

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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MTD PRODUCTS INC.,  
Patent Owner.

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IPR2016-00194  
Patent 8,011,458

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Before WILLIAM V. SAINDON and TIMOTHY J. GOODSON,  
*Administrative Patent Judges.*

SAINDON, *Administrative Patent Judge.*

TERMINATION  
Dismissal on Remand  
37 C.F.R. § 42.72

## I. INTRODUCTION

The Toro Company (“Petitioner”) requested an *inter partes* review of claims 1–16 of U.S. Patent No. 8,011,458 (Ex. 1001, “the ’458 patent”), owned by MTD Products Inc. (“Patent Owner”). Paper 6 (“Pet.”). We instituted *inter partes* review on all challenged claims and grounds. Paper 13 (“Dec. on Inst.”). After briefing and oral argument, we issued a Final Written Decision, determining that Petitioner had shown, by a preponderance of the evidence, that claims 1–16 of the ’458 patent were unpatentable. Paper 41 (“Decision”). In relevant part, we determined that the construction of a certain claim term argued by the parties was not governed by 35 U.S.C. § 112 ¶ 6. Decision 14–25.

Patent Owner filed a notice of appeal with the U.S. Court of Appeals for the Federal Circuit (the “Federal Circuit”), challenging, among other things, our construction regarding § 112 ¶ 6. While the appeal was pending, the parties entered into a settlement agreement and Petitioner withdrew as a party. See Order Granting Motion to Withdraw, *MTD Products Inc. v. Iancu*, 933 F.3d 1336 (Fed. Cir. 2019) (No. 2017-2292). The Federal Circuit subsequently decided the appeal and held that the claim term was governed by § 112 ¶ 6, and remanded the case for further proceedings consistent with that construction. *MTD Products Inc. v. Iancu*, 933 F.3d 1336, 1345 (Fed. Cir. 2019) (“the term ‘mechanical control assembly . . . configured to’ perform certain functions in independent claims 1 and 9 of the ’458 patent is governed by § 112, ¶ 6”). The mandate issued October 3, 2019.

On remand, we held a conference call with Patent Owner to discuss how to proceed on remand. See Paper 42. The options discussed included a schedule to proceed to a second final written decision and dismissal of the

proceeding without rendering another final written decision. *Id.* We determined that it would be more efficient for Patent Owner to prepare a motion to dismiss prior to any briefing on the merits of the case. *See id.*; *see also* Paper 43 (Patent Owner’s Motion to Dismiss, hereinafter “Motion”).

## II. DISCUSSION

In its Motion, Patent Owner asserts that it is appropriate, under 35 U.S.C. § 317 and 37 C.F.R. § 42.72, for the Board to dismiss this proceeding without rendering another final decision. *See* Motion 2–3. Specifically, Patent Owner argues that dismissal is appropriate because the parties have settled their dispute. *See id.*

Our rules state that “[t]he Board may terminate a trial without rendering a final written decision, where appropriate, including where [there is a] joint request [to terminate] under 35 U.S.C. § 317.” 37 C.F.R. § 42.72. Under 35 U.S.C. § 317, an instituted proceeding may be terminated upon the joint request of the petitioner and the patent owner, with a provision that any settlement agreement between the parties must be filed with the Office. 35 U.S.C. § 317. Here, because Patent Owner and Petitioner settled during the appeal at the Federal Circuit, only Patent Owner remains before us now. Accordingly, we do not have before us a *joint request* to terminate the proceeding, nor a copy of the settlement agreement, as required by 35 U.S.C. § 317. Notwithstanding, 35 U.S.C. § 317(a) concludes with the statement that: “[i]f no petitioner remains in the inter partes review, the Office may terminate the review.”

In the case before us, our instructions on remand are to evaluate the patentability of the claims under a new claim construction, but we have not yet begun such an evaluation. There is no party remaining in the case

asserting unpatentability under the construction the Federal Circuit has ordered, and the only remaining party, Patent Owner, does not wish to proceed to a second final written decision. We are not aware of any other compelling reason to proceed. Under these circumstances, we determine that it is appropriate to terminate the proceeding without rendering a final written decision. 35 U.S.C. § 317(a) (last sentence); 37 C.F.R. § 42.72.

### III. ORDER

In consideration of the foregoing, it is hereby  
ORDERED that the Final Written Decision remains vacated; and  
FURTHER ORDERED that this proceeding is terminated.

#### PATENT OWNER:

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