

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MITO RED LIGHT, INC.,
Petitioner,

v.

JOOVV, INC.,
Patent Owner.

IPR2024-00621
Patent 11,253,719 B2

Before HUBERT C. LORIN, ARTHUR M. PESLAK, and
SEAN P. O'HANLON, *Administrative Patent Judges*.

LORIN, *Administrative Patent Judge*.

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

I. INTRODUCTION

On November 8, 2024, after Board authorization on October 23, 2024, the parties filed a “Corrected Joint Motion to Terminate Proceeding.” Paper 11 (“Mot.”, “Motion”).¹ Along with the Motion, the parties filed a copy of a “Confidential Settlement Agreement” (“Agreement,” Ex. 1018). The parties also filed a “Corrected Joint Motion to Treat Settlement Agreement as Business Confidential Information.” Paper 12.²

II. DISCUSSION

On March 5, 2024, Petitioner filed a Petition requesting *inter partes* review of claims 1, 2, 3, 9, 10, 11, 16, 17, and 19 of U.S. Patent No. 11,253,719 B2. Paper 2. On September 19, 2024, we entered a decision denying institution of *inter partes* review. Paper 7. However, on October 10, 2024, Petitioner filed a Request for Rehearing. Paper 8. Thus, Petitioner’s request to institute an *inter partes* review (Paper 2) is still in consideration. *Cf. Medtronic Xomed, Inc. v. Neurovision Med. Prods., Inc.*, IPR2017-00456 (PTAB May 11, 2017) (Paper 14 (“On May 5, 2017, the Petition was denied. Paper 10. As a result, there is no *inter partes* review to be terminated.”)). For this reason, we treat the Motion as a request to terminate *inter partes* review *prior* to institution of trial.

In the Motion, the parties represent that “Petitioner and Patent Owner have settled their dispute regarding the ’719 Patent, including this proceeding and Patent Owner’s assertion of the ’719 Patent in the related district court litigation against Petitioner.” Mot. 1. The parties further represent that the Agreement is a “true and correct copy of the parties’

¹ The original joint motion was filed as Paper 9.

² The original joint motion was filed as Paper 10.

settlement agreement,” and that “there are no collateral agreements or understandings made in connection with, or in contemplation of, the termination of the proceedings beyond the settlement agreement in Exhibit 1018.” Mot. 1–2.

The parties “jointly request termination of this proceeding, IPR2024-00621.” Mot. 2.

Due to the fact that we have not yet decided Petitioner’s Request for Rehearing, this proceeding is still at a stage where a trial may be instituted. In view of this and the settlement between the parties, we understand the filed agreement settles all disputes between the parties with respect to this proceeding. We determine that good cause exists to dismiss the petition, and grant the motion to terminate the proceeding with respect to the parties. This moots Petitioner’s Request for Rehearing (Paper 8).

The parties also 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)
Paper 12, at 1.

After reviewing the Agreement (Confidential Exhibit 1018) between Petitioner and Patent Owner, we find that the Agreement contains confidential business information regarding the terms of settlement. We determine that good cause exists to treat the Agreement between Petitioner and Patent Owner as business confidential information pursuant to 37 C.F.R. § 42.74(c).

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

III. ORDER

Accordingly, for the reasons discussed above, it is:

ORDERED that the Corrected Joint Motion to Terminate Proceeding (Paper 11) is *granted*, the Petition is dismissed and the above proceeding is *terminated*;

FURTHER ORDERED that the Request for Rehearing, Paper 8, is *denied* as moot; and

FURTHER ORDERED that the parties' Corrected Joint Motion to Treat Settlement Agreement as Business Confidential Information (Paper 12) is *granted*, and the Settlement Agreement (Ex. 1018) shall remain designated as "Parties and Board Only" in Board's filing system, shall be made available only to Federal Government agencies on written request, or to any person on a showing of good cause, and shall be kept separate from the files of the involved patents and associated preliminary proceedings, pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

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