

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

PANASONIC CORPORATION and
PANASONIC CORPORATION OF NORTH AMERICA,
Petitioner

v.

OPTICAL DEVICES, LLC,
Patent Owner.

Case IPR2014-00303
Patent RE40,927 E

Before ERICA A. FRANKLIN, GLENN J. PERRY, and JAMES B. ARPIN,
Administrative Patent Judges.

PERRY, *Administrative Patent Judge.*

DECISION
Termination of the Proceeding
37 C.F.R. § 42.72

I. DISCUSSION

On February 23, 2015, the parties filed a Joint Motion (Paper 24) to terminate this proceeding, as well as a Joint Request (Paper 25) to have their settlement agreement treated as business confidential information under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c). The parties also filed a true copy of their written settlement agreement. Ex. 2006. The settlement agreement was filed so as to limit viewing to the parties and the Board only.

The parties indicated in their Joint Motion that termination of this proceeding is appropriate because they have reached an agreement regarding their dispute with respect to U.S. Patent No. RE40,927 E (“the ’927 patent”). The Joint Motion indicates that the parties have settled their dispute. The record in this proceeding is incomplete. Terminating this *inter partes* review will not affect the *inter partes* reviews now pending with another party.

The parties indicate that their related District Court litigation is settled and that the related ITC investigation is dismissed. Petitioner indicates that it will not file any further papers in this proceeding. Patent Owner acknowledges that disputes remain with other parties and that the ’927 patent and related patents are involved in other proceedings including *inter partes* reviews and litigation.

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.” As the parties indicate in their Joint Motion, this proceeding has not been decided on its merits.

Further, under 37 C.F.R. § 42.74(b), “[a]ny agreement or understanding between the parties made in connection with, or in contemplation of, the termination of a proceeding shall be in writing and a true copy shall be filed with the Board before termination of the trial.” As the parties have filed their written settlement agreement, and the co-pending district court cases have been dismissed, we determine that it is appropriate to terminate this proceeding without rendering a Final Written Decision as to the patentability of claims 48, 49, 51–53, 55, 57, 60, 61, 63–65, 67, 68, and 71 of the ’927 patent. *See* 37 C.F.R. §§ 42.72, 42.73, 42.74.

II. ORDER

It is, therefore,

ORDERED that the Joint Motion to terminate the proceeding is GRANTED and the proceeding is hereby terminated; and

FURTHER ORDERED that the parties’ Joint Request that the settlement agreement be treated as business confidential information and shall be kept separate from the file of the involved patent under the provisions of 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c), is GRANTED.

Case IPR2014-00303

Patent RE40,927 E

For PETITIONER:

Christopher D. Bright

Amol A. Parikh

McDermott Will & Emery LLP

cbright@mwe.com

amparikh@mwe.com

For PATENT OWNER:

Thomas Engellenner

Reza Mollaaghababa

Pepper Hamilton LLP

engellererrt@pepperlaw.com

mollaaghababar@pepperlaw.com

Theodosios Thomas

OPTICAL DEVICES, LLC

ted.thomas@sceneralabs.com