

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MICRO MOTION, INC.
Petitioner

v.

INVENSYS SYSTEMS, INC.
Patent Owner

Patent No. 7,571,062
Issue Date: August 4, 2009
Title: DIGITAL FLOWMETER

Inter Partes Review No. IPR2014-00393

**JOINT MOTION TO TERMINATE PROCEEDING
PURSUANT TO 35 U.S.C. § 317 AND 37 C.F.R. § 42.72**

and

**JOINT REQUEST THAT SETTLEMENT RELATED AGREEMENTS BE
TREATED AS BUSINESS CONFIDENTIAL INFORMATION PURSUANT
TO 35 U.S.C. § 317 and 37 C.F.R. § 42.74**

Pursuant to 35 U.S.C. §317 and 37 C.F.R. § 42.72, Patent Owner Invensys Systems, Inc. and Schneider Electric SA (“Patent Owner”) and Petitioner Micro Motion, Inc. and Emerson Electric Co. (“Petitioner”) (collectively, “the Parties”) jointly request termination of *Inter Partes* Review No. IPR2014-00393, involving claims 1, 29, 40, and 45 of U.S. Patent 7,571,062 (“’062 Patent”).

The Parties have settled all of their disputes involving the ’062 Patent, as well as other patents owned by Patent Owner. More specifically, the Parties have agreed to jointly request termination of this proceeding, as well as IPR Nos. IPR2014-00167, -00170, -00178, -00179, -00390, and -00392 (“the co-pending IPRs”)¹. The Parties also have agreed to settle and dismiss their related district court litigation (*Invensys Systems, Inc. v. Emerson Electric Co. and Micro Motion Inc., USA*, CA No. 6:12-cv-00799 (LED) (E.D. Tex.)).

Pursuant to 37 C.F.R. § 42.74(b), the Parties’ settlement agreement and any collateral agreements made in contemplation of termination of the proceeding are in writing, and true and correct copies of such documents are being filed herewith as Exhibit 1080. The Parties hereby jointly request that the settlement related agreements be treated as business confidential information and be kept separate

¹ The Parties are submitting a Joint Motion to Terminate Proceeding in each of IPR2014-00167, -00170, -00178, -00179, -00390, and -00392.

I. Background

This proceeding (IPR2014-00393) involves claims 1, 29, 40, and 45 of the '062 Patent. The Patent Trial and Appeal Board (the "Board") issued a Decision to Institute Trial on August 4, 2014. A final hearing in this proceeding, scheduled for March 12, 2015, was cancelled so that termination papers could be filed and considered. The Board has not decided this IPR on the merits.

On March 10, 2015, the Parties agreed to settle all of their disputes involving the '062 Patent and the patents involved in the co-pending IPRs. That same day, the Parties informed the Board of the settlement and requested a phone conference with the Board requesting authorization to file a joint motion to terminate the proceeding with respect to both the Patent Owner and the Petitioner. In a conference call with the Board on March 11, 2015, the Parties confirmed that settlement had been reached and agreements were in the process of being drafted and finalized.

As more fully set forth in the Order for Conduct of the Proceedings, March 11, 2015 (Paper 40)("Order"), the Board authorized the filing of the requested joint motion to terminate this proceeding as to both parties.

ARGUMENT

II. Petitioner Must Be Removed From This *Inter Parties* Review

The concurrently-submitted settlement agreement, filed along with this Joint Motion to Terminate, requires Petitioner to withdraw from this review. Pursuant to the agreement, Petitioner cannot and will not participate further in this review. The Parties therefore jointly request that the *inter partes* review be terminated at least as to Petitioner pursuant to 35 U.S.C. § 317(a).

For this reason, Patent Owner submits that this *inter partes* review should be terminated in its entirety. The Board has discretion to terminate an *inter partes* review in its entirety if no petitioner remains in the proceeding. 35 U.S.C. § 317(a). Because Petitioner must withdraw and no longer participate, the Board should respectfully exercise its discretion to terminate this review.

III. Termination as to Patent Owner Is Also Appropriate

Pursuant to the Board's instructions in the Order, following is a brief explanation as to why termination as to all Parties is appropriate.

“Generally, [the Board] expects that a proceeding will terminate after the filing of a settlement agreement.” *See* Order at 2. Termination of this IPR is appropriate as the Board has not yet “decided the merits of the proceeding.” *See, e.g.,* Office Patent Trial Practice Guide, 77 Fed. Reg. 48756, 48768 (Aug. 14, 2012); *Medline Industries, Inc. v. Paul Harmann AG*, IPR2013-00173, Judgment

Termination of the Proceeding (Paper 44) (appropriate to terminate fully briefed IPR as to all parties and without rendering final written decision where settlement of IPR and co-pending district court litigation, and no other proceedings concern involved patent); *Atrium Medical Corp. v. Davol Inc.*, IPR2013-00186, Judgment (Paper 75) (appropriate to terminate IPR as to all parties where briefing is complete but no final decision on the merits has been rendered).

Notably, no dispute remains between the Patent Owner and the Petitioner involving the '062 Patent or the patents involved in the co-pending IPRs:

- i. the Parties have agreed to jointly request termination of this IPR and the co-pending IPRs;
- ii. the litigation between the parties involving the '062 Patent and the patents involved in the co-pending IPRs is being dismissed as part of the settlement; and
- iii. no other litigations are pending involving other parties relating to the '062 patent and the patents involved in the co-pending IPRs.

Termination of this case will conserve the time and resources of the Parties and the Board which can be put to other uses. Further, the Parties are unaware of any other matter before the Board, or a district court, that would be affected by the outcome of this proceeding or the related IPRs identified above.

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