

UNITED STATES DISTRICT COURT
EASTERN DISTRICT OF TEXAS
SHERMAN DIVISION

SPINE HOLDINGS, LLC	§	
	§	
v.	§	CIVIL ACTION NO. 4:20-CV-77-SDJ
	§	
ORTHOFIX MEDICAL, INC.	§	

ORDER GRANTING IN PART JOINT MOTION TO STAY
PENDING INTER PARTES REVIEW

Before the Court is Defendant Orthofix Medical, Inc. (“Orthofix”) and Plaintiff Spine Holdings, LLC’s (“Spine Holdings”) Joint Motion to Stay Pending Inter Partes Review. (Dkt. #7). The Court, having considered the motion and applicable law, finds that it should be **GRANTED in part**.

I

Spine Holdings has filed a complaint alleging patent infringement on United States Patent Numbers 9,216,096 and 9,649,203 by Orthofix’s post-filled spinal implant products. (Dkt. #1). Orthofix intends to file one or more petitions for inter partes review of the patents by the Patent Trial and Appeal Board (“PTAB”). In anticipation of the petition and grant of review, the parties jointly ask the Court to stay the proceedings before this Court during the inter partes review process.

Courts consider three factors when determining whether to stay a case pending inter partes review: “(1) whether the stay will unduly prejudice the nonmoving party, (2) whether the proceedings before the court have reached an advanced stage, including whether discovery is complete and a trial date has been set, and (3) whether

the stay will simplify issues in question in litigation.” *Trover Grp., Inc. v. Dedicated Micros USA*, No. 2:13-CV-1047-WCB, 2015 WL 1069179, at *2 (E.D. Tex. Mar. 11, 2015) (Bryson, J., sitting by designation) (citations omitted). A case should be stayed if, taken together, the “benefits of a stay outweigh the inherent costs of postponing resolution of the litigation.” *Id.* (citing *EchoStar Techs. Corp. v. TiVo, Inc.*, No: 5:05-cv-81, 2006 WL 2501494 (E.D. Tex. July 14, 2006)).

II

The parties have stipulated to each of the above-described factors regarding a potential stay pending inter partes review, noting that (1) no party will be prejudiced by granting the jointly requested relief, (2) the case is not at an advanced stage, as there is no scheduling order and no discovery has taken place, and (3) a stay is likely to simplify court proceedings by resolving some or all issues while conserving party and judicial resources. (Dkt. #7 at 2). The Court agrees and finds that the facts of this case weigh in favor of granting a stay. Particularly salient to the Court’s analysis is the fact that neither party will be prejudiced and that the case is early enough in the litigation process that a stay is likely to result in considerable conservation of both judicial and party resources. For these reasons, the Court will grant the motion in part and stay the case.

The parties have noted that they intend file a status report within 30 days of completion of inter partes review proceedings. The Court will instead require that the parties file a joint status report within two weeks of each of the following events regarding inter partes review: (1) filing a petition with PTAB; (2) receiving a decision

from PTAB regarding review; and (3) receiving a final decision from PTAB. The Court will additionally require that the parties file a joint status report every sixty days that the stay remains in place.

III

For the reasons stated above, it is therefore **ORDERED** that Defendant Orthofix Medical, Inc. and Plaintiff Spine Holdings, LLC's Joint Motion to Stay Pending Inter Partes Review, (Dkt. #7), is hereby **GRANTED in part**. All proceedings in this are **STAYED** pending further order of the Court.

It is further **ORDERED** that the parties will file a joint status report within two weeks of each of the following events regarding inter partes review: (1) the filing of a petition for review with PTAB; (2) a decision from PTAB regarding review; and (3) receiving a final decision from PTAB.

It is further **ORDERED** that the parties will also file a joint status report every sixty days that this stay remains in place.

So ORDERED and SIGNED this 8th day of June, 2020.


SEAN D. JORDAN
UNITED STATES DISTRICT JUDGE