

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF NORTH DAKOTA
SOUTHEASTERN DIVISION

ALIEN TECHNOLOGY CORPORATION,)	
)	
Plaintiff,)	
v.)	Case No. 3:06-cv-51
)	
INTERMEC, INC., INTERMEC)	
TECHNOLOGIES CORPORATION,)	
and INTERMEC IP CORP.,)	
)	
Defendants.)	

Order on Motion to Stay Litigation

Plaintiff Alien Technology Corporation ("Alien") moves to stay the proceedings pending reexamination by the Patent and Trademark Office ("PTO") of U.S. Patent No. 6,812,841 ("the '841 Patent") (Doc. #838). Defendants (collectively "Intermec") have filed a brief in opposition to the motion (Doc. #889). For the reasons set forth below, the Court grants a conditional stay.

The Court granted summary judgment of non-infringement with regard to U.S. Patent Nos. 5,528,222, 5,850,181, 5,828,318, and 6,812,852 (Docs. #803, 804, and 805). However, the Court denied each party's motion for summary judgment with regard to infringement of the '841 patent (Doc. #812). On October 15, 2009, Alien filed a motion for reconsideration of the '841 infringement order, which remains pending (Doc. #822). Trial in this matter is scheduled to commence on January 25, 2010.

On November 19, 2009, Alien submitted a request to the PTO for *inter partes* reexamination of the '841 Patent. Alien asserts the PTO's reexamination of the '841 Patent will simplify the remaining issues in this case because it will eliminate the need

for an infringement trial or it will allow the Court to benefit from the PTO's expertise in analyzing the validity of the '841 Patent. Alien also contends that judicial economy would be served by a stay and that Intermecc would not be prejudiced. Intermecc responds that it would be prejudiced by a stay, that a stay would not simplify issues for trial, and that the proximity to trial should prevent entry of a stay.

In the alternative, Intermecc suggests staying the proceedings until February 19, 2010, or until such time as the PTO provides its decision. Under the statute, the PTO is required to make a determination on a request within three months of it being filed. See 35 U.S.C. § 312(a); 37 C.F.R. § 1.923 ("Within three months following the filing date of a request for inter partes reexamination under § 1.915, the examiner will consider the request and determine whether or not a substantial new question of patentability affecting any claim of the patent is raised by the request and the prior art citation."). Alien's reexamination request was filed on November 19, 2009, and accordingly the PTO's determination should be issued on or before February 19, 2010. In the event that the Court stays the action during the entire PTO reexamination, Intermecc also requests the entry of a partial final judgment under Rule 54(b) on the patents already decided by the Court in order to allow those patents to proceed on appeal. Alien agrees to Intermecc's alternative request to conditionally stay the proceedings pending the PTO's determination, and to enter a partial final judgment if the stay

is maintained during the PTO reexamination.

After careful consideration, the Court agrees with the parties that a conditional stay pending the PTO's determination on the request for reexamination is appropriate. A conditional stay will serve the interests of both parties, as exemplified by each party's brief on this matter. The Court therefore conditionally stays the proceedings until February 19, 2010, or until such time as the PTO provides its decision. After the PTO makes its determination on the request, the Court intends to hold a hearing with the parties on their recommended courses of action at that point. The trial date of January 25, 2010 is continued until a later date in 2010.

CONCLUSION

For the foregoing reasons, Alien's motion to stay the litigation pending reexamination of the '841 Patent is **GRANTED** until February 19, 2010, or until such time as the PTO provides its decision on the request.

IT IS SO ORDERED.

Dated this 23rd day of December, 2009.

/s/ Ralph Erickson
Ralph R. Erickson, Chief Judge
United States District Court