

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

STELLAR ENERGY AMERICAS, INC.,
Petitioner,

v.

TAS ENERGY, INC.,
Patent Owner.

Cases IPR2016-00426
Patent RE44,079 E

Before JOSIAH C. COCKS, MICHAEL J. FITZPATRICK, and
BARRY L. GROSSMAN, *Administrative Patent Judges*.

COCKS, *Administrative Patent Judge*.

ORDER

Joint Motion to Terminate *Inter Partes* Review
35 U.S.C. § 317 and 37 C.F.R. § 42.72

I. Introduction

On December 6, 2016, Petitioner, Stellar Energy Americas, Inc. (“SEA”), and Patent Owner, TAS Energy, Inc. (“TAS”) (collectively the “parties”) filed a Joint Motion to Terminate this *inter partes* review. Paper 11 (“Joint Motion to Terminate”). Along with the Joint Motion to Terminate, the parties a true copy of a written settlement agreement (Ex. 1235), as well as a joint request to have their settlement agreement treated as business confidential information under 35 U.S.C. § 317 and 37 C.F.R. § 42.74(c) (Paper 12).

II. Discussion

The parties are reminded that the Board is not a party to the settlement, and may identify independently any question of patentability. 37 C.F.R. § 42.74(a). Generally, however, the Board expects that a proceeding will terminate after the filing of a settlement agreement. *See, e.g., Office Patent Trial Practice Guide*, 77 Fed. Reg. 48,756, 48,768 (Aug. 14, 2012). 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 the 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 SEA is met.

Furthermore, 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).” SEA is the sole petitioner in this *inter partes* review, such that termination with respect to SEA means that no petitioner remains in the proceeding. The Board, thus, has discretion to terminate this review with respect to TAS.

The panel entered a Decision to institute trial on July 1, 2016 (Paper 7). TAS has filed no Patent Owner Response. Thus, briefing is not complete in this proceeding. The parties also state that they “have settled their dispute,” and represent the following:

On December 2, 2016, the parties filed dismissal notices in the related district court litigations *TAS Energy Inc. v. Stellar Energy Americas, Inc., et al.*, Case No. 8:14-cv-3145-T-30MAP (M.D. Fla.) and *TAS Energy Inc. v. Direct Energy, Inc., et al.*, Case No. 4:14-cv-512 (S.D. Tex.), and the parties are concurrently filing joint motions to terminate related *Inter Partes* Reviews IPR2016-00294, IPR2016-00335, IPR2016-00425, and IPR2016-00426. In addition, the parties moved to dismiss Patent Owner's appeals to the United States Court of Appeals for the Federal Circuit of the final written decisions in IPR 2015-00882 and IPR 2015-00886. The Federal Circuit granted that motion and dismissed the appeals on December 5, 2016. The parties are not aware of any other related pending litigation involving the subject patent. In addition, the parties are not contemplating any litigation or proceeding involving the subject patent in the foreseeable future.

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Upon consideration of the circumstances of this case, the panel has determined to terminate this *inter partes* review as to both SEA and TAS without rendering a final written decision.

III. Order

It is

ORDERED that the Joint Motion to Terminate this proceeding in (Paper 11) is *granted*, and this proceeding is hereby *terminated*; and

FURTHER ORDERED that, as was requested timely by the parties (Paper 12), the settlement agreement and license agreement (Exhibit 1235)

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will be treated as business confidential information under 35 U.S.C. § 317(b)
and 37 C.F.R. § 42.74(c).

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