

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ECOBEE TECHNOLOGIES ULC,
Petitioner,

v.

ROSEN TECHNOLOGIES LLC,
Patent Owner.

IPR2023-01455
Patent RE40,437 E

Before MEREDITH C. PETRAVICK, JAMES P. CALVE, and
JASON W. MELVIN, *Administrative Patent Judges*.

MELVIN, *Administrative Patent Judge*.

DECISION
Settlement Prior to Institution of Trial
37 C.F.R. § 42.74

Petitioner (Ecobee Technologies ULC) and Patent Owner (Rosen Technologies LLC) have indicated that they have reached an agreement to settle the above-identified *inter partes* review proceeding. The Board authorized the parties to file a joint motion to terminate the proceeding on February 14, 2024.

On February 20, 2024, pursuant to 37 C.F.R. § 42.74 and 35 U.S.C. § 317(a), the parties filed a Joint Motion to Terminate the above-identified proceeding (Paper 6 (“Joint Motion”)) and a Joint Request to Treat a Settlement Agreement as business confidential information and to keep said Settlement Agreement separate from the public file (Paper 7 (“Joint Request”)), along with a copy of the confidential Settlement Agreement (Ex. 1018 (“Settlement Agreement”)). The parties describe the copy of the confidential Settlement Agreement as comprising “the true and complete copy of the Settlement Agreement.” Paper 7, 1; *see also* Paper 6, 1. The parties further represent that “[t]here are no collateral agreements, oral or written, between the parties made in connection with, or in contemplation of, the termination of the proceeding.” Paper 6, 1–2. The parties submit that they “have resolved their dispute relating to U.S. Patent No. RE40,437” through the Settlement agreement, and have also “filed a stipulation to dismiss the [District Court proceeding between the parties involving RE40,437 (*Rosen Technologies LLC v. ecobee Technologies ULC*, No. 2:23-cv-0033 (E.D. Tex.))].” *Id.*

The above-identified proceeding is at an early stage, and we have not yet decided whether to institute a trial in this proceeding. There are strong public policy reasons to favor settlement between the parties to a proceeding. *Patent Trial and Appeal Board Consolidated Trial Practice*

Guide, 84 Fed. Reg. 64,280 (Nov. 21, 2019). In view of the early stage of the proceeding and the parties' settlement and representations, we determine that good cause exists to terminate this proceeding and dismiss its petition without rendering a decision on institution. Accordingly, we *grant* the Joint Motion.

The parties also "jointly request that the Board treat as business confidential and keep separate from the file of the involved patent, the true and complete copy of the Settlement Agreement (Confidential Exhibit 1018)." Paper 7, 1. We have reviewed the Settlement Agreement, which contains confidential business information regarding the terms of settlement, and we determine that good cause exists to treat the Settlement Agreement as business confidential information and to keep it separate from the files of the respective patent involved in the above-identified proceeding pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c). Accordingly, we *grant* the Joint Request.

This Order does not constitute a final written decision pursuant to 35 U.S.C. § 318(a).

Accordingly, it is:

ORDERED that the Joint Motion (Paper 6) to terminate the above-identified proceeding is *granted*, the Petition is *dismissed*, and IPR2023-01455 is *terminated*;

FURTHER ORDERED that the Joint Request (Paper 7) is *granted*, and the Settlement Agreement (Ex. 1018) shall be treated as business confidential information, shall be kept separate from the file of the involved patent (U.S. RE40,437 E), and shall be made available only to Federal Government agencies on written request, or to any person on a showing of

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good cause on written request, pursuant to 35 U.S.C. § 317(b) and 37 C.F.R.
§ 42.74(c); and

FURTHER ORDERED that Exhibit 1018 shall remain designated as
“Parties and Board Only” in the Board’s P-TACTS system.

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