

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MIPOX CORPORATION,
Petitioner,

v.

INTERNATIONAL TEST SOLUTIONS, INC.,
Patent Owner.

IPR2017-00869 (Patent 8,801,869 B2)
IPR2017-00937 (Patent 7,202,683 B2)
IPR2017-00938 (Patent 6,777,966 B1)¹

Before JO-ANNE M. KOKOSKI, JEFFREY W. ABRAHAM, and
JOHN F. HORVATH, *Administrative Patent Judges*.

KOKOSKI, *Administrative Patent Judge*.

DECISION

Termination of the Proceeding
35 U.S.C. § 317(a) and 37 C.F.R. § 42.72

¹ This Decision addresses the same issues in all three cases. Therefore, we exercise our discretion to issue one Decision to be entered in all three proceedings.

IPR2017-00869 (Patent 8,801,869 B2)
IPR2017-00937 (Patent 7,202,683 B2)
IPR2017-00938 (Patent 6,777,966 B1)

On November 22, 2017, with Board authorization, the parties filed a joint motion to terminate, along with what they indicate is a true copy of their written settlement agreement, in each of IPR2017-00869 (Papers 12, 13), IPR2017-00937 (Papers 13, 15), and IPR2017-00938 (Papers 12, 14). The parties also filed a joint request in each proceeding that the settlement agreement be treated as business confidential information and kept separate from the patent files. IPR2017-00869, Paper 14; IPR2017-00937, Paper 14; IPR2017-00938, Paper 13.

Under 35 U.S.C. § 317(a), “[a]n inter partes review instituted under this chapter shall be terminated with respect to any petitioner upon the joint request of the petitioner and patent owner, unless the Office has decided the merits of the proceeding before the request for termination is filed.” We instituted a trial in each proceeding, but Patent Owner has not yet filed its Patent Owner Responses, and we have not yet decided the merits of the proceedings.

Further, under 37 C.F.R. § 42.74(b), “[a]ny 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 shall be filed with the Board before the termination of the trial.” The parties have filed what they indicate is a true copy of their written settlement agreement, which they represent constitutes the entire agreement between the parties with respect to these *inter partes* reviews. IPR2017-00869, Paper 12, 2; IPR2017-00937, Paper 13, 2; IPR2017-00938, Paper 12, 2. In view of the foregoing, we determine that it is appropriate to terminate these proceedings without rendering final written decisions.

IPR2017-00869 (Patent 8,801,869 B2)
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As requested by the parties, the settlement agreement will be treated as business confidential information and kept separate from the patent files. 37 C.F.R. § 42.74(c).

Accordingly, it is

ORDERED that the joint motions to terminate the proceedings in IPR2017-00869 (Papers 12), IPR2017-00937 (Paper 13), and IPR2017-00938 (Paper 12) are *granted*;

FURTHER ORDERED that the parties' joint requests (IPR2017-00869, Paper 14; IPR2017-00937, Paper 14; IPR2017-00938, Paper 13)) that the settlement agreement (IPR2017-00869 (Paper 13), IPR2017-00937 (Paper 15), and IPR2017-00938 (Paper 14)) be treated as business confidential information are *granted*; and

FURTHER ORDERED that the proceedings in IPR2017-00869, IPR2017-00937, and IPR2017-00938 are hereby *terminated*.

IPR2017-00869 (Patent 8,801,869 B2)
IPR2017-00937 (Patent 7,202,683 B2)
IPR2017-00938 (Patent 6,777,966 B1)

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