

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

STELLAR ENERGY AMERICAS, INC.,
Petitioner,

v.

TAS ENERGY INC.,
Patent Owner.

Case IPR2016-00294
Patent RE44,815 E

Before WILLIAM V. SAINDON, DONNA M. PRAISS, and
MICHAEL L. WOODS, *Administrative Patent Judges*.

WOODS, *Administrative Patent Judge*.

JUDGMENT

Termination Due to Settlement After Institution of *Inter Partes* Review
35 U.S.C. § 317 and 37 C.F.R. § 42.74

I. Introduction

We instituted trial on May 10, 2016 (Paper 12). On December 6, 2016, Petitioner, Stellar Energy Americas, Inc. (“Stellar”), and Patent Owner, TAS Energy Inc. (“TAS”), (collectively referred to as “the parties”), filed a Joint Motion to Terminate Proceeding Pursuant to 35 U.S.C. § 317. Paper 22 (“Joint Motion to Terminate”).¹ Along with the Joint Motion to Terminate, the parties filed a true copy of a Settlement Agreement and License (Ex. 1231, “Settlement Agreement”), as well as a joint request to have their Settlement Agreement treated as business confidential information under 35 U.S.C. § 317 and 37 C.F.R. § 42.74(c) (Paper 23).

II. Discussion

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. 48,756, 48,768 (Aug. 14, 2012).

In the Joint Motion to Terminate, the parties represent that they have settled their dispute and have reached an agreement to terminate this proceeding. Paper 22, 1. The parties further represent that they (1) have filed dismissal notices in the related district court litigations, (2) have filed joint motions to terminate certain other related *inter partes* reviews, (3) have moved to dismiss certain appeals to the United States Court of Appeals for the Federal Circuit in other related *inter partes* reviews, and (4) do not

¹ Filing of the Joint Motion to Terminate was authorized in e-mail correspondence from Board personnel on December 2, 2016.

contemplate any litigation or other contested proceedings involving the subject patent in the foreseeable future. *Id.* at 1–2. The parties further represent that the Federal Circuit granted their motion and dismissed the appeals on December 5, 2016. *Id.* at 2.

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 requirement for terminating review with respect to Stellar is met.

Furthermore, under 35 U.S.C. § 317(a), “[i]f no petitioner remains in the *inter partes* review, the Office may terminate the review or proceed to a final written decision under section 318(a).” Stellar is the sole petitioner in this *inter partes* review, such that termination with respect to Stellar means that no petitioner remains in the proceeding. The Board, thus, has discretion to terminate this review with respect to TAS.

At this stage of the proceeding, Stellar has filed a Patent Owner Response. Paper 16. Pursuant to the Scheduling Order (Paper 13) as amended by the parties (Paper 21), Petitioner’s Reply is not due until December 23, 2016, and oral argument was set for February 1, 2017. Upon consideration of the circumstances of this case, the panel has determined to terminate this *inter partes* review as to both Stellar and TAS without rendering a final written decision.

III. Orders

It is

ORDERED that the Joint Motion to Terminate IPR2016-00294 (Paper 22) is *granted*, and this proceeding is hereby *terminated*; and

FURTHER ORDERED that, as was requested timely by the parties (Paper 23), the settlement agreement (Ex. 1231) will be treated as business confidential information under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

IPR2016-00294
Patent RE44,815 E

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