



UNITED STATES JUDICIAL PANEL
on
MULTIDISTRICT LITIGATION

**IN RE: LIQUID TOPPINGS DISPENSING
SYSTEM ('447) PATENT LITIGATION**

MDL No. 2832

REMAND ORDER

Before the Panel: Defendants in the thirteen actions listed on Schedule A move under Panel Rule 10.2 to vacate our order that conditionally remanded those actions to their respective transferor courts. Plaintiff Kona Ice, Inc. (Kona Ice), opposes the motion.

After receiving a suggestion of remand from the transferee judge, the Panel placed these actions on a conditional remand order to the respective district in which each was filed. Defendants initially requested that we vacate our conditional remand order to give the transferee judge the opportunity to stay the litigation pending ex parte reexamination of the asserted patent. Alternatively, defendants asked the Panel itself to stay the litigation while the ex parte reexamination was pending. Those arguments are now moot after the U.S. Patent and Trademark Office (USPTO) closed prosecution in the ex parte reexamination and stated that it will issue a certificate confirming the asserted patent's patentability.

Defendants argue that remand is inappropriate because some pretrial matters concerning damages and willfulness are unresolved. Section 1407 does not prevent remand before all pretrial proceedings are complete; it merely sets an outer deadline by which the Panel must remand actions. *See* 28 U.S.C. § 1407(a) ("Each action so transferred shall be remanded by the panel *at or before the conclusion of* such pretrial proceedings to the district from which it was transferred unless it shall have been previously terminated." (emphasis added)). In deciding when to remand actions within that deadline, the Panel gives significant weight to a transferee judge's suggestion of remand. *In re Brand-Name Prescription Drugs Antitrust Litig.*, 264 F. Supp. 2d 1372, 1376 (J.P.M.L. 2003). "After all, the transferee judge is charged with the day-to-day supervision of centralized pretrial proceedings and, accordingly, has special insight into the question of whether further coordinated or consolidated proceedings are likely to be useful." *Id.* In this case, the transferee judge, Judge K. Michael Moore, addressed defendants' concern about whether there is a sufficient record for plaintiff to pursue damages and willfulness cases against each defendant. In his view, those issues "require a fact-intensive, individualized assessment" that is better suited for resolution in each defendant's respective transferor court. Suggestion of Remand at 2, *In re Liquid Toppings Dispensing Sys. ('447) Pat. Litig.*, No. 1:18-md-02832 (S.D. Fla. May 29, 2025), Dkt. No. 193. Defendants do not offer a sufficient reason for us to reject that reasoned determination.

Plaintiff Kona Ice argues in a supplemental filing that the USPTO's conclusion of the ex parte reexamination fully moots defendants' motion. Defendants disagree and argue that plaintiff should be judicially estopped from asserting its patent in this litigation because Kona Ice made

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inconsistent statements in the ex parte reexamination proceedings. Defendants argue now that we should vacate our conditional remand order so that Tikiz Franchising, LLC (Tikiz)—against which Judge Moore has entered final judgment in Tikiz’s declaratory judgment action¹—can raise the judicial estoppel argument in a Rule 60 motion. They assert that Judge Moore should decide the judicial estoppel issue because he heard the testimony that is allegedly inconsistent with plaintiff’s statements in the ex parte reexamination. Our remand of these actions will not affect Judge Moore’s ability to adjudicate a Rule 60 motion from Tikiz in its declaratory judgment action, as that action is not among those that we conditionally remanded. We are also not persuaded that the prospect that multiple courts may adjudicate the judicial estoppel question weighs strongly in favor of vacating the conditional remand order. These actions, if appealed, will all go to the Federal Circuit, avoiding the possibility of inconsistent appellate decisions.

IT IS THEREFORE ORDERED that pursuant to 28 U.S.C. § 1407, defendants’ motion to vacate the conditional remand order is DENIED, and the actions listed on Schedule A are remanded to their respective transferor courts.

PANEL ON MULTIDISTRICT LITIGATION



Karen K. Caldwell
Chair

Nathaniel M. Gorton
David C. Norton
Dale A. Kimball

Matthew F. Kennelly
Roger T. Benitez
Madeline Cox Arleo

¹ Final Judgment, *Tikiz Franchising, LLC v. Kona Ice, Inc.*, No. 1:18-cv-60237 (S.D. Fla. June 27, 2024), Dkt. No. 61.

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SCHEDULE A

Southern District of Florida

KONA ICE, INC. v. MESSIER, ET AL., C.A. No. 1:18–21402 (D. Arizona,
C.A. No. 2:17–03298)
KONA ICE, INC. v. LIU, C.A. No. 1:18–21403 (D. Colorado, C.A. No. 1:17–02301)
KONA ICE, INC. v. SILVA-ROMERO, C.A. No. 1:18–21404 (D. Colorado,
C.A. No. 1:17–02302)
KONA ICE, INC. v. HOCKING, ET AL., C.A. No. 1:18–22850 (M.D. Florida,
C.A. No. 3:18–00646)
KONA ICE, INC. v. BAILEY, ET AL., C.A. No. 1:18–21406 (N.D. Florida,
C.A. No. 3:17–00698)
KONA ICE, INC. v. NAVARRE, C.A. No. 1:18–21410 (W.D. Louisiana,
C.A. No. 2:17–01208)
KONA ICE, INC. v. SNEE, ET AL., C.A. No. 1:18–21408 (D. Maryland,
C.A. No. 1:17–02809)
KONA ICE, INC. v. BUMGARNER, C.A. No. 1:18–21405 (W.D. North Carolina,
C.A. No. 3:17–00563)
KONA ICE, INC. v. O'CONNOR, ET AL., C.A. No. 1:18–22828 (S.D. Ohio,
C.A. No. 1:18–00409)
KONA ICE, INC. v. HALE, ET AL., C.A. No. 1:18–22799 (E.D. Tennessee,
C.A. No. 1:18–00041)
KONA ICE, INC. v. HODGSON, ET AL., C.A. No. 1:18–21407 (E.D. Texas,
C.A. No. 4:17–00667)
KONA ICE, INC. v. CROWDER, ET AL., C.A. No. 1:18–21409 (S.D. Texas,
C.A. No. 4:17–02837)
KONA ICE, INC. v. DETAVERNIER, ET AL., C.A. No. 1:18–21411 (W.D. Texas,
C.A. No. 5:17–00931)