

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MITO RED LIGHT, INC., Petitioner

v.

JOOVV, INC., Patent Owner.

Inter Partes Review Case No. IPR2024-00621

U.S. Patent No. 11,253,719

**JOINT MOTION TO TREAT SETTLEMENT AGREEMENT AS
BUSINESS CONFIDENTIAL INFORMATION**

EXHIBIT LIST

Exhibit No.	Description
1001	U.S. Patent No. 11,253,719 (“the ’719 patent”)
1002	Declaration of E. Bretschneider ISO Petition
1003	Prosecution History File Wrapper of the ’719 patent
1004	U.S. Patent Publication No. 2019/0030359 A1 (“ <i>Dijkstra</i> ”)
1005	U.S. Patent Publication No. 2006/0237439A1 (“ <i>Norwood</i> ”)
1006	U.S. Patent No. 10,478,635 (Reexamined) (“the ’635 patent”)
1007	Prosecution History File Wrapper of U.S. Patent No. 10,478,635 (excerpts)
1008	<i>Ex Parte</i> Reexamination History of U.S. Patent No. 10,478,635 (excerpts)
1009	U.S. Patent No. 10,639,495 (Reexamined) (“the ’495 patent”)
1010	Prosecution History File Wrapper of U.S. Patent No. 10,639,495 (excerpts)
1011	<i>Ex Parte</i> Reexamination History of U.S. Patent No. 10,639,495 (excerpts)
1012	U.S. Patent No. 11,524,172 (“the ’172 patent”)
1013	Prosecution History File Wrapper of U.S. Patent No. 11,524,172 (excerpts)
1014	Patent Owner’s Preliminary Infringement Contentions, Exhibit 5 (the ’719 patent) in <i>Joovv, Inc. v Mito Red Light, Inc.</i> , Civil Action No. Case 2:23-cv-01084-MTL (D. Ariz.) (October 20, 2023).
1015	U.S. Patent No. 6,314,699 B1 (<i>Tucker</i>)
1016	U.S. Patent Publication No. 2004/0127961 A1 (“ <i>Whitehurst</i> ”)
1017	U.S. Patent Publication No. US 2011/0054573 (“ <i>Mitchell</i> ”)
1018 <i>New</i>	Confidential Settlement Agreement Between Parties [FILED UNDER SEAL]

Pursuant to 37 C.F.R. § 42.74, and the authorization provided in the Board's email of November 7, 2024, Petitioner Mito Red Light, Inc. and Patent Owner Joovv, Inc., by and through their respective counsel of record, have reached a settlement and jointly move to terminate the above-captioned proceeding. As permitted by statute, Petitioner and Patent Owner request that the Board treat as business confidential information the true and complete copy of the settlement agreement (Confidential Exhibit 1018) between the parties, as referenced in the parties' Joint Motion to Terminate Proceeding, filed concurrently herewith.

35 U.S.C. § 317(b) provides in relevant part that:

[a]t the request of a party to the proceeding, the agreement or understanding shall be treated as business confidential information, shall be kept separate from the file of the involved patents, and shall be made available only to Federal Government agencies on written request, or to any person on a showing of good cause.

Similarly, 37 C.F.R. 42.74(c) provides that:

A party to a settlement may request that the settlement be treated as business confidential information and be kept separate from the files of an involved patent or application. The request must be filed with the settlement. If a timely request is filed, the settlement shall only be

available:

- (1) To a Government agency on written request to the Board; or
- (2) To any other person upon written request to the Board to make the settlement agreement available, along with the fee specified in § 42.15(d) and on a showing of good cause.

The present request, which is being filed contemporaneously with the settlement agreement, is timely and complies with the foregoing authority. The parties therefore respectfully request that the settlement agreement (Confidential Exhibit 1018) (i) be treated as business confidential information, (ii) be maintained separate from the publicly available file of the involved patent, and (iii) be made available only to Federal Government agencies on written request, or to persons showing good cause on written request, pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

Further, Petitioner and Patent Owner each request that they be notified if the Board receives and/or considers a request for access to the settlement agreement and be offered an opportunity to respond to any such request. *See Arista Networks, Inc. v. Castlemorton Wireless, LLC*, IPR2020-00986, Paper 7 (PTAB Oct. 28, 2020).

November 8, 2024
Dated

/Robert S. McArthur/

Robert S. McArthur, Esq.
Registration No. 45,674
VASQUEZ, BENISEK &
LINDGREN LLP
1550 Parkside Drive, Suite 130
Walnut Creek, California 94596
Main Telephone (925) 637-4250
Direct Telephone (415) 699-0630
Main Facsimile (925) 403-0900
mcarthur@vblaw.com
Attorneys for Petitioner

By: /Scott D. Smiley/
Scott D. Smiley, Esq.
Registration No. 55,627
Robert C. Kain
Registration No. 30,648
THE CONCEPT LAW GROUP, P.A.
6400 N. Andrews Avenue, Suite 500
Fort Lauderdale, Florida 33309
Main Telephone: (754) 300-1500
Main Facsimile: (754) 300-1501
scott@conceptlaw.com
rkain@conceptlaw.com
Attorneys for Patent Owner

CERTIFICATE OF FILING AND SERVICE

I hereby certify that a true and correct copy of the foregoing is being filed electronically via P-TACTS and served on counsel for Patent Owner by electronic mail on November 8, 2024 as follows:

Scott Smiley (scott@conceptlaw.com)
Robert Kain (rkain@conceptlaw.com)
THE CONCEPT LAW GROUP
6400 North Andrews Avenue, Suite 500
Fort Lauderdale, Florida 33309

Dated: November 8, 2024

/Robert S. McArthur/

Robert S. McArthur, Esq.
Registration No. 45,674
VASQUEZ BENISEK AND LINDGREN, LLP
1550 Parkside Drive, Ste 130
Walnut Creek, CA 94596
Main Telephone (925) 637-4250
Direct Telephone (415) 699-0630
Main Facsimile (925) 403-0900
mcarthur@vblaw.com

Counsel for Patent Owner