

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FIREKING SECURITY PRODUCTS, LLC,
FIREKING COMMERCIAL SERVICES, LLC,
CORPORATE SAFE SPECIALISTS, LLC,
FK II, LLC,
FK III, LLC,
FK SAFETY AND SECURITY, L.L.C., and
PFINGSTEN PARTNERS LLC,
Petitioner,

v.

ELLENBY TECHNOLOGIES, INC.,
Patent Owner.

IPR2021-00531
Patent 7,779,983 B2

Before PATRICK R. SCANLON, GEORGE R. HOSKINS, and
RICHARD H. MARSCHALL, *Administrative Patent Judges*.

SCANLON, *Administrative Patent Judge*.

TERMINATION

Due to Settlement After Institution of Trial
35 U.S.C. § 317; 37 C.F.R. § 42.74
Granting Joint Motion to Expunge
37 C.F.R. § 42.56

On November 24, 2021, FireKing Security Products, LLC, FireKing Commercial Services, LLC, Corporate Safe Specialists, LLC, FK II, LLC, FK III, LLC, FK Safety and Security, L.L.C., and Pfingsten Partners LLC (collectively, “Petitioner”) and Ellenby Technologies, Inc. (“Patent Owner”) filed a joint motion to terminate this proceeding. Paper 23 (“Motion” or “Mot.”). The Motion was accompanied by a true copy of a Settlement and License Agreement. Ex. 1999 (“the Settlement Agreement”).¹ The parties request that the Settlement Agreement be treated as business confidential information, be kept separate from the file of the patent involved in this proceeding, and be 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). Mot. 3. The parties also filed a joint motion to expunge. Paper 22.

Termination of Trial

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

Petitioner filed its petition in this proceeding in February 2021, and we issued a decision granting institution on August 23, 2021. We have not conducted a hearing in this proceeding, and we have not decided the merits. Under these circumstances, we determine that termination of the proceeding

¹ Although the parties label and identify the Settlement Agreement as Exhibit 3001, it has been entered into the PTAB E2E filing system as Exhibit 1999.

is appropriate. *See* Consolidated Trial Practice Guide (November 2019) (“CTPG”)² at 86 (“The Board expects that a proceeding will terminate after the filing of a settlement agreement, unless the Board has already decided the merits of the proceeding.”).

We also determine that good cause exists to treat the Settlement Agreement as business confidential information under 37 C.F.R. § 42.74(c).

This Order does not constitute a final written decision pursuant to 35 U.S.C. § 318(a).

Motion to Expunge

The parties jointly request that the confidential version of the Patent Owner Response (Paper 20) and Exhibits 2005, 2008, 2048, 2049, and 2075 be expunged from the record. Paper 22, 1. The parties note that the Board did not rely on any of these documents in the decision granting institution and there is no final written decision. *Id.*

“After denial of a petition to institute a trial or after final judgment in a trial, a party may file a motion to expunge confidential information from the record.” 37 C.F.R. § 42.56. The Board’s Consolidated Trial Practice Guide explains that “[t]he rule balances the needs of the parties to submit confidential information with the public interest in maintaining a complete and understandable file history for public notice purposes,” and “[t]here is an expectation that information will be made public where the existence of the information is referred to in a decision to grant or deny a request to institute a review or is identified in a final written decision following a trial.” CTPG at 22.

² Available at <https://www.uspto.gov/TrialPracticeGuideConsolidated>.

We did not rely on Paper 20 or Exhibits 2005, 2008, 2048, 2049, and 2075 in rendering the decision granting institution; indeed, each of these documents was submitted after the decision was rendered on August 23, 2021. Furthermore, we have not relied on Paper 20 or Exhibits 2005, 2008, 2048, 2049, and 2075 in this Order terminating the proceeding. Thus, we find the public's interest in being able to access this information does not outweigh the parties' need to protect their confidential information.

Accordingly, we grant the parties' request to expunge Paper 20 and Exhibits 2005, 2008, 2048, 2049, and 2075.

It is:

ORDERED that the joint motion to terminate is *granted*;

FURTHER ORDERED that this proceeding is *terminated*;

FURTHER ORDERED that the joint request to treat the Settlement Agreement as business confidential information is *granted*, and the Settlement Agreement shall be kept separate from the file of U.S. Patent No. 7,779,983, and be made available only to Federal Government agencies on written request, or to any person on a showing of good cause, pursuant to 37 C.F.R. § 42.74(c);

FURTHER ORDERED that the joint motion to expunge is *granted*;
and

FURTHER ORDERED that Paper 20 and Exhibits 2005, 2008, 2048, 2049, and 2075 are expunged from the record.

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FOR PETITIONER:

Christopher B. Ferenc
Brian Sodikoff
KATTEN MUCHIN ROSENMAN LLP
Christopher.ferenc@katten.com
Brian.sodikoff@katten.com

FOR PATENT OWNER:

John S. Goetz
John B. Pegram
Kenneth W. Darby
FISH & RICHARDSON P.C.
goetz@fr.com
pegram@fr.com
kdarby@fr.com