Trials@uspto.gov
571-272-7822

Paper 50
Entered: April 1, 2015

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MICRO MOTION, INC.,
Petitioner,

v.

INVENSYS SYSTEMS, INC.,
Patent Owner.

Case IPR2014-00179
Patent 7,124,646 B2

Before WILLIAM V. SAINDON, MICHAEL R. ZECHER, and JENNIFER M. MEYER, *Administrative Patent Judges.*

MEYER, *Administrative Patent Judge.*

DECISION
Termination of the Proceeding after Institution
37 C.F.R. § 42.72

I. DISCUSSION

On March 24, 2015, the parties filed a Joint Motion to Terminate this proceeding, in which they request that their settlement agreement be treated as business confidential information under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c). Paper 49, "Joint Mot." The parties also filed a true copy of their written settlement agreement under 37 C.F.R. § 42.74(b). Ex. 1169. For the reasons discussed below, the Joint Motion to Terminate and the request to treat the settlement agreement as business confidential information are *granted*.

In the Joint Motion to Terminate, the parties indicate that termination of this proceeding is appropriate because they have reached an agreement regarding all of their disputes involving U.S. Patent No. 7,124,646 B2 ("the '646 patent"). Joint Mot. 1–2. The parties also indicate that their settlement includes dismissing the co-pending district court case involving the '646 patent, as well as terminating six other co-pending *inter partes* reviews ("IPRs") between the parties. *Id*. at 1, 4. The parties represent that there are no other related district court cases involving the '646 patent or the patents involved in the co-pending IPRs. *Id*. at 4.

Under 35 U.S.C. § 317(a), "[a]n inter partes review instituted under this chapter shall be terminated with respect to any petitioner upon the joint request of the petitioner and patent owner, unless the Office has decided the merits of the proceeding before the request for termination is filed." The parties indicate that, although a Decision to Institute was entered on June 2, 2014 (Paper 8), we have not rendered a Final Decision on the merits. Joint Mot. 2.

The parties contend that maintaining this proceeding would be contrary to public policy and would discourage future settlements by removing significant motivations for settlement—namely, eliminating litigation risk by resolving the parties' disputes and ending the pending proceedings between them, and conserving judicial resources. Joint Mot. 5–6. In view of the circumstances presented in this case, we agree. Indeed, there are strong public policy reasons to favor settlement between the parties to a proceeding. *Office Patent Trial Practice Guide*, 77 Fed. Reg. 48,756, 48,768 (Aug. 14, 2012). When, as here, we have not rendered a Final Decision on the merits, we generally expect that the proceeding will terminate after the filing of a settlement agreement. *See id*.

As the parties have filed their written settlement agreement as to this proceeding and the co-pending IPRs, and the co-pending district court case is being dismissed as part of the settlement, we determine that it is appropriate to terminate this proceeding without rendering a Final Decision as to the patentability of claims 1, 2, 5, 9–12, 15, and 19 of the '646 patent.

II. ORDER

Accordingly, it is:

ORDERED that the parties' request that the settlement agreement (Ex. 1169) be treated as business confidential information under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) is GRANTED; and

ORDERED that the parties' Joint Motion to Terminate this proceeding is GRANTED, and this proceeding is hereby terminated.

For PETITIONER:

Andrew S. Baluch
Jeffrey N. Costakos
Angela Murch
Michelle Moran
Linda Hansen
Kadie Jelenchick
FOLEY & LARDNER LLP
abaluch@foley.com
jcostakos@foley.com
amurch@foley.com
mmoran@foley.com
lhansen@foley.com
kjelenchick@foley.com

For PATENT OWNER:

Jeffrey L. Johnson
James M. Heintz
DLA Piper LLP (US)
Jeffrey.johnson@dlapiper.com
Invensys_Micro_IPR@dlapiper.com