

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ARRAY PHOTONICS, INC.¹,
Petitioner Application No. 16/132,059,

v.

IQE, PLC,
Respondent Patent No. 9,768,339 B2,
Respondent.

Case DER2018-00019

Before JONI Y. CHANG, JOSIAH C. COCKS, and JUSTIN T. ARBES,
Administrative Patent Judges.

CHANG, *Administrative Patent Judge.*

DECISION
Settlement Prior to Institution of Trial
37 C.F.R. § 42.74

¹ Petitioner changed its name from “Solar Junction Corporation” to “Array Photonics, Inc.” Paper 8 (Petitioner’s Updated Mandatory Notices).

Petitioner and Respondent jointly move to terminate this derivation proceeding in light of their settlement that resolves their disputes regarding the application and patent at issue. Paper 14 (“Mot.”). The parties request that the Board terminate this proceeding in its entirety. *Id.* at 3.

In support of their Motion to Terminate Proceeding, the parties filed a true copy of their Settlement Agreement made in connection with, or in contemplation of, the termination as required by 35 U.S.C. § 135(e) and 37 C.F.R. § 42.74(b). Ex. 1074. Pursuant to 35 U.S.C. § 135(e) and 37 C.F.R. § 42.74(c), the parties also filed a joint request to treat the Settlement Agreement as business confidential information kept separate from the files of the involved application and patent. Paper 15.

Generally, the Board expects that a proceeding will terminate after the filing of a settlement agreement. *See Consolidated Trial Practice Guide*² at 86; *see also* 84 Fed. Reg. 64,280 (Nov. 21, 2019). Here, the parties indicate that, “[p]ursuant 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.” Mot. 1–2.

The parties also indicate that “[t]here are no pending litigation matters between the parties” and that “[t]here are no collateral agreements between the parties.” *Id.* Moreover, this proceeding is in an early stage. We have not yet determined whether a trial should be instituted in this proceeding. Upon review of the procedural posture of this proceeding and the facts before us, we determine that the parties’ request has merit and that it is appropriate to terminate this proceeding. *See* 37 C.F.R. §§ 42.2, 42.72.

² Available at <https://www.uspto.gov/TrialPracticeGuideConsolidated>.

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ORDER

In consideration of the foregoing, it is hereby

ORDERED that the parties' Joint Motion to Terminate Proceeding is *granted*; and

FURTHER ORDERED that the parties' Joint Request to File Settlement Agreement as Business Confidential Information and to keep such settlement agreement separate from the files of the involved application and patent, and to make it available only to Federal Government agencies on written request, or to any person on a showing of good cause, pursuant to 35 U.S.C. § 135(e) and 37 C.F.R. § 42.74(c), is *granted*.

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