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571-272-7822

Paper 22
Filed: May 19, 2020

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ICONEX, LLC,
Petitioner,

v.

MAXSTICK PRODUCTS LTD.,
Patent Owner.

IPR2019-01119 (Patent 8,445,104 B2)
IPR2019-01122 (Patent 9,646,517 B2)
IPR2019-01124 (Patent 9,208,699 B2)[1]

Before JO-ANNE M. KOKOSKI, CHRISTOPHER M. KAISER, and SHELDON M. McGEE, *Administrative Patent Judges*.

KOKOSKI, *Administrative Patent Judge*.

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

[1] This Order addresses identical issues in each of three related cases. We exercise our discretion to issue one Order to be entered in each case.

On May 18, 2020, with Board authorization, Petitioner (Iconex, LLC) and Patent Owner (MAXStick Products Ltd.) filed a Joint Motion to Terminate each of the above-referenced proceedings (IPR2019-01119, Paper 20; IPR2019-01122, Paper 22; IPR2019-01124, Paper 19), and a Joint Request that the settlement agreement be treated as business confidential and kept separate from the patent file (IPR2019-01119, Paper 21; IPR2019-01122, Paper 21; IPR2019-01124, Paper 20), along with what the parties indicate is a copy of their written settlement agreement (Ex. 1033 in each proceeding).

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." Section 317(a) also provides that if no petitioner remains in the *inter partes* review, the Office may terminate the review.

In the Joint Motions, the parties represent that they have reached an agreement resolving their disputes, and that Exhibit 1033 is a true copy of their written settlement agreement. IPR2019-01119, Paper 20 at 1; IPR2019-01122, Paper 22 at 1; IPR2019-01124, Paper 19 at 1. The parties further represent that there are no other agreements or understandings made in connection with the termination of the proceedings. IPR2019-01119, Paper 20 at 2; IPR2019-01122, Paper 22 at 2; IPR2019-01124, Paper 19 at 2.

We instituted trials in these proceedings on December 6, 2019, but we have not yet decided the merits of the proceedings. Under these circumstances, we determine that it is appropriate to terminate these

proceedings without rendering a final written decision. *See* 37 C.F.R. §§ 42.72, 42.74. Further, after reviewing the settlement agreement between Petitioner and Patent Owner, we determine it is appropriate to treat it as business confidential information and keep it separate from the file of the patent in each proceeding pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

Therefore, we grant the Joint Motion to Terminate and the Joint Request to treat the settlement agreement as business confidential information in each of these proceedings. This determination does not constitute a final written decision pursuant to 35 U.S.C. § 318(a).

Accordingly, it is:

ORDERED that the Joint Motions to Terminate (IPR2019-01119, Paper 20; IPR2019-01122, Paper 22; IPR2019-01124, Paper 19) are *granted*;

FURTHER ORDERED that the Joint Requests (IPR2019-01119, Paper 21; IPR2019-01122, Paper 21; IPR2019-01124, Paper 20) to treat the settlement agreement (Ex. 1033) as business confidential and kept separate from the respective patent files are *granted*; and

FURTHER ORDERED that IPR2019-01119, IPR2019-01122, and IPR2019-01124 are *terminated* with respect to both Petitioner and Patent Owner.

IPR2019-01119 (8,445,104 B2)
IPR2019-01122 (9,646,517 B2)
IPR2019-01124 (9,208,699 B2)

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