

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TRUTEK CORP.
Petitioner

v.

MATRIX INITIATIVES, INC.
Patent Owner

Case No. PGR2021-00005
Patent 10,736,931

JOINT MOTION TO DISMISS PETITION FOR POST GRANT REVIEW

I. INTRODUCTION

Pursuant to 35 U.S.C. § 327 and 37 C.F.R. § 42.74 and the Board's authorization by email dated November 30, 2020, Petitioner Trutek Corp. ("Trutek") and Patent Owner Matrixx Initiatives, Inc. ("Matrixx") jointly move to dismiss the present post grant review proceeding in light of the parties' settlement of their dispute insofar as it relates to U.S. Patent No. 10,736,931 ("the '931 patent"). The parties are concurrently filing true copies of their Settlement Agreement in connection with this matter as required by statute. The Settlement Agreement completely resolves all pending controversies between the Patent Owner and the Petitioner concerning the '931 patent.

The parties further jointly certify that there are no other agreements or understandings, oral or written, between them, including any collateral agreements, made in connection with, or in contemplation of, the dismissal of the present proceeding as set forth in 35 U.S.C. § 327(b).

The parties request that the Settlement Agreement be treated as business confidential information and kept separate from the file of the '931 patent. A joint request for treatment of the Settlement Agreement as business confidential information and kept separate from the file of the '931 patent pursuant to 35 U.S.C. § 327(b) and 37 C.F.R. § 42.74(c) is being filed concurrently herewith.

II. DISMISSAL IS WARRANTED

1. Explanation for Dismissal. Dismissal is appropriate because the merits have not yet been decided and the parties have settled their entire dispute concerning the '931 patent. As provided by statute, a post grant proceeding “shall be terminated with respect to any petitioner upon the joint request of the petitioner and the patent owner, unless the Office has decided the merits of the proceeding before the request for termination is filed.” 35 U.S.C. § 327(a). Finally, this proceeding has not been instituted, does not impact any other currently-pending litigation proceedings as explained below, and there are “strong public policy reasons to favor settlement.” *See Patent Office Trial Practice Guide*, 77 Fed. Reg. 48756, 48768 (Aug. 14, 2012).

2. Related Litigation for the '931 patent. Trutek contends that the litigation entitled *Trutek Corp. v. Matrixx Initiatives, Inc., et al.*, Case No. 3:19-cv-17647-BRM-ZNQ (D.N.J. Sept. 5, 2019) (“New Jersey Litigation”) is related. The Application of the '931 Patent is a continuation of the Application of U.S. Patent No. 9,555,069 (“the '069 Patent”), which in turn is a continuation of the Application of U.S. Patent No. 9,034,401 (“the '401 Patent”). Trutek stated in its Mandatory Notice that “[t]he complaint alleges that the claimed subject matter of the '069 and '401 Patents were derived from Petitioner’s trade secrets in violation of three confidential disclosure agreements between Petitioner and Patent Owner.” (Petition

at 3.) A joint motion to dismiss the New Jersey Litigation in its entirety is being filed in light of the settlement between Matrixx and Trutek.

3. Related Proceedings Before the Patent Office. There are no related proceedings before the Patent Office concerning the '931 patent. One petition filed by Matrixx to institute an *inter partes* proceeding concerning a different patent owned by Trutek is pending, namely IPR2020-01592 involving U.S. Patent No. 8,163,802. Two petitions filed by Trutek to institute *inter partes* proceedings concerning two different patents owned by Matrixx are pending, namely IPR2020-01554 involving the '069 Patent and IPR2020-01511 involving the '401 Patent. No institution decision has been issued in any of the above proceedings and a motion to dismiss each of these proceedings is being filed in light of the settlement between Matrixx and Trutek.

III. CONCLUSION

Matrixx and Trutek respectfully submit that dismissal of this proceeding is warranted and respectfully request entry of such relief.

Date: November 30, 2020

Respectfully submitted,

/Stanley H. Kremen/

Stanley H. Kremen (Reg. No. 51900)
PATENTS GROUP LLC
4 Lenape Lane
East Brunswick, NJ 08816
Telephone: (732) 593-7294
Facsimile: (732) 312-5218
uspto@patentsgroup.com

Amirali Y. Haidri (Reg. No. 29164)
Law Offices of Amirali Y. Haidri
110 Hillside Avenue, Suite #104
Springfield, NJ 07081
Telephone: (908) 688-8700
Facsimile: (908) 688-8445
amiraliyhaidri@aol.com

Attorneys for Petitioner Trutek Corp.

/Reza Dokhanchy/

Reza Dokhanchy (Reg. No. 62,795)
Adam R. Alper, (to seek *pro hac vice*
admission)
Barbara Barath, (to seek *pro hac vice*
admission)
KIRKLAND & ELLIS LLP
555 California St.
San Francisco, CA 94104
Telephone: 415-439-1400
Fax: 415-439-1500
reza.dokhanchy@kirkland.com
adam.alper@kirkland.com
barbara.barath@kirkland.com

Michael W. De Vries, (to seek *pro hac*
vice admission)
KIRKLAND & ELLIS LLP
555 South Flower Street
Los Angeles, CA 90071
Telephone: 213-680-8400
Facsimile: 213-680-8500
michael.devries@kirkland.com

Patricia A. Carson, (to seek *pro hac*
vice admission)
patricia.carson@kirkland.com
KIRKLAND & ELLIS LLP
601 Lexington Avenue
New York, New York 10022
Telephone: (212) 446-4800
Facsimile: (212) 446-4900

***Attorneys for Patent Owner Matrixx
Initiatives, Inc.***

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