

UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF KANSAS

DIGITAL ALLY, INC.,

Plaintiff,

v.

Case No. 16-2349-JTM

ENFORCEMENT VIDEO, LLC,
d/b/a WATCHGUARD VIDEO,

Defendant.

ORDER

This matter comes before the court on defendant WatchGuard's motion to stay this litigation pending resolution of five petitions for inter partes review (IPR) by the United States Patent and Trademark Office's Trial and Appeal Board (PTAB) of the patents at issue in this case (ECF No. 62). WatchGuard's motion was filed on May 11, 2017. On May 25, 2017, at the request of the parties, the court postponed consideration of the motion until after July 24, 2017.

The following IPR petitions were filed challenging the validity of the patents at issue in this case: (1) IPR2017-00375 filed by Taser on December 1, 2016 regarding U.S. Patent No. 8,781,292 ("the '292 Patent"); (2) IPR2017-00376 filed by Taser on December 1, 2016 regarding the '292 Patent; (3) IPR2017-00515 filed by Taser on December 20, 2016 regarding U.S. Patent No. 9,253,452 ("the '452 Patent"); (4) IPR2017-00775 filed by Taser on January 25, 2017 regarding the '452 Patent; and (5) IPR2017-01401 filed by WatchGuard on May 9, 2017 regarding U.S. Patent No.

9,325,950 (“the ’950 Patent”).

On June 6, 2017, the PTAB commenced review of Taser’s December 1, 2016 IPR petition challenging the validity of the ’292 Patent (Case IPR2017-00375), which implicates fourteen (14) claims at issue in this litigation (1, 8, 18, 20, 21, 26, 36, 38, 39, 42, 48, 51, 54, and 57). The PTAB’s review of that patent is ongoing. That same day, the PTAB denied review of Taser’s December 1, 2016 IPR petition (Case IPR2017-00376), which challenged the validity of certain claims of the ’292 Patent on additional grounds. On July 6, 2017, the PTAB denied review of Taser’s December 20, 2016 IPR petition (Case IPR2017-00515), challenging the validity of the ’452 Patent. The PTAB has yet to rule on Taser’s January 25, 2017 IPR petition (Case IPR2017-00775), which asserts additional challenges to the validity of the ’452 Patent. The PTAB is expected to issue its decision whether to institute review of that petition on August 8, 2017. The PTAB has also not ruled on WatchGuard’s May 9, 2017 IPR petition challenging the validity of the ’950 Patent (Case IPR2017-01401), which implicates seventeen (17) claims at issue in this litigation (1-4, 8-10, 12-17, 20-22, and 24). The PTAB is expected to issue its institution decision by December 6, 2017.

On July 25, 2017, the parties jointly submitted a report regarding a status of the IPR petitions and requested that the litigation be stayed at least until the PTAB issues an institution decision on WatchGuard’s IPR petition (Case IPR2017-01401), challenging the validity of ’950 Patent, at which time the parties request the opportunity to again report to the court regarding the status of WatchGuard’s IPR, any then-active TASER

IPRs, and how the PTAB proceedings may affect this lawsuit.

IT IS THEREFORE ORDERED that defendant's unopposed motion motion to temporarily stay litigation pending inter partes review is hereby GRANTED. The parties are ordered to jointly submit an updated report regarding the status of the petitions for inter partes review on or before **January 5, 2018**.

Dated August 1, 2017, at Kansas City, Kansas.

s/ James P. O'Hara
James P. O'Hara
U.S. Magistrate Judge