

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AVIGILON USA CORPORATION AND AVIGILON CORPORATION,
Petitioner,

v.

CANON INC.,
Patent Owner.

IPR2020-00656
IPR2020-00866
Patent 10,135,952 B2¹

Before LYNNE E. PETTIGREW, BART A. GERSTENBLITH, and
JASON W. MELVIN, *Administrative Patent Judges*.

PETTIGREW, *Administrative Patent Judge*.

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

¹ This Decision addresses issues that are the same in both proceedings. We exercise our discretion to issue one Decision to be entered in each proceeding.

Petitioner and Patent Owner (collectively, “the parties”) have requested that these proceedings be terminated pursuant to a settlement. The Board authorized the parties to file a joint motion to terminate the proceedings on July 13, 2020.

On July 14, 2020, pursuant to 37 C.F.R. § 42.74 and 35 U.S.C. § 317(b), the parties submitted joint motions to terminate each of the proceedings (collectively, “Joint Motions”) (Paper 7²) and joint requests to file a Settlement Agreement as business confidential information and to be kept separate from the patent file (collectively, “Joint Requests”) (Paper 8³), along with copies of the written Settlement Agreement (Ex. 1009⁴).

In the Joint Motions, the parties represent that they have reached an agreement to jointly seek termination of these proceedings and that the filed copies of the Settlement Agreement are true and complete copies. Paper 7, 1–2. The parties further represent that their Settlement Agreement resolves all currently pending Patent Office and district court proceedings between the parties involving the patent at issue. *Id.* at 3–4.

² For convenience, we cite to Papers filed in IPR2020-00656. The parties submitted a similar Joint Motion in IPR2020-00866 (Paper 6).

³ The parties submitted a similar Joint Request regarding the Settlement Agreement in IPR2020-00866 (Paper 7).

⁴ For convenience, we cite to Exhibits filed in IPR2020-00656. The parties also submitted a copy of the Settlement Agreement in IPR2020-00866 (Ex. 1108). We note that the Joint Motion in IPR2020-00656 incorrectly refers to the exhibit number of the Settlement Agreement as “3001.” Paper 7, 1.

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These proceedings are at an early stage, as we have not yet decided whether to institute a trial in either of these proceedings. In view of the early stage of these proceedings and the settlement between the parties, we determine that good cause exists to terminate these proceedings with respect to the parties.

Additionally, upon review of the Joint Requests that the Settlement Agreement be treated as business confidential information and be kept separate from the file of the patent involved in these proceedings, we determine that good cause exists to treat the Settlement Agreement between Petitioner and Patent Owner as business confidential information pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

Therefore, the Joint Motions and the Joint Requests are *granted*.

This Order does not constitute a final written decision pursuant to 35 U.S.C. § 318(a).

Accordingly, it is:

ORDERED that the Joint Motions (IPR2020-00656, Paper 7; IPR2020-00866, Paper 6) to terminate these proceedings are *granted*, and that IPR2020-00656 and IPR2020-00866 are *terminated* with respect to both Petitioner and Patent Owner; and

FURTHER ORDERED that the Joint Requests (IPR2020-00656, Paper 8; IPR2020-00866, Paper 7) that the Settlement Agreement (IPR2020-00656, Ex. 1009; IPR2020-00866, Ex. 1108) be treated as business confidential information and be kept separate from the file of the involved patent (U.S. Patent No. 10,135,952 B2) under the provisions of 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) are *granted*.

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