

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TRUTEK CORP.,
Petitioner,

v.

MATRIX INITIATIVES, INC.
Patent Owner.

IPR2020-01511; Patent 9,034,401 B2
IPR2020-01554; Patent 9,555,069 B2

Before SUSAN L. C. MITCHELL, MICHELLE N. ANKENBRAND, and
DEVON ZASTROW NEWMAN, *Administrative Patent Judges*.

NEWMAN, *Administrative Patent Judge*.

DECISION
Settlement Prior to Institution of Trial
37 C.F.R. § 42.74

On August 27, 2020, Trutek Corporation (“Petitioner”) filed a Petition seeking an *inter partes* review of claims 1–10 of U.S. Patent No. 9,034,401 B2 (“the ’401 patent”), beginning the IPR2020-001511 proceeding (“1511 proceeding”). 1511 proceeding Paper 2. On September 9, 2020, Petitioner filed a second Petition seeking an *inter partes* review of claims 1–7 of U.S. Patent No. 9,555,069 B2 (“the ’069 patent”), beginning the IPR2020-01554 proceeding (“1554 proceeding”). 1554 proceeding Paper 1.

With authorization of the Board, the parties filed a Joint Motion to Dismiss the Petition (“Joint Motion”) in each case. 1511 proceeding Paper 7; 1554 proceeding Paper 9. The parties explain that dismissal is appropriate because they have reached an agreement that “completely resolves all pending controversies between the Patent Owner and the Petitioner concerning” the ’401 and the ’069 patents. 1511 proceeding Paper 7, 2; 1554 proceeding Paper 9, 2.

The parties have filed a true copy of their written settlement agreement (1511 proceeding Paper 8; 1554 proceeding Paper 10), and, in each, they “certify that there are no other agreements or understandings, oral or written, between them, including any collateral agreements, made in connection with, or in contemplation of, the dismissal of the present proceeding as set forth in 35 U.S.C. § 317(b),” 1511 proceeding Paper 8, 2; 1554 proceeding Paper 10, 2. In the Joint Motions, the parties also explain that they are filing a joint motion to dismiss the related district court litigation, *Trutek Corp. v. Matrixx Initiatives, Inc.*, Case No. 3:19-cv-17647-BRM-ZNQ (D.N.J. Sept. 5, 2019), in light of the settlement. 1511 proceeding Paper 7, 3; 1554 proceeding Paper 9, 3.

The parties correctly note that we have not entered a Decision on Institution or decided the merits in either proceeding. 1511 proceeding Paper 7, 3; 1554 proceeding Paper 9, 3.

Based on the foregoing, pursuant to 37 C.F.R. § 42.74, we determine that it is appropriate to dismiss both Petitions and terminate the proceedings.

Additionally, the parties filed a joint request in each proceeding that we treat the settlement agreement as business confidential information and kept separate from the file of the involved patent. 1511 proceeding Paper 9; 1554 proceeding Paper 11. Pursuant to 35 U.S.C § 317(b) and 37 C.F.R. § 42.74, we also grant those requests.

ORDER

In accordance with the foregoing, it is hereby:

ORDERED that the Joint Motion to dismiss the Petition in each proceeding is *granted*;

FURTHER ORDERED that the joint request for each settlement agreement, 1511 proceeding Paper 9; 1554 proceeding Paper 11, to be treated as business confidential information and kept separate from the file of the respective involved patent under the provisions of 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) is *granted*; and

FURTHER ORDERED that the proceedings are *terminated* due to settlement.

IPR2020-001511; Patent 9,034,401 B2
IPR2020-001554; Patent 9,555,069 B2

For PETITIONER:

Stanley Kremen
PATENTS GROUP LLC
uspto@patentsgroup.com

For PATENT OWNER:

Michael Dokhanchy
KIRKLAND & ELLIS LLP
Reza.dokhanchy@kirkland.com