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Paper No. 12
Entered: March 11, 2015

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

STEALTH MONITORING, INC.,
Petitioner,

v.

DISCOVERY PATENTS, LLC,
Patent Owner.

Case IPR2015-00256
Patent 7,323,980 B2

Before BART A. GERSTENBLITH and MATTHEW R. CLEMENTS, *Administrative Patent Judges*.

CLEMENTS, *Administrative Patent Judge*.

ORDER
Conduct of the Proceeding
37 C.F.R. § 42.5

On March 3, 2015, Stealth Monitoring, Inc. ("Petitioner") and Discovery Patents, LLC ("Patent Owner") filed a joint motion to terminate the trial proceedings under 35 U.S.C. § 317(a). Paper 11. Along with the motion, the parties filed a Joint Request to File True Copy of Agreement Resolving Dispute as Business Confidential Information Pursuant to 35 U.S.C. § 317 (Paper 9), and a copy of a document they described as the written settlement agreement (Exhibit 1).

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 because the Office has not yet decided the merits of the proceeding. Mot. 1–2.

The parties also indicate that "[d]ismissal pleadings have been filed in all related district court actions in which the '980 Patent has been asserted, except for one that does not involve [Petitioner]," and "orders have been issued dismissing the cases in which the defendant had appeared." *Id.* at 1. The parties note that, in the remaining case, the parties to that case have been ordered to mediation. *Id.*

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). We have not yet decided the merits of this proceeding. For example, the oral argument has not been held. 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.

ORDER

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 1) 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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