

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ELECTRIC RELIABILITY COUNCIL OF TEXAS, INC,
Petitioner,

v.

GRID INNOVATIONS, LLC,
Patent Owner.

Cases¹
IPR2017-02033 (7,945,502 B2)
IPR2017-02040 (9,256,905 B2)

Before WILLIAM V. SAINDON, SCOTT DANIELS, and
BARRY L. GROSSMAN, *Administrative Patent Judges*.

GROSSMAN, *Administrative Patent Judge*.

DECISION
Granting Joint Motions to Terminate Proceedings
35 U.S.C. § 317(a); 37 C.F.R. § 42.72

¹ This Order addresses issues that are the same in both cases. Therefore, we exercise our discretion to issue one Decision to be filed in each case. The parties are not authorized to use this style heading for any subsequent papers.

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IPR2017-02040 Patent 9,256,905 B2

Pursuant to our e-mail authorizations on November 14, 2017, Petitioner and Patent Owner filed a corrected Joint Motion to Terminate Proceeding (Paper 5, “Joint Motion to Terminate”) in each of the above-captioned proceedings. Pursuant to 37 C.F.R. § 42.74(b), the parties also filed in both proceedings what they represent is a true copy of their written settlement agreement (Ex. 1031, “Settlement Agreement”).

In these proceedings, respective Petitions for *Inter Partes* Review of U.S. Patent No. 7,945,502 B2 (“the ’502 patent”), and U.S. Patent No. 9,256,905 B2 (“the ’905 patent”) were filed on September 6, 2017 (“the Petitions”). See Papers 1, 3. We have *not* rendered a decision on institution in these proceedings.

In each Joint Motion to Terminate, the parties indicate that they have reached an agreement regarding all of their disputes involving the ’502 and the ’905 patents. Joint Motion to Terminate, 1–3. The parties’ settlement includes dismissing a related district court proceeding between the parties involving the ’502 and the ’905 patent. *Id.* at 2–3. The parties certify that the Settlement Agreement constitutes the entire understanding and agreement between the parties, and that there are no other collateral agreements or understandings made in connection with, or in contemplation of, terminating this *inter partes* review. *Id.* at 3.

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 termination as to both parties is appropriate here. As the parties note, we have not rendered a Final Written Decision on the merits in either proceeding. Joint Motion to Terminate, 1. Furthermore, we have not

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issued a decision on institution in these proceedings. In view of the circumstances presented in this proceeding, we agree that termination is appropriate. 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). Accordingly, we determine that it is appropriate to terminate these proceedings without rendering a final written decision. *See* 37 C.F.R. § 42.72.

Accordingly, it is:

ORDERED that the Joint Motion to Terminate Proceeding (Paper 5) in each proceeding is *granted*, and these proceedings are hereby *terminated*.

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