

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

RESIDEO TECHNOLOGIES, INC.,
Petitioner,

v.

INNOVATION SCIENCES, LLC,
Patent Owner.

IPR2019-01306
Patent 9,912,983 B2

Before JONI Y. CHANG, KERRY BEGLEY, and
CHRISTOPHER L. OGDEN, *Administrative Patent Judges*.

OGDEN, *Administrative Patent Judge*.

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

By our authorization, on October 5, 2020, the parties filed a Joint Motion to Terminate the above-captioned proceeding. Paper 29 (“Joint Motion”). Along with the Joint Motion, the parties filed a confidential settlement agreement (Exhibit 1033, “Settlement Agreement”) and a Joint Motion to File Settlement Agreement as Business Confidential Information (Paper 31, “Joint Request”), in which the parties request the settlement agreement be treated as business confidential information pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

The parties state that they “have settled their disputes and seek termination to promote efficiency and minimize unnecessary costs.” Paper 29, 1. They state that the patent at issue in this case was also the subject of a district court action, in which the district court dismissed Patent Owner’s claims with prejudice on September 25, 2020. *Id.* The parties characterize the Settlement Agreement as “a true copy of their Executed Confidential Settlement Agreement,” and “certify that there are no other agreements, oral or written, between the parties made in connection with, or in contemplation of, the termination of this proceeding.” *Id.* at 2.

We instituted trial on January 27, 2020. Paper 19. We have not yet held an oral hearing, and we have not yet decided the merits. Under the circumstances, we determine that it is appropriate to terminate this proceeding. *See* 35 U.S.C. § 317(a). We also agree that the Settlement Agreement contains business confidential information, so we grant the Joint Request. *See* 35 U.S.C. § 317(b); 37 C.F.R. § 42.74(c).

It is

ORDERED that the Joint Motion is *granted*, and the proceeding is *terminated*; and

FURTHER ORDERED that the Joint Request is *granted*, and under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c), the Settlement Agreement (Exhibit 1033) shall be kept separate from the file of Patent No. 9,912,983 B2, and shall only be made available, on written request to the Board, to Federal Government agencies, or to any person on a showing of good cause.

IPR2019-01306
Patent 9,912,983 B2

For PETITIONER:

Brian Berliner
bberliner@omm.com

Cameron Westin
cwestin@omm.com

For PATENT OWNER:

Donald Jackson
djackson@dbjg.com

James Berquist
jberquist@dbjg.com

Alan Wright
awright@dbjg.com

Aldo Noto
anoto@davidsonberquist.com