

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

VALENCELL, INC.,
Patent Owner.

Case IPR2017-01701, Patent 8,157,730 B2
Case IPR2017-01702, Patent 8,652,040 B2
Case IPR2017-01703, Patent 8,652,040 B2
Case IPR2017-01883, Patent 8,942,776 B2
Case IPR2017-01947, Patent 9,044,180 B2
Case IPR2018-00695, Patent 9,289,135 B2¹

Before JEFFREY S. SMITH, JAMES B. ARPIN, and SHEILA F. McSHANE,
Administrative Patent Judges.

ARPIN, *Administrative Patent Judge.*

DECISION

Granting Motion to Terminate the Proceeding
35 U.S.C. § 317(a) and 37 C.F.R. §§ 42.72, 42.74(c)

¹ The Board elects to enter a single paper addressing the parties' related requests. *See, e.g.*, IPR2017-01701, Ex. 1213 (listing of pending cases). The parties are not authorized to use such multiple case caption filings.

Case IPR2017-01701, Patent 8,157,730 B2
Case IPR2017-01702, Patent 8,652,040 B2
Case IPR2017-01703, Patent 8,652,040 B2
Case IPR2017-01883, Patent 8,942,776 B2
Case IPR2017-01947, Patent 9,044,180 B2
Case IPR2018-00695, Patent 9,289,135 B2

These cases are assigned to panels including Judges Smith, McNamara, Arpin, and/or McShane. The panel in each case includes only three judges, and no panel in any of these cases has been expanded. Judge McNamara is unavailable at this time to participate in this judgement. Because of the approaching deadlines relating to the oral hearings in IPR2017-01701–01703 and the institution decision in IPR2018-00695, the available judges have promptly addressed the parties’ requests for termination.

On September 11, 2018, the parties filed a Joint Motion to Terminate pursuant to 35 U.S.C. § 317(a) in each of the above-captioned cases. IPR2017-01701, Paper 23; IPR2017-01702, Paper 13; IPR2017-01703, Paper 14; IPR2017-01883, Paper 14; IPR2017-01947, Paper 22; IPR2018-00695, Paper 7. In addition, pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c), Petitioner filed a copy of a Settlement Agreement along with a Joint Request That Settlement Agreement Be Treated As Business Confidential Information And Kept Separate Under 37 C.F.R. § 42.74(c) (Paper 10), to be kept separate from the patent file in each of the above-captioned cases. IPR2017-01701, Paper 24, Ex. 1212;² IPR2017-01702, Paper 14,

² With the exception of IPR2018-00695, in each case, Petitioner has failed to comply with the exhibit numbering requirements, as set forth in 37 C.F.R. § 42.63(c), with respect to Ex. 1212. Because this exhibit will be maintained in confidence and because this paper terminates these proceedings, we do not require that Petitioner renumber and refile these exhibits.

Case IPR2017-01701, Patent 8,157,730 B2
Case IPR2017-01702, Patent 8,652,040 B2
Case IPR2017-01703, Patent 8,652,040 B2
Case IPR2017-01883, Patent 8,942,776 B2
Case IPR2017-01947, Patent 9,044,180 B2
Case IPR2018-00695, Patent 9,289,135 B2

Ex. 1212; IPR2017-01703, Paper 15, Ex. 1212; IPR2017-01883, Paper 15,
Ex. 1212; IPR2017-01947, Paper 23, Ex. 1212; IPR2018-00695, Paper 8,
Ex. 1212.

In each of IPR2017-01701–01703, IPR2017-01883, and IPR2017-01947, the Board has instituted review, but has not yet issued a final written decision. In IPR2018-00695, this case is in the preliminary proceeding³ stage; no decision whether to institute a trial has been made. Under these circumstances, we determine that it is appropriate to terminate each case without rendering a final written decision. 37 C.F.R. §§ 42.72, 42.74. Therefore, the Joint Motions to Terminate are granted.

Accordingly, it is

ORDERED that the parties' requests that the Settlement Agreement be treated as business confidential information, to be kept separate from the patent file, are *granted*;

FURTHER ORDERED that the Joint Motions to Terminate are *granted*; and
FURTHER ORDERED that the proceedings are *terminated*.

³ A preliminary proceeding begins with the filing of a petition for instituting a trial and ends with a written decision as to whether trial will be instituted.
37 C.F.R. § 42.2.

Case IPR2017-01701, Patent 8,157,730 B2
Case IPR2017-01702, Patent 8,652,040 B2
Case IPR2017-01703, Patent 8,652,040 B2
Case IPR2017-01883, Patent 8,942,776 B2
Case IPR2017-01947, Patent 9,044,180 B2
Case IPR2018-00695, Patent 9,289,135 B2

PETITIONER:

Michelle K. Holoubek
Michael D. Specht Jason A. Fitzsimmons
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.
holoubek-ptab@skgf.com
mspecht-ptab@skgf.com
jfitzsimmons-ptab@skgf.com

PATENT OWNER:

Justin B. Kimble
Nicholas C. Klierer
BRAGALONE CONROY PC
jkimble-ipr@bcpc-law.com
nklierer@bcpc-law.com