

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ARRAY PHOTONICS, INC.
Petitioner Application No. 16/132,059,
v.

IQE, PLC
Respondent Patent No. 9,768,339.

Case No. DER2018-00019

JOINT MOTION TO TERMINATE PROCEEDING

I. INTRODUCTION

Petitioner Array Photonics, Inc. (“Petitioner”) and Respondent IQE, PLC (“Respondent”) jointly move to terminate this proceeding under 35 U.S.C. §§ 135(a)(1) and 135(e). The parties have entered into a confidential settlement agreement (“Settlement Agreement”) that resolves the disputes between the parties, including this proceeding. The Board authorized this joint Motion via e-mail on February 25, 2021.

II. REASONS FOR RELIEF

The present proceeding involves Application No. 16/132,059 (“the ’059 Application”) assigned to Petitioner and Patent No. 9,768,339 (“the ’339 Patent”) assigned to Respondent. As set forth in the Petition, at page 67, the proceeding is co-pending with three matters: (1) an action in the United States District Court for the Southern District of New York (Case No. 17-cv-9478); (2) an another action in the District Court (Case No. 18-cv-2564); and (3) an arbitration with the London Court of International Arbitration (Case No. 183861). The parties have now entered into the Settlement Agreement, filed under seal herewith, that resolves the disputes between parties. There are no collateral agreements between the parties.

Pursuant to the Settlement Agreement, the parties stipulated to dismiss the two District Court actions on February 18, 2021, and the Court entered the parties’

stipulation on February 19, 2021. There are no pending litigation matters between the parties. The only remaining matter is the present derivation proceeding.

This proceeding has not yet been instituted, so the expected normal course is to terminate proceedings upon settlement. *See, e.g.*, Office Patent Trial Practice Guide, 77 Fed. Reg. 48756, 46768 (Aug. 14, 2012) (“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.”). Indeed, termination following settlement comports with public policy. *See* 77 Fed. Reg. 48680, 48680 (Aug. 14, 2012) (“The purpose of the AIA and this final rule is to establish a more efficient and streamlined patent system that will improve patent quality and limit unnecessary and counterproductive litigation costs”). As stated in the Board’s Trial Practice Guide, “[t]here are strong public policy reasons to favor settlement between the parties to a proceeding.” Office Patent Trial Practice Guide, 77 Fed. Reg. 48756, 46768 (Aug. 14, 2012).

Furthermore, the Office can conserve its resources through terminating this proceeding now, obviating the need for the Board to further consider whether to institute this proceeding.

Finally, the parties are mindful of the Board’s request to submit the Settlement Agreement. Accordingly, the parties submit the Settlement Agreement as Exhibit 1074. Pursuant to 35 U.S.C. § 135(e) and 37 C.F.R. 42.74, the parties

request that the Settlement Agreement be treated as business confidential information, kept separate from the file of the involved patents or applications, and made available only to Government agencies on written request, or to any person on a showing of good cause. A confidentiality request accompanies this joint Motion.

III. CONCLUSION

For the foregoing reasons, Petitioner and Respondent request that the Board terminate this proceeding in its entirety.

Respectfully submitted,

Dated: March 1, 2021

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Certificate of Service (37 C.F.R. § 42.6(e)(4))

I hereby certify that the attached JOINT MOTION TO TERMINATE PROCEEDING was served as of the below date via e-mail to the following counsel of record for the Respondent.

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