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11  
12 UNITED STATES DISTRICT COURT  
13 FOR THE SOUTHERN DISTRICT OF CALIFORNIA

14 JENS ERIK SORENSEN, as Trustee of ) Case No. 07cv2121 BTM (CAB),  
15 SORENSEN RESEARCH AND ) 07cv2278, 08cv60, 08cv70, 08cv134,  
16 DEVELOPMENT TRUST, ) 08cv136, 08cv234, 08cv304, 08cv305,  
17 ) 08cv306, 08cv411, 08cv559, 08cv1080,  
Plaintiff, ) 08cv1670, 09cv56, 09cv57, 09cv58,  
18 v. ) 09cv558  
19 GIANT INTERNATIONAL (USA) ) **PLAINTIFF’S AMENDED MOTION**  
20 LTD., a Delaware corporation, and DOES ) **FOR RECONSIDERATION OF**  
1-10, ) **JOINT ORDER ENTERING STAY**  
21 ) **IN SORENSEN CASES**  
22 Defendants. )

23 ) Date: July 16, 2010  
24 ) Time: 11:00 a.m.  
and related ‘184 Patent Cases. ) Courtroom 15 – 5<sup>th</sup> Floor  
25 ) The Hon. Barry T. Moskowitz  
26 ) *Per Chambers: No Oral Argument*  
27 ) *Unless Requested By The Court*  
28 )

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1 **INTRODUCTION**

2 In light of two new developments since May 5, 2010, and material legal errors  
3 underlying the Court recent action further continuing stay, Plaintiff respectfully  
4 requests the Court to reconsider the “Joint Order Entering Stay in Sorensen Cases”  
5 (“Order”) for the following reasons:

6 1. The PTO’s withdrawal of all rejections on June 4, 2010, except 35  
7 U.S.C. § 103(a) rejections which are subject to attack on a discreet legal issue,  
8 renews the issue of the impermissible switching of the burdens of proof relating to  
9 (1) issuance of stay; and (2) validity of the patent.

10 2. The Order is in direct contravention of the prohibition against  
11 immoderate and indefinite stays set forth by the United States Supreme Court in  
12 *Landis v. No. American Co.*, 299 U.S. 248 (1936).

13 3. The Order violates Plaintiff’s constitutional rights of access to judicial  
14 process.

15 4. The Order resulted from a legally erroneous conclusion that proceeding  
16 with a district court patent infringement case while reexamination was pending  
17 would result in an advisory opinion.

18 **NEW DEVELOPMENTS**

19 ***Dramatic narrowing of reexamination issues.*** On June 4, 2010, the United  
20 States Patent and Trademark Office (“PTO”) issued an Advisory Action Before the  
21 Filing of an Appeal Brief” (“Advisory Action”). A true and correct copy of that  
22 document was filed with this Court under separate “Notice of Withdrawal of Six of  
23 the Nine Claim Rejections and Reversal of Construction of “Laminated” in the ‘184  
24 Patent Reexamination.” Doc. #81 in *Sorensen v. Giant*.

25  
26 This Advisory Action was issued by the same three Examiners that prepared  
27 the Final Office Action and subsequent advisory opinions, and prior to the filing of  
28 Plaintiff Patentee’s Appeal Brief to the BPAI. The Advisory Action, in relevant part,

1 does the following:

2 1. As requested by Patentee Sorensen, returns construction of the term  
3 “laminated” to the definition used in the First Office Action dated October 31, 2008  
4 (from the Order and Opinion in *Sorensen, et al v. Daimler Chrysler, et al*).

5 2. Withdraws six of the nine claim rejections contained within the Final  
6 Office Action.

7 The remaining three rejections all depend upon a narrow legal error that, when  
8 corrected, cannot allow those rejections to stand.

9 The three remaining rejections (paragraphs 8, 9, and 10 in the Final Office  
10 Action,<sup>1</sup> “Remaining Rejections”) are all obviousness rejections under 35 U.S.C. §  
11 103(a), however, those rejections do not satisfy the legal requirements for  
12 obviousness under Section 103(a).

13 With an obviousness (35 U.S.C. § 103(a)) rejection, the PTO compares a prior  
14 art reference (such as an old patent) with the subject patent (in this case the ‘184  
15 patent) and determines whether all the elements of the subject patent were previously  
16 disclosed in one or more prior art references.

17 The reason that the Remaining Rejections do not satisfy legal requirements is  
18 simple. In each rejection, the Examiner relies upon finding the element of  
19 “stabilization” as being only *inherent* (not explicitly disclosed within a prior art  
20 patent) in the Moscicki prior art reference.

21 Portions of the first plastic component [in Moscicki] . . . inherently act  
22 as a “stabilizing regions” during the second injection step as recited in  
23 claim 1 of the ‘184 patent. . . . While Moscicki does not explicitly  
24 disclose stabilization, there is no requirement that a person of ordinary  
25 skill in the art would have recognized the inherent disclosure at the time  
26 of invention, but only that the subject matter is in fact inherent in the  
prior art reference. *Schering Corp. v. Geneva Pharm. hw.*, 339 F.3d  
1373, 1377 (Fed.Cir. 2003).

---

27  
28 <sup>1</sup> A copy of the Final Office Action was previously lodged with the Court at Doc.  
#61 in the low-numbered *Sorensen v. Giant* case.

1 See Doc. #61, pg. 18 (pg. 9 of original document), last sentence. (This language  
2 appears within paragraph 5 of the Final Office Action, now withdrawn, however this  
3 reasoning is incorporated by reference into the Remaining Rejections, numbered  
4 paragraphs 6, 7, and 8, in the same document.)

5 Although the concept of *inherency* is available for anticipation purposes under  
6 35 U.S.C. § 102(b) (“anticipation” being a rejection where a single prior art  
7 reference embodies all elements of the invalidated claims), it is not available for  
8 obviousness purposes under 35 U.S.C. § 103(a) *unless* there is also evidence the  
9 inherent feature was known at the time. The *Schering* case cited by the Examiner  
10 above relates to the use of inherency for anticipation, not obviousness, and thus was  
11 not appropriately incorporated by reference into obviousness rejections constituting  
12 the Remaining Rejections.

13 An element which is only *inherent* cannot support an obviousness rejection  
14 under 35 U.S.C. § 103(a) except where the element is recognized at the time of  
15 invention.

16 Obviousness cannot be predicated on what is not known at the time an  
17 invention is made, even if the inherency of a certain feature is later  
18 established.

19 Manual of Patent Examining Procedures (“MPEP”) § 2142.01 (*citing In re Rijckaert*,  
20 9 F.3d 1531 (Fed. Cir. 1993)).

21 In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial  
22 burden of presenting a *prima facie* case of obviousness. *In re Oetiker*,  
23 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed.Cir.1992). Only if  
24 that burden is met, does the burden of coming forward with evidence or  
25 argument shift to the applicant. *Id.* “A *prima facie* case of obviousness  
26 is established when the teachings from the prior art itself would appear  
27 to have suggested the claimed subject matter to a person of ordinary  
28 skill in the art.” *In re Bell*, 991 F.2d 781, 782, 26 USPQ2d 1529, 1531  
(Fed.Cir.1993) (quoting *In re Rinehart*, 531 F.2d 1048, 1051, 189  
USPQ 143, 147 (CCPA 1976)). If the examiner fails to establish a  
*prima facie* case, the rejection is improper and will be overturned. *In re*



1 *Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed.Cir.1988).  
2 *Rijckaert*, at 1532 (emphasis added).

3 In other words, the use of inherency for purposes of an obviousness rejection  
4 requires an additional step beyond use of inherency for purposes of an anticipation  
5 rejection, a step that the Examiner failed to take. The Remaining Rejections cannot  
6 stand without evidence that the inherency would have been obvious on February 5,  
7 1988 (evidence not part of the record), not obvious decades later with the hindsight  
8 of the '184 patent.

9 *Defendants Helen of Troy/OXO highlight stay problems.* On June 4, 2010,  
10 Defendants in the Helen of Troy case filed an Opposition to Plaintiff's Motion for  
11 Leave to Proceed with Litigation on Patent Claim which is not Subject to  
12 Reexamination (Case No. 07cv2278, Doc. #79). This Opposition, among other  
13 matters that will be addressed in a Reply in that case, claims that Plaintiff should be  
14 estopped from proceeding on Claim 3 of the '184 patent (a claim not subject to  
15 reexamination) because that claim has never been asserted against them previously.  
16 Plaintiff has not been able to serve his preliminary infringement contentions in these  
17 cases because of litigation stays. This highlights the fact that Defendants are blithely  
18 treating both proceeding and not proceeding in these cases as prejudicial to them.

19  
20 Due to these significant developments in the reexamination proceedings, as  
21 well as other legal errors described herein, Plaintiff urges the Court to reconsider its  
22 Order staying these cases for another year.

## 23 24 **ARGUMENT**

25 I. THE ORDER RESULTED FROM IMPERMISSIBLE SWITCHING OF THE  
26 BURDEN OF PROOF RELATING TO STAY ISSUANCE AND PATENT  
27 VALIDITY.

1           A.    Being Required to Defend a Suit Does Not Constitute Sufficient  
2                    Grounds to Support Continued Stay.

3           [T]he suppliant for a stay must make out a clear case of hardship or  
4           inequity in being required to go forward, if there is even a fair  
5           possibility that the stay for which he prays will work damage to some  
6           one else.

6           *Landis v. No. American Co.*, 299 U.S. 248, 255 (1936).

7           “[B]eing required to defend a suit [if the stay is vacated], does not constitute a  
8           ‘clear case of hardship or inequity’ within the meaning of *Landis*.” *Dependable*  
9           *Highway Exp., Inc. v. Navigators Ins. Co.*, 498 F.3d 1059, 1066 (9<sup>th</sup> Cir. 2007).

10          As discussed below and during the May 5<sup>th</sup> hearing, there is far more than a  
11          fair possibility that Plaintiff will be damaged as a result of such lengthy stays. It is a  
12          virtual certainty. Notwithstanding the prejudice to Plaintiff, some of which is  
13          absolutely unavoidable when stay extends this long, the Court renewed stay of the  
14          Sorensen cases. This Court heavily relied on Defendant’s burden of being required  
15          to defend suit as support for continuing the stay. See, e.g., *May 5, 2010 Status*  
16          *Conference Transcript*, pages 32:6-33:18, page 37:11-15.

17          Because the Court did not require those in favor of stay to make out a clear  
18          case for hardship, other than the impermissible “being required to defend suit,” the  
19          resulting stay was the result of an impermissible burden shift to Plaintiff to  
20          demonstrate why the cases should not be stayed.

21          Especially with the new Advisory Action filed by the PTO, the burden should  
22          be placed upon the Defendants to explain a clear case of hardship or inequity in  
23          going forward aside from the impermissible argument of burden of defending the  
24          cases.

25          On May 5, 2010, the almost 3-yr-old reexamination had nine rejections and a  
26          factually erroneous definition of “laminated” that were all in the process of being  
27          appealed up to the BPAI. Now a month later, and before Plaintiff’s BPAI appellate  
28          brief has even been filed, two-thirds of the rejections have been withdrawn by the

1 very three Examiners that issued them, including the hotly-contested definition of  
2 “laminated.” The remaining three rejections are reliant on a straightforward legal  
3 error upon which there is ample legal authority supporting Plaintiff’s position.

4 Plaintiff should not be required to continue through the lengthy BPAI appeal  
5 process (current statistics are 29.2 months from the filing of the Notice of Appeal) to  
6 correct this dispositive legal issue before proceeding with infringement litigation in  
7 this Court. At a minimum, the burden should be placed on Defendants to  
8 demonstrate, if they can, how these remaining rejections are so strong as to warrant  
9 continued delay in allowing these infringement cases from proceeding on the merits  
10 despite the inevitable prejudice accruing to Plaintiff.

11  
12 B. The Court Erred in Impermissibly Switching the Burden to Plaintiff to  
13 Establish Validity of the ‘184 Patent, Rather than Placing the Burden on  
14 Defendants to Establish Invalidity as is Mandated by Statute.

15 35 U.S.C. § 282 provides a presumption of validity to an issued patent and the  
16 burden of establishing invalidity of a patent is on the party asserting invalidity.

17 As reflected in the May 5, 2010 transcript, however, the Court has repeatedly  
18 and consistently refused to allow Plaintiff to proceed with this case until he “wins”  
19 the reexamination, thus implicitly rejecting the burden of proof set forth in 35 U.S.C.  
20 § 282. *May 5, 2010 Status Conference Transcript*, pages 37:16-38:13, pages 40:4,  
21 43:2-5, see also *Sorensen v. Giant*, Doc. # 59 with a consistent theme.

22 District courts cannot use their discretion to deny permission to proceed with a  
23 patent infringement case, especially for an indefinite and immoderate period of time,  
24 by requiring that the patent holder submit its patent to the PTO first.

25 If such power were authorized, it would be a taking of property without  
26 due process of law. If such power were authorized to be exerted upon  
27 the discretion of the district court, it would raise problems of equal  
28 protection.

1 *Johnson & Johnson, Inc. v. Wallace A. Erickson & Co.*, 627 F.2d 57, 61 (7<sup>th</sup> Cir.  
2 1980).

3 In *Sorensen v. Spectrum*, Case No. 09cv0058 (Doc. #26), this Court has  
4 already found invalidity assertions in both a counterclaim and affirmative defense  
5 insufficient to state a claim. The same problem exists in the bulk of the other  
6 *Sorensen* cases<sup>2</sup>, but because of litigation stays Plaintiff has not yet had the  
7 opportunity to file Fed.R.Civ.P. Rule 12(c) motions for judgment on the pleadings.

8 Almost all of Defendants' invalidity contentions are not even sufficient to  
9 state a claim upon which relief can be granted and, as of now in the PTO's  
10 reexamination, only three rejections remain, all of which are legally unsupportable.  
11 Continuing to require Plaintiff to prove-up patent validity in the PTO before  
12 proceeding in court equates to switching Defendant's statutory burden of  
13 establishing invalidity into a burden on Plaintiff to establish validity.

14 This Court should not deny Plaintiff access to the courts to enforce a valid  
15 patent on the speculation of future invalidation, especially in light of the recent  
16 withdrawal of two-thirds of the current rejections before Plaintiff even filed his  
17 BPAI appellate brief, and a simple, straightforward legal error in the remaining  
18 rejections. It is time to give Plaintiff the benefit of the doubt (presumption) of  
19 validity of the subject '184 patent. At the very minimum, the Court needs to place  
20 the burden on Defendants to at least sufficiently state a claim for invalidity before  
21 stay of any length continues.

22  
23 **II. STAYS IN EVERY SORENSEN CASE WILL EXCEED IMMODERATE**  
24 **LENGTHS UNDER THE TERMS OF THE ORDER, AND ARE ALSO**

---

25 <sup>2</sup> See *Acco v. Sorensen*, Case No. 08cv1670, *Sorensen v. Big Lots*, Case No. 09cv57,  
26 *Sorensen v. DMS Holdings*, Case No. 08cv559, *Sorensen v. Emissive*, Case No. 08cv234,  
27 *Sorensen v. Giant*, Case No. 07cv2121, *Sorensen v. Human Touch*, Case No. 08cv1080,  
28 *Sorensen v. Kyocera*, Case No. 08cv411, *Sorensen v. Metabo*, Case No. 08cv304, *Sorensen*  
*v. Motorola*, Case No. 08cv136, *Sorensen v. Rally*, Case No. 08cv305, *Sorensen v.*  
*Sunbeam*, Case No. 08cv306, *Sorensen v. Target*, Case No. 09cv56.

1 INDEFINITE.

2 Notwithstanding new developments in the PTO, the Court should reconsider  
3 its decision because under the terms of the Order stays in every Sorensen case either  
4 have exceeded or will exceed the bounds of moderation, and are furthermore  
5 indefinite as demonstrated by the stay patterns in these cases.

6 In the seminal United States Supreme Court case of *Landis v. No. American*  
7 *Co.*, the Supreme Court made clear that all stays of litigation must be “kept within  
8 the bounds of moderation.” *Landis*, 299 U.S. 248, 255-57 (1936).

9 In *Landis*, a stay that was a year long, and anticipated to continue for another  
10 year or more, was found immoderate by the United States Supreme Court. *Id.* at  
11 256-57. With the exception of *Sorensen v. Fein*, stays in every one of the Sorensen  
12 cases will have exceeded a period of time that was deemed immoderate under *Landis*  
13 during the operative effect of the current stay, which continues until May 9, 2011.  
14 Fourteen of the 18 pending Sorensen cases already exceed that time period.

15 Although the Order appears on its face to last only one year, all of these cases  
16 have already been effectively stayed for much longer. The low-numbered case has  
17 already been stayed for more than 27 months. Even the most recently filed case has  
18 been pending for over 14 months, and will have been pending for over 26 months by  
19 the time the current stay order expires.

20 Although the Court has previously made repeated statements either during  
21 court hearings or in orders in the Sorensen cases indicating limits on the duration of  
22 stay or a date certain for expiration of stay, the Court has never allowed either to  
23 occur as detailed below.

24  
25 Sep. 10, 2007 “An average delay for reexamination of  
26 approximately 18-23 months is ... inconsequential  
27 ...” (*Sorensen v. The Black & Decker Corporation, et*  
28 *al*, Case No. 06cv1572, at Doc. #243, pg 7:19-21)

1 Feb. 25, 2008 “If it turns out that this just is not going to be  
2 practicable because it’s going to take five years . . .  
3 that’s obviously something of concern to the court.  
4 Two years is, well, let’s say it’s long enough.”  
5 (*Sorensen v. Helen of Troy*, Case No. 07cv2278,  
6 February 25, 2008 Status Conf., page 17:19-24)

7 Feb. 28, 2008 “[I]f it appears that the reexamination will not be  
8 effected within a reasonable time, Plaintiff may  
9 move to vacate the stay.” (*Sorensen v. Giant*, at Doc.  
10 #28. The same or similar language appears in stay  
11 orders in the other cases.)

12 Aug. 20, 2008 “My two years is two years when the ball is in the  
13 Patent Office’s PTO’s court to deal with it . . . five  
14 years. I don’t find that acceptable. There is just no  
15 finality and there is lots of economic issues that  
16 companies are involved with that they can’t have this  
17 hanging over their head for five years, plus the time  
18 of litigation. So when I say two years, that means  
19 two years that the Patent Office has had it to decide.  
20 . . . .” (*Request for Judicial Notice*, Hearing  
21 Transcript, August 20, 2008, page 33:11-22)

22 Dec. 21, 2009 “[T]he Court does not believe the stay should be  
23 indefinite. . . . Its seems that the PTO can resolve  
24 these issues in the next several months. If the PTO  
25 can not, the light at the end of the tunnel may be so  
26 dim that the length of time required to traverse the  
27 distance becomes unreasonable. Therefore, . . . the  
28 stay will expire no later than April 30, 2010. . . .  
status conference on May 5, 2010 . . .” (*Sorensen v.*  
*Giant*, at Doc. #59)

Mar. 17, 2010 “Any stay issued by the Court in these [Sorensen]  
cases . . . shall be dissolved on **April 30, 2010** absent  
further action from the Court.” (*Sorensen v. Giant*, at  
Doc. #69)

Mar. 26, 2010 “This is one of many in which Plaintiff asserts  
claims under one of its patents. . . . stays in those

1 cases are set to expire on April 30, 2010. The Court  
 2 has also stayed this case, but the stay here is  
 3 indefinite. . . . stay will expire on **April 30, 2010**  
 4 absent further action from the Court.” (*Sorensen v.*  
 5 *Dorman*, at Doc. #37; *Sorensen v. Spectrum*, at Doc.  
 #40)

6 Mar. 29, 2010 “[T]he Court orders that no parties may start  
 7 discovery, file any motions, or otherwise proceed  
 8 with their cases before the status conference on May  
 5, 2010 . . .” (*Sorensen v. Giant*, at Doc. #71)

9 May 5, 2010 “I entered an order that the stay would be over April  
 10 30<sup>th</sup> because I wanted the Patent and Trademark  
 11 Office to move or we were just going to get going.  
 12 Enough is enough. So enough is enough. If they  
 13 vacated and send it back for further reexamination,  
 14 no, we are going to go ahead, I mean, unless the  
 defendants can offer something else.” (*May 5,*  
*2010 Status Conference Transcript*, page 41:6-16)

15 “MS. KRAMER: . . . is there some outside time [for  
 16 length of stay] because again the BPAI statistics say  
 17 29 months from notice to their ruling, but . . . it’s  
 18 been dramatically increasing. Is there some outside  
 19 window on this that we can say, ‘Your Honor, it’s  
 been this much time, can we come back in and lift  
 stay?’”

20 THE COURT: No . . . (*May 5, 2010 Status*  
 21 *Conference Transcript*, page 42:20-43:2)

22 May 7, 2010 “[T]he Court STAYS these cases until May 9, 2011.  
 23 Any party may move for reconsideration of the stay  
 24 based upon grounds stated in the record.” (*Sorensen*  
*v. Giant*, at Doc. #77)

25 There is nothing in the record to suggest that the Order will be limited to a stay  
 26 of moderate duration, nor that there will be a definite end to the stay, other than the  
 27 outside limit of reexamination completion, a date that is unknown to all. Rather, stay  
 28

1 in all cases will exceed the bounds of moderation by May 9, 2011, and  
2 notwithstanding the one-year effective date for the stay, there is no *real* end in sight  
3 for this litigation stay. On May 9, 2011, Plaintiff will again be put in the position of  
4 attempting to persuade the Court to put an end to the litigation stay.

5 As reflected in the May 5<sup>th</sup> hearing transcript, the Court has given no reason to  
6 believe that a similar pattern will not continue. To date, the Court has not yet given  
7 and enforced any limit on duration of stay nor any date certain for lifting of stay in  
8 the Sorensen cases. *May 5, 2010 Status Conference Transcript*, page 42:20-43:11.  
9 As the *Landis* court explained, “an order which is to continue by its terms for an  
10 immoderate stretch of time is not to be upheld as moderate because conceivably the  
11 court that made it may be persuaded at a later time to undo what it has done.  
12 Disapproval of the very terms that have already been approved as reasonable is at  
13 best a doubtful outcome of an application for revision.” *Landis*, 299 U.S. at 257.

14 The present situation is precisely that which was disallowed by the United  
15 States Supreme Court in *Landis*. Such a continued set of stays for an indefinite and  
16 immoderate length of time is not permissible.

17  
18 III. THE COURT ERRED IN IGNORING THE INEVITABLE PREJUDICE TO  
19 PLAINTIFF THAT WILL RESULT FROM CONTINUED STAY

20 A. Continued Stay of these Cases Violates Plaintiff’s Fundamental  
21 Constitutional Rights to Access Judicial Process to Enforce His Rights.

22 “The very essence of civil liberty certainly consists in the right of every  
23 individual to claim the protection of the laws, whenever he receives an injury.”  
24 *Marbury v. Madison*, 5 U.S. (1 Cranch) 137, 163, 2 L.Ed. 60 (1803).

25 “[A] stay of the litigation . . . involves fundamental constitutional rights  
26 governing access to and use of the judicial process . . . .” *Jones v. Clinton*, 72 F.3d  
27 1354, 1363 (8<sup>th</sup> Cir. 1996) (concurring opinion), *aff’d by Clinton v. Jones*, 520 U.S.  
28 681 (1997).



1 To stay a suit pending another speculative and protracted proceeding is to  
 2 place the plaintiff effectively out of court. *Cherokee Nation of Oklahoma v. United*  
 3 *States*, 124 F.3d 1413, 1418 (Fed. Cir. 1997).

4  
 5 B. Lengthy Delay Impairs Plaintiff's Ability to Plead His Cause of Action  
 6 and Ignores Plaintiff's Interest In Bringing These Cases To Trial.

7 Lengthy delay impairs a plaintiff's ability to plead its causes of action. As the  
 8 Federal Circuit has noted, "[w]ith the passage of time, memories will fade, litigation  
 9 costs will balloon, and resolve will dwindle. These factors will make it difficult for  
 10 the [plaintiff] to retool for litigation when, and if, their claim is allowed to proceed."  
 11 *Cherokee Nation*, 124 F.3d at 1418.

12 Even where a party seeks only civil monetary damages, as is the case in the  
 13 Sorensen cases, an immoderate stay causes prejudice to the plaintiff of constitutional  
 14 magnitude:

15 **It is incorrect . . . to assert that the delay is of no consequence to**  
 16 **[plaintiff].** Aside from the adage that justice delayed is justice denied,  
 17 [plaintiff] faces real dangers of loss of evidence through the  
 18 unforeseeable calamities inevitable with the passage of time. **To argue**  
 19 **that this problem may be dealt with by episodic exceptions when the**  
 20 **risk of loss is apparent is to miss the point. Only rarely does life**  
 21 **proceed in such a foreseeable fashion.**

22 . . . If a blanket stay is granted and discovery is precluded . . . [plaintiff]  
 23 will have no way . . . to perpetuate the testimony of any party or witness  
 24 should they die or become incompetent during the period the matter is  
 25 held in abeyance. Should the death or incompetence of a key witness  
 26 occur, proving the elements of [plaintiff's] alleged causes of action will  
 27 become impossible. Thus, her "chase in action" would be obliterated, or  
 28 at least substantially damaged if she is denied reasonable and timely  
 access to the workings of the federal tribunal.

*Jones*, 72 F.3d at 1363-64 (concurring opinion) (emphasis added); *see also Clinton v.*  
*Jones*, 520 U.S. 681, 707 (1997) (Court affirmed *Jones* on the grounds that the stay

1 failed to take into account the plaintiff's "interest in bringing the case to trial").

2 Plaintiff's counsel explained to the Court on May 5<sup>th</sup> the types and nature of  
3 prejudice that would accrue to Plaintiff if stay were to continue (see, e.g., *Transcript*  
4 at 32:19-36:16), but the Court did not place any weight whatsoever on any prejudice  
5 that would naturally occur as a result of this continued stay and explicitly  
6 disregarded Plaintiff's interest in bringing these cases to trial. As in *Jones*, to argue  
7 that such prejudice can be dealt with through episodic exceptions for preservation of  
8 evidence, as is proposed in the Order, misses the point. *See Jones*, 72 F.3d at 1363.

9 Of further concern, as evidenced by the recently-filed opposition to Plaintiff's  
10 motion to proceed against Defendants in the *Sorensen v. Helen of Troy, et al*, case<sup>3</sup>,  
11 Defendants are trying to play the system both ways. The Helen of Troy Defendants  
12 assert that Sorensen never asserted Claim 3 previously and thus should be estopped  
13 from asserting it now, blithely ignoring that Sorensen never had the opportunity to  
14 file preliminary infringement contentions because the case has been stayed was  
15 almost since inception. Defendants are claiming that Plaintiff suffers no prejudice  
16 from these lengthy stays, but simultaneously claims that Defendants are suffering  
17 prejudice. Such a situation cannot continue.

18 **As currently structured by the Court, Plaintiff has everything to lose**  
19 **during stay and Defendants have nothing to lose.** Plaintiff's infringement cases  
20 against the Defendants are being eroded, but Defendants' rights and arguments are  
21 being maintained intact.

22 Because the Order disregards Plaintiff's interest in bringing these cases to  
23 trial, and due to the inevitable loss of evidence that will occur through delay, the  
24 Court should reverse its recent Order and lift stay in all Sorensen cases so they can  
25 proceed on their merits.

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<sup>3</sup> Case No. 07cv2278, at Doc. #79.

1 IV. THE COURT ERRED IN CONTINUING STAY BASED ON THE  
2 ERRONEOUS LEGAL CONCLUSION THAT PROCEEDING WITH THE  
3 CASES WOULD RESULT IN AN ADVISORY OPINION.

4 As indicated during the May 5, 2010 hearing, the Court was of the opinion that  
5 proceeding with these cases would result in only an “advisory opinion.” See, e.g.,  
6 *Transcript* at page 32:6-33:18.

7 This legal conclusion was erroneous. “PTO examination procedures have  
8 distinctly different standards, parties, purposes, and outcomes compared to civil  
9 litigation.” *In re Swanson*, 540 F.3d 1368, 1377 (Fed. Cir. 2008) (citing *In re Etter*,  
10 756 F.2d 852, 856 (Fed. Cir. 1985)). “The two forums take different approaches in  
11 determining validity and on the same evidence could quite correctly come to  
12 different conclusions....And, if the district court determines a patent is not invalid,  
13 the PTO should continue its reexamination because, of course, the two forums have  
14 different standards of proof for determining invalidity.” *Ethicon, Inc. v. Quigg*, 849  
15 F.2d 1422, 1428-29 (Fed. Cir. 1988).

16 Because the Order arose from an erroneous legal premise, it should be  
17 reconsidered and reversed in accord therewith.

18  
19 **CONCLUSION**

20 For the reasons set forth above, Plaintiff respectfully requests the Court to  
21 reconsider its “Joint Order Entering Stay in Sorensen Cases” issued on May 7, 2010  
22 and modify it to allow Plaintiff to proceed with litigation of its claims forthwith.

23  
24 DATED this Wednesday, June 09, 2010.

25  
26 JENS ERIK SORENSEN, as Trustee of  
27 SORENSEN RESEARCH AND DEVELOPMENT  
28 TRUST, Plaintiff

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/s/ Melody A. Kramer  
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Melody A. Kramer, Esq.  
J. Michael Kaler  
Attorneys for Plaintiff

**AFFIDAVIT PER LOCAL RULE 7.1**

I, MELODY A. KRAMER, declare:

1. I am not a party to the present action. I am over the age of eighteen. I have personal knowledge of the facts contained within the following paragraphs, and could and would competently testify thereto if called as a witness in a court of law.

2. At all times relevant herein I have been an attorney for Sorensen Research and Development Trust (“Sorensen”), Plaintiff/Defendant in the above-captioned matters.

3. The new and different circumstances upon which this Motion for Reconsideration is being filed are:

a. Prior to the May 5<sup>th</sup> hearing and subsequent Order, Plaintiff was lead to believe that the stays in these cases would end if the reexamination was not completed within approximately two years.

b. Prior to the May 5<sup>th</sup> hearing and subsequent Order, the Court had finally issued orders citing a date certain upon which stay would expire – April 30, 2010.

c. Prior to April 30, 2010, the Court effectively continued the stay until May 5<sup>th</sup> by ordering that no party could proceed with their cases until after the May 5<sup>th</sup> status conference.

d. The Federal Circuit refused to exercise jurisdiction over appeals of Sorensen stays and in their order dismissing specifically notes that

[T]he district court has lifted stays of proceedings due to the pending reexamination proceedings in several other cases involving the patent-in-suit and that the district court specifically provided in this case that any party could move to vacate the stay “if it appears that the reexamination will not be completed within a reasonable time.”

e. Based upon the issuance of orders citing a date certain upon which stay of these cases would expire, and the Federal Circuit’s reliance on such

1 stay lifts, Plaintiff waived his right to pursue a rehearing of his appeals to the Federal  
2 Circuit relating to indefinite stays.

3 f. Now that the Court has demonstrated no intent to proceed with  
4 these cases until the reexamination is completed, has failed to allow stated expiration  
5 dates of stay to stand, and has stated no concrete and definitive criteria upon which  
6 stay will ever be lifted, Plaintiff is demonstrably at the end of options in obtaining  
7 enforcement of his rights to not be subjected to an immoderate or indefinite stay  
8 within this district court.

9 g. Due to the lack of notice that the May 5<sup>th</sup> status conference was  
10 actually intended as an OSC re why stay should not continue, and due to lack of  
11 opportunity to brief the matter, the *Landis* case was not specifically addressed during  
12 the hearing. Plaintiff is, by this motion, formally advising the Court that the *Landis*  
13 case prohibits the type of stay that has been issued here and requests the Court to  
14 reconsider its Order.

15 4. The original orders staying most of Sorensen's cases cited reliance on  
16 the *Sorensen v. Black & Decker* stay order issued in September 2007 and a status  
17 conference in the *Sorensen v. Helen of Troy* case in February 2008. The orders  
18 stated that "if it appears that the [patent] reexamination will not be effected within a  
19 reasonable time, Plaintiff may move to vacate the stay." However, no criteria were  
20 stated within the Order as to what constituted a "reasonable time" nor has any since  
21 that time.

22 5. On March 25, 2009, Plaintiff requested lift of stays in all the stayed  
23 cases because the United States Patent and Trademark Office had published an Ex  
24 Parte Reexamination Interview Summary noting that agreement had been reached to  
25 withdraw all of the PTO's rejections regarding disputed claims of the '184 patent in  
26 the two reexaminations upon which the stay had been based.

27 6. On July 10, 2009, the Court denied the request to lift stays because "the  
28 record is not clear that allowance of the claims is a foregone conclusion" and that

1 neither a NIIRC (Notice of Intent to Issue an Ex Parte Reexamination Certificate),  
2 nor a reexamination certificate had yet issued.

3 7. On October 10, 2009, Plaintiff requested the Court to terminate the  
4 immoderate and unlawful stays in the oldest 15 cases<sup>4</sup> citing the seminal United  
5 States Supreme Court case of *Landis v. No. American Co.*, 299 U.S. 248, 257 (1936)  
6 (hereinafter “Landis Motions”).

7 8. On November 20, 2009, Plaintiff requested the Court to vacate stays in  
8 another six cases<sup>5</sup> on the grounds that the stay orders (hereinafter “Vacate Stay  
9 Motions”) had stated that “if it appears that the reexamination will not be effected  
10 within a reasonable time” a request to vacate stay could be filed, and Plaintiff  
11 asserted that a reasonable time had already passed.

12 9. On December 21, 2009, more than two years after the oldest case was  
13 filed and 22 months after the initial stay was entered, the Court “denied” the Landis  
14 Motions citing the inherent power of courts to stay patent infringement suits pending  
15 outcome of reexamination.

16 10. Despite “denying” the Landis Motion, the Court stated:

17 Notwithstanding the analysis set forth above, the Court does not believe  
18 the stay should be indefinite. . . . It seems that the PTO can resolve  
19 these issues in the next several months. If the PTO can not, the light at  
20 the end of the tunnel may be so dim that the length of time required to  
21 traverse the distance becomes unreasonable. Therefore, assuming that  
22 Plaintiff does not seek any further delays in connection with the PTO’s  
23 reconsideration, the stay will expire no later than **April 30, 2010**. The  
24 parties in all pending ‘184 Patent cases shall appear before the Court for  
25 a status conference on **May 5, 2010 at 4:00 p.m.**

26 *Id.*, at pg. 4:1-9.

27 11. On January 27, 2010, the Court also “denied” the Vacate Stay Motions,

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28 <sup>4</sup> Those 15 cases included the still pending *Sorensen v. Giant*, 07cv2121, and others.

<sup>5</sup> Those six cases included the still pending *Sorensen v. Human Touch*, Case No. 08cv1080, and others.

1 stating:

2 Plaintiff recently filed similar motions to vacate stays in several related  
3 cases. The Court denied those motions, and the reasoning in those  
4 orders applies with equal force here. Thus, for the reasons stated in the  
5 Court's Joint Order dated December 21, 2009 . . . the Court DENIES  
6 each of the six Motions to Vacate Stays Per Terms of Stay Orders . . .  
7 the stays in these six cases will nevertheless expire on April 30, 2010. . .

8 12. Several of the Sorensen cases did not have formal stay motions filed or  
9 stay orders issued, but Plaintiff was still prohibited by  
10 Court order and/or actions from proceeding with the cases. These cases include the  
11 still pending *Sorensen v. Target* (see Doc. #21-23, 26, 28, 31, 33).

12 13. The *Sorensen v. Spectrum* case was subject to an automatic bankruptcy  
13 stay almost immediately upon the filing of this case (see Doc. #11), but emerged  
14 from the bankruptcy stay only long enough for Spectrum to file an Answer and  
15 Counterclaims and striking of all of Spectrum's invalidity accusations by both  
16 counterclaim and affirmative defense. Notwithstanding the elimination of all  
17 invalidity contentions, the Court entered a stay and gave Spectrum 45 days after lift  
18 of stay to amend. See Doc. #26.

19 14. Additionally, on March 17, 2010, the Court issued an "Order Setting  
20 Status Conference in All Sorensen Cases" which stated that:

21 Any stay issued by the Court in [the Sorensen cases], except for  
22 bankruptcy stays and stays on appeal, shall be dissolved on **April 30,**  
23 **2010** absent further action by the Court. The parties' counsel in all the  
24 above-captioned cases, including those subject to bankruptcy stays and  
25 stays on appeal, shall appear before the Court for a status conference on  
26 **May 5, 2010 at 4:00 p.m.**

27 15. Despite ordering that the stay "expire no later than" April 30, 2010, on  
28 March 29, 2010, the Court issued another order refusing the parties the ability to  
proceed in any manner on this case until after the May 5<sup>th</sup> status conference.  
*Sorensen v. Giant*, Docket No. 71.



1           16. On May 5, 2010, without any notice to the parties or opportunity for  
2 briefing, the Court conducted an impromptu hearing on why the case should not  
3 continue to be stayed. This intent of the Court was not voiced until *after* all of the  
4 parties had made statements on the record.

5           17. During the impromptu hearing on May 5<sup>th</sup>, the Court indicated certain  
6 beliefs or understandings regarding the proceedings that were not legally accurate,  
7 but the Plaintiff was not prepared to sufficiently argue them on the spot and were  
8 never offered an opportunity due to lack of notice regarding the intended scope of  
9 the hearing and not being provided any opportunity to brief the matters.

10           18. Further, the Court did not acknowledge the impact of the *Landis*  
11 prohibition of immoderate stays on May 5<sup>th</sup>. In fact, during the hearing the Court  
12 first stated that the stay would proceed until the BPAI made a decision even though  
13 that was 29 months away, though later stated only one year: “I’m going to grant the  
14 stay for a period of one year and then we will see what is happening at that point.”  
15 *Transcript* at page 50:16-18.

16           19. The resulting “Joint Order Entering Stay in Sorensen Cases” continued  
17 stays of all of the Sorensen cases until May 9, 2011, however, does not state that stay  
18 will actually be lifted at that time.

19           20. In short, all of Sorensen’s cases have been effectively stayed  
20 continuously since 2007 and no definitive end of stay has been ordered.

21           21. On June 4, 2010, the USPTO issued a new Advisory Action that  
22 materially changed the status of the reexamination as described above.

23           22. On June 4, 2010, Defendants in the *Sorensen v. Helen of Troy, et al*,  
24 case filed an Opposition to Plaintiff’s motion to proceed on Claim 3 of the patent,  
25 and claim never subject to reexamination, which by its arguments highlighted the  
26 huge problems created via such lengthy stays.

1 SWORN TO under penalty of perjury of the laws of the State of California  
2 and the United States, this Wednesday, June 09, 2010.

3  
4 /s/ Melody A. Kramer

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Melody A. Kramer, Esq.  
7 Attorney for Plaintiff  
8 mak@kramerlawip.com  
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1 PROOF OF SERVICE

2 I, Melody A. Kramer, declare: I am and was at the time of this service  
3 working within in the County of San Diego, California. I am over the age of 18 year  
4 and not a party to the within action. My business address is the Kramer Law Office,  
5 Inc., 9930 Mesa Rim Road, Suite 1600, San Diego, California, 92121.

6 On Wednesday, June 09, 2010, I served the following documents:  
7

8 **PLAINTIFF'S AMENDED MOTION FOR RECONSIDERATION OF JOINT ORDER**  
9 **ENTERING STAY IN SORENSEN CASES**

10 Service was effectuated by electronically filing the documents via the  
11 CM/ECF system for the United States District Court for the Southern District of  
12 California in the above-identified cases, and relying upon the ECF emailing to  
13 distribute service to all parties.

14 I declare that the foregoing is true and correct, and that this declaration was  
15 executed on Wednesday, June 09, 2010, in San Diego, California.  
16

17 /s/ Melody A. Kramer

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19 Melody A. Kramer  
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