

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LOREX CANADA, INC.
Petitioner

v.

e-WATCH, INC.
Patent Owner

Case IPR2013-00521
Patent 7,839,926

Before JAMESON LEE, TREVOR M. JEFFERSON, and
MATTHEW R. CLEMENTS, *Administrative Patent Judges*.

CLEMENTS, *Administrative Patent Judge*.

ORDER
Joint Motion to Terminate
37 C.F.R. § 42.72

On May 29, 2014, the parties filed a joint motion to terminate the instant proceeding under 35 U.S.C. § 317(a). Paper 15. Along with the motion, the parties filed a Joint Request to File a True Copy of the Settlement Agreement as Business Confidential Information Pursuant to 35 U.S.C. § 317 (Paper 18), and filed a true copy of the settlement agreement (Exhibit 2001).

On June 2, 2014, the parties filed a redacted copy of the Settlement Agreement. Exhibit 2002.

On June 3, 2014, a conference call was held between respective counsel for Petitioner and Patent Owner, and Judges Clements and Parvis. The Board explained that the joint motion to terminate erroneously refers to the redacted copy of the settlement agreement as “Exhibit 1.” The Board instructed the parties to file a revised joint motion to terminate that refers to the redacted copy of the settlement agreement as “Exhibit 2002.” Later that day, the parties filed a revised joint motion to terminate the instant proceeding under 35 U.S.C. § 317(a). Paper 19. The revised joint motion to terminate, however, erroneously refers to Exhibit 2001 as a redacted copy of the Settlement Agreement.

On June 5, 2014, the Board expunged the revised joint motion to terminate and authorized the parties to file a second revised joint motion to terminate that characterizes correctly Exhibit 2001. Paper 22. Later the same day, the parties filed a replacement revised joint motion to terminate the instant proceeding under 35 U.S.C. § 317(a). Paper 25. For the reasons discussed below, the motion is *granted*.

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.” In their joint motion, the parties request termination of the instant proceeding because they have settled their dispute and have reached agreement to terminate this inter partes review and the co-pending litigation, and because the Office has not yet decided the merits of the proceeding. Paper 25, 2-3.

Patent Owner further indicates that the parties have agreed to dismiss the related litigation (Ex. 2004, 1). The joint motion indicates that there is no other litigation involving the ’926 patent pending. Paper 25 at 3.

The parties are reminded that the Board is not a party to the settlement and that, even if the parties agree to settle any issue in a proceeding, the Board may independently determine 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). This proceeding is still in the preliminary stages. The Patent Owner’s Response has not yet been filed. The Board is persuaded that, under these circumstances, it is appropriate to terminate this proceeding as to both Petitioner and Patent Owner without rendering a final written decision. 37 C.F.R. § 42.72.

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Accordingly, it is:

ORDERED that the revised joint motion to terminate this proceeding is GRANTED and this proceeding is hereby terminated as to both Petitioner and Patent Owner; and

FURTHER ORDERED that the parties' joint request that the settlement agreement (Exhibit 2001) be treated as business confidential information, kept separate from the file of the involved patent, and made available only to Federal Government agencies on written request, or to any person on a showing of good cause, under the provisions of 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c), is GRANTED.

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