

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GARMIN INTERNATIONAL, INC.
and GARMIN USA, INC.
Petitioner

v.

CUOZZO SPEED TECHNOLOGIES LLC
Patent Owner

IPR2013-00373
Patent 6,778,074

Before JAMESON LEE and JOSIAH C. COCKS,
Administrative Patent Judges.

LEE, *Administrative Patent Judge.*

ORDER
Conduct of the Proceeding
37 C.F.R. § 42.5

Introduction

On January 9, 2014, an initial telephone conference call was held between respective counsel for the parties and Judges Lee and Cocks. Neither party filed a list of proposed motions. During the conference call, counsel for the parties asked for authorization to file a joint motion to terminate this proceeding. They indicated that Petitioner (“Garmin”) and Patent Owner (“Cuozzo”) have settled.

Discussion

Generally, the Board expects that a proceeding will terminate after the filing of a settlement agreement. Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,768 (Aug. 14, 2012). The rule governing settlement indicates that any agreement between the parties made in connection with, or in contemplation of, the termination of a proceeding¹ shall be in writing and filed with the Board. 37 C.F.R. § 42.74.

The Board indicated that the filing of a joint motion to terminate this proceeding is authorized. The joint motion must include an explanation as to why termination is appropriate in this proceeding. For example, the joint motion should include a section discussing the effect of termination on the public’s interest. The joint motion should explain the status of Garmin in any related district court action in which infringement of the involved patent in this proceeding has been alleged. The joint motion also should identify all codefendants in any related district court action in which infringement of the involved patent in this proceeding has been alleged, and explain the status of each such codefendant in each such action.

¹ A “proceeding” includes a preliminary proceeding. 37 C.F.R. § 42.2.

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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. With respect to having 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 confidential settlement agreement electronically via the Patent Review Processing System (PRPS) in accordance with the instructions provided on the Board’s website (uploading as “Parties and Board Only”). The parties were 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 their settlement agreement as confidential.

Accordingly, it is

ORDERED that the parties are authorized to file a joint motion to terminate this proceeding;

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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