

1 Brian E. Mitchell (SBN 190095)
 Jigang Jin (SBN 239465)
 2 MITCHELL + COMPANY, LAW
 OFFICES
 3 4 Embarcadero Center, Suite 1400
 San Francisco, CA 94111
 4 Telephone: (415) 766-3515
 Facsimile: (415) 402-0058
 5 Email: info@mcolawoffices.com

6 Craig C. Daniel (SBN 212588)
 Axcel Law Partners LLP
 7 Four Embarcadero Center, 14th Floor
 San Francisco, CA 94111
 8 Telephone: 415-0704-8800
 Facsimile: 415-704-8804
 9 cdaniel@ax-law.com

D. James Pak (SBN 194331)
 BAKER & McKENZIE LLP
 12544 High Bluff Drive, Third Floor
 San Diego, CA 92130-3051
 Telephone: +1 858 523 6200
 Facsimile: +1 858 259 8290
 D.James.Pak@bakermckenzie.com

Tod Gamlen (SBN 83458)
 BAKER & McKENZIE LLP
 660 Hansen Way
 Palo Alto, California 94304
 Tel: (650) 856-5504
 Fax: (650) 856-9299
 Tod.Gamlen@bakermckenzie.com

Attorneys for Defendant Suprema, Inc.

10 Attorneys for Plaintiff SecuGen Corporation

11
 12 **UNITED STATES DISTRICT COURT**
 13 **NORTHERN DISTRICT OF CALIFORNIA**
 14 **SAN FRANCISCO DIVISION**

15 **SECUGEN CORPORATION**

16 **Plaintiff,**

17 **v.**

18 **SUPREMA, INC., et al.**

19 **Defendants.**

Case No. 11-CV-3450 SI

20
 21
 22
 23
 24
 25
 26
 27
 28

**STIPULATION AND [~~PROPOSED~~]
 ORDER TEMPORARILY STAYING
 CASE**

1 Plaintiff SecuGen Corporation (“SecuGen”) and Defendant Suprema, Inc.
2 (“Suprema”) hereby stipulate as follows:

3 WHEREAS, there are currently two pending lawsuits between SecuGen and
4 Suprema;

5 WHEREAS, on July 14, 2011, Plaintiff SecuGen filed this action for patent
6 infringement against Defendant Suprema [D.I. 1] (“the SecuGen Patent Infringement
7 Action”);

8 WHEREAS, on October 14, 2011, SecuGen filed a First Amended Complaint
9 adding as defendants RBH Access Technologies, Inc., RBH USA, Inc. and Apirary,
10 Inc. on the basis that they market or re-sell Suprema’s products in the United States
11 [D.I. 15];

12 WHEREAS, Suprema’s response to the First Amended Complaint is due on
13 December 1, 2011 [D.I. 18], and the Case Management Conference has been
14 scheduled for January 13, 2012 [D.I. 13];

15 WHEREAS, on June 7, 2011, prior to the filing of the present action, Suprema
16 filed a Declaratory Judgment action in this District Court against SecuGen, seeking,
17 *inter alia*, a declaration as valid and enforceable a “No Proceeding Clause” in an OEM
18 Agreement between Suprema and SecuGen dated May 6, 2009, [Case No. 3:11-cv-
19 02783-WHA (“the Suprema Contract Action”)]. SecuGen denies that the “No
20 Proceeding Clause” is valid and enforceable, and has counterclaimed for breach of
21 contract and fraud,

22 WHEREAS, in the Suprema Contract Action, Suprema alleges that under the
23 No Proceeding Clause SecuGen is precluded from initiating any adverse proceeding
24 against Suprema, including any action for infringement of any of SecuGen’s IP rights,
25 during the term of the OEM Agreement, which is set to expire on May 6, 2012; and

26 WHEREAS, SecuGen and Suprema agree that the OEM Agreement does not
27 bar SecuGen’s pursuit of a patent infringement action against Suprema for products

1 sold or offered for sale on or after May 6, 2012, and therefore currently agree, at a
2 minimum, to stay the SecuGen Patent Infringement Action until May 6, 2012,
3 without prejudice to any party seeking to extend such stay pending resolution of the
4 Suprema Contract Action.

5 THEREFORE, IT IS HEREBY STIPULATED by the parties and the parties
6 respectfully request the Court as follows:

7 (1) The present SecuGen Patent Infringement Action shall be stayed until
8 May 6, 2012;

9 (2) Defendants responses to the First Amended Complaint in the present
10 SecuGen Patent Infringement Action shall be due within fourteen (14) days of the lift
11 of the stay; and

12 (3) Nothing in this stipulation prevents any party from requesting an
13 extension of this stay from the Court pending resolution of the Suprema Contract
14 Action.

15
16 Dated: December 1, 2011

Respectfully submitted,

17
18 SecuGen Corporation

Suprema, Inc.

19
20 /s/
Brian E. Mitchell

/s/
D. James Pak

21 Attorneys for Plaintiff SecuGen
22 Corporation

Attorneys for Defendant Suprema, Inc.

23
24 ORDER

25 PURSUANT TO STIPULATION, IT IS SO ORDERED

26 December 4, 2011

27 
28 Susan Ilston
Susan Ilston
United States District Judge

ATTESTATION PER GENERAL ORDER 45

I, Craig C. Daniel, am the ECF User whose ID and password are being used to file this Stipulation. In compliance with General Order 45, X.B., I hereby attest that the counsel listed above have concurred with this filing.

Dated: December 1, 2011

 /s/
Craig C. Daniel

Attorneys for SecuGen Corporation