

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BOE TECHNOLOGY GROUP CO., LTD., BOE DISPLAY
TECHNOLOGY CO., LTD., and MOTOROLA (WUHAN) MOBILITY
TECHNOLOGIES COMMUNICATION CO., LTD.,
Petitioner,

v.

ELEMENT CAPITAL COMMERCIAL COMPANY PTE. LTD.,
Patent Owner.

IPR2023-01178
Patent 7,259,736 B2

Before DAVID C. McKONE, TERRENCE W. McMILLIN, and
RUSSELL E. CASS, *Administrative Patent Judges*.

CASS, *Administrative Patent Judge*.

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

BOE Technology Group Co., Ltd., BOE Display Technology Co., Ltd., and Motorola (Wuhan) Mobility Technologies Communication Co., Ltd. (collectively, “Petitioner”) filed a Petition requesting an *inter partes* review of claims 18, 23, 33, and 35 (the “challenged claims”) of U.S. Patent No. 7,259,736 B2 (Ex. 1001, “the ’736 patent”). Paper 4, 1 (“Pet.”). The parties subsequently contacted the Board via e-mail, requesting permission to file a joint motion to dismiss this proceeding. We granted the parties request.

On March 1, 2024, the parties filed a joint motion to dismiss the Petition in this proceeding. Paper 12 (“Mot.”). In their joint motion, the parties state that they “have resolved their dispute regarding the patent involved in this proceeding and have filed a joint motion to dismiss the related district court litigation styled *Element Capital Commercial Company PTE. Ltd. v. BOE Technology Group Co., Ltd. et al.*, Case No. 2:22-cv-0118-JRG (E.D. Tex.)” with prejudice, where the ’736 patent was previously asserted by Patent Owner. Mot. 1, 3. The parties assert that “[t]ermination of this IPR is appropriate as the Board has not yet ‘decided the merits of the proceeding’” on the record before it, and “the dispute at the center of the IPR no longer remains between the parties.” *Id.* at 2–3 (citing Patent Office Trial Practice Guide, 77 Fed. Reg. 48756, 48768 (Aug. 14, 2012)). The parties further argue that termination “promotes the Congressional goal of establishing a more efficient patent system by limiting unnecessary and counterproductive costs.” *Id.* at 3 (citing Changes to Implement Inter Partes Review Proceedings, Post-Grant Review Proceedings, and Transitional Program for Covered Business Method Patents, 77 Fed. Reg. 48,680 (Aug. 14, 2012)). Finally, the parties represent that “there are no other

agreements, oral or written, between the Parties made in connection with, or in contemplation of, the termination of the proceeding.” *Id.* at 1.

This proceeding is at an early stage and we have not yet issued a decision determining whether to institute a trial. In view of the early stage of this proceeding, and the parties’ settlement of the related district court litigation, we determine it is appropriate to dismiss the Petition and terminate the proceeding to promote efficiency and minimize unnecessary costs. *See* 37 C.F.R. § 42.71(a); *General Elec. Co. v. Regents of the Univ. of Cal.*, IPR2020-01456, Paper 9 (PTAB Dec. 1, 2020) (granting unopposed motions to dismiss).

Accordingly, it is:

ORDERED that the Petition is *dismissed* and this proceeding is terminated. This paper does not constitute a final written decision pursuant to 35 U.S.C. § 318(a).

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