

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

WILLOW TECHNOLOGIES, LLC,
Petitioner,

v.

JOHNSON CONTROLS TECHNOLOGY COMPANY,
Patent Owner.

Case No. IPR2023-00346

U.S. PATENT NO. 10,055,114

**JOINT MOTION TO TERMINATE PROCEEDING
PURSUANT TO 35 U.S.C. § 317 AND 37 C.F.R. § 42.72**

I. INTRODUCTION

Pursuant to 35 U.S.C. § 317 and 37 C.F.R. § 42.72, Petitioner Willow Technologies, LLC and Patent Owner Johnson Controls Technology Company (collectively, the “Parties”) jointly request termination of *Inter Partes* Review No. IPR2023-00346.

The Parties have settled all of their disputes involving U.S. Patent No. 10,055,114 (the “’114 Patent”), and have settled all of their disputes involving related U.S. Patent Nos. 7,031,880; 10,515,098; 11,016,998; 11,024,292; 11,038,709; and 11,070,390 (collectively, the “Related Patents”). More specifically, the Parties have agreed to settle and dismiss their related district court litigation, captioned *Johnson Controls Tech. Co. v. Willow Tech., LLC, et al.*, C.A. No. 21-1796 (JDW) (D. Del.), and all proceedings currently pending before the Patent Trial and Appeal Board.

Pursuant to 37 C.F.R. § 42.74(b), the Parties’ 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 filed herewith as Exhibit 1009. No other such agreements, written or oral, exist between or among the parties.

The Parties hereby jointly request that the settlement agreement be treated as confidential business information and be kept separate from the files of the above-captioned IPR pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

II. BACKGROUND

On December 13, 2022, Petitioner Willow Technologies, LLC filed a request for *Inter Parties* Review of claims 1, 7, 8, 11, and 15–17 of the '114 Patent. *See* IPR2023-00346, Paper No. 2. Petitioner also filed requests for *Inter Partes* Review involving the Related Patents as follows:

- On October 7, 2022, Petitioner filed a request for *Inter Partes* Review of claims 1–3, 10–12, and 19 of U.S. Patent No. 11,070,390. *See* IPR2023-00022, Paper No. 2.
- On October 20, 2022, Petitioner filed a request for *Inter Partes* Review of claims 1, 4, 6, 15, and 19 of U.S. Patent No. 11,016,998. *See* IPR2023-00085, Paper No. 2.
- On November 7, 2022, Petitioner filed a request for *Inter Partes* Review of claims 9–11 and 18 of U.S. Patent No. 10,515,098. *See* IPR2023-00170, Paper No. 2.
- On November 15, 2022, Petitioner filed a request for *Inter Partes* Review of claims 1, 3, 8, 10, and 11 of U.S. Patent No. 11,038,709. *See* IPR2023-00217, Paper No. 2.

- On November 23, 2022, Petitioner filed a request for *Inter Partes* Review of claims 1, 3, 5, 10, and 12 of U.S. Patent No. 11,024,292. *See* IPR2023-00257, Paper No. 2.
- On December 13, 2022, Petitioner filed a request for *Inter Partes* Review of claims 1, 4, 15, 21, 24, 37, 39, 42, and 53 of U.S. Patent No. 7,031,880. *See* IPR2023-00347, Paper No. 2.

Patent Owner filed Preliminary Responses in IPR2023-00022 and IPR2023-00085 on January 25, 2023. Patent Owner has yet to file any other Preliminary Responses in the above-identified proceedings.

On January 26, 2023, the Parties agreed to settle all of their disputes involving the '114 Patent and the Related Patents, including all litigation and Patent Trial and Appeal Board proceedings related thereto.

On February 1, 2023, the Parties informed the Board of the settlement and requested authorization to (i) file a joint motion to terminate the proceeding with respect to both Petitioner and Patent Owner, and (ii) file a joint motion to keep the settlement agreement between the Parties separate from the files in the above-captioned IPR. On February 7, 2023, the Board authorized the filing of the requested joint motion to terminate this proceeding and request to separate as to both parties.

Neither the '114 Patent, nor any Related Patent, is currently the subject of any other pending *Inter Partes* Review proceedings.

III. TERMINATION AS TO PETITIONER AND PATENT OWNER IS APPROPRIATE

Termination of this IPR is appropriate because the Board has not yet “decided the merits of the proceeding.” 77 Fed. Reg. 48755, 48768 (Aug. 14, 2022). Furthermore, no dispute remains between Petitioner and the Patent Owner involving the ’114 Patent. The Parties have agreed to jointly request termination of *Inter Partes Review* of the ’114 Patent and all Related Patents, and the district court litigation between the Parties involving the ’114 Patent and Related Patents has been dismissed as part of the settlement.

IV. STATUS OF RELATED LITIGATION

On February 3, 2023, the related district court action between Petitioner and Patent Owner was dismissed due to the settlement between the Parties.

V. CONCLUSION

For the foregoing reasons, Patent Owner and Petitioner jointly request that the Board terminate this *Inter Partes Review* proceeding.

Date: February 10, 2023

Respectfully submitted,

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