Trials@uspto.gov
Tel: 571-272-7822

Paper 32
Entered: March 26, 2020

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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BOWTECH, INC.,
Petitioner,

v.

MCP IP, LLC,
Patent Owner.

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IPR2019-00380 (Patent 7,946,281 B2);
IPR2019-00382 (Patent 9,816,775 B2);
IPR2019-00383 (Patent 9,423,201 B2);
IPR2019-00386 (Patent 8,919,333 B2)[1]

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Before SCOTT C. WEIDENFELLER, *Vice Chief Administrative Patent Judge*, MICHAEL W. KIM, and PHILLIP J. KAUFFMAN, *Administrative Patent Judges*.

KAUFFMAN, *Administrative Patent Judge.*

TERMINATION
Due to Settlement After Institution of Trial
*35 U.S.C. § 317; 37 C.F.R. § 42.74*

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[1] This Order addresses issues that are the same in all identified proceedings. We exercise our discretion to issue one Order to be filed in each proceeding. The parties, however, are not authorized to use this style heading in subsequent papers.

## I. INTRODUCTION

With the Board's authorization, Petitioner and Patent Owner ("Parties") filed a Joint Motion to Terminate this proceeding due to settlement. Paper 31[2] ("Joint Motion"). In support of the Joint Motion, the Parties filed a confidential settlement agreement in the form of a binding Term Sheet and corresponding exhibits (Ex. 1060 ("Settlement Agreement"); Ex. 3002[3]), as well as a Joint Request to File the Settlement Agreement as Business Confidential Information pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) (Paper 32 ("Joint Request")).

## 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." Section 35 U.S.C. § 317(a) also provides that if no petitioner remains in the *inter partes* review, the Office may terminate the review. Section 317(b) requires that any agreement between the parties, including collateral agreements, made in connection with the termination of an *inter partes* review "shall be in writing and a true copy of such agreement or understanding shall be filed in the Office before the termination of the inter partes review as between the parties."

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[2] For expediency, we cite to Papers and Exhibits in IPR2019-00380, unless otherwise indicated. Similar Papers and Exhibits were filed in IPR2019-00382, IPR2019-00383, and IPR2019-00386.

[3] Though Ex. 3002 refers to IPR2019-00838, we understand IPR2019-00838 to mean IPR2019-00383.

The Parties represent that they have reached an agreement to jointly seek termination of this *inter partes* review proceeding (Joint Motion 1), the Settlement Agreement "is the sole document governing the Parties' settlement of their dispute regarding the patents at issue in the related IPR proceedings" (Ex. 3001[4]), and that the filed copy of the Settlement Agreement is a true and complete copy (Joint Motion 1). The Parties further represent that the Settlement Agreement resolves all currently pending Patent Office and District Court proceedings between the Parties involving the '281 patent. Joint Motion 1.

We instituted a trial on the above-identified proceeding on July 3, 2019. Paper 15. We have not yet held an oral hearing, decided the merits of the proceeding, or entered a final written decision. Under these circumstances, we determine that good cause exists to terminate the proceeding. We further determine that the Settlement Agreement complies with the requirements for written agreements regarding termination set forth in 35 U.S.C. § 317(b).

The Parties also filed a Joint Request that the Settlement Agreement be treated as business confidential information, and be kept separate from the file of the respective patents involved in this proceeding. Joint Request. We find that the Settlement Agreement contains confidential business information regarding the terms of settlement. We determine that good cause exists to treat the Settlement Agreement between Petitioner and Patent

[4] Though Ex. 3001 refers to IPR2019-00838, we understand IPR2019-00838 to mean IPR2019-00383.

Owner 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, for each proceeding, the Joint Motion to Terminate is *granted*, and that IPR2019-00380, IPR2019-00382, IPR2019-00383, and IPR2019-00386 are each *terminated* pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. § 42.72; and

FURTHER ORDERED that, for each proceeding, the Joint Request to Treat the Settlement Agreement as Business Confidential Information is *granted*, and the Settlement Agreement shall be kept separate from the files of U.S. Patent Nos. 7,946,281 B2, 8,919,333 B2, 9,423,201 B2, and 9,816,775 B2, and made available only to Federal Government agencies on written request, or to any person on a showing of good cause, pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

IPR2019-00380 (Patent 7,946,281 B2)
IPR2019-00382 (Patent 9,816,775 B2)
IPR2019-00383 (Patent 9,423,201 B2)
IPR2019-00386 (Patent 8,919,333 B2)

PETITIONER:
Thomas Rozylowicz
tar@fr.com
Mark Hebert
hebert@fr.com
Andrew Patrick
patrick@fr.com

PATENT OWNER:
Jeffrey Costakos
jcostakos@foley.com
Kadie M. Jelenchick
kjelenchick@foley.com
Michelle A. Moran
mmoran@foley.com