

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SIEMENS INDUSTRY, INC.,
Petitioner

v.

EMA ELECTROMECHANICS, INC.,
Patent Owner.

IPR2021-01517
Patent 7,724,489 B2

Before CHRISTOPHER L. CRUMBLEY, KRISTINA M. KALAN, and
RUSSELL E. CASS, *Administrative Patent Judges*.

CASS, *Administrative Patent Judge*.

TERMINATION

Due to Settlement After Institution of Trial
35 U.S.C. § 317(a),(b); 37 C.F.R. §§ 42.72, 42.74

I. INTRODUCTION

On June 21, 2022, Petitioner Siemens Industry, Inc. (“Petitioner” or “Siemens”) and Patent Owner EMA Electromechanics, Inc. (“Patent Owner” or “EMA”) (hereinafter “Joint Movants”) filed a Joint Motion to Terminate Proceedings. Paper 12 (“Motion”). The Joint Movants also filed, on the same day, a copy of a settlement agreement (Ex. 2003, “Settlement Agreement”) and a Joint Request to Treat Exhibit 2003 as Business Confidential Information. Paper 13 (“Request”).

II. DISCUSSION

The Motion states that “the Parties have settled their disputes relating to the ‘489 patent” and have “filed a Stipulation of Dismissal in the co-pending litigation” which “terminated the co-pending litigation and did so with prejudice.” Mot. 1–2. The Motion further states that “EMA has granted Siemens a covenant not to sue with respect to the ‘489 Patent in the same agreement by which EMA and Siemens agreed to ask this Board to terminate *inter partes* review of the ‘489 patent.” Mot. 2. The Joint Movants also filed a copy of their Confidential Settlement and Patent License Agreement as Exhibit 2003. The Joint Movants request that, “[i]n light of the Settlement Agreement between the Parties, termination is appropriate because the dispute between the Parties has been resolved and both the Petitioner and Patent Owner support termination of the proceeding.” Mot. 2.

Generally, the Board expects that a proceeding will terminate after the filing of a settlement agreement, unless the Board has already decided the merits of the proceeding. PTAB Consolidated Trial Practice Guide, 86

(November 2019).¹ Here, although the Board has instituted *inter partes* review of the challenged patents, the Board has not decided the merits of these proceedings. Under these circumstances, we grant the Motion to terminate in this proceeding.

Additionally, the Request states that the Joint Movants “jointly request that Exhibit 2003, a Confidential Settlement and License Agreement, be designated as ‘Board and Parties Only’ and treated as business confidential information to be kept separate from the files of the involved patent pursuant to 37 C.F.R. § 42.74(c).” Request 1.

We grant the Request. The Settlement Agreement shall be designated as “Board and Parties Only” and treated as business confidential information to be kept separate from the files of the challenged patent pursuant to 37 C.F.R. § 42.74(c).

III. ORDER

In view of the foregoing, it is:

ORDERED that the Joint Motion to Terminate Proceedings in each of the above-identified proceedings is *granted*;

FURTHER ORDERED that the Joint Request to Designate Exhibit 2003 as “Board and Parties Only” and treat Exhibit 2003 as business confidential information is *granted*; and

FURTHER ORDERED that Exhibit 2003 shall be kept separate from the files of U.S. Patent No. 7,724,489 B2, and will be made available only under the provisions of 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

¹ Available at <https://www.uspto.gov/TrialPracticeGuideConsolidated>.

IPR2021-01517
Patent 7,724,489 B2

For PETITIONER:

Robert Hilton
Tyler VanHoutan
MCGUIRE WOODS LLP
rhilton@mcguirewoods.com
tvanhoutan@mcguirewoods.com

For PATENT OWNER:

William Moon
Michael Karson
WINSTEAD P.C.
amoon@winstead.com
mkarson@winstead.com