

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

KYOCERA COMMUNICATIONS, INC.,
Petitioner,

v.

E-WATCH, INC. and E-WATCH CORPORATION,
Patent Owner.

Case IPR2015-00406 (Patent 7,365,871 B2)
Case IPR2015-00407 (Patent 7,643,168 B2)¹

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

CLEMENTS, *Administrative Patent Judge*.

ORDER
Conduct of the Proceeding
37 C.F.R. § 42.05

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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On June 22, 2015, the parties requested authorization to file a joint motion to terminate this proceeding with respect to both Petitioner and Patent Owner, on the basis that they have settled.

Generally, 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). Any agreement or understanding between the parties made in connection with, or in contemplation of, the termination of a proceeding shall be in writing, and a true copy of the agreement shall be filed with the Board prior to termination. 37 C.F.R. § 42.74(b).

The joint motion must include a brief explanation as to why termination is appropriate. Information should be provided on the status of related district court actions in which U.S. Patent Nos. 7,365,871 and 7,643,168 have been asserted, whether or not involving Petitioner, particularly regarding the status of all defendants.

The joint motion to terminate must be accompanied by **a true copy** of the settlement agreement as required by 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b). A redacted version of the settlement agreement will not be accepted as a true copy of the settlement agreement. Counsel for the parties indicated that they intend to file a confidential true copy of the settlement agreement.

With regard to having the true copy of the settlement agreement treated as business confidential information and kept separate from the patent file(s) under 37 C.F.R. § 42.74(c), the parties must file the true copy of the confidential settlement agreement electronically via the Patent Review Processing System (PRPS) in accordance with the instructions provided on

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the Board's website (uploading as "Parties and Board Only"). Attention of the parties is also directed to FAQ G2 on the Board's website page at <http://www.uspto.gov/ip/boards/bpai/prps.jsp> for instructions on how to file a settlement agreement as confidential.

ORDER

Accordingly, it is

ORDERED that the parties are authorized to file a joint motion to terminate the proceeding with respect to both Petitioner and Patent Owner;

FURTHER ORDERED that the joint motion must be accompanied by a true copy, labeled as an exhibit, of the settlement agreement as required by 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b);

FURTHER ORDERED that in the joint motion the parties may request that the settlement agreement be treated as business confidential information and kept separate from the underlying patent file, as provided in 37 C.F.R. § 42.74(c); and

FURTHER ORDERED that any confidential settlement agreement must be filed electronically via PRPS in accordance with the instructions provided on the Board's website (uploading as "Parties and Board Only").

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