

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

FACETOFACE BIOMETRICS, INC.,
Patent Owner.

IPR2023-00833
Patent 11,042,623 B2

Before SCOTT A. DANIELS, and CYNTHIAL. MURPHY,
Administrative Patent Judges.

DANIELS, *Administrative Patent Judge.*

ORDER
Conduct of the Proceeding
37 C.F.R. § 42.5

Including various emails to the Board dated November 20th, 28th, December 1st, 5th, and 12th, 2023, the parties requested a telephone conference with the Board seeking clarification regarding the remaining claims in U.S. Patent No. 11,042,623 (“the ’623 patent”), which were *not* invalidated in the underlying district court litigation and, therefore, still at

issue in the present proceeding. *See* Ex. 1014 (District Court’s Memorandum and Order granting “defendant’s motion to dismiss [15], which was converted to a motion for summary judgment” based on invalidity of claims 1–5, 7, 8, 11, 14, 15, 17, and 18 of the ’623 patent).

We conducted a conference call on December 15, 2023 with Patent Owner’s counsel Anthony Simon and Petitioner’s counsel Adam Seitz. During the call, Mr. Simon and Mr. Seitz confirmed that they were in earnest discussions to enter into a settlement agreement with respect to the remaining claims in the ’623 patent. Counsel indicated that they should be able to complete a settlement agreement by January 20, 2024. The Board explained that when the parties had a signed settlement agreement, they should email the Board and request authorization to file a joint motion to terminate this proceeding. The Board reminds the parties that in accordance with 35 U.S.C. § 317(b), any agreement or understanding between the patent owner and a petitioner, including any collateral agreements must be filed before termination. The parties may also request that the agreement be treated as business confidential information and kept separate from the file of the involved patent.

Finally, until the case is terminated, the current Scheduling Order (Paper 8) is still in effect with the Patent Owner’s Response due February 9, 2024.

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