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U.S. District Court
District of Delaware (Wilmington)
CIVIL DOCKET FOR CASE #: 1:20-cv-01197-GBW-CJB

Tonal Systems, Inc. v. iFIT Inc.
Assigned to: Judge Gregory B. Williams
Referred to: Judge Christopher J. Burke
Related Case: [1:21-cv-00652-GBW-CJB](#)
Cause: 35:1 Patent Infringement

Date Filed: 09/08/2020
Date Terminated: 05/12/2023
Jury Demand: Both
Nature of Suit: 830 Patent
Jurisdiction: Federal Question

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02/09/2023

188

ORAL ORDER: The Court, having reviewed Tonal Systems, Inc.'s ("Tonal") motion to stay pending inter partes review ("IPR"), (D.I. 144 or "Motion"), having reviewed the parties' letter briefing, (D.I. 145; D.I. 151; D.I. 153), and having considered the three stay-related factors, hereby ORDERS that the Motion is DENIED. The Motion presents a very close call, and Tonal made some good arguments in favor of granting it. But for the following reasons, the Court concludes that a stay is not appropriate: (1) The simplification factor favors iFit Inc. ("iFit"), or is at most neutral. Now, to be sure, Tonal did persuasively explain why the U.S. Patent Trial and Appeal Board's ("PTAB") review of the 268 and 214 patents-in-suit (including 19 of the 24 asserted claims as to those patents), will have an impact not only on Section 102/103 validity assessments of those claims, but also as to issues relevant to the asserted claims of the 925 and 767 patents-in-suit that are not in IPR (as to which there are a total of 12 additional asserted claims in this case). Because all four patents are related, and share lots of overlapping claim terms, the IPR process will likely add real value to the Court's review of all asserted claims in this case, impacting various legal defenses at play. Cf. IOENGINE, LLC v. PayPal Holdings, Inc., Civil Action No. 18-452-WCB, Civil Action No. 18-826-WCB, 2019 WL 3943058, at *9 (D. Del. Aug. 21, 2019). But that said, only a little over 50% of the 36 asserted claims are at issue in the PTAB. And even if Tonal is entirely successful with its IPRs, claims from all four patents-in-suit will still be going forward in this case. (D.I. 187 (hereinafter, "Tr.") at 36) Moreover, iFit effectively explained why, in light of the numerous defenses that Tonal is raising here (including some that you do not see in every case, like inequitable conduct, reverse doctrine of equivalents, or obviousness-type double patenting), if Tonal is unsuccessful with its IPRs, then a greater-than-usual percentage of its total defenses will still be viable in district court (and left for this Court to address). (D.I. 151 at 1-2) Lastly, the fact that we are in this predicament (that is, that we are dealing with a case where two patents-in-suit are at issue in IPRs and two are not) is due at least in part to Tonal's strategic choices. Tonal chose not to challenge the asserted claims of the 925 and 767 patents (and certain of the asserted claims of the 268 and 214 patents) in the PTAB, in significant part because it felt it had strong non-infringement arguments against those claims (or because the claims were "trivial" in its view). (Tr. at 20, 24-33) In other words, Tonal intentionally did not put all of its eggs in the IPR basket; it felt that proceeding in two fora as to these four patents made sense, at least as an initial matter. Having made that choice, Tonal cannot be entirely surprised with an outcome here that results in dual tracking.; (2) As to the case status factor, it may slightly favor Tonal, though only barely so, as we are around the halfway mark in the case. See WSOU Invs., LLC v. Netgear, Inc., Civil Action No. 21-1117-MN-CJB, Civil Action No. 21-1120-MN-CJB, 2022 WL 17337924, at *1 (D. Del. Nov. 30, 2022); Speyside Med., LLC v. Medtronic Corevalve, LLC, Civil Action No. 20-361-GBW-CJB, D.I. 155 (D. Del. Sept. 30, 2021) ("Speyside"). On the one hand, we are almost at the close of fact discovery, the Markman hearing is next week, and the Court has already resolved a number of issues in the cases. On the other hand, no Markman decision has issued, and expert discovery, summary judgment and trial all lay ahead.; (3) With regard to the undue prejudice factor, again, it is close. It might slightly favor iFit; if not, it is neutral. The Court sees no evidence of gamesmanship as to Tonal's timing for filing the IPR petitions (it did so on the last day of the statutory deadline, but its petitions were understandably filed only shortly after iFit was required to dramatically narrow the number of asserted claims in this case) or for a stay. (Tr. at 44-45) That said, there is some evidence of direct competition. The record includes a sworn declaration from a 26-year Vice President of Public Relations and Corporate Communications and Director of Marketing for iFit; the declarant asserts that iFit and Tonal are the only major players in the "interactive, motor-controlled cable strength training device[]" market. (D.I. 151, ex. C at paras. 10-11) Though Tonal carries the burden on this Motion, it chose not to submit record evidence on the competition issue. And though there is evidence indicating that some potential buyers of iFit's devices may look to a broader array of competing choices beyond just

		Tonal's products, (id., ex. 2 at 1), that does not mean that an amount of head-to-head competition does not exist. There is thus some prospect that iFit may be unduly prejudiced were this case to drag out far longer than normal.; (4) With each of the factors being close to neutral (and some perhaps slightly favoring iFit), a clear case for a stay has not been made.; and (5) The Court notes that this Motion is close on its facts to another motion to stay -- one that the Court granted -- in Speyside. That motion too was a "tough call[.]" (Speyside, D.I. 155) But despite the many similarities between the motions, there are a few differences that led to the different outcomes: (a) in Speyside, three of the five patents-in-suit were at issue in the PTAB; here, it is only two of four; (b) in Speyside, all asserted claims of the three IPR patents-in-suit were instituted on; here, none of the four patents-in-suit have all asserted claims at issue in the PTAB; and (c) in Speyside, the parties were not direct competitors; here, there is some evidence of direct competition. (Id.) Ordered by Judge Christopher J. Burke on 2/9/2023. (dlb) (Entered: 02/09/2023)
02/09/2023	189	NOTICE to Take Deposition of Colleen Logan on February 10, 2023 filed by Tonal Systems, Inc..(Ying, Jennifer) (Entered: 02/09/2023)
02/10/2023	190	ORAL ORDER: For the Court's administrative purposes, by no later than February 14, 2023, each party shall file a "Motion for Claim Construction" that requests the Court to adopt the claim construction position(s) of that party set forth in the Amended Joint Claim Construction Chart and their briefing. The motion shall not contain any argument and shall simply state that the party "requests that the Court adopt the claim construction position[s] of [the party] set forth in the Amended Joint Claim Construction Chart and its briefing." Ordered by Judge Christopher J. Burke on 2/10/2023. (dlb) (Entered: 02/10/2023)
02/10/2023	191	MOTION for Claim Construction re 119 Joint Claim Construction Brief, 130 Claim Construction Chart, 190 Oral Order,, - filed by Tonal Systems, Inc.. Motions referred to Christopher J. Burke.(Ying, Jennifer) (Entered: 02/10/2023)
02/10/2023	192	MOTION for Claim Construction re 119 Joint Claim Construction Brief, 130 Claim Construction Chart, 190 Oral Order,, - filed by iFIT Inc.. Motions referred to Christopher J. Burke.(Haynes, Christine) (Entered: 02/10/2023)
02/13/2023	193	NOTICE OF SERVICE of Tonal Systems, Inc.'s Objections and Responses to iFIT, Inc.'s Notice of Deposition Pursuant to Federal Rule of Civil Procedure 30(b)(6) filed by Tonal Systems, Inc..(Ying, Jennifer) (Entered: 02/13/2023)
02/13/2023	194	NOTICE OF SERVICE of iFIT, Inc.'s Responses and Objections to Tonal Systems, Inc.'s Interrogatories Nos. 11-18 filed by iFIT Inc..(Haynes, Christine) (Entered: 02/13/2023)
02/13/2023	195	STIPULATION TO EXTEND TIME for Tonal to file Answering Brief in Opposition to D.I. 177 and iFIT to file Reply Brief to February 17, 2023 and March 1, 2023, respectively - filed by Tonal Systems, Inc.. (Ying, Jennifer) (Entered: 02/13/2023)
02/14/2023		SO ORDERED D.I. 195 STIPULATION TO EXTEND TIME for Tonal to file Answering Brief in Opposition to D.I. 177 and iFIT to file Reply Brief to February 17, 2023 and March 1, 2023, respectively filed by Tonal Systems, Inc., Set Briefing Schedule: re 177 MOTION to Dismiss for Failure to State a Claim <i>COUNTERCLAIMS V AND VI PURSUANT TO FED. R. CIV. P. 12(B)(6) AND TO STRIKE TONAL DEFENSES 11, 12, AND INTRODUCTORY PARAGRAPHS 922 PURSUANT TO FED. R. CIV. P. 12(F)</i> . (Answering Brief due 2/17/2023., Reply Brief due 3/1/2023.) Ordered by Judge Christopher J. Burke on 2/14/2023. (mlc) (Entered: 02/14/2023)
02/14/2023	196	NOTICE of Amended Subpoena to Precor Incorporation by Tonal Systems, Inc. (Attachments: # 1 Exhibit 1)(Ying, Jennifer) (Entered: 02/14/2023)