

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ROBERT BOSCH TOOL CORPORATION,
Petitioner,

v.

SD3, LLC,
Patent Owner.

Case IPR2016-01750
Patent 7,225,712 B2

Before HYUN J. JUNG, SCOTT A. DANIELS, and ROBERT L. KINDER,
Administrative Patent Judges.

DANIELS, *Administrative Patent Judge.*

JUDGMENT
TERMINATION OF THE PROCEEDING
37 C.F.R. § 42.73

On June 14, 2017, the Parties filed a Joint Motion to Terminate Proceeding under 35 U.S.C. § 317 and 37 C.F.R. § 42.74(b) (Motion to Terminate) in IPR2016-01750. The Parties' Motion to Terminate stated that

[t]he Parties, having settled their dispute and having reached an agreement to terminate this *inter partes* review, respectfully submit that termination of this proceeding is appropriate. The Parties' Settlement Agreement, which has been reduced to a writing and which was executed on June 2, 2017, is attached hereto as Exhibit 1100. The Settlement Agreement fully resolves the Parties' dispute regarding the '712 patent.

Motion to Terminate 1. The Agreement, having an effective date of June 7, 2017 and attached as Exhibit 1100 to the Motion to Terminate, stated that "[w]ithin one week of the Effective Date, the Parties will jointly request the Board's permission to file a joint motion to terminate the IPR Proceeding pursuant to 35 U.S.C. § 317." Agreement 2.

In addition to this proceeding, the '712 patent has been asserted by SawStop against Bosch in the United States International Trade Commission ("ITC"), in the matter of *Certain Table Saws Incorporating Active Injury Mitigation Technology and Components Thereof*, Inv. No. 337-TA-965 (the "ITC Action"), and in the United States District Court for the District of Oregon, Case No. 3:15-cv-01320, currently stayed. SawStop states that it will not appeal the ITC Administrative Law Judge's findings that Bosch does not infringe the '712 patent. Agreement 1. Motion to Terminate 2. In addition, the Agreement states that "the Parties wish to resolve the Oregon Action and IPR Proceeding with respect to the '712 Patent." Agreement 1. The Agreement further indicates that if and when the District Court's stay is lifted, the parties will execute a stipulation dismissing the claims of

infringement against Bosch of the '712 patent in the Oregon Action.
Agreement 2.

The Parties represented that the Agreement fully resolves the Parties' dispute with respect to the '712 patent and further certify that there is no other agreement or understanding between the Parties, including other collateral agreements. Motion to Terminate 1–2. In view of the Parties' certification that the ITC Action will not be appealed, that the District Court action and IPR Proceeding regarding '712 patent are settled, and that there are no collateral agreements of any kind, the Board determines that where this proceeding is in its early stages and SawStop's Response to the Petition has not been filed, it is appropriate to enter judgment without rendering a final written decision.

In view of the foregoing,

It is ORDERED that the Parties' Motion to Terminate IPR2016-01750 is GRANTED and the IPR Proceeding is terminated.

IPR2016-01750
Patent 7,225,712 B2

PETITIONER:

Patrick R. Colsher
Mark A. Hannemann (Pro Hac Vice)
Thomas R. Makin (Pro Hac Vice)
SHEARMAN & STERLING LLP

ptab@shearman.com
patrick.colsher@shearman.com

PATENT OWNER:

Jared W. Newton
QUINN EMANUEL URQUHART & SULLIVAN LLP

jarednewton@quinnemanuel.com
sawstopipr@quinnemanuel.com