disadvantage the non-moving party; 2) whether a stay will simplify the issues and streamline the trial; and 3) whether a stay will reduce the burden of litigation on the parties and on the court. Id. Courts also examine whether discovery has been completed in the current or related cases and the length of the litigation between the two parties. See, e.g., Baxa Corp. v. Forhealth Tech., Inc., 2006 WL 4756455, *1 (M.D. Fla. May 5, 2006).

First, neither parties contend that a stay will result in undue prejudice or tactically disadvantage the Plaintiff. Second, granting the stay may likely streamline the trial as this is an *inter partes* reexamination which “has great potential for simplifying the issues” due to its *res judicata* effect.³ See, e.g., Tomco Equip., Co. v. Southeastern Agri-Systems, Inc., 542 F. Supp.

relitigate any issue addressed by the PTO.”

2d 1303, 1309 (N.D. Ga. 2008). Third, while there is no evidence that a stay will necessarily reduce the burden of litigation on the Court, the Defendant represents that it will reduce said burden on the parties. Moreover, while this case was initiated in August 2010 in the Northern District of Illinois (Doc. 1), it was only recently transferred to this Court on April 14, 2011 (Docs. 45, 46, 47) and a Rule 16(b) Scheduling Order was just issued on June 23, 2011, scheduling the close of discovery as March 30, 2012. (Doc. 70). Further, the U.S. Patent & Trademark Office's Notice of *Inter Partes* Reexamination Request Filing Date indicates that entry of a stay will not result in excessive delay, as a decision on the request "will be mailed within three months from the filing date[.]" (Doc. 74-2). Finally, the Court notes that this is a consent motion, and thus, both parties agree to entry of an order staying of this case.

Accordingly, based on a balancing of foregoing factors and the representations of Defendant (with Plaintiff's consent), it is **ORDERED** that the Defendant's Consent Motion is **GRANTED**; this action is **STAYED** pending resolution of the U.S. Patent & Trademark Office's *inter partes* reexamination of the 153 Patent. It is further **ORDERED** that the parties shall file a Joint Status Report within **fourteen (14) days** of the U.S. Patent & Trademark Office's determination or by **December 1, 2011**, whichever occurs first.

DONE and ORDERED this the **18th** day of **July 2011**.

/s/ Kristi K. DuBose
KRISTI K. DuBOSE
UNITED STATES DISTRICT JUDGE

³ As noted in Tomco, 542 F. Supp. 2d at 1309: "It has a *res judicata* effect, and it allows the court to consider the expertise of the PTO before making its own conclusions. Because the *inter partes* review provides the third party the right to participate, in the reexamination process, the results of the reexamination are binding on the third party requester. 35 U.S.C. §§ 314(b)(2), 315(c). ...the *inter partes* reexamination is very likely to simplify issues before this Court because the defendant cannot relitigate any of the issues determined by the PTO. *Id.* ..."[T]he technical expertise provided by the reexamination proceeding will be helpful to the Court on any issues that remain."