Trials@uspto.gov
571-272-7822

Paper No. 27
Entered: July 8, 2019

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

IPDATATEL, LLC; ALULA HOLDINGS, LLC; AND
RESOLUTION PRODUCTS, LLC,
Petitioner,

v.

ICN ACQUISITION, LLC,
Patent Owner.

Case IPR2018-01820
Patent 7,956,736 B2

Before KALYAN K. DESHPANDE, KEVIN W. CHERRY, and NABEEL U. KHAN, *Administrative Patent Judges*.

CHERRY, *Administrative Patent Judge*.

ORDER
Granting Joint Motion to Terminate Proceeding Due to Settlement after Institution and
Granting Joint Request to Treat Settlement Agreement as Business Confidential Information
35 U.S.C. § 317; 37 C.F.R. §§ 42.72, 42.74

I. INTRODUCTION

Petitioner and Patent Owner ("Parties") have requested that this *inter partes* review proceeding be terminated. On July 3, 2019, the Parties filed a Joint Motion to Terminate ("Motion"). Paper 24. The Parties represent that the Board authorized filing of the Motion. *Id.* at 1. The Parties also filed a Joint Motion ("Request") (Paper 25) to treat their Settlement Agreement (Ex. 1048) as business confidential information pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

II. DISCUSSION

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 the patent owner, unless the Office has decided the merits of the proceeding before the request for termination is filed." It is also provided in 35 U.S.C. § 317(a) that if no petitioner remains in the *inter partes* review, the Office may terminate the review.

The Parties represent that they have reached an agreement to jointly seek termination of this *inter partes* review proceeding, and that the filed copy of the Settlement Agreement is a true and complete copy. Paper 24, 1. The Parties further represent that they have resolved their disputes in this proceeding and the related litigation[1] regarding U.S. Patent No. 7,956,736. *Id.* at 1–2.

We instituted a trial on April 17, 2019. *See* Paper 19. We have not yet decided the merits of this proceeding, and a final written decision has not been entered. Notwithstanding that this proceeding has moved beyond the

[1] *Alarm.com Inc. & ICN Acquisition, LLC v. ipDataTel*, Civil Action No. 4:18-cv-02108 (S.D. Tex.).

preliminary stage, the Parties have shown adequately that the termination of this proceeding is appropriate. Under these circumstances, we determine that good cause exists to terminate the proceeding with respect to the Parties.

Regarding the Parties' Request to treat the Settlement Agreement as business confidential information to be kept separate from the file of U.S. Patent No. 7,956,736, we determine that good cause exists to treat the Settlement Agreement as business confidential information pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

This Order does not constitute a final written decision pursuant to 35 U.S.C. § 318(a).

III. ORDER

Accordingly, for the reasons discussed above, it is:

ORDERED that the Joint Motion to Terminate (Paper 24) is *granted*, and that this proceeding is *terminated* with respect to Petitioner and Patent Owner pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. § 42.72; and

FURTHER ORDERED that the Joint Motion (Paper 25) to treat the Settlement Agreement (Ex. 1048) as business confidential information pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) is *granted*.

For PETITIONER:

Richard M. Marsh, Jr.
Walter C. Linder
FAEGRE BAKER DANIELS LLP
richard.marsh@faegrebd.com
walter.linder@faegrebd.com

For PATENT OWNER:

Matthew A. Argenti
Michael T. Rosato
Quincy Lu
WILSON SONSINI GOODRICH & ROSATI
margenti@wsgr.com
mrosato@wsgr.com
qalu@wsgr.com