

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INTEL CORPORATION,
Petitioner,

v.

TELA INNOVATIONS, INC.,
Patent Owner.

IPR2019-01257
IPR2019-01262
Patent 7,446,352 B2¹

Before JO-ANNE M. KOKOSKI, KRISTINA M. KALAN, and
WESLEY B. DERRICK, *Administrative Patent Judges*.

KOKOSKI, *Administrative Patent Judge*.

DECISION
Dismissal Prior to Institution of Trial
35 U.S.C. § 314

¹ Because the resolution of the issues set forth in this decision applies to both of the above-identified cases, we exercise our discretion to issue a single decision to be entered in each case.

On December 20, 2019, with Board authorization, Petitioner filed substantively-identical motions to dismiss the Petition in each of the above-identified proceedings. IPR2019-01257, Paper 15 (“Motion to Dismiss IPR2019-01257”); IPR2019-01262, Paper 15 (“Motion to Dismiss IPR2019-01262”) (individually or collectively referred to herein as “Mot.”). In the motions, Petitioner represents that Patent Owner does not oppose the motions. Mot. 1.

Petitions in the above-identified proceedings were filed on June 21, 2019. IPR2019-01257, Paper 2; IPR2019-01262, Paper 2. Patent Owner filed its Preliminary Responses on October 11, 2019. IPR2019-01257, Paper 9; IPR2019-01262, Paper 9. The Board’s decisions on institution in these cases are due on January 11, 2020. Although preliminary review of both cases had commenced, the Board had not yet reached a decision regarding institution in either of the above-identified proceedings.

In the motions, Petitioner states that, in the related district court litigation between the parties, a claim construction order was issued “in which the Court found that the claim phrase ‘physically and electrically separated by a [conductor] line end spacing of minimum size’ to be indefinite.” Mot. 1. Petitioner further states that, because this phrase is recited twice in the only independent challenged claim, “under the Court’s Order, all challenged claims of the ’352 Patent are invalid for indefiniteness,” and, accordingly, the patent “is no longer asserted” in the related district court litigation. *Id.* at 1–2. Therefore, Petitioner contends that the “withdrawal of the present petition does not prejudice the Patent Owner, which does not oppose the filing of this motion.” *Id.* at 2.

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Under 37 C.F.R. § 42.71(a), “[t]he Board may take up petitions or motions for decisions in any order, [and] may grant, deny, or dismiss any petition or motion.” The above-captioned proceedings are at an early stage, and although some resources have been expended by the Board on initial review of both proceedings, under these circumstances, we are persuaded that it is appropriate to dismiss the petitions and terminate the proceedings to promote efficiency and minimize unnecessary costs.

This paper does not constitute a final written decision pursuant to 35 U.S.C. § 318(a).

Accordingly, it is:

ORDERED that Petitioner’s Motion to Dismiss IPR2019-01257 is *granted*;

FURTHER ORDERED that the petition in IPR2019-01257 is *dismissed* and the proceeding in IPR2019-01257 is *terminated*;

FURTHER ORDERED that Petitioner’s Motion to Dismiss IPR2019-01262 is *granted*; and

FURTHER ORDERED that the petition in IPR2019-01262 is *dismissed* and the proceeding in IPR2019-01262 is *terminated*.

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