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

8 IRONBURG INVENTIONS LTD.,

9 Plaintiff,

10 v.

11 VALVE CORPORATION,

12 Defendant.

C17-1182 TSZ

MINUTE ORDER

13 The following Minute Order is made by direction of the Court, the Honorable  
14 Thomas S. Zilly, United States District Judge:

15 (1) Defendant's motion to compel supplemental infringement contentions and  
16 to strike doctrine of equivalents infringement contentions, docket no. 71, is DENIED.

17 (2) Defendant's motion for stay pending resolution of proceedings before the  
18 Patent Trial and Appeal Board ("PTAB"), docket no. 136, is DENIED in part and  
19 GRANTED in part, as follows:

20 (a) With regard to plaintiff's infringement claims relating to U.S. Patent  
21 Nos. 8,641,525 (the "'525 Patent") and 9,089,770 (the "'770 Patent"), defendant's  
22 motion for stay is DENIED. The PTAB has already issued final written decisions  
23 in Case IPR2016-00948 (regarding the '525 Patent) and Case IPR2016-00949  
(regarding the '770 Patent). *See* Exs. E & F to Becker Decl. (docket nos. 142-5  
& 142-6). Although Case IPR2017-00136 (regarding the '525 Patent) and  
Case IPR2017-00137 (regarding the '770 Patent) remain pending, plaintiff has  
been authorized to file motions to terminate such proceedings on the basis of  
estoppel arising from defendant's failure to earlier raise the grounds of  
unpatentability asserted therein. *See* Ex. G to Becker Decl. (docket no. 142-7).  
Even if, however, plaintiff's motions to terminate are denied, given the patent

1 claims as to which Case IPR2017-00136 and Case IPR2017-00137 were instituted,  
2 any PTAB decision would not affect the patent claims that plaintiff may, in light  
3 of the PTAB's prior rulings, assert in this action were and/or are being infringed,  
4 namely dependent claims 2-5, 7-12, 15, and 18 of the '525 Patent, and dependent  
5 claims 13 and 14 of the '770 Patent. The Court is persuaded that a stay with  
6 respect to infringement claims relating to the '525 and '770 Patents would serve  
7 no purpose and might unduly prejudice plaintiff. *See Supercell Oy v. Rothschild*  
8 *Digital Media Innovations, LLC*, 2016 WL 9226493 at \*2 (W.D. Wash. July 28,  
9 2016) (outlining as factors to consider in deciding a motion to stay: (i) the stage  
10 of the case; (ii) whether a stay would simplify the court proceedings; and  
11 (iii) whether a stay would unduly prejudice or present a clear tactical disadvantage  
12 to the non-moving party).

13 (b) With regard to plaintiff's infringement claims relating to U.S. Patent  
14 Nos. 9,289,688 (the "'688 Patent") and 9,352,229 (the "'229 Patent"), defendant's  
15 motion for stay is GRANTED. Having reviewed the PTAB's Decision Instituting  
16 *Inter Partes* Review ("IPR") in Case IPR2017-00858 (relating to the '688 Patent)  
17 and defendant's Petition for *Inter Partes* Review of the '229 Patent, which were  
18 filed at the Court's direction, *see* Minute Order (docket no. 145); Def.'s Resp.  
19 (docket no. 147), the Court is persuaded that the issues raised in the pending IPR  
20 proceedings are distinct from the matters addressed in the PTAB's final decisions  
21 relating to the '525 and '770 Patents. Moreover, with the exception of the term  
22 "elongate member," the claim language in the '688 and '229 Patents that the  
23 parties have asked the Court to construe does not overlap with the disputed terms  
of the '525 and '770 Patents. *See* Joint Claim Construction Statement (docket  
no. 64). Thus, bifurcating the infringement claims relating to the '525 and '770  
Patents from those arising from the '688 and '229 Patents, and staying the latter  
claims pending the outcome of the associated proceedings before the PTAB, will  
likely simplify this litigation without causing undue prejudice or resulting in an  
unfair tactical advantage.

(3) In light of the stay relating to the '688 and '229 Patents, the Court  
DECLINES to construe at this time the disputed terms numbered 11-15 and 17-18 in  
Exhibit 1 to the parties' Joint Claim Construction Statement, docket no. 64-1. On or  
before noon on January 2, 2018, the parties shall file supplemental briefs, not to exceed  
ten (10) pages in length, addressing the following issues: (i) with respect to the disputed  
claim terms numbered 1, 3, 4, and 5, whether the PTAB's interpretations as set forth in its  
final decisions in Case Nos. IPR2016-00948 and IPR2016-00949 are binding, or, if not,  
whether they should be adopted for purposes of this litigation; (ii) whether, as a result of  
the PTAB's rulings in the IPR matters, any of the other disputed claim terms can be  
removed from the list of terms the parties wish the Court to construe; and (iii) whether  
defendant's contention that certain disputed terms are "indefinite" is more appropriately  
addressed in connection with a dispositive motion, rather than during claim construction.

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(4) A scheduling conference is SET for Friday, January 5, 2018, at 9:00 a.m.

(5) The Clerk is directed to send a copy of this Minute Order to all counsel of record.

Dated this 6th day of December, 2017.

William M. McCool  
Clerk

s/Karen Dews  
Deputy Clerk