

1 QUINN EMANUEL URQUHART  
& SULLIVAN, LLP  
2 David Eiseman (Bar No. 114758)  
50 California Street, 22nd Floor  
3 San Francisco, California 94111  
Telephone: (415) 875-6600  
4 Facsimile: (415) 875-6700  
davideiseman@quinnemanuel.com

5 Attorneys for Defendant  
6 Barnes & Noble, Inc.

7  
8 UNITED STATES DISTRICT COURT  
9 NORTHERN DISTRICT OF CALIFORNIA  
10 SAN FRANCISCO DIVISION

11 TECHNOLOGY PROPERTIES LIMITED, ) CASE NO. C 12-3863 NC  
12 LLC, PHOENIX DIGITAL SOLUTIONS )  
13 LLC, AND PATRIOT SCIENTIFIC ) **STIPULATION AND [PROPOSED] ORDER**  
CORPORATION, ) **STAYING ACTION PURSUANT TO 28**  
14 ) **U.S.C. § 1659**  
Plaintiffs, )  
15 v. )  
BARNES & NOBLE, INC., )  
16 Defendant. )

17  
18 **STIPULATION**

19 Plaintiffs Technology Properties Limited, LLC, Phoenix Digital Solutions, LLC, and  
20 Patriot Scientific Corporation (collectively, “TPL”), and Defendant Barnes & Noble, Inc. (“Barnes  
21 & Noble”) herein seek to stay this entire civil action (“Action”) pursuant to 28 U.S.C. § 1659 and  
22 the Court’s inherent powers. Subject to Barnes & Noble reserving its right to contest jurisdiction,  
23 venue, and service and all other rights to answer or otherwise respond to the Complaint at a later  
24 time, TPL and Barnes & Noble hereby agree and stipulate to a stay of this Action, on the  
25 following grounds:

- 26 1. TPL filed its Complaint in this Court against Barnes & Noble in this case on July 24,  
27 2012, asserting infringement of U.S. Patent No. 5,440,749 (“the ‘749 Patent”), U.S. Patent No.  
28 5,530,890 (“the ‘890 Patent”), and U.S. Patent No. 5,809,336 (“the ‘336 Patent”).

1           2.       On that same day, TPL also filed a Complaint under Section 337 of the Tariff Act  
2 of 1930 (As Amended) with the U.S. International Trade Commission (“ITC Complaint”) alleging  
3 infringement of the ‘336 Patent. TPL’s ITC Complaint was filed against a number of respondents,  
4 including Barnes & Noble, the only named defendant in this Action.

5           3.       The ITC’s Notice of Institution of ITC Investigation No. 337-TA-853 was  
6 published in the Federal Register on August 24, 2012. *See 77 Fed Reg. 51,572 (Aug. 24, 2012).*  
7 Section 1659 of Title 28 provides that where “a civil action involving the parties that are also  
8 parties to a proceeding before the International Trade Commission under section 337 of the Tariff  
9 Act of 1930, at the request of a party to the civil action that is also a respondent in the proceeding  
10 before the Commission, the district court shall stay, until the determination of the Commission  
11 becomes final, proceedings in the civil action with respect to any claim that involves the same  
12 issues involved in the proceedings before the Commission.” 28 U.S.C. § 1659(a). This stay is  
13 mandatory if such a request is made within thirty (30) days from institution of the Investigation.  
14 *Id.*

15           4.       All of the requirements of Section 1659 have been met as to the ‘336 patent  
16 because (i) the parties to this Action are also parties to ITC Investigation No. 337-TA-853; (ii)  
17 Barnes & Noble, who is also a named respondent in ITC Investigation No. 337-TA-853, requests a  
18 stay, which TPL does not oppose; and (iii) the patent-infringement claims at issue in this Action  
19 include those at issue in ITC Investigation No. 337-TA-853. Further, to conserve judicial  
20 resources, TPL and Barnes & Noble agree that the Action should be stayed as to the ‘749 and ‘890  
21 patents asserted in this Action pending final resolution of ITC Investigation No. 337-TA-853. The  
22 Court has the inherent power to grant such a request. *See SanDisk Corp. v. Phison Elecs. Corp.*,  
23 538 F. Supp. 2d 1060, 1065 (W.D. Wis. 2008) (district courts have the power to stay patent  
24 infringement proceedings that pertain to similar issues in investigations pending in the ITC even  
25 when the patents at issue are not identical).

26           Accordingly, subject to the approval of the Court, the parties agree to stay the entirety of  
27 this Action, including, without limitation, the time to answer or otherwise respond to the  
28 Complaint, until the determination of the Commission becomes final in ITC Investigation No.

1 337-TA-853, including any and all appeals. The parties agree that Barnes & Noble need not  
2 respond to the Complaint before the Court approves this Stipulation and Order, and further agree  
3 that upon dissolution of the stay, Barnes & Noble will have thirty (30) days to answer or otherwise  
4 respond to the Complaint.

5 For all the foregoing reasons, TPL and Barnes & Noble respectfully request that the Court  
6 stay this action as to all parties pursuant to 28 U.S.C. § 1659(a) and the Court's inherent powers.

7

8 Dated: September 21, 2012

QUINN EMANUEL URQUHART &  
SULLIVAN, LLP

9

10

By: /s/ David Eiseman

11

David Eiseman

12

Attorneys for Defendant  
Barnes & Noble, Inc.

13

14

Dated: September 21, 2012

AGILITY IP LAW, LLP

15

16

By: /s/ Michelle G. Breit

17

Michelle G. Breit

18

Attorneys for Plaintiffs Technology  
Properties Limited LLC and Phoenix Digital  
Solutions LLC

19

20

Dated: September 21, 2012

KIRBY NOONAN LANCE & HOGE LLP

21

22

By: /s/ Charles T. Hoge

23

Charles T. Hoge

24

Attorneys for Plaintiff Patriot Scientific  
Corporation

25

26

27

28

1  
2  
3  
4  
5  
6  
7  
8  
9  
10  
11  
12  
13  
14  
15  
16  
17  
18  
19  
20  
21  
22  
23  
24  
25  
26  
27  
28

**ORDER**

PURSUANT TO STIPULATION, IT IS SO ORDERED.

Dated: September 26 2012



1  
2  
3  
4  
5  
6  
7  
8  
9  
10  
11  
12  
13  
14  
15  
16  
17  
18  
19  
20  
21  
22  
23  
24  
25  
26  
27  
28

**CERTIFICATE OF SERVICE**

I hereby certify on this 21<sup>st</sup> day of September, 2012 that a copy of the foregoing was filed electronically through the Court’s CM/ECF system, with notice of case activity automatically generated and sent electronically to all parties.

Dated: September 21, 2012

QUINN EMANUEL URQUHART &  
SULLIVAN, LLP

By: /s/ David Eiseman  
David Eiseman

Attorneys for Defendant  
Barnes & Noble, Inc.