

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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GARMIN INTERNATIONAL, INC.,  
Petitioner,

v.

THE REGENTS OF THE UNIVERSITY OF MICHIGAN,  
Patent Owner.

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Case IPR2015-00769  
Patent 7,234,351

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Before JOSIAH C. COCKS, RAMA G. ELLURU, and  
SCOTT C. MOORE, *Administrative Patent Judges*.

MOORE, *Administrative Patent Judge*.

DECISION  
Joint Motion to Terminate  
37 C.F.R. §§ 42.5(a), 42.71(a)

On July 22, 2015, counsel for Petitioner, Garmin International, Inc., and Patent Owner, The Regents of the University of Michigan, Inc., jointly sought, and were granted, authorization to file a motion to terminate this proceeding on the basis that the parties have reached a settlement agreement. Later that same day, the parties filed their Joint Motion to Terminate the *Inter Partes* Review (“Mot.”). Paper 10. Along with their Joint Motion to Terminate, the parties filed a Joint Request to File Settlement Agreement as Business Confidential Information and be Kept Separate Under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) (Paper 11), and a copy of the parties Settlement Agreement (Ex. 1025).

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.”

35 U.S.C. § 317(b), however, also requires that:

[a]ny agreement or understanding between the patent owner and a petitioner, including any collateral agreements referred to in such agreement or understanding, made in connection with, or in contemplation of, the termination of an *inter partes* review under this section shall be in writing and a true copy of such agreement or understanding shall be filed in the Office before the termination of the *inter partes* review as between the parties.

In their Joint Motion to Terminate, the parties jointly request termination of this proceeding pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. § 42.72. Mot. 2. The parties indicate that termination is appropriate because, *inter alia*, the parties have reached a settlement agreement resolving all issues between them involving the patent at issue in this

proceeding, and the Board has not yet issued a Decision on Institution or decided the merits of this *inter partes* review proceeding. *Id.* The parties also represent that they have complied with 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b) by filing a true copy of the confidential settlement agreement between the parties. *Id.* The parties further represent that there are no “collateral agreements” that would need to be filed pursuant to 35 U.S.C. § 317(b) prior to termination of this proceeding. *Id.* at 3.

We recognize that a trial has not yet been instituted, but the considerations here are similar. Under the present circumstances, we are persuaded that it is appropriate to dismiss the Petition pursuant to 37 C.F.R. §§ 42.5(a) and 42.71(a) without rendering a final written decision.

#### ORDER

For the foregoing reasons, it is:

ORDERED that the Joint Motion to Terminate the *Inter Partes* Review (Paper 10) is GRANTED;

FURTHER ORDERED that the Petition for *Inter Partes* Review of the above-referenced patent is DISMISSED;

FURTHER ORDERED that the parties’ Joint Request to File Settlement Agreement as Business Confidential Information and be Kept Separate Under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) (Paper 11) is GRANTED; and

FURTHER ORDERED that the Settlement and License Agreement (Exhibit 1025) be treated as business confidential information pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) and also remain designated as “Parties and Board Only” in PRPS.

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