

IPR2023-00815, IPR2023-00816, IPR2023-00817

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ASSA ABLOY Global Solutions, Inc., HID Global Corp.,

Petitioners,

v.

Urban Intel Inc.,
Patent Owner

**JOINT MOTION TO TERMINATE PURSUANT
TO 35 U.S.C. § 317 AND 37 C.F.R. §§ 42.72 AND 42.74**

Pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. §§ 42.72 and 42.74, Petitioners, ASSA ABLOY Global Solutions, Inc., HID Global Corp. (“Petitioners”), and Patent Owner, Urban Intel Inc. (“Patent Owner”) (collectively, the “Parties”), jointly move to terminate these *inter partes* reviews (IPR2023-00815, IPR2023-00816, IPR2023-00817) relating to Urban Intel’s U.S. Patent Nos. 9,373,205 (“the ’205 patent”); 11,373,474 (“the ’474 patent”), and 10,657,747 (“the ’747 patent”). These proceedings are at an early stage, and the deadline for the Institution Decisions have not yet passed. In accordance with 37 C.F.R. § 42.20(b), the parties received authorization from the Board to file this joint motion on December 8, 2023.

Patent Owner’s exclusive licensee has executed a confidential settlement agreement with a third party. ASSA ABLOY AB is a third party beneficiary of such settlement agreement, and Petitioners are subsidiaries of ASSA ABLOY AB, covered by such settlement agreement. Patent Owner has represented and hereby does represent that it cannot separately pursue an infringement action against Petitioners. In the confidential settlement agreement, the Parties agree to terminate these *inter partes* reviews and all parallel district court litigations¹ between the Parties and related entities relating to the ’205, ’474, and ’747 patents. The Parties

¹ *Liberty Access Technologies Licensing LLC v. ASSA ABLOY AB et al.*, 2:22-cv-00507 (E.D. Tex.); and *ASSA ABLOY Global Solutions, Inc. v. Liberty Access Technologies Licensing LLC*, 1:23-cv-00756 (N.D. Ill.).

and related entities agree not to assert or argue that extortion, criminal misconduct, discovery misconduct, protective order violation, ethical breach and/or any other improper failure to report professional misconduct occurred related to these proceedings. Together, the Parties will submit a true and correct copy of that confidential settlement agreement to the Board as Confidential Exhibit 2011, through the concurrently filed Joint Request to Treat Agreement as Business Confidential. There is no other pending proceeding involving the '205 patent, the '474 patent, or the '747 patent at issue in these IPRs, and there are no collateral agreements. Termination of these proceedings are proper for several reasons.

First, this is a joint request by parties that have settled their dispute. 77 Fed. Reg. 48756, 48768 (Aug. 14, 2012) (“There are strong public policy reasons to favor settlement between the parties to a proceeding.”). Both Congress and the federal courts have expressed a strong interest in encouraging settlement in litigation. *See, e.g., Delta Air Lines, Inc. v. August*, 450 U.S. 346, 352 (1981) (“The purpose of [Fed. R. Civ. P.] 68 is to encourage the settlement of litigation.”); *Bergh v. Dept. of Transp.*, 794 F.2d 1575, 1577 (Fed. Cir. 1986) (“The law favors settlement of cases.”). The Federal Circuit places a particularly strong emphasis on settlement. *See Cheyenne River Sioux Tribe v. U.S.*, 806 F.2d 1046, 1050 (Fed. Cir. 1986) (noting that the law favors settlement to reduce antagonism and hostility between

parties). Here, no public interest or other factors weigh against termination of these proceedings.

Second, the Board has not yet “decided the merits of the proceeding before the request for termination is filed.” 35 U.S.C. § 317(a); 77 Fed. Reg. 48768 (“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.”) Indeed, the Board has not yet made a decision on institution of this *inter partes* review. Petitioners filed their petitions for *inter partes* review on May 25, 2023. No motions are outstanding in this proceeding. No other party’s rights will be prejudiced by the termination of this *inter partes* review. This supports the propriety of terminating this proceeding even though the settlement and termination provisions of 35 U.S.C. § 317, on their face, apply to “instituted” proceedings. 77 Fed. Reg. 48680, 48686 (Aug. 14, 2012) (§ 317(a) provides that “[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.”). Indeed, the Board has terminated entire IPR proceedings based on joint motions to terminate before institution. *See Samsonite, LLC v. Otter Prods., LLC*, IPR2015-00507, Paper 13, at 2 (P.T.A.B. July 31, 2015) (granting motion to terminate pre-institution).

As required by 35 U.S.C. § 317 and 37 C.F.R. § 42.74, the written settlement agreement that contemplates the termination of this proceeding will be filed with this motion as Confidential Exhibit 2011, along with a separate request that the written settlement agreement be kept separate as business confidential information.

Alternatively, Petitioners and Patent Owner jointly request dismissal of these *inter partes* reviews pursuant to 37 C.F.R. § 42.71(a). *See Ecobee, Inc. v. Lime Green Lighting, LLC*, IPR2019-00315, Paper 9 at 2-3 (P.T.A.B. March 19, 2019) (treating joint motion under 35 U.S.C. § 317(a) and 37 C.F.R. § 42.74 as a motion to dismiss under 37 C.F.R. § 42.71(a) and granting motion to dismiss pre-institution). Dismissal under 37 C.F.R. § 42.71(a) is appropriate because the Board has not yet issued a decision whether to institute an *inter partes* review. These proceedings are still in a preliminary stage, the Board has not considered the merits of the Petition, and the parties are jointly requesting dismissal. Dismissal is warranted under these circumstances. *See* 37 C.F.R. § 42.71(a) (authorizing the Board to dismiss a petition). *See Sony Corporation v. Avago Technologies General IP (Singapore) Pte. Ltd.*, IPR2017-00520, Paper 10 at 2-3 (P.T.A.B. June 22, 2017) (granting joint motion to dismiss pre-institution).

For all these reasons, Petitioners and Patent Owner respectfully request that the Board grant the Parties' Joint Motion to Terminate these *inter partes* reviews in

their entirety and grant the Parties' joint request to treat the settlement agreement between the parties as business confidential information.²

² Motion to be filed contemporaneously herewith.

DATED: December 12, 2023

Respectfully submitted,

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6, the undersigned certifies that on this day the foregoing document was served on counsel of record for Petitioners by filing this document through the End-to-End System, as well as *via* electronic mail to counsel of record for Petitioners at the following address:

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