

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ITRON, INC.,
Petitioner,

v.

SMART METER TECHNOLOGIES, INC.,
Patent Owner.

Case IPR2017-01199
Patent 7,058,524 B2

Before BRYAN F. MOORE, BARBARA A. BENOIT, and
JOHN D. HAMANN, *Administrative Patent Judges*.

HAMANN, *Administrative Patent Judge*.

ORDER
Granting Joint Motion to Limit the Petition
37 C.F.R. § 42.20

In this proceeding, we initially instituted an *inter partes* review only as to *Count 1*, which alleges claims 17–22 are unpatentable over Suh under 35 U.S.C. § 103(a). Paper 8, 20. We did not institute an *inter partes* review as to *Count 2*, which alleges claims 17–22 are unpatentable over Suh and Bartone under 35 U.S.C. § 103(a), and *Count 3*, which alleges claims 17–22 are unpatentable over Bartone and Villicana under 35 U.S.C. § 103(a). *Id.* at 19–20. Subsequently, we modified our institution decision to include *Counts 2* and *3* in light of the Supreme Court’s *SAS Institute Inc. v. Iancu*, 138 S. Ct. 1348 (2018) decision. Paper 22 (modifying the Decision on Institution to include all grounds presented in the Petition).

On May 10, 2018, with our prior authorization, the parties filed a Joint Motion to Limit the Petition. Paper 23; *see also* Paper 22, 2–3. The parties “jointly move[d] to limit the petition for inter partes review IPR2017-01199 to Count 1 (challenging claims 17-22 of U.S. Patent No. 7,058,524 under 35 U.S.C. § 103 over Suh).” Paper 23, 1. More specifically, the parties requested “that the Board remove the newly instituted grounds, *viz.*, Count 2 (challenging claims 17-22 under 35 U.S.C. § 103 over Suh and Bartone) and Count 3 (challenging claims 17-22 under 35 U.S.C. § 103 over Bartone and Villicana), from this proceeding.” *Id.*

Removing grounds from dispute, pursuant to a joint request of the parties, serves our overarching goal of resolving this proceeding in a just, speedy, and inexpensive manner. 37 C.F.R. § 42.1(b); *see, e.g., Apotex Inc., v. OSI Pharms., Inc.*, Case IPR2016-01284 (PTAB Apr. 3, 2017) (Paper 19) (granting, after institution, a joint motion to limit the petition by removing a patent claim that was included for trial in the institution decision); *SAS*, 138 S. Ct. at 1357.

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Accordingly, we *grant* the Joint Motion to Limit the Petition. As such, *Counts 2 and 3* are removed from dispute in this proceeding. The sole ground of unpatentability remaining in dispute is *Count 1*, which challenges claims 17–22 under 35 U.S.C. § 103(a) over Suh.

In consideration of the foregoing, it is hereby:

ORDERED that the Joint Motion to Limit the Petition is *granted*;

FURTHER ORDERED that the Petition is limited to the Count 1 which challenges claims 17–22 based on obviousness under 35 U.S.C. § 103(a) over Suh.

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