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Paper 12
Date: March 1, 2018

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HONEYWELL INTERNATIONAL, INC.,
Petitioner,

v.

INTELLICHECK, INC. [1],
Patent Owner.

CBM2017-00062 (Patent 7,899,751 B2)
CBM2018-00010 (Patent 7,899,751 B2)[2]

Before MEREDITH C. PETRAVICK, FRANCES L. IPPOLITO, and CHRISTOPHER G. PAULRAJ, *Administrative Patent Judges*.

PETRAVICK, *Administrative Patent Judge*.

JUDGMENT
Termination Due to Settlement
35 U.S.C. § 327 and 37 C.F.R. §§ 42.10, 42.74

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[1] On March 1, 2001, Petitioner updated its Mandatory Notices to indicate its named changed from Intellicheck Mobilisa, Inc. to Intellicheck, Inc. Paper 6, 1.

[2] This Order addresses the same or similar issue in the proceedings listed above, and we issue one Order to be filed in each proceeding.

I. INTRODUCTION

On February 28, 2018, the parties filed joint motions to terminate the instant proceedings (Paper 14[3]), along with, a true copy of their written settlement agreement made in connection with the termination of the instant proceedings (Ex. 1039). The parties also filed joint requests to treat the settlement agreement as business confidential information. Paper 15. The Board authorized these filings by email on February 21, 2018. For the reasons set forth below, we grant the motions and requests.

II. DISCUSSION

Under 35 U.S.C. § 327(a), a covered business method patent review proceeding shall be terminated with respect to any petitioner upon the joint request of the petitioner and the patent owner, unless the Board has decided the merits of the proceeding before the request for termination is filed. *See* 37 C.F.R. §§ 42.71(a), 42.72. These proceedings are in the early stages. In CBM2017-00062, we entered a decision to institute on January 22, 2018 (Paper 12), and a patent owner's response has not yet been filed. In CBM2018-00010, we have not yet entered a decision on institution. Thus, we have not yet decided the merits in these proceedings. Under 35 U.S.C. § 327(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 328(a)." Petitioner is the sole petitioner in this review. The Board has discretion to terminate this review with respect to Patent Owner.

[3] For the purposes of this Order, CBM2017-00062 is representative and all citations are to papers in CBM2017-00062 unless otherwise noted.

Under 35 U.S.C. § 327(b) and 37 C.F.R. § 42.74(b), any agreement or understanding between the Patent Owner and a Petitioner, including any collateral agreements referred to in such agreement or understanding, made in connection with, or in contemplation of, the termination of the proceeding shall be in writing, and a true copy of such agreement or understanding shall be filed in the Office. The parties state that they have settled their dispute concerning the patent at issue and have reached a written agreement to terminate this proceeding. Paper 14, 1–2. In support of the joint motions, the parties submitted a true copy of their written agreement as Exhibit 1039. The parties also indicate the no other pending litigation or proceeding concerning the patent at issue. Paper 14, 3.

Upon consideration of the facts in the case before us, we grant the joint motions and terminate these proceedings as to both Petitioner and Patent Owner without rendering final written decisions. We also grant the joint requests to maintain the settlement agreement as business confidential in accordance with 37 C.F.R. § 42.74(c).

In CBM2018-00010, a Motion for Admission *Pro Hac Vice* of Amber N. Davis is pending. CBM2018-00010, Paper 7. We dismiss the Motion for Admission *Pro Hac Vice* of Amber N. Davis as moot.

III. CONCLUSION

It is:

ORDERED that the joint motions to terminate these proceedings are *granted*, and these proceedings are, hereby, *terminated*; and

FURTHER ORDERED that the parties' joint requests that the settlement agreement be treated as business confidential information and

kept separate from the file of the involved patent under 35 U.S.C. § 327(b) and 37 C.F.R. § 42.74(c) is *granted;*

FURTHER ORDERED that the Motion for Admission *Pro Hac Vice* of Amber N. Davis in CBM2018-00010 is *dismissed* as moot.

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