

**IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE**

EASTMAN CHEMICAL COMPANY,)
GRUPO PETROTEMEX, S.A. DE C.V., and)
DAK AMERICAS LLC,)
)
Plaintiffs,)
)
v.) Civ. Action No. 09-971-LPS-CJB
)
ALPHAPET INC., INDORAMA HOLDINGS)
ROTTERDAM B.V., INDORAMA)
POLYMERS ROTTERDAM B.V.,)
INDORAMA POLYMERS WORKINGTON)
LTD., and INDORAMA POLYMERS PCL,)
)
Defendants.)

GRUPO PETROTEMEX, S.A. DE C.V. and)
DAK AMERICAS LLC,)
)
Plaintiffs,)
)
v.) Civ. Action No. 11-702-LPS
)
ALPHAPET INC.,)
)
Defendant.)

MEMORANDUM ORDER

Presently before the court is a motion by AlphaPet, Inc. ("AlphaPet") to consolidate Civ. Action No. 09-971-LPS-CJB ("the 971 action") with Civ. Action No. 11-702-LPS ("the 702 action"), pursuant to Fed. R. Civ. P. 42(a)(2). (971 action, D.I. 79) Eastman Chemical Company ("Eastman"), Grupo Petrotemex, S.A. de C.V. ("Petrotemex"), and DAK Americas, LLC ("DAK") timely opposed. (971 action, D.I. 89) Briefing on AlphaPet's motion to consolidate was completed on December 15, 2011, and the motion is ripe for decision.

For the reasons stated below, the Court GRANTS AlphaPet's motion to consolidate.

I. BACKGROUND

A. The 971 Action¹

The 971 action was originally filed on December 18, 2009. (D.I. 1) On March 31, 2010, Eastman filed a three-count Amended Complaint. (D.I. 15) The First Count of Eastman's Amended Complaint asserts that Defendants AlphaPet and Indorama Polymers PCL ("IRP") have infringed U.S. Patent Nos. 6,906,164 ("the '164 patent"); 7,358,322 ("the '322 patent"); and 7,459,113 ("the '113 patent") by making, using, selling, or offering for sale certain polyester monomers, polyester melt phase products, and polyester containers in the United States. (*Id.* at ¶¶ 50–52)

Each of the patents-in-suit was assigned to Eastman at the time the Amended Complaint was filed. (*Id.* at ¶ 48) However, on January 31, 2011, Eastman assigned the three patents asserted in the First Count of the Amended Complaint (along with other patents) to Petrotemex, who in turn exclusively licensed those patents to DAK. (D.I. 55 at 2)

On August 31, 2011, Judge Stark referred the 971 action to me to hear and resolve all pretrial matters, up to and including the resolution of case-dispositive motions, subject to 28 U.S.C. § 636(b).² (D.I. 65) On December 9, 2011, after receiving briefing and hearing argument from the parties on a motion by Eastman to substitute DAK and Petrotemex for Eastman as

¹ Additional background facts regarding the 971 action are found in the Court's Report & Recommendation Regarding Defendants' Motion to Dismiss the Amended Complaint (D.I. 75) and Memorandum Opinion (D.I. 81), both dated November 4, 2011, and in the Court's Memorandum Order (D.I. 92), dated December 9, 2011.

² As the instant motion was filed in the 971 action (as well as in the 702 action), I have jurisdiction to resolve the motion.

plaintiffs in the 971 action, I ordered that Petrotemex and DAK instead be joined with Eastman (collectively, "Plaintiffs") in that case. (D.I. 92)

Thereafter, Plaintiffs filed a Supplemental and Second Amended Complaint (D.I. 98), which, *inter alia*, excludes the prior claims of infringement based upon the '322 patent and the '113 patent (*id.* at 4 n.3; ¶¶ 52–55), leaving the '164 patent as the only patent asserted in the 971 action. The '164 patent is entitled "Polyester Process Using a Pipe Reactor," and names Bruce Roger DeBruin as the sole inventor. (*Id.* at ex. D) The '164 patent includes 243 claims. While the majority of these claims are directed to methods of making a polyester monomer, polymer, or oligomer from a plurality of reactants, the '164 patent also includes related apparatus claims.

The Second Count of the Second Amended Complaint asserts that defendants Indorama Holdings Rotterdam ("IHR"), Indorama Polymers Rotterdam ("IPR"), and Indorama Polymers Workington ("IPW") breached a Technology License Agreement ("the TLA"), which was entered into by Eastman, IHR, IPR, and IPW on March 31, 2008. (*Id.* at ¶¶ 18, 57–59) The TLA licenses certain intellectual property rights relating to polyethylene terephthalate ("PET") and purified terephthalic acid, but excludes other rights relating to Eastman's polyester melt phase technology, known as IntegRex™. (*Id.* at ¶¶ 18–30) The Third Count of the Second Amended Complaint asserts that all the defendants misappropriated certain Eastman trade secrets relating to IntegRex™ technology, which were not licensed under the TLA. (*Id.* at ¶¶ 60–69)

On December 8, 2011, the Court held a Rule 16 teleconference and heard argument from the parties relating to their respective scheduling proposals and discovery protocols. The Court then entered a Scheduling Order for the 971 action on December 16, 2011. (D.I. 97) Although no trial date has been set for the 971 action, the deadline for filing case-dispositive motions is

May 29, 2013. (*Id.* at 8) No defendant has yet answered the Second Amended Complaint, although briefing on a motion to dismiss IRP for lack of personal jurisdiction has been stayed, pending jurisdictional discovery that is to be completed by January 19, 2012. (*Id.* at 1)

B. The 702 Action

On August 10, 2011, Petrotemex and DAK filed the 702 action, alleging patent infringement against AlphaPet. (D.I. 1) In the 702 action, Petrotemex and DAK allege that by making, using, selling, and offering ES(11)A PET Resin for sale, AlphaPet has infringed U.S. Patent Nos. 7,868,125 ("the '125 patent"); 7,863,405 ("the '405 patent"); 7,345,139 ("the '139 patent"); and 7,989,577 ("the '577 patent") (collectively, "the 702 patents-in-suit"). (*Id.* at ¶¶ 13–16) Like the '164 patent, the 702 patents-in-suit all relate to polyester polymers, and to processes of making them. The '125, '405, and '139 patents are exclusively directed to method claims (147 claims in total), while the '577 patent includes 15 claims, all directed to polyester products. The '139 patent is a continuation of the application that led to the '164 patent (now the sole asserted patent in the 971 action). Petrotemex asserts that it is the owner by assignment of all right, title, and interest in the 702 patents-in-suit, and that DAK holds an exclusive license under each of these patents. (*Id.* at ¶¶ 8–11)

In response to the allegations of infringement, AlphaPet asserted counterclaims of non-infringement and invalidity, which DAK and Petrotemex timely opposed. (D.I. 9, 20) No scheduling order has been entered in the 702 action, and no responses to any requests for discovery have yet been served.

II. STANDARD OF REVIEW

"If actions before the court involve a common question of law or fact, the court may . . .

consolidate the actions." Fed. R. Civ. P. 42(a). The Court has broad authority to consolidate actions involving common questions of law or fact if, in its discretion, such consolidation would "facilitate the administration of justice." *Ellerman Lines, Ltd. v. Atlantic & Gulf Stevedores, Inc.*, 339 F.2d 673, 675 (3d Cir. 1964). Although the existence of common questions of law or fact is a prerequisite to consolidation, their presence does not require consolidation pursuant to Rule 42(a). *Rohm & Haas Co. v. Mobil Oil Corp.*, 525 F. Supp. 1298, 1309 (D. Del. 1981). Instead, in considering such a motion, the Court must balance any savings of time and effort gained through consolidation against any "inconvenience, delay, or expense" that may result. *Id.*

III. DISCUSSION

A. Common Questions of Law or Fact

In line with the requirements of Rule 42(a), AlphaPet argues that there are multiple common questions of law and fact between the 971 and 702 actions. For example, AlphaPet states that "[a]ll asserted claims and all accused technology relate to [PET] technology," that "[a]ll claims in both [the 971 and 702 actions] are asserted against the same Alpha[P]et PET manufacturing plant in Decatur, Alabama," and that "there is in substance a complete overlap in parties between the cases." (D.I. 79 at 2)³ AlphaPet further contends that because the '139 patent is a continuation of the '164 patent, and because all of the patents relate to similar technology, "[c]ommon questions of law and fact will arise, for example, with respect to the conception and reduction to practice of the invention, and during claim construction when the Court construes the meaning of the claim terms." (*Id.* at 3) In response, Plaintiffs do not directly dispute that

³ Hereinafter all record citations, unless otherwise noted, are to items on the docket in the 971 action.

there is a common question of law or fact between these two actions, but instead contend that the "commonalities of parties, law, and fact" that do exist are "insufficient . . . to justify consolidation." (D.I. 89 at 1)

The Court agrees with AlphaPet that there are numerous common questions of law and fact between the 971 action and the 702 action. For example, both the 971 action and the 702 action involve patents that cover similar technology relating to polyesters, and to methods of making them. One patent (the '164 patent) is asserted in the 971 action, and four patents are asserted in the 702 action. All five of these asserted patents were classified by the U.S. Patent & Trademark Office as belonging to Class 528, while the '164 patent, the '139 patent, and the '577 patent each fall into Subclass 308. (971 action, D.I. 98 at ex. D; 702 action, D.I. 1 at exs. A–D) This Court has frequently ordered consolidation where the technology at issue in the separate actions appeared to be similarly related. *See, e.g., Abbott Diabetes Care, Inc. v. Dexcom, Inc.*, C.A. No. 06-514 GMS, 2007 WL 2892707, at *4 & n.5 (D. Del. Sept. 30, 2007) (consolidating two proceedings where multiple patents were asserted, and noting that "[t]he PTO's classification of most of the patents into the same Class persuades the court" that the asserted patents there claimed "related technologies"); *Rohm & Haas Co.*, 525 F. Supp. at 1301 & n.2, 1309–10 (consolidating a declaratory judgment action with a patent infringement action in part because "[a]ll of the six patents underlying the two suits are directed toward different [diphenyl ether compounds characterized by a common formula and chemical substituents] such that "the questions to be decided in both suits are highly technical and closely intertwined").

Although Plaintiffs contend that "the technology of the patents in the 702 [a]ction involves substantial differences from the claims at issue in the 971 [a]ction," (D.I. 89 at 4),

Plaintiffs do not then identify a specific asserted difference as to the respective technologies at issue. While it is certainly true that the claims of these five patents differ in scope, the Court finds that the underlying technology is generally similar, in that all of the asserted patents relate to polyester processes or particles. Indeed, given that the '164 patent and the '139 patent are from the same family, they share the same specification, and the vast majority of their claims describe similar processes of making esters using a pipe reactor. *Cf. Rohm & Haas Co.*, 525 F. Supp. at 1310 (noting that because "the claims of several of the[] patents [at issue in the consolidated actions] overlap" and "all can be traced to a common . . . specification," common issues of law and fact existed). In light of their technological similarities, considering the '164 patent and the 702 patents-in-suit together during pretrial proceedings will likely result in synergies that would otherwise be lost if the cases were to proceed on separate paths.

Moreover, the two matters involve related technologies that were allegedly utilized at a single AlphaPet facility in Decatur, Alabama. (D.I. 79 at 3) This will likely result in other commonalities of fact and law. For example, the development and scope of the parties' respective PET trade secrets will likely be relevant to both actions, given that those issues will be closely tied to the ultimate question of whether infringing activity has occurred. And given that it appears that the allegedly infringing conduct in both cases occurred at the same facility by employees of the same company (AlphaPet), there are likely to be numerous similarities among the defenses asserted in these two actions. For these reasons, the Court finds that Rule 42(a)'s requirement that "common questions of law or fact" exist among the actions has been met.

B. Consolidation Would Best Facilitate Conduct of This Litigation

Having determined that there are common questions of law and fact between the two

actions, the Court must then examine whether consolidating the cases would best serve the administration of justice. In making this determination, this Court has generally examined whether there are overlapping parties, witnesses and documents between the actions; or whether consolidation would likely generate inconvenience, delay, expense or the risk of inconsistent results. *See generally Waste Distillation Tech., Inc. v. Pan Am. Res., Inc.*, 775 F. Supp. 759, 761 (D. Del. 1991); *Rohm & Haas Co.*, 525 F. Supp. at 1310.

1. Increased Efficiency Regarding Overlapping Parties, Witnesses and Documents

In this case, there are likely to be a number of efficiencies that result from consolidation. First, there is significant overlap of parties between the two actions, which should result in a more coordinated, focused discovery and pretrial process than in cases involving multiple unrelated, unaffiliated parties. For example, in the 971 action (in light of this Court's recent Order regarding joinder), Petrotemex, DAK, and Eastman are named plaintiffs, while Petrotemex and DAK are the only plaintiffs in the 702 action. Although Plaintiffs note that Eastman is "not a party in the 702 Action," (D.I. 89 at 2), that is only because Eastman recently sold its rights to the asserted patents to Petrotemex, who licensed them to DAK. This series of transactions does not diminish the relatedness among the plaintiffs in both actions. All the asserted patents in both cases were applied for by the same party (Eastman), were sold by Eastman or were directly issued to the same party (Petrotemex), and were then licensed by Petrotemex to the same party (DAK). All three of those parties are plaintiffs in the two actions taken together; two of them are plaintiffs in both.

As for the defendants, it is significant that AlphaPet is a named defendant in both cases.

As noted above, in both cases, AlphaPet's employees and Alabama PET facility appear to be at the center of many disputed issues. Plaintiffs correctly note that in the 971 action, there are four other named defendants: IRP, IHR, IPR and IPW. (D.I. 89 at 3) It may be that the involvement of these four defendants (whose principal places of business are overseas) in the 971 action will implicate disputes that would not have arisen in the 702 action. But again, there is a significant interrelationship among the defendants, which are all directly or indirectly related corporations represented by the same counsel. Indeed, it was Eastman who, in the context of its previous Motion for Jurisdictional Discovery, repeatedly emphasized the close corporate connections between these five defendants. (D.I. 28 at 4–5, 8)

Second, in addition to the overlap amongst parties, document discovery is also likely to overlap considerably between the two actions, given that the same conduct in the same AlphaPet Alabama PET facility is at issue in both actions and that at least two of the five asserted patents are directly related. (D.I. 96 at 7) In addition, there are likely to be a number of witnesses whose testimony will be relevant to both the 971 action and the 702 action. For instance, Bruce Roger DeBruin is a named inventor on all of the patents asserted in both actions. Moreover, individuals working at the Alabama PET facility—particularly certain Eastman employees who were transferred pursuant to the TLA and related agreements (*see* D.I. 98 at ¶ 20)—will likely be called upon to testify in both cases. It will be more efficient and expeditious to coordinate deposition testimony and document discovery issues (and to adjudicate any disputes that arise regarding those topics) in consolidated cases, which will proceed on the same schedule.

In opposing consolidation, Plaintiffs have rightly noted that there are differences between the 971 action and the 702 action. For example, Plaintiffs emphasize that unlike the 702 action,

the 971 action includes non-patent claims, and contend that "[t]he law and facts surrounding the trade secret and breach of contract claims in the 971 [a]ction are wholly different from the patent infringement issues raised in the 702 [a]ction." (D.I. 89 at 3) There is little doubt that the trade secret and breach of contract claims in the 971 action will implicate certain legal or factual issues that would not have otherwise arisen in the 702 action. This may include the impact of Delaware trade secret law on the discovery process—an issue that has already been raised by the parties in the 971 action. (D.I. 83 at 3) However, the breach of contract and trade secret claims in the 971 action (the Second and Third Counts) were brought alongside the patent infringement claims (the First Count). This suggests that, at least in Plaintiffs' view, there is some factual nexus or overlap among these albeit legally distinct claims. Moreover, the TLA, which is at the heart of both the breach of contract and trade secret misappropriation claims in the 971 action, licenses certain patent rights from Eastman to IHR, IPR, and IPW. Thus, resolution of even the Second and Third Counts of the 971 action will likely involve patent law issues, which are in turn likely to implicate the technology of the asserted patents. (D.I. 98 at ¶¶ 18–30) In short, while the breach of contract and trade secret claims in the 971 action do present issues that are different from those at play in the 702 action, the degree of that difference is not particularly great.

Even when faced with disparate proceedings implicating different law, this Court has ordered consolidation so long as there was "minimal factual and legal overlap" between actions. *Syngenta Seeds, Inc. v. Monsanto Co.*, No. Civ. 04-908-SLR, 2005 WL 678855, at *3 (D. Del. Mar. 24, 2005). In *Syngenta*, the defendants moved to consolidate a patent infringement action (referred to as the "Shah Litigation") with a separate action alleging that the defendants' conduct in the corn seed market violated Section 2 of the Sherman Act (referred to as the "Antitrust

Litigation"). *Id.* at *1. In reviewing the motion to consolidate, this Court noted that "the Antitrust Litigation presents distinct factual issues from the Shah Litigation," and particularly highlighted the distinct legal issues that each action presented:

The Shah Litigation will focus on patent issues such as construction of patent claims, whether defendants are estopped from asserting the [patent-in-suit] based on representations made in prior litigations, whether the [patent-in-suit] is valid, and whether plaintiff infringes the [patent-in-suit]. The Antitrust Litigation will focus on typical antitrust issues such as whether defendants are monopolists and whether defendants engaged in anticompetitive conduct.

Id. at *2. Despite these distinctions, there was nonetheless overlap in the underlying technology at issue in the two cases, such that the Court found that "consolidating the Shah Litigation and the Antitrust Litigation will be more efficient than managing the cases separately." *Id.* at *3. Here, while there may be some legal and factual distinctions between the patent infringement counts at issue in the 971 and 702 actions on the one hand, and the breach of contract and trade secret counts at issue in the 971 action on the other hand, there is far more than the "minimal" overlap at issue in *Syngenta*, which did not preclude consolidation in that case.

Plaintiffs also characterize AlphaPet's motion as "rel[ying] heavily on the fact that one of the patents in the 702 [a]ction is 'related' to a patent at issue in the 971 [a]ction," and cite two decisions from this Court denying consolidation where certain "*identical*" patents were asserted in two different actions. (D.I. 89 at 4 (emphasis in original)) Plaintiffs first cite *Clopay Corp. v. Newell Cos.*, 527 F. Supp. 733, 735 (D. Del. 1981), a case in which they state that "this Court [] declined to consolidate cases when one identical patent was involved in two cases." (*Id.* at 4) While this description is accurate, *Clopay* is distinguishable from the present circumstances.

In *Clopay*, the plaintiff asserted infringement of the same patent against two defendants in two separate actions. *Clopay*, 527 F. Supp. at 735. Each of these defendants separately moved for transfer to another jurisdiction. *Id.* While those transfer motions were pending, plaintiff *Clopay* moved to consolidate the two cases and keep them in the District of Delaware. *Id.* In granting transfer of the cases to the Northern District of Illinois, this Court noted that both of those "suits have their 'center of gravity' in the mid-West," and that every potential witness "is a resident of either Illinois or Wisconsin." *Id.* at 736. This Court thus found that any efficiency gained by consolidating the cases for pretrial purposes would be lessened by "structuring the cases in a way that requires any disputes relating to discovery—disputes likely to arise in Illinois, Ohio, or Wisconsin—[to] be resolved in Wilmington." *Id.* In contrast, here no party to the 971 or 702 actions has moved to transfer, and there has been no suggestion that this litigation will not best proceed in Delaware (as opposed to another forum). Even more significantly, the *Clopay* Court was clearly concerned that because *Clopay* had sued two different, apparently unrelated companies in the respective actions, consolidation might prejudice the defendants, as "it may not be reasonable to expect a jury to screen out, in its deliberations regarding one defendant, evidence it has been instructed to consider with respect to another defendant." *Id.* at 735. In this case, in contrast, not only is there a close connection between the defendants in both actions (who, unlike in *Clopay*, are the parties seeking consolidation here), but, as discussed below, the Court's decision here does not require that the instant actions be consolidated for trial.

Plaintiffs also cite *Apple Inc. v. High Tech Computer Corp.*, C.A. No. 10-544-GMS, 2011 WL 143909 (D. Del. Jan. 18, 2011), alleging that in that case, "this Court . . . declined to consolidate cases where *three* identical patents were shared between the actions." (D.I. 89 at 4

(emphasis in original)) As was the case with *Clopay*, however, *Apple* is easily distinguishable from the present circumstances. In *Apple*, the Court was faced with a motion to consolidate four separate actions (two of which were stayed at the time) involving at least twenty-seven patents. Brief in Opposition to Motion to Consolidate at 5, *Apple, Inc. v. High Tech Computer Corp.* (D. Del. June 21, 2010) (No. 10-167, D.I. 41). Of the 19 patents at issue in the non-stayed actions, only three patents overlapped. *Id.* The requested consolidation was denied not because there were no common questions of fact, but because the sheer "magnitude of the cases" and "limited commonalities" among the many non-overlapping patents would result in an unworkable proceeding. *Apple*, 2011 WL 143909 at *3. In contrast, here AlphaPet seeks to consolidate only two cases involving at total of five patents, where all of the parties in the 702 action are already parties to the 971 action. Even if consolidated, the resulting proceeding would involve far less complexity and diversity than was at issue in *Apple*.

2. Potential for Inconvenience, Delay, Expense, or Inconsistent Results

Much of Plaintiffs' opposition to consolidating the 971 and 702 actions centers on their concern that consolidation "will likely significantly delay—and not expedite—resolution of the 702 [a]ction." (D.I. 89 at 1) This concern appears to be based on DAK and Petrotemex's proposed schedule for the 702 action. Plaintiffs assert that discovery in the 702 action could proceed more promptly than in the 971 action, primarily because less discovery will be needed on the patent claims in the 702 action as compared to the 971 action, which also involves trade secret and breach of contract claims. (*Id.* at 5)

As discussed above, no scheduling order has been entered in the 702 action, and while requests for discovery have recently been served by both sides, no responses have yet been

served. (702 action, D.I. 15–17) If anything, discovery should, at least as an initial matter, proceed more rapidly in the 971 action, given that the parties should have preserved and gathered relevant information during the two years that case has been pending. In both actions, discovery will likely involve the background, structure, processes, products, and operation of the AlphaPet facility in Alabama, including the alleged purchase of third-party technology to produce PET products, and related expert discovery. (D.I. 96 at 7) While it may be (though it is not certain) that some aspects of discovery on the patent claims in the 702 action could move more quickly than they might if that case were consolidated with the 971 action, the overlapping nature of discovery applicable to both cases means that efficiency will best be aided by consolidation. *Rohm & Haas Co.*, 525 F. Supp. at 1310 (noting that where "both cases will undoubtedly involve a large number of the same witnesses, and the same documentary evidence" this weighs in favor of consolidation).

Moreover, a review of the parties' proposed schedules in the 702 action convinces the Court that consolidating the two actions for pretrial purposes will not likely result in undue delay. DAK and Petrotemex's proposed schedule for the 702 action is not dramatically different from the schedule currently in place in the 971 action.⁴ In the 702 action, DAK and Petrotemex seek to hold a *Markman* hearing on July 25, 2012; in the 971 action, a *Markman* hearing is scheduled for just over two months later on October 3, 2012. (702 action, D.I. 13 at 9; 971 action, D.I. 97 at 7) Moreover, under DAK and Petrotemex's proposal for the 702 action, discovery will not close until September 12, 2012 (D.I. 13. at 2), which is only four months before the date

⁴ AlphaPet's proposed schedule in the 702 action is nearly identical to the schedule currently in place in the 971 action. (*Cf.* 702 action, D.I. 13; 971 action, D.I. 97)

currently scheduled for close of discovery in the 971 action (D.I. 97 at 2).

Indeed, perhaps the most significant difference between DAK and Petrotemex's proposed schedule for the 702 action and the current schedule in the 971 action is Plaintiffs' proposal to conduct document discovery in the 702 action over a very limited period ending on February 24, 2012—an unworkably short period of time to conduct such discovery. (702 action, D.I. 13 at 3) The document discovery deadline in the 971 action is August 1, 2012—a date that would provide for a reasonable period of document discovery if also utilized in the 702 action. In light of the similarities amongst the schedule in the 971 action and the proposals in the 702 action, as well as the other factors listed above, the Court finds that Plaintiffs would not be unduly prejudiced if the two actions are consolidated and the schedule in the 971 action is imposed for both cases.⁵ If anything, the schedule currently in place in the 971 action is a more reasonable schedule for the 702 action than the one that Plaintiffs proposed.

In addition, to the extent that Plaintiffs are concerned that discovery on the trade secret claims will slow the progress of the consolidated action (D.I. 89 at 4), that issue is at least partly in Plaintiffs' hands. Both sides have an obligation to work together in good faith in order to minimize any discovery disputes regarding the trade secret claim. In addition, the Court will be mindful of the need for discovery to move forward expeditiously in the consolidated cases, especially in light of the time that has elapsed since the filing of the 971 action.

⁵ In contrast, in at least one case in this circuit where consolidation was not ordered due to concerns regarding the discovery schedule, the actions at issue were at vastly different stages from the cases here. *See, e.g., Borough of Olyphant v. PPL Corp.*, 153 F. App'x 80, 80–82 (3d Cir. 2005) (upholding district court's decision to deny motion to consolidate where fact discovery in one case had been closed for nearly a year, while fact discovery in the other case had just begun and would not close for nine more months).

Plaintiffs have not identified any additional expense or inconvenience that it would suffer if the 702 and 971 actions were consolidated. Given that, and in light of the other factors discussed above, Court finds that the relationship between the cases and the efficiencies that would be gained by combining these cases into a single action weighs strongly in favor of consolidation.⁶

3. Potential for Jury Confusion if Consolidated for Trial

Plaintiffs also oppose AlphaPet's motion, at least in part, based on their view that granting this motion would necessarily involve consolidating "for purposes of trial." (D.I. 89 at 1) However, Rule 42(a) does not foreclose the possibility of separate trials. Indeed, Rule 42(b) provides that "[f]or convenience, to avoid prejudice, or to expedite and economize, the court may order a separate trial of one or more separate issues, claims, crossclaims, counterclaims, or third-party claims." Fed. R. Civ. P. 42(b). This Court has frequently consolidated cases solely for pre-trial purposes, and left open the question of how the actions will ultimately be tried. *See, e.g., Tracinda Corp. v. DaimlerChrysler AG*, No. CIV. A. 00-993-JJF, 2001 WL 849736, at *3 (D. Del. July 26, 2001) (ordering "consolidation for pre-trial and discovery purposes," while "reserv[ing] decision on the question of consolidation for trial purposes"); *Honeywell Int'l Inc. v. Audiovox Comm'ns Corp.*, No. Civ.A. 04-1337-KAJ, 2005 WL 2465898, at *4 (D. Del. May 18, 2005) (consolidating multiple patent actions for pretrial purposes but noting that "[w]hether a single trial . . . makes sense is a question for another day").

⁶ The Court agrees with Plaintiff that if the two actions were not consolidated, there is little chance of inconsistent results (such those arising from two separate claim construction proceedings), because both actions are pending before the same district judge in the same jurisdiction. (D.I. 89 at 6) While this factor does not support consolidation, the other countervailing factors discussed above do.

Although the 971 action was referred to me for pretrial purposes, these cases will be tried before Judge Stark (absent consent of the parties to a U.S. Magistrate Judge's authority to conduct all proceedings), who will make all decisions regarding the nature and conduct of any trial. In light of this, and in recognition of the many contingencies that could occur over the intervening months that might impact whether these cases should be tried jointly or separately, I decline to rule on whether the cases should be consolidated for purposes of trial. To the extent that Plaintiffs wish to have certain issues or claims separately tried, they can move Judge Stark to do so at a later time. At this stage, the Court finds that the cases should be consolidated solely for pretrial purposes, up through and including the resolution of case-dispositive motions.

IV. CONCLUSION

For the foregoing reasons, it is hereby ORDERED that Civ. Action No. 09-971-LPS-CJB and Civ. Action No. 11-702-LPS are consolidated for all pretrial purposes. Hereafter all papers shall be filed under Civ. Action No. 09-971-LPS-CJB. The consolidated action shall proceed according to the Court's Scheduling Order in the 971 action (D.I. 97).

Dated: December 29, 2011



Christopher J. Burke
UNITED STATES MAGISTRATE JUDGE