IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF UTAH, CENTRAL DIVISION

CAO GROUP, INC., Plaintiff, v. GE Lighting, Inc., Osram Sylvania, Lighting Science Group Corp., Nexxus Lighting, Inc., Toshiba International Corp., Feit Electric Company, Inc., and Lights of America, Inc., Defendants.	**ORDER** Case No. 2:11-cv-426-DB Judge Dee Benson

Before the Court is Plaintiff CAO Group, Inc.'s Motion to Reopen the Case and Lift Stay. (Dkt. 210.)[1] The motion has been fully briefed by the parties and the Court has considered the facts and arguments set forth in those filings.[2] Given the unique circumstances and social gathering restrictions brought about by the current global pandemic, the Court elects to determine the motion on the basis of the written memoranda. DUCivR 7-1(f).

DISCUSSION

Plaintiff's motion asks this Court to lift the stay and reopen this matter so that Plaintiff can assert "one or more" "new claims" resulting from reexamination. (Dkt. 210, Pl.'s Mot. at 2.) Plaintiff represents that it is "not asking this Court to decide the merits of any issue. Rather, it is simply asking the Court … to determine what would be the most efficient course forward for the

[1] This action was filed on May 10, 2011. (*CAO Group v. GE Lighting, et al.*, Case No. 2:11-cv-426, Dkt. 2.) At the joint request of the parties, on March 25, 2013, the action was stayed pending reexamination proceedings initiated by the United States Patent and Trademark Office. (Dkt. 183). The action was administratively closed on October 1, 2013. (Dkt. 185.)

[2] Defendants GE Lighting Co., Osram Sylvania, Inc., Feit Electric Co., Nexxus Lighting Inc., Lighting Science Group Corp., Toshiba International Corp., filed a joint response to Plaintiff's motion. (Dkt. 233.)

parties and the Court." (Dkt. 237, Pl.'s Reply at 3.) Having reviewed the history and current status of this case, as well as the facts and arguments set forth in the parties' filings, the Court denies Plaintiff's motion and dismisses this action.

As an initial matter, Plaintiff CAO Group no longer has an interest in the patents asserted in the Complaint (the "Asserted Patents"). Plaintiff CAO Group has assigned the Asserted Patents multiple times during the pendency of this action. (Dkt. 234, Exhs. G1, G2, H & I.) Most recently, in October 2016, Plaintiff CAO Group assigned the Asserted Patents to non-party CAO Lighting. (Dkt. 234 Exs. H & I.)

Additionally, all of the original claims regarding the Asserted Patents have been either disclaimed or cancelled, effectively rendering the case moot. *See Fresenius USA, Inc. v. Baxter Int'l, Inc.*, 721 F.3d 1330, 1340 (Fed. Cir. 2013) ("[U]nder either the reissue or reexamination statute . . . if the original claim is cancelled or amended to cure invalidity, the patentee's cause of action is extinguished and the suit fails."); *see also Mylan Pharm. Inc. v. Research Corp. Techs., Inc.*, 914 F.3d 1366, 1369 n.1 (Fed. Cir. 2019) ("[T]here is no case or controversy regarding . . . cancelled claims."). There is nothing before the Court to suggest that the Complaint filed in 2011 continues to present any viable claim. And Plaintiff's current request, seeking to reopen the case to assert "new claims," confirms this. Any potentially viable claim would require the filing of a new and amended complaint. In sum, the Court would be presented with a new plaintiff presenting new claims; essentially, a new lawsuit.

Moreover, any attempt to proceed in this Court in the District of Utah would be futile given that the one issue on which all parties appear to agree is that this Court no longer has venue. (Dkt. 234, Defs.' Opp'n at 9-10; Dkt 237, Pl.'s Reply at 4.) During the pendency of the stay in this case, the United States Supreme Court issued its decision in *TC Heartland LLC v.*

Kraft Foods Group Brands LLC, 137 S. Ct. 1514 (2017), holding that, for purposes of determining venue under the patent venue statute (28 U.S.C. 1400(b)), a corporation is deemed to "reside" only in its state of incorporation. *Id.* at 1517. The new rule of law announced in *TC Heartland* applies to cases that were pending at the time of the Supreme Court's decision; cases such as this one. *See, e.g., In re Oath Holdings, Inc.*, 908 F.3d 1301, 1303-06 (Fed. Cir. 2018) (holding that defendant had not waived venue objection by raising it for the first time after *TC Heartland*). The Defendant corporations in this case "reside" in no fewer than two different states. Notably, however, none of the Defendant corporations reside in Utah and therefore this Court is without venue.[3]

In light of the foregoing, the Court DENIES Plaintiff's Motion to Reopen the Case and Lift Stay (Dkt. 210) and DISMISSES this action in its entirety.

CAO Lighting – the purported assignee of Plaintiff CAO Group and the apparent current owner of the Asserted Patents – can proceed with whatever lawsuits CAO Lighting believes are advisable.

Dated: April 23, 2020.

BY THE COURT

Dee Benson
United States District Judge

[3] Additionally, Plaintiff failed to comply with the terms of the Stay Order which expressly provides:

> Plaintiff is directed to inform the Court of the issuance by the United States Patent Office of a notice of intent to issue a reexamination certificate in any of the identified reexaminations within ten (10) days of the receipt of such certificate. Plaintiff shall serve any such notice filed with the Court on all Defendants. The stay shall be lifted forty-five (45) days after the Court's receipt of the notice filed by Plaintiff.

(Dkt. 183, Stay Order, 3/25/2013.) Plaintiff's failure to comply with the Stay Order prevented the expeditious and orderly disposition of this case and provides an additional and independent basis for dismissal. *See Olsen v. Mapes*, 333 F.3d 1199, 1204 n.3 (10th Cir. 2003) (providing that courts may dismiss actions *sua sponte* when a plaintiff fails to prosecute or comply with orders); *see also* Federal Rule of Civil Procedure 41(b) (allowing for involuntary dismissal of an action if plaintiff fails to comply with court order or fails to prosecute).