IN THE UNITED STATES DISTRICT COURT

FOR THE DISTRICT OF DELAWARE

WIRTGEN AMERICA, INC., Plaintiff, v. CATERPILLAR INC., Defendant.	Civil Action No. 17-770-RGA

ORDER

The above-captioned case was stayed on August 29, 2017, due to proceedings pending before the U.S. International Trade Commission (the "ITC"), and the parties have submitted a joint letter informing this Court of the status of the ITC proceedings. (D.I. 9; D.I. 24).

There were five patents in the ITC proceedings. On appeal, the Federal Circuit affirmed the ITC's findings relating to claims involving U.S. Patent 7,828,309 ("'309 Patent") and U.S. Patent 9,656,530 ("'530 Patent"). *Caterpillar Prodotti Stradali S.R.L. v. Int'l Trade Comm'n,* 2021 WL 960759, at *4 (Fed. Cir. Mar. 15, 2021). The Federal Circuit reversed two rulings regarding indirect infringement of claims 11 and 17 of U.S. Patent No. 7,530,641 ("'641 Patent") and remanded for further proceedings. *Id.* at *6. The appeal did not involve the other two patents, U.S. Patent 9,624,628 ("'628 Patent") and U.S. Patent 9,644,340 ("'340 Patent"). Wirtgen voluntarily dismissed its claims as to the '628 Patent and there was no appeal regarding the decision on the '340 Patent. *Id.* at *1 n.1.

Plaintiff Wirtgen now takes the position that the stay should be lifted in its entirety, while Defendant Caterpillar argues that 28 U.S.C. § 1659(a) requires a mandatory stay for issues

related to the ’641, ’309, ’530, ’628 and ’340 Patents and that a discretionary stay should remain in place for proceedings related to the other seven patents in suit. (D.I. 24).

Since a mandatory stay depends upon statutory authority, I consider the statute and its interpretation. The Federal Circuit has held that the language of 28 U.S.C. § 1659(a) “necessarily suggests that after a final determination by the Commission, the district court may resume its consideration of the civil action.” *Fuji Photo Film Co. v. Benun,* 463 F.3d 1252, 1256 (Fed. Cir. 2006). Additionally, § 1659(a) and its legislative history show that the purpose of the statute is to avoid duplicative proceedings in the district court and the ITC by issuing a mandatory stay only “when parallel claims involve the same issues about the same patent.” *SanDisk Corp. v. Phison Elec. Corp.,* 538 F.Supp.2d 1060, 1065 (W.D. Wisc. 2008) (citing H.R. REP. NO. 103–826(I), at 140 (1994), *reprinted in* 1994 U.S.C.C.A.N. 3773, 3912–3913). When a stay is not mandatory as to an asserted patent, it still may be stayed at the discretion of the district court. *Id.* at 141. Furthermore, the Federal Circuit has ruled that ITC proceedings are “final” as they relate to 28 U.S.C. § 1659(a) when they are “no longer subject to judicial review,” including any remand proceedings. *In re Princo Corp.,* 478 F.3d 1345, 1355 (Fed. Cir. 2007).

Here, the only patent that now has any overlapping issues is the ’641 Patent. *Caterpillar*, 2021 WL 960759, at *4 (discussing “only Wirtgen's challenge to the two rulings regarding indirect infringement of claims 11 and 17 of the ’641 patent.”). The ITC’s handling of the other four patents at issue in the ITC proceedings is “no longer subject to judicial review.” Therefore, this Court is required to continue the stay regarding claims involving the ’641 Patent pursuant to § 1659(a), but the stay regarding the other four patents and the seven patents not overlapping with the ITC proceedings is committed to the discretion of this Court.

When deciding whether to institute or maintain a discretionary stay, the Court will typically consider whether issues will be simplified for trial, the current stage of litigation, and whether the non-movant will suffer any undue prejudice from the stay. *Toshiba Samsung Storage Tech. Korea Corp. v. LG Elecs., Inc.,* 193 F. Supp. 3d 345, 348 (D. Del. 2016). In the present action, the current stage of litigation is very early. I do not find Wirtgen's claim of undue prejudice particularly persuasive. Nevertheless, a stay is simply postponing the inevitable. Neither the issues nor the discovery in this action will be simplified by issuing a stay relating to the claims involving the eleven patents that are not now at issue in the ITC.[1] Besides encompassing similar subject matter and having a shared presence in the accused infringing products, the issues involving the '641 Patent are largely independent since that patent is in a different family from all the other patents-in-suit. (D.I. 1 at 5). Thus, claim construction may also be simplified since one less patent from a different patent family provides less complications. *See Align Tech., Inc. v. 3Shape A/S,* 2018 WL 4292675, at *2 (D. Del. Sept. 7, 2018).

THEREFORE, IT IS HEREBY ORDERED that the stay in the above-captioned case is lifted with respect to claims related to all the patents in suit, excluding U.S. Patent No. 7,530,641.

Entered this 27th day of May, 2021.

/s/ Richard G. Andrews
United States District Judge

1 It seems likely that lifting the stay may result in dismissal of the '641 patent. Plaintiff has asserted many more patents from many more patent families than can actually be tried in a one-week trial. Thus, the need for the '641 patent is likely minimal at most. I am not going to hold two *Markmans* or two trials in this case. Thus, unless the ITC proceedings involving the '641 patent are quickly resolved, it should drop out of this case.