

Filed: July 1, 2020

UNITED STATES PATENT AND TRADEMARK OFFICE

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**BEFORE THE PATENT TRIAL AND APPEAL BOARD**

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VANGUARD PRODUCTS GROUP, INC., D/B/A VANGUARD PROTEX  
GLOBAL,

Petitioner

v.

INVUE SECURITY PRODUCTS INC.,

Patent Owner

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IPR2020-00069

Patent 10,043,358 B1

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**JOINT MOTION TO TERMINATE PROCEEDINGS PURSUANT  
TO 35 U.S.C. § 317**

Pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. § 42.72, Petitioner and Patent Owner (collectively, “the Parties”) jointly request termination of the *Inter Partes* Review (IPR) of U.S. Patent No. 10,043,358, Case No. IPR2020-00069. The Board authorized this motion via an email communication dated June 26, 2020.

The Office Patent Trial Patent Guide recognizes that “[t]here are strong public policy reasons to favor settlement between the parties to a proceeding.” 77 Fed. Reg. 48768 (Aug. 14, 2012). Indeed, 35 U.S.C. § 317(a) dictates that “[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 the patent owner, unless the Office has decided the merits of the proceeding before the request for termination is filed.” Therefore, the present IPR is ripe for termination because the trial is still in its early stages, and the Board has not yet decided the merits of the proceeding. Indeed, the Parties have not yet deposed any expert witnesses, and the only scheduled event that has occurred since institution is Due Date 1, on which Patent Owner filed its response to the petition.<sup>1</sup>

The Parties have also been involved in litigation concerning eight asserted patents, including U.S. Patent No. 10,043,358 – *InVue Security Products Inc., v.*

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<sup>1</sup> Patent Owner filed its response for purposes of preserving its rights contingent on the Board terminating this proceeding.

*Vanguard Products Group, Inc., d/b/a Vanguard Protex Global*, Case No. 8:18-cv-02548-VMC-SPF (M.D. Fla. 2018). On June 23, 2020, the Parties executed a Settlement Agreement resolving all disputes between the Parties, including all pending IPRs and the litigation. Under the terms of the Settlement Agreement, the Parties filed a joint motion to dismiss the litigation, and, on June 30, 2020, the court dismissed the case with prejudice.

Pursuant to the terms of the Settlement Agreement, the Parties are to file joint motions to terminate each of the pending IPRs. The Parties are also involved in the following related pending IPRs, Case Nos. IPR2020-00032, IPR2020-00048, and IPR2020-00066. Concurrently with this motion, the Parties are filing joint motions to terminate each of these related IPRs.

The Settlement Agreement referenced herein has been made in writing, and a true and correct copy is being filed concurrently with this motion. The Parties are filing the Settlement Agreement as business confidential pursuant to 35 U.S.C. § 317(b), the request for which is provided concurrently herewith. The Parties hereby certify that there are no collateral agreements or understandings made in connection with, or in contemplation of, the termination of this IPR.

For the reasons set forth above, Petitioner and Patent Owner respectfully request termination of the IPR2020-00069 instituted against U.S. Patent No. 10,043,358.

Dated: July 1, 2020

Respectfully submitted,

/andriy lytvyn /

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## **CERTIFICATE OF SERVICE**

The undersigned hereby certifies that a copy of the above Joint Motion to Terminate the Proceeding was served electronically via email on July 1, 2020 at the following email addresses of record:

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Date: July 1, 2020

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