

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GENERAL ELECTRIC COMPANY,
Petitioner,

v.

TAS ENERGY, INC.,
Patent Owner.

Case IPR2014-00162
Patent 6,470,686

Before JOSIAH C. COCKS, BARRY L. GROSSMAN, and
PHILLIP J. HOFFMANN, *Administrative Patent Judges*.

COCKS, *Administrative Patent Judge*.

DECISION

Termination of the Proceeding
35 U.S.C. § 317(a) and 37 C.F.R. § 42.72

On September 22, 2014, General Electric, Inc. (“GE”) and TAS Energy Inc. (“TAS”) (collectively referred to as “the Parties”) filed a joint motion to terminate *this inter partes* review involving U.S. patent 6,470,686 (“the ’686 patent”).¹ Paper 17 (“Joint Motion to Terminate”); see 35 U.S.C. § 317(b); 37 C.F.R. § 42.72. Along with the Joint Motion to Terminate, the Parties filed a copy of their written settlement and licensing agreement (Exhibit 2006) covering the ’686 patent, as well as a joint request (Paper 18) to have their settlement and licensing agreement treated as business confidential information under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c). The Parties state in their Joint Motion to Terminate that:

Termination of Case No. IPR2014-00162 by the PTAB would be appropriate. The IPR Proceeding was filed on November 18, 2013 as a petition by GE for inter partes review of 6,470,686. The Board instituted review on May 13, 2014. TAS provided its Patent Owner Response on August 13, 2014. GE’s reply briefing is not due until November 13, 2014.

The parties have entered into a Confidential Settlement Agreement (attached hereto as Exhibit TAS-2006, filed under seal). The Confidential Agreement resolves the parties’ disputes with respect to U.S. Patent No. 6,470,686, including by (i) requiring TAS and GE to seek dismissal of this IPR and (ii) requiring TAS to dismiss its claims in TAS Energy v. San Diego Gas & Electric, Case No. 12-cv-2777 (S.D. Cal.) (named defendant San Diego Gas & Electric is GE’s customer). Therefore, termination of this case is appropriate because (i) the case is at a sufficiently early stage of the trial, (ii) the parties have resolved their disputes, (iii) Patent Owner has agreed to dismiss its litigation claims, and (iv) the parties to this case agree that this inter partes review should be terminated.

¹ Authorization for the motion was given in e-mail correspondence from Board personnel on September 22, 2014.

The Parties are reminded that the Board is not a party to the settlement, and may identify independently any question of patentability. 37 C.F.R. § 42.74(a). Generally, however, the Board expects that a proceeding will terminate after the filing of a settlement agreement. *See, e.g., Office Patent Trial Practice Guide*, 77 Fed. Reg. 48756, 48768 (Aug. 14, 2012). A decision by the Board to institute was entered on May 13, 2014. Paper 11. TAS filed a Patent Owner Response on August 13, 2014. Paper 16. GE has not yet filed any reply. Briefing, thus, has not been completed in this proceeding. As noted above, TAS also has agreed to dismiss the litigation associated with the '686 patent. Under the circumstances, based on the record before us, the Board determines that it is appropriate to terminate this proceeding without rendering a final written decision. *See* 37 C.F.R. § 42.72.

ORDER

In consideration of the foregoing, it is

ORDERED that, as was timely requested by the parties, the settlement agreement (Exhibit 2006) will be treated as business confidential information under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c);

FURTHER ORDERED that the joint motion to terminate this proceeding is GRANTED and this proceeding is hereby TERMINATED.

IPR2014-00162
Patent 6,470,686

PETITIONER:

Deakin Lauer
deakin.lauer@klarquist.com

Joseph Jakubek
joseph.jakubek@klarquist.com

PATENT OWNER:

Thomas King
ipr.thomas.king@haynesboone.com

Kenneth Parker
ken.parker.ipr@haynesboone.com