

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MICRO MOTION, INC.,
Petitioner,

v.

INVENSYS SYSTEMS, INC.,
Patent Owner.

Case IPR2014-00167 (US 7,505,854 B2)
Case IPR2014-00170 (US 6,311,136 B1)
Case IPR2014-00393 (US 7,571,062 B2)¹

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

SAINDON, *Administrative Patent Judge*.

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

¹ For purposes of administrative efficiency, we enter the same Decision in these three related proceedings.

IPR2014-00167 (US 7,505,854 B2)
IPR2014-00170 (US 6,311,136 B1)
IPR2014-00393 (US 7,571,062 B2)

I. DISCUSSION

On March 24, 2015, the parties filed a Joint Motion to Terminate in each of the proceedings identified above, in which they request that their settlement agreements be treated as business confidential information under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c). Paper 41, “Joint Mot.”² The parties also filed a true copy of their written settlement agreements under 37 C.F.R. § 42.74(b). Ex. 1080. For the reasons discussed below, the Joint Motions to Terminate and the requests to treat the settlement agreements as business confidential information are *granted*.

In the Joint Motions to Terminate, the parties indicate that termination of these proceedings is appropriate because they have reached an agreement regarding all of their disputes involving the challenged patents. Joint Mot. 1–2. The parties also indicate that their settlement includes dismissing the co-pending district court case involving the challenged patents, as well as terminating four 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 challenged patents or the patents involved in the co-pending IPRs. *Id.* at 5.

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 a Decision to Institute was entered in each of these

² Citations in this paper are to those documents filed in Case IPR2014-00393. Similar citations exist with respect to the Joint Motions to Terminate in Case IPR2014-00167 (Paper 51) and Case IPR2014-00170 (Paper 45).

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proceedings, but we have not yet rendered Final Decisions on the merits.

Joint Mot. 2. The parties further indicate that an oral hearing originally scheduled for March 12, 2015 for IPR2014-00393 was canceled so that the Joint Motion to Terminate could be filed and considered by the panel.³ *Id.*

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 Final Decisions on the merits, we generally expect that proceedings will terminate after the filing of a settlement agreement. *See id.*

As the parties have filed their written settlement agreement as to these proceedings and the co-pending IPRs, and the co-pending district court case was dismissed as part of the settlement, we determine that it is appropriate to terminate these proceedings without rendering Final Decisions as to the patentability of the challenged claims.

³ In IPR2014-00167 and IPR2014-00170, oral hearings were held January 15, 2015.

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II. ORDER

Accordingly, it is:

ORDERED that the parties' requests that the settlement agreement (IPR2014-00167—Ex. 1169; IPR2014-00170—Ex. 1169; IPR2014-00393—Ex. 1080) be treated as business confidential information under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) are GRANTED; and

ORDERED that the parties' Joint Motions to Terminate IPR2014-00167, IPR2014-00170, and IPR2014-00393 are GRANTED, and each of these proceedings is hereby terminated.

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