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Paper 45
Entered: March 6, 2015

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

IRON DOME LLC,
Petitioner,

v.

E-WATCH, INC.,
Patent Owner.

Case IPR2014-00439
Patent 7,365,871

Before JAMESON LEE, GREGG. I. ANDERSON, and MATTHEW R. CLEMENTS, *Administrative Patent Judges*.

CLEMENTS, *Administrative Patent Judge*.

DECISION

Joint Motion to Terminate
37 C.F.R. § 42.72

On February 24, 2015, Iron Dome LLC ("Petitioner") and e-Watch, Inc. ("Patent Owner") filed a joint motion to terminate the trial proceedings under 35 U.S.C. § 317(a). Paper 41. Along with the motion, the parties filed a Joint Request to File True Copy of Agreement Resolving Dispute as Business Confidential Information Pursuant to 35 U.S.C. § 317 (Paper 40), a copy of a document they described as the written settlement agreement (Exhibit 2041), and a separate exhibit containing Patent Owner's Explanation re Termination (Exhibit 2042).

On February 26, 2015, we expunged the joint motion to terminate and authorized the parties to re-file a revised joint motion to terminate that incorporates the arguments from Exhibit 2042. Paper 42.

On February 26, 2015, the parties filed a revised joint motion to terminate the trial proceedings under 35 U.S.C. § 317(a). Paper 43 ("Mot.").

Under 35 U.S.C. § 317(a), "[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 patent owner, unless the Office has decided the merits of the proceeding before the request for termination is filed." In their joint motion, the parties request termination of the instant proceeding because they have settled their dispute and have reached agreement to terminate this *inter partes* review, and because the Office has not yet decided the merits of the proceeding. Mot. 2–3. Specifically, the parties state that, "[b]ecause the parties are jointly requesting termination and the Office has not yet 'decided the merits of the proceeding before the request for termination is filed,' the USPTO is required to terminate the *inter partes* review with respect to Petitioner." *Id.* at 3.

The parties also indicate that nine litigations involving the '871 patent are pending, one is stayed, and one is terminated. *Id.* at 4–6. The parties note, however, that "none of these Defendants have sought to join this IPR proceeding. In addition, none of these Defendants have cited the same ground of rejection as cited in this IPR proceeding in their IPR petitions related to the '871 patent." *Id.* at 4.

The parties are reminded that the Board is not a party to the settlement and that, even if the parties agree to settle any issue in a proceeding, the Board may independently determine any question of patentability. 37 C.F.R § 42.74(a). Generally, however, the Board expects that a proceeding will terminate after the filing of a settlement agreement. *See, e.g.*, Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,768 (Aug. 14, 2012). We have not yet decided the merits of this proceeding. For example, the oral argument has not been held. The Board is persuaded that, under these circumstances, it is appropriate to terminate this proceeding as to both Petitioner and Patent Owner without rendering a final written decision. 37 C.F.R. § 42.72.

ORDER

Accordingly, it is:

ORDERED that the revised joint motion to terminate this proceeding is GRANTED and this proceeding is hereby terminated as to both Petitioner and Patent Owner; and

FURTHER ORDERED that the parties' joint request that the settlement agreement (Exhibit 2041) be treated as business confidential information, kept separate from the file of the involved patent, and made available only to Federal Government agencies on written request, or to any

person on a showing of good cause, under the provisions of 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c), is GRANTED; and

FURTHER ORDERED that the settlement agreement (Exhibit 2041) is changed to "Board Only" in PRPS.

IPR2014-00439
Patent 7,365,871

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