

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GENERAL ELECTRIC CO. and
GE RENEWABLES NORTH AMERICA, LLC,
Petitioner,

v.

SIEMENS GAMESA RENEWABLE ENERGY A/S,
Patent Owner.

IPR2021-00722 (Patent 9,279,413 B2)
IPR2021-00723 (Patent 8,575,776 B2)¹

Before MEREDITH C. PETRAVICK, GEORGE R. HOSKINS,
MICHELLE N. WORMMEESTER, and FREDERICK C. LANEY,
*Administrative Patent Judges.*²

PETRAVICK, *Administrative Patent Judge.*

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

¹ Because this decision resolves issues that are identical in both cases, we exercise our discretion to issue a single decision to be entered in each case.

² This is not an expanded panel. The panel for IPR2021-00722 is Judges Petravick, Wormmeester, and Laney. The panel for IPR2021-00723 is Judges Petravick, Hoskins, and Laney.

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On October 5, 2021, Petitioner filed a Motion to Dismiss the Petition in each of these proceedings. Paper 10³ (“Mot.”). The Board authorized the Motions to Dismiss after a September 27, 2021 conference call, during which Petitioner explained that it seeks to end these proceedings to conserve its resources for the related district court proceeding, *Siemens Gamesa Renewable Energy A/S v. General Electric Co. and GE Renewables North America, LLC*, Case No. 1:21-cv-10216 (D. Mass.), and acknowledged that, in view of the related district court proceeding’s progress, the Board’s precedent in *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (precedential) favors the Board exercising discretion to deny institution of trial in these proceedings. *See* Paper 9.

Petitioner states that “Petitioner and Patent Owner have met and conferred, and Patent Owner does not oppose the relief requested in this motion.” Mot. 2.

Petitioner submits that dismissal of the Petitions is appropriate because these proceedings are in a preliminary stage and the Board has not issued decisions on institution, which are due on October 21, 2021. *Id.* Petitioner contends it would be appropriate to dismiss the Petitions “to preserve the Board’s and parties’ resources and promote a speedy and inexpensive resolution to this dispute.” *Id.* at 3. Petitioner also notes that it “has represented to Patent Owner that it does not intend to file another petition for *inter partes* review” with respect to these patents. Thus, Petitioner asserts, dismissal of the Petitions does not prejudice Patent Owner. *Id.*

³ The motions are substantively identical. Unless otherwise noted, citations are to the papers filed in IPR2021-00722.

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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.” These proceedings are at an early stage, and although the Board has expended some resources in its initial review of the Petitions, under the circumstances presented here we are persuaded 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).

It is:

ORDERED that Petitioner’s Motion to Dismiss in IPR2021-00722 is *granted*;

FURTHER ORDERED that the Petition in IPR2021-00722 is *dismissed* and the proceeding in IPR2021-00722 is *terminated*;

FURTHER ORDERED that Petitioner’s Motion to Dismiss in IPR2021-00723 is *granted*; and

FURTHER ORDERED that the Petition in IPR2021-00723 is *dismissed* and the proceeding in IPR2021-00723 is *terminated*.

IPR2021-00722 (Patent 9,279,413 B2)

IPR2021-00723 (Patent 8,575,776 B2)

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