

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

JUKI AMERICA, INC. and JUKI CORPORATION,
Petitioner,

v.

ABM INTERNATIONAL, INC.,
Patent Owner.

IPR2020-01371 (Patent 9,840,797 B2)
IPR2020-01372 (Patent 10,100,449 B2)
IPR2020-01373 (Patent 10,240,270 B2)¹

Before GEORGE R. HOSKINS, ERIC C. JESCHKE, and
SCOTT B. HOWARD, *Administrative Patent Judges*.

HOSKINS, *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 is being filed in each proceeding listed in the caption. The parties may use this style caption only if the paper includes a statement certifying that the identical paper is being filed in each proceeding listed in the caption.

IPR2020-01371 (Patent 9,840,797 B2)
IPR2020-01372 (Patent 10,100,449 B2)
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I. INTRODUCTION

Petitioner and Patent Owner (collectively “the Parties”) have requested that the above-identified *inter partes* review proceedings be terminated pursuant to a settlement. Specifically, on November 24, 2021, the Parties jointly requested via an e-mail communication that the Board authorize the filing of Joint Requests to Terminate these proceedings, and the Board granted this authorization via a responsive e-mail communication on the same day. *See* IPR2020-01371 & 01372, Ex. 3001; IPR2021-01373, Ex. 3002. On December 1, 2021, the Parties filed a Joint Request to Terminate Proceedings Pursuant to 35 U.S.C. § 317(a) (Paper 34², “Joint Motion”) in each of these proceedings. The Parties also filed a copy of a settlement agreement (Ex. 2008, “Settlement Agreement”) and a joint request that the Settlement Agreement be treated as business confidential information and kept separate under 37 C.F.R. § 42.74(c) (Paper 35, “Joint Request”) in each of the proceedings.

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.” It is also provided in 35 U.S.C. § 317(a) that if no petitioner remains in the *inter partes* review, the Office may terminate the review.

² For expediency, we cite to the Papers and Exhibits filed in IPR2020-01371, except as noted otherwise. Similar Papers and Exhibits were filed in IPR2020-01372 and IPR2020-01373.

IPR2020-01371 (Patent 9,840,797 B2)
IPR2020-01372 (Patent 10,100,449 B2)
IPR2020-01373 (Patent 10,240,270 B2)

In the Joint Motion, the Parties represent that they have reached an agreement to seek termination of these proceedings, that the filed copy of the Settlement Agreement is a true and correct copy, and that “there are no other agreements or understandings between Petitioner[] and Patent Owner made in connection with, or in contemplation of, the termination of these proceedings.” Joint Motion 1–2.

We instituted trial in these proceedings on February 11, 2021. Paper 8. Oral argument has not yet taken place, we have not yet decided the merits of the proceedings, and final written decisions have not been entered. Notwithstanding that the proceedings have moved beyond the preliminary stage, the Parties have shown adequately that termination of the proceedings is appropriate. Under these circumstances, we determine that good cause exists to terminate the proceedings.

The Parties also requested that the Settlement Agreement be treated as business confidential information and be kept separate from the files of U.S. Patent Nos. 9,840,797; 10,100,449; and 10,240,270. Joint Request 1. After reviewing the Settlement Agreement, we find that it contains confidential business information regarding the terms of settlement. We determine that good cause exists to treat the Settlement Agreement 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).

IPR2020-01371 (Patent 9,840,797 B2)
IPR2020-01372 (Patent 10,100,449 B2)
IPR2020-01373 (Patent 10,240,270 B2)

III. ORDER

Accordingly, for the reasons discussed above, it is:

ORDERED that the Joint Motions are *granted*, and IPR2020-01371, IPR2020-01372, and IPR2020-01373 are *terminated*, pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. § 42.72; and

FURTHER ORDERED that the Joint Requests are *granted*, and the Settlement Agreement shall be kept separate from the files of U.S. Patent Nos. 9,840,797; 10,100,449; and 10,240,270, 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).

IPR2020-01371 (Patent 9,840,797 B2)
IPR2020-01372 (Patent 10,100,449 B2)
IPR2020-01373 (Patent 10,240,270 B2)

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