

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

UNIDEN AMERICA CORPORATION,
Petitioner,

v.

ESCORT INC.,
Patent Owner.

IPR2019-00724
Patent 7,576,679 B1

Before HUBERT C. LORIN, PATRICK R. SCANLON, and
BARRY L. GROSSMAN, *Administrative Patent Judges*.

GROSSMAN, *Administrative Patent Judge*.

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

I. INTRODUCTION

Per our authorization provided in an email dated August 18, 2020, Petitioner and Patent Owner (collectively “the Parties”) filed a Joint Motion to Terminate (Paper 22, “Joint Motion”) and a Joint Request to Treat Agreement as Business Confidential Information (Paper 23, “Joint Request”). In support of the Joint Motion, the Parties also filed a copy of a Settlement and Patent License Agreement. Ex. 2005 (“Agreement”).

II. DISCUSSION

In the Joint Motion, the Parties represent that terminating this proceeding is appropriate because they have resolved their disputes regarding U.S. Patent No. 7,576,679 B1 (“the ’679 patent”). Joint Motion 1. According to the Parties, “[t]here are no other agreements, oral or written, between the [P]arties made in connection with, or in contemplation of, the termination of this proceeding.” *Id.*

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.” Indeed, there are strong public policy reasons to favor settlement between the parties to a proceeding. Consolidated Office Patent Trial Practice Guide, November 2019, at 86¹.

We instituted a trial in this proceeding on September 17, 2019. Paper 6. However, we have not yet decided the merits of the proceeding, and a final written decision has not been entered. Notwithstanding that the

¹ Available at <https://www.uspto.gov/TrialPracticeGuideConsolidated>.

proceeding has moved beyond the preliminary stage, the Parties have shown adequately that the termination of the proceeding is appropriate.

Accordingly, we determine that good cause exists to terminate the proceeding with respect to the Parties without rendering a final written decision. *See* 37 C.F.R. § 42.72.

In the Joint Request, the Parties request that the Settlement Agreement be treated as business confidential information and be kept separate from the file of the '679 patent. Joint Request 1. After reviewing the Settlement Agreement between the Parties, 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 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

In consideration of the foregoing, it is hereby:

ORDERED that the Joint Motion to Terminate (Paper 22) is *granted*, and IPR2019-00724 is *terminated* with respect to Petitioner and Patent Owner; and

FURTHER ORDERED that the Joint Request to Treat Agreement as Business Confidential Information (Paper 23) as business confidential information is *granted*, and the Agreement (Ex. 2005) shall be kept separate from the file of Patent 7,576,679 B1, under the provisions of 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

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Patent 7,576,679 B1

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