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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

WILLOW TECHNOLOGIES, LLC,
Petitioner,

v.

JOHNSON CONTROLS TECHNOLOGY COMPANY,
Patent Owner.

IPR2023-00022 (Patent 11,070,390 B2)
IPR2023-00085 (Patent 11,016,998 B2)
IPR2023-00170 (Patent 10,515,098 B2)
IPR2023-00217 (Patent 11,038,709 B2)
IPR2023-00257 (Patent 11,024,292 B2)
IPR2023-00346 (Patent 10,055,114 B2)
IPR2023-00347 (Patent 7,031,880 B1)[1]

Before GARTH D. BAER, SCOTT B. HOWARD, and RUSSELL E. CASS, *Administrative Patent Judges.*

CASS, *Administrative Patent Judge.*

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

[1] This Order addresses issues that are the same in each of the above-captioned preliminary proceedings. We exercise our discretion to issue one order for all of the above-captioned preliminary proceedings. The proceedings have not been consolidated, and the parties are not authorized to use this caption format.

I. INTRODUCTION

In each of the above-captioned preliminary proceedings, Petitioner Willow Technologies, LLC and Patent Owner Johnson Controls Technology Company (collectively, the "Parties"), with the Board's prior authorization, filed a Joint Motion to Terminate Proceeding (Paper 11, "Joint Motion") and a Joint Request to Keep Papers Separate as Confidential Business Information (Paper 12, "Joint Request").[2] In support of each Joint Motion, the Parties filed a copy of a written "GTM Collaboration, Patent License and Settlement Agreement." Ex. 1013 ("Settlement Agreement").

II. DISCUSSION

In each Joint Motion, the Parties "jointly request termination of [this] *Inter Partes* Review." *See* Joint Motion 2.[3] The Parties state that they "have settled all of their disputes involving" U.S. Patent Nos. 11,070,390; 7,031,880; 10,055,114; 10,515,098; 11,016,998; 11,024,292; and 11,038,709 (collectively, the "Challenged Patents"). *Id.* The Parties also state that they "have agreed to settle and dismiss their related district court litigation, captioned *Johnson Controls Tech. Co. v. Willow Tech., LLC., et al.*, C.A.

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[2] We cite to Papers and Exhibits in IPR2023-00022. Similar items were filed in IPR2023-00085, IPR2023-00170, IPR2023-00217, IPR2023-00257, IPR2023-00346, and IPR2023-00347.

[3] This Paper does not include page numbers. We identify the pages of this Paper as if they were numbered consecutively, starting with "Joint Motion 1" and ending with "Joint Motion 6."

No. 21-1796 (JDW) (D. Del.), and all proceedings currently pending before the Patent Trial and Appeal Board." *Id.* The Parties further state that their "settlement agreement and any collateral agreements made in contemplation of termination of all proceedings are in writing, and true and correct copies of such documents are being file herewith as Exhibit 1013," and that "[n]o other such agreements, written or oral, exist between or among the parties." *Id.*

There are strong public policy reasons to favor settlement between the parties to a proceeding. Consolidated Trial Practice Guide (Nov. 2019), 86.[4] Here, in each Joint Motion, the Parties state that "[t]ermination of this IPR is appropriate because" (1) "the Board has not yet decided the merits of the proceeding," (2) "no dispute remains between Petitioner and the Patent Owner involving the" Challenged Patents, (3) "[t]he Parties have agreed to jointly request termination of *Inter Partes* Review of the" Challenged Patents, and (4) "the district court litigation between the Parties involving the [Challenged] Patents has been dismissed as part of the settlement." *See* Joint Motion 5 (citations and internal quotations omitted).

For at least these reasons, we agree that good cause exists and that it is appropriate to dismiss the petition and terminate the preliminary proceeding as to the Parties in each of the above-captioned matters, without rendering a

[4] *Available at* https://www.uspto.gov/TrialPracticeGuideConsolidated.

decision on institution or a final written decision. *See* 37 C.F.R. § 42.74 (2022).

In each Joint Request, the Parties "request that the settlement agreement (including any related attachments) . . . be treated as confidential business information, be kept separate from the file of the above-captioned IPR, and be made available only to Federal Government agencies on written request or to a person only upon a showing of good cause." *See* Joint Request 2.[5]

After reviewing the Settlement Agreement between the Parties, we find that the Settlement Agreement contains business confidential information regarding the terms of settlement. Thus, we determine that good cause exists to treat the Settlement Agreement (Ex. 1013) between the Parties as business confidential information under 37 C.F.R. § 42.74(c), to keep it separate from the files of the involved patents and associated preliminary proceedings, and to limit its availability 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).

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[5] This Paper does not include page numbers. We identify the pages of this Paper as if they were numbered consecutively, starting with "Joint Request 1" and ending with "Joint Request 2."

III. ORDER

Accordingly, it is:

ORDERED that, in each of IPR2023-00022, IPR2023-00085, IPR2023-00170, IPR2023-00217, IPR2023-00257, IPR2023-00346, and IPR2023-00347, the Parties' Joint Motion to Terminate Proceeding is *granted*;

FURTHER ORDERED that, in in each of IPR2023-00022, IPR2023-00085, IPR2023-00170, IPR2023-00217, IPR2023-00257, IPR2023-00346, and IPR2023-00347, the preliminary proceeding is *terminated* and the petition is *dismissed*; and

FURTHER ORDERED that, in each of IPR2023-00022, IPR2023-00085, IPR2023-00170, IPR2023-00217, IPR2023-00257, IPR2023-00346, and IPR2023-00347, the Parties' Joint Request to Keep Papers Separate as Confidential Business Information is *granted*, and the Settlement Agreement shall remain designated as "Parties and Board Only" in Board's filing system, shall made available only to Federal Government agencies on written request, or to any person on a showing of good cause, and shall be kept separate from the files of the involved patents and associated preliminary proceedings, pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

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