UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

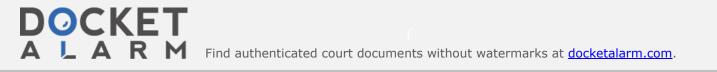
HONEYWELL INTERNATIONAL INC., Petitioner

v.

ALLURE ENERGY, INC., Patent Owner

> Case IPR2016-01475 Patent 8,174,381

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 July 21, 2016, directed to U.S. Patent No. 8,174,381 (the "'381 Patent"), and assigned Proceeding Number IPR2016-01475. 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 '381 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 IPR2016-01093 and shall submit a joint motion to terminate IPR 2016-01605 as well:

Case No.	Filing Date	Subject Patent
IPR2016-01093	May 24, 2016	US 8,509,954
IPR2016-01605	August 12, 2016	US 8,498,749

For the foregoing reasons, the Parties jointly request termination of IPR No. IPR2016-01475.

Respectfully submitted,

Date: <u>May 3, 2017</u>	/Bruce J. Rose/ Bruce J. Rose, Reg. No. 37,431, for Petitioner, Honeywell International Inc.
Date: May 3, 2017	/John S. Artz/ John S. Artz, Reg. No. 36,431, for Patent Owner, Allure Energy, Inc.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

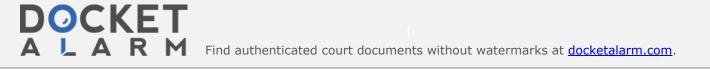
HONEYWELL INTERNATIONAL INC., Petitioner

v.

ALLURE ENERGY, INC., Patent Owner

> Case IPR2016-01475 Patent 8,174,381

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



DOCKET A L A R M



Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.