

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HONEYWELL INTERNATIONAL INC.,
Petitioner

v.

ALLURE ENERGY, INC.,
Patent Owner

Case IPR2016-01605
Patent 8,498,749

JOINT MOTION TO TERMINATE PROCEEDING UNDER 35 U.S.C. § 317

Pursuant to 35 U.S.C. § 317(a), the Petitioner, Honeywell International Inc., and Patent Owner, Allure Energy, Inc., (collectively, “Parties”) hereby jointly move for an order terminating the *Inter Partes* review, subject to the terms of the Settlement Agreement, dated April 13, 2017, entered into by the Parties.

The IPR Proceeding relates to a petition for *Inter Partes* Review filed August 12, 2016, directed to U.S. Patent No. 8,498,749 (the “749 Patent”), and assigned Proceeding Number IPR2016-01605. The PTAB instituted trial on February 3, 2017. (Paper No. 6.)

The Parties have settled their dispute, and have reached agreement to terminate this IPR Proceeding. The Parties’ Settlement Agreement has been made in writing, and a copy of same is being filed concurrently herewith as an Exhibit. There are no other agreements relating to the proceeding.

In addition, the Parties desire that the Settlement Agreement be maintained as business confidential information under 37 C.F.R. § 42.74(c), and a separate joint request to that effect is being filed concurrently herewith.

As stated in 35 U.S.C. § 317(a), because Petitioner and Patent Owner jointly request this termination, no estoppel under 35 U.S.C. § 315(e) shall attach to Petitioner.

1. Reasons Why Termination Is Appropriate.

Termination is proper under 35 U.S.C. § 317(a) because 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.” Patent Owner’s Response to the Petition and Institution Decision has not yet been filed, and is not due until May 22, 2017, under the current Scheduling Order, as modified by a joint stipulation by the parties. (Paper Nos. 7 and 8.)

As noted in the Patent Office Trial Practice Guidelines, “there are strong public policy reasons to favor settlement between the parties to a proceeding The Board expects that a proceeding will terminate after the filing of a settlement agreement, unless the Board has already decided the merits of the proceeding. 35 U.S.C. 317(a), as amended, and 35 U.S.C. 327.”¹ Accordingly, termination is appropriate here.

2. Status of Related District Court Litigation.

There is no underlying litigation involving the ‘749 Patent. However, there is litigation between Petitioner and Patent Owner that is addressed by the Settlement Agreement that involves related patents U.S. 8,626,344 and U.S. 8,497,797. That litigation is styled *Allure Energy, Inc. v. Honeywell Int’l Inc.*,

¹ See Federal Register Vol. 77, No. 157 at 48768.

Case Number 1:15-cv-00079-RP, W.D. Texas and has settled. No other parties are involved in the litigation.

3. Related IPR Proceedings

The Parties are also involved in the following IPR proceedings, and pursuant to the Settlement Agreement, have already submitted a joint motion to terminate both IPR2016-01093 and IPR 2016-01605.

| Case No. | Filing Date | Subject Patent |
|---------------|---------------|----------------|
| IPR2016-01093 | May 24, 2016 | US 8,509,954 |
| IPR2016-01475 | July 21, 2016 | US 8,174,381 |

For the foregoing reasons, the Parties jointly request termination of IPR No. IPR2016-01605.

Respectfully submitted,

Date: May 4, 2017

/Bruce J. Rose/
Bruce J. Rose, Reg. No. 37,431, for
Petitioner, Honeywell International Inc.

Date: May 4, 2017

/John S. Artz/
John S. Artz, Reg. No. 36,431, for
Patent Owner, Allure Energy, Inc.

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**JOINT REQUEST TO FILE SETTLEMENT AGREEMENT AS BUSINESS
CONFIDENTIAL INFORMATION PURSUANT TO 35 U.S.C. § 317**

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