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Paper 9
Entered: May 9, 2019

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GENERAL ELECTRIC CO.,
Petitioner,

v.

THE UNIVERSITY OF FLORIDA RESEARCH FOUNDATION, INC.,
Patent Owner.

Case IPR2018-01428
Patent 7,062,251 B2

Before DEBRA K. STEPHENS, BRYAN F. MOORE, and KAMRAN JIVANI, *Administrative Patent Judges*.

STEPHENS, *Administrative Patent Judge*.

DECISION
Granting Joint Motion to Terminate Proceeding
37 C.F.R. §§ 42.71(a), 42.72

I. INTRODUCTION

Petitioner and Patent Owner (collectively referred to as "the Parties") have requested that the above-identified *inter partes* review proceeding of U.S. Patent 7,062,251 B2 ("'251 Patent") be terminated pursuant to a settlement. On April 3, 2019, we authorized the Parties via email to file a joint motion to terminate the above-identified proceeding. On April 4, 2019,

the Parties filed a Joint Motion to Terminate the above-identified proceeding (Paper 8, "Joint Motion") and a Settlement Agreement (Exhibit 2001, "Settlement Agreement").

II. DISCUSSION

In the Joint Motion and Settlement Agreement, the Parties represent that this proceeding is moot because the Federal Circuit has found "all of the claims of [U.S. Patent 7,062,251] are not patent eligible under 35 U.S.C. § 101" (Joint Motion 3; Settlement Agreement 2). The Parties further represent that Patent Owner has agreed "to not seek rehearing or pursue any appeal or other review of that decision in the Federal Circuit, United States Supreme Court, or any other forum" (Settlement Agreement 2; Joint Motion 4). The Parties assert that "[n]o dispute remains between the Parties involving the '251 patent" and termination of the proceeding "will conserve the time and resources of the Parties and the Board; and is appropriate because the proceeding "is in the very early stages and the Board has not yet 'decided the merits of the proceeding'" (Joint Motion 4).

In accordance with 37 C.F.R. § 42.74, the Parties have submitted their Settlement Agreement in writing, and represent that the filed copy is a true and correct copy (Joint Motion 2). In the Settlement Agreement, the Parties assert that the "Federal Circuit decision in light of the Settlement Agreement disposes of all of the disputes between the Parties related to *this proceeding*. No dispute remains between Petitioner and Patent Owner involving the '251 patent in any forum" (Joint Motion 5 (emphasis added) (citations omitted)). The Settlement Agreement, however, refers to the proceeding before the Court of Appeals for the Federal Circuit, but does not specifically state this

inter partes review has been settled. Indeed, the Settlement Agreement is focused on appeal of the Federal Circuit decision (Settlement Agreement; Ex. 2001). In that Decision, the Federal Circuit found the claims of the '251 Patent are not patent eligible under 35 U.S.C. § 101 (Joint Motion 2; Ex. 2002 11).

Nevertheless, as noted above the parties represent no dispute remains between the parties and the proceeding is in an early stage. The case has been stayed awaiting Decision from the Court of Appeals for the Federal Circuit on the Eleventh Amendment immunity right at issue in this request for *inter partes* review (Paper 6). No preliminary response has been filed and no decision on whether to institute trial has been made.

Based on the facts of this case, it is appropriate to dismiss the Petition for *inter partes* review (37 C.F.R. § 42.72). "The Board may terminate a trial without rendering a final written decision" (*id.*).

III. CONCLUSION

The joint motion to terminate this *inter partes* review is *granted*. This paper does not constitute a final written decision pursuant to 35 U.S.C. § 318.

IV. ORDER

Accordingly, for the reasons discussed above, it is:

It is, therefore,

ORDERED that the Joint Motion to Terminate (Paper 8) is *granted* and the proceeding is terminated; and

FURTHER ORDERED that this proceeding is terminated as to all parties.

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