

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MAXSTICK PRODUCTS LTD.,
Petitioner,

v.

ICONEX, LLC,
Patent Owner.

IPR2019-01542
Patent 8,537,184 B2

Before JONI Y. CHANG, STACY B. MARGOLIES, and
SCOTT RAEVSKY, *Administrative Patent Judges*.

CHANG, *Administrative Patent Judge*.

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

Petitioner and Patent Owner jointly move to terminate the instant *inter partes* review in light of their settlement that resolves their dispute regarding U.S. Patent No. 8,537,184 B2 (“the ’184 patent”). Paper 15 (“Mot.”). The parties also filed a true copy of their written settlement agreement in connection with the termination as required by 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b). Ex. 1036. Pursuant to 37 C.F.R. § 42.74(c), the parties additionally filed a joint request to treat the Settlement Agreement as business confidential information kept separate from the file of the involved patent. Paper 14.

Generally, the Board expects that a proceeding will terminate after the filing of a settlement agreement. *See* Consolidated Trial Practice Guide¹ at 86; *see also* 84 Fed. Reg. 64,280 (Nov. 21, 2019). Here, the parties indicate that their Settlement Agreement completely resolves the controversy between the parties relating to the involved patent. Mot. 1. Although the instant *inter partes* review has been instituted on March 9, 2020, the proceeding is still in the briefing stage. We have not yet held an oral hearing and have not entered a final written decision in this proceeding.

Upon review of the procedural posture of this proceeding and the facts before us, we determine that the parties’ requests have merit and that it is appropriate to terminate this proceeding and enter judgment without rendering a final written decision. *See* 35 U.S.C. § 317(a); 37 C.F.R. §§ 42.2, 42.72.

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

In consideration of the foregoing, it is hereby
ORDERED that the Joint Motion to Terminate is *granted*; and
FURTHER ORDERED that the Joint Request to File Settlement
Agreement as Business Confidential Information and to keep such
settlement agreement separate from the patent file, and to make it 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), is *granted*.

For PETITIONER:

James Muldoon
Laura Smalley
HARRIS BEACH PLLC
jmuldoon@harrisbeach.com
lsmalley@harrisbeach.com

For PATENT OWNER:

Matias Ferrario
Andrew Rinehart
Courtney Dabbieri
KILPATRICK TOWNSEND & STOCKTON LLP
mferrario@kilpatricktownsend.com
arinehart@kilpatricktownsend.com
cdabbieri@kilpatricktownsend.com