

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CIENNA CORPORATION,
Petitioner,

v.

OYSTER OPTICS LLC,
Patent Owner.

IPR2021-00565
Patent 10,554,297 B2

Before JAMESON LEE, PATRICK M. BOUCHER, and
JOHN R. KENNY, *Administrative Patent Judges*.

LEE, *Administrative Patent Judge*.

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

On September 7, 2021, the parties filed a Joint Motion to Terminate this proceeding. Paper 14 (“Motion”). The Motion states that Patent Owner and Petitioner “have settled their dispute as to the ’297 Patent and have agreed to terminate this *inter partes* review.” Motion 1. The Motion also refers to Exhibit 2101, filed on September 7, 2021, as “the Parties’

agreement,”¹ and further states: “The Patent Owner and Petitioner certify that there are no other collateral agreements or understandings made in connection with, or in contemplation of, the termination of this *inter partes* review.” *Id.* at 1–2.

We instituted inter partes review on August 23, 2021. Paper 11. Patent Owner has not yet filed its Patent Owner Response, and we have not yet issued a final written decision.

The Motion explains: “Given the early stage of the proceeding and because the Board has not conducted an oral hearing or decided the merits of the proceeding, this motion should be granted in accordance with [35 U.S.C. § 317].” Motion 3. The Motion further explains: “Termination of this inter partes review would save the parties from significant further expenditure of resources, and no public interest factors weigh against termination of this proceeding.” *Id.*

“An 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.” 35 U.S.C. § 317(a). There is no other petitioner entity remaining in the proceeding after termination of Petitioner. Under the circumstances here, we agree it also would be appropriate to terminate the proceeding with respect to Patent Owner without rendering a final written decision. *See* 37 C.F.R. § 42.72.

¹ Exhibit 2101 was filed as a public paper and the parties have not filed any request under 37 C.F.R. § 42.74(c) to have it treated as business confidential information and kept separate from the files of the involved patent.

Accordingly, it is
ORDERED that the Joint Motion to Terminate is *granted*; and
FURTHER ORDERED that this proceeding is *terminated* in its
entirety with respect to both Petitioner and Patent Owner.

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