

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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POLYGROUP LIMITED (MCO),  
Petitioner,

v.

WILLIS ELECTRIC CO., LTD.,  
Patent Owner.

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Cases IPR2016-01615, IPR2016-01616, and IPR2016-01617<sup>1</sup>  
Patent 8,936,379 B1

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Before WILLIAM V. SAINDON, JEREMY M. PLENZLER, and  
BARBARA A. PARVIS, *Administrative Patent Judges*.

PARVIS, *Administrative Patent Judge*.

TERMINATION

Due to Settlement After Institution of Trial  
*35 U.S.C. § 317; 37 C.F.R. § 42.74*

Polygroup Limited (MCO) (“Petitioner”) requested an *inter partes* review of claims 1–6, 8, 10–17, 28, 29, and 32 of U.S. Patent No. 8,936,379 B1 (*see, e.g.*, IPR2016-01615, Ex. 1001, “the ’379 patent”) in a series of three Petitions. IPR2016-01615, Paper 2; IPR2016-01616, Paper 2; IPR2016-01617, Paper 2. Upon consideration of the parties’ contentions

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<sup>1</sup> This Decision applies to each of the listed cases and should be docketed in each case.

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and supporting evidence, we instituted an *inter partes* review pursuant to 35 U.S.C. § 314, as to the challenged claims of the '379 Patent. IPR2016-01615, Paper 16; IPR2016-01616, Paper 15; IPR2016-01617, Paper 16.

After institution, Willis Electric Company, Limited (“Patent Owner”) filed a Patent Owner Response in each of the instant proceedings. IPR2016-01615, Paper 32; IPR2016-01616, Paper 31; IPR2016-01617, Paper 33. Patent Owner also filed a Motion to Amend in each of the proceedings. *See, e.g.*, IPR2016-01615, Paper 64. A hearing was held on December 15, 2017. *See, e.g.*, IPR2016-01615, Paper 90. On February 26, 2018, we entered a Final Written Decision in each of the instant proceedings finding no challenged claims unpatentable and dismissing Patent Owner’s Motions to Amend. *See, e.g.*, IPR2016-01615, Paper 94.

The Federal Circuit issued a decision affirming-in-part, vacating-in-part, and remanding back to the Office for additional proceedings. *Polygroup Limited MCO v. Willis Electric Co.*, Cases 2018-1748, 2018-1749, 2018-1750 (Fed. Cir. Jan. 28, 2019). In particular, the Federal Circuit vacated that Board’s determination that Petitioner failed to prove that claims 1–6, 8, 10, 11, 13, 14, 16, 17, 28, and 29 of the '379 Patent are not unpatentable. The Federal Circuit affirmed the Board’s determination that Petitioner failed to prove that claims 12, 15, and 32 of the '379 Patent are unpatentable.

With our authorization, on July 8, 2019, the Parties filed a Joint Motion to Terminate the Proceeding in IPR2016-01615. *See* IPR2016-01615, Paper 101. On July 12, 2019, the Parties filed a Joint Motion to Terminate the Proceeding in each of IPR2016-01616 and IPR2016-01617. *See* IPR2016-01616, Paper 103; IPR2016-01617, Paper 106. A copy of the

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Parties' Settlement Agreement was filed along with the Joint Motion to Terminate the Proceeding in each of the instant proceedings. *See e.g.*, IPR2016-01615, Paper 102. The Parties also filed a Joint Request to File the Settlement Agreement as Business Confidential Information Pursuant to 35 U.S.C. § 317(b) in each of the instant proceedings. *See e.g.*, IPR2016-01615, Paper 103. The Parties represent that they have settled their disputes with respect to the challenged patent and memorialized their settlement in the written agreement. *See e.g.*, IPR2016-01615, Paper 101, 1.

Under 35 U.S.C. § 317(a), “[a]n inter partes review instituted under this chapter shall be terminated with respect to any petitioner upon the joint request of the petitioner and patent owner, unless the Office has decided the merits of the proceeding before the request for termination is filed.” The requirement for terminating review with respect to Petitioner is met in each of the instant proceedings with respect to the claims pending before us, i.e., claims 1–6, 8, 10, 11, 13, 14, 16, 17, 28, and 29 of the '379 Patent because the Office has not decided the merits following the remand by the Federal Circuit.

Under 35 U.S.C. § 317(a), “[i]f no petitioner remains in the inter partes review, the Office may terminate the review or proceed to a final written decision under section 318(a).” On this record, Polygroup Limited (MCO) is the only petitioner in this proceeding. The Board has discretion to terminate the instant review with respect to Patent Owner.

In the joint motion, the parties indicate that their settlement agreement provides for dismissal of related civil litigation. In particular, the parties represent that in an action in the United States District Court for Minnesota Civil Action No. 0:15-cv-03443-WMW-KMM, the parties have moved that

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claims 1–6, 8, 10, 11, 13, 14, 16, 17, 28, and 29 of the ‘379 Patent be dismissed with prejudice. *See* IPR2016-01615, Paper 101, 3. Additionally, the parties have not identified any other *inter partes* review proceedings involving challenges to claims of the ’379 Patent before the Office.

We determine in these circumstances, it is appropriate to terminate review both as to Petitioner and Patent Owner in each of IPR2016-01615, IPR2016-01616, and IPR2016-01617 without rendering a final written decision subsequent to the remand. *See* 35 U.S.C. § 317; 37 C.F.R. § 42.74. Therefore, the Joint Motions to Terminate the Proceeding are granted. We also grant the requests of the parties to treat the Settlement Agreement as business confidential information. This paper does not constitute a final written decision pursuant to 35 U.S.C. § 318(a).

#### ORDER

For the foregoing reasons, it is:

ORDERED that the Joint Request to File the Settlement Agreement as Business Confidential Information Pursuant to 35 U.S.C. § 317(b) in each of IPR2016-01615, IPR2016-01616, and IPR2016-01617 is *granted*;

FURTHER ORDERED that the Settlement Agreement (IPR2016-01615, Paper 102; IPR2016-01616, Ex. 2093; IPR2016-01617, Ex. 2093) shall be treated as business confidential information and shall be kept separate from the patent file; and

FURTHER ORDERED that the Joint Motion to Terminate the Proceeding in each of IPR2016-01615, IPR2016-01616, and IPR2016-01617 is *granted* and the IPR2016-01615, IPR2016-01616, and IPR2016-01617 *inter partes* reviews are *terminated* as to all parties.

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