

**UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE PATENT TRIAL AND APPEAL BOARD**

Shenzhen Zhiyi Technology Co., Ltd.,
Petitioner

v.

iRobot Corporation,
Patent Owner.

Case IPR2017-02061
Patent 6,809,490

**JOINT MOTION TO TERMINATE PROCEEDING UNDER
35 U.S.C. § 317(a) AND 37 C.F.R. § 42.72 AND JOINT
REQUEST THAT THE SUBMITTED SETTLEMENT
AGREEMENT BE KEPT SEPARATE AS
BUSINESS CONFIDENTIAL INFORMATION**

I. JOINT REQUEST FOR TERMINATION OF THE REVIEW

Pursuant to 35 C.F.R. § 317(a) and 37 C.F.R. § 42.72, the Patent Owner, iRobot Corp. (“iRobot”) and Petitioner, Shenzhen Zhiyi Technology Co., Ltd., d/b/a iLife (“iLife”) (collectively “Parties”), hereby jointly move for an order terminating the *inter partes* review, subject to the terms of the Settlement Agreement entered into by the Parties.

The Board authorized the filing of the instant motion in an email dated September 26, 2018. This motion is accompanied by a copy of the settlement agreement between the Parties.

The IPR Proceeding relates to a petition for *inter partes* review filed on September 6, 2017, directed to U.S. Patent No. 6,809,490 (the “490 patent”).

SETTLEMENT AGREEMENT

The Parties have settled their dispute, and Pursuant to 35 C.F.R. § 317(a) and 37 C.F.R. § 42.74(b), the Parties’ settlement agreement is in writing, and a true and correct copy is being filed concurrently herewith as Exhibit 1013.

The Parties further certify that there are no collateral agreements or understandings made in connection with, or in contemplation of, the termination of the present *inter partes* review.

As stated in 35 C.F.R. § 317(a), because Petitioners and Patent Owner jointly request this termination, no estoppel under 35 C.F.R. § 315(3) shall attach to Petitioners.

1. Reasons Why Termination is Appropriate

Termination is proper under 35 C.F.R. § 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.” Indeed, in this IPR Proceeding, no decision on the merits has been made.

Moreover, 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 C.F.R. § 317(a), as amended, and 35 C.F.R. § 327.”¹

2. Status of Related District Court Litigation

The '490 patent is the subject of the following pending litigations: *Certain Robotic Vacuum Cleaning Devices and Components Thereof Such as Spare Parts*, Inv. No. 337-TA-1057 (Int'l Trade Comm'n), filed April 18, 2017 (the “ITC Action”) and *iRobot Corp. v. Shenzhen Zhiyi Technology Co., Ltd., d/b/a iLife*, Case

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

No. 1:17-cv-10652 (D. Mass) (the “iRobot District Court Action”). The ITC Action is pending a Final Determination from the International Trade Commission. The iRobot District Court Action was stayed prior to iLife being required to file an answer or otherwise respond to the complaint. The Parties notified the ITC and district court that the parties had reached an agreement to resolve the dispute. Consistent therewith, pursuant to the Parties’ Settlement Agreement, the Parties shall file with the ITC and district court, respectively, stipulated motions requesting termination of the ITC Action and dismissing without prejudice all claims and counterclaims pending between iRobot and iLife in the iRobot District Court Action.

II. JOINT REQUEST THAT THE SUBMITTED SETTLEMENT AGREEMENT BE KEPT SEPARATE AND TREATED AS BUSINESS CONFIDENTIAL INFORMATION

Under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c), Petitioner and Patent Owner also concurrently request that the Settlement Agreement “be treated as business confidential information, [] be kept separate from the file of the involved patents, and [] be made available only to Federal Government agencies on written request, or to any person on a showing of good cause.” 35 U.S.C. § 317(b). In view of this request, the Settlement Agreement (Exhibit 1013) has been filed for access by the “Parties and Board Only.”

III. CONCLUSION

For the foregoing reasons, Petitioner and Patent Owner jointly request that this motion be granted pursuant to 35 U.S.C. § 317 and 37 C.F.R. §§ 42.72, 42.74.

This paper is being filed by Petitioner with the approval of counsel for Patent Owner iRobot Corporation.

Respectfully submitted,
GREENBERG TRAUIG, LLP

Date: September 27, 2018

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