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5 UNITED STATES DISTRICT COURT  
6 WESTERN DISTRICT OF WASHINGTON  
7 AT SEATTLE

8 ELLIOT KREMERMAN,

9 Plaintiff,

10 v.

11 OPEN SOURCE STEEL, LLC, et al.,

12 Defendants.

CASE NO. 2:17-cv-00953-BAT

**ORDER GRANTING  
STIPULATION OF DISMISSAL  
WITH PREJUDICE AND  
DISMISSING PLAINTIFF'S  
UNFAIR BUSINESS PRACTICES  
CLAIM WITHOUT PREJUDICE**

13 Before the Court is the joint stipulation of Plaintiff Elliot Kremerman ("Kremerman")  
14 and Defendants Open Source Steel, Joshua Dellay and James Dellay ("Defendants") regarding  
15 Plaintiff's Unopposed Motion to Voluntarily Dismiss Plaintiff's Claims (Dkt. 98). Dkt. 101. The  
16 Court grants the parties' stipulation to dismiss Kremerman's claims for Patent Infringement  
17 under 35 U.S.C. § 271(a) and Trade Dress Infringement under the Lanham Act § 43(a), 15  
18 U.S.C. § 1125(a), with prejudice. Kremerman's claim for Unfair Business Practices under Cal.  
19 Bus. & Prof. Code § 17200, *et seq.* shall be dismissed without prejudice.

20 **DISCUSSION**

21 After Kremerman filed his motion to voluntarily dismiss his affirmative claims without  
22 prejudice on May 4, 2018 (Dkt. 98), Kremerman submitted a terminal disclaimer to the United  
23 States Patent and Trademark Office ("USPTO") disclaiming the remaining term of the Asserted

1 Patents as of May 18, 2018. Plaintiff's disclaimer renders the pending patent and trade dress  
2 claims moot, and eliminates any likelihood of future issues regarding those patents and  
3 corresponding trade dress. In view of this, Kremerman modified the request for relief in his  
4 motion. Kremerman will voluntarily dismiss his claims for Patent Infringement under 35 U.S.C.  
5 § 271(a) and Trade Dress Infringement under the Lanham Act § 43(a), 15 U.S.C. § 1125(a), with  
6 prejudice. Defendants agree to and stipulate to this modification. Dkt. 101. Accordingly, the  
7 Court will grant this stipulation.

8         The parties disagree, however, as to how Kremerman's claim for Unfair Business  
9 Practices under Cal. Bus. & Prof. Code § 17200, *et seq.* should be dismissed. Kremerman  
10 requests that dismissal of the Unfair Business Practices claim be without prejudice and contends  
11 that Defendants have failed to show that they will suffer some plain legal prejudice as a result of  
12 the dismissal. Defendants contend that because the Unfair Business Practices claim is based on  
13 the same act of trade dress infringement, it should also be dismissed with prejudice. However,  
14 when Defendants initially responded to Kremerman's unopposed motion (Dkt. 98), Defendants  
15 recognized that Ninth Circuit precedent generally favors granting a request to voluntarily dismiss  
16 without prejudice absent a showing of legal prejudice, and asked that any dismissal be subject to  
17 the condition that should Kremerman (or a related entity) refile an action against Defendants  
18 under the same or substantially similar facts or law, Kremerman would be ordered to bear  
19 Defendant's fees and costs. Dkt. 100 at 2 and 7.

20         A determination of whether a party will suffer "legal prejudice" focuses on the rights and  
21 defenses available to a defendant in future litigation, *i.e.*, prejudice to some legal interest, some  
22 legal claim, or some legal argument such as a loss of a federal forum, the right to a jury trial or a  
23 statute-of limitations defense. *See Westlands Water Dist. v. U.S.*, 100 F.3d 94, 97 (9th Cir. 1996)

1 (and cases cited therein). Expense incurred in defending against a lawsuit also does not amount  
2 to legal prejudice. *Hamilton v. Firestone Tire & Rubber Co.*, 679 F.2d 143, 145 (9th Cir.1982).  
3 Neither does uncertainty because a dispute remains unresolved. *Westlands*, 100 F.3d at 97.

4 Defendants will not lose any claim or argument by virtue of the voluntary dismissal of  
5 this claim without prejudice. As Defendants have not shown that they will suffer plain legal  
6 prejudice, dismissal without prejudice of the Unfair Business Practices claim is appropriate.

7 Accordingly, it is **ORDERED**:

8 1) The parties' joint stipulation (Dkt. 101) regarding Plaintiff's voluntary motion to  
9 dismiss (Dkt. 98) is **GRANTED**; Plaintiff's claims for Patent Infringement under 35 U.S.C. §  
10 271(a) and Trade Dress Infringement under the Lanham Act § 43(a), 15 U.S.C. § 1125(a) are  
11 **dismissed with prejudice**.

12 2) Plaintiff's claim for Unfair Business Practices under Cal. Bus. & Prof. Code §  
13 17200, et seq. is dismissed **without prejudice**.

14 3) The Clerk shall send copies of this Order to counsel for the parties.

15 DATED this 31st day of May, 2018.

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19 BRIAN A. TSUCHIDA  
20 Chief United States Magistrate Judge  
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