

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SONY MOBILE COMMUNICATIONS (USA), INC.,
Petitioner,

v.

E-WATCH, INC.,
Patent Owner.

Case IPR2015-00401 (Patent 7,643,168 B2)
Case IPR2015-00402 (Patent 7,365,871 B2)¹

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

ANDERSON, *Administrative Patent Judge*.

DECISION
Joint Motion to Terminate
37 C.F.R. §§ 42.5(a), 42.71(a)

¹ This order addresses issues that are the same in all cases. We exercise our discretion to issue one order to be filed in each case. The parties, however, are not authorized to use this style heading in subsequent papers.

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IPR2015-00402, Patent 7,365,871

On August 17, 2015, Sony Mobile Communications (USA) Inc. (“Petitioner”) and e-Watch, Inc. (“Patent Owner”) filed a Joint Motion to Terminate (“Motion to Terminate”) based on a settlement agreement that resolves the parties’ disputes related to the challenged patents. Paper 20.² The parties filed a copy of the settlement agreement (IPR2015-00401, Ex. 1029; IPR2015-00402, Ex. 1027) along with a Joint Motion to Seal (“Motion to Seal”). Paper 19; *see also* 37 C.F.R. § 42.74(c) (“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 parties should have filed a “Request to keep separate” under 37 C.F.R. § 42.74(c). A “motion to seal” is not the same as what is provided under the rules. To the extent that the parties request that the settlement agreement be treated as business confidential information and be kept separate from the files of the involved U.S. Patent Nos. 7,643,168 B2 and 7,365,871 B2 under Rule 42.74(c), that is granted. Otherwise, the Joint Motion to Seal is denied.

Under 35 U.S.C. § 317(a), “[i]f no petitioner remains in the *inter partes* review, the Office may terminate the review or proceed to a final written decision under section 318(a).” Petitioner is the sole petitioner in these reviews. The Board has discretion to terminate these reviews with respect to the Patent Owner. No final written decision has been issued, and,

² The Motion to Terminate and Motion to Seal are virtually the same in IPR2015-00401 and IPR2015-00402. Accordingly, all citations are to IPR2015-00401 unless otherwise noted. Patent Owner advises us that a prior motion to terminate (Paper 17) contained typographical and formatting errors and, with the permission of Petitioner, requests it be expunged. Also, a second copy of the erroneously filed Joint Motion to Terminate was filed as Paper 18, which appears in PRPS as a “Joint Motion to Seal.” Papers 17 and 18 will be expunged.

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apart from the instant motions, there are no outstanding motions in these proceedings.

The Board acknowledges that the written settlement agreements appear to be true copies, and that the parties seek settlement of the district court actions between the parties. All terminated and pending district court actions with respect to the patents are listed in the Motion to Terminate. Motion to Terminate, 4–5. The parties also request that we terminate these proceedings with respect to Patent Owner as well. *Id.* at 5.

The parties argue termination is appropriate because the proceeding is still at an early stage, with Patent Owner’s Response not due until September 21, 2015. *Id.* at 2–3. The parties also contend that strong public policy reasons favor settlement and that no public interest factors mitigate against settlement as to both parties. *Id.* at 3.

The Board determines that, in the circumstances of these cases, it is appropriate to terminate the reviews both as to Petitioner and Patent Owner without rendering final written decisions. *See* 35 U.S.C. § 317(a); 37 C.F.R. § 42.72. This paper does not constitute a final written decision pursuant to 35 U.S.C. § 318(a).

ORDER

Accordingly, it is

ORDERED that the Joint Motion to Terminate is *granted*;

ORDERED that Papers 17 and 18 are expunged; and

FURTHER ORDERED that the settlement agreement (IPR2015-00401, Exhibit 1029; IPR2015-00402, Exhibit 1027) be treated as business confidential information and be kept separate from the files of the involved U.S. Patent Nos. 7,643,168 B2 and 7,365,871 B2.

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IPR2015-00402, Patent 7,365,871

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