

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BMO HARRIS BANK NATIONAL ASSOCIATION,
Petitioner,

v.

LEON STAMBLER,
Patent Owner

Case CBM2014-00129
Patent 5,793,302

Before BRYAN F. MOORE, TRENTON A. WARD, and PETER R. CHEN,
Administrative Patent Judges.

WARD, *Administrative Patent Judge.*

ORDER
Joint Motion to Terminate
37 C.F.R. § 42.72

On August 14, 2014, the parties filed a joint motion to terminate the trial proceedings under 35 U.S.C. § 327(a). Paper 8. The motion requested authorization for leave to file a true copy of the written settlement agreement entered into between the parties. Paper 8, 2. The Board subsequently informed the parties that authorization for such a filing is not required and, pursuant to 37 C.F.R. § 42.74(c), a party may request that a settlement agreement be treated as business confidential information. On August 19, 2014, the parties filed a Notice of Filing Settlement Agreement as Business Confidential Information (Paper 9) and a copy of a document they described as the written settlement agreement (Ex. 1021),¹ requesting to treat the settlement agreement as business confidential information under the provisions of 35 U.S.C. § 327(b) and 37 C.F.R. § 42.74(c). Paper 9, 2.

Under 35 U.S.C. § 327(a), “[a] post grant review instituted under this chapter shall be terminated with respect to any petitioner upon the joint request of the petitioner and patent owner, unless the Office has decided the merits of the proceeding before the request for termination is filed.” The motion indicates that concurrent with the filing of this Joint Motion to Terminate, the parties filed a motion to dismiss with prejudice the related district court lawsuit between the parties involving, at least, the patent at issue in this proceeding, U.S. Patent No. 5,793,302. Paper 8, 2. We note that a trial has not been instituted in this proceeding.

The parties are reminded that the Board is not a party to the settlement, and may independently identify any question of patentability.

¹ The parties filed the settlement agreement as “Exhibit 1,” but the Board renumbered the exhibit as Exhibit 1021 to follow the sequence of previously filed exhibits.

37 C.F.R. § 42.74(a). Generally, however, the Board expects that a proceeding will terminate after the filing of a settlement agreement. *See, e.g.,* Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,768 (Aug. 14, 2012). These proceedings are still in the preliminary stages, as the time period for filing the Patent Owner's Preliminary Response has not yet expired. The Board is persuaded that, under these circumstances, it is appropriate to terminate this proceeding without rendering a final written decision. 37 C.F.R. § 42.72.

Accordingly, it is:

ORDERED that the joint motion to terminate this proceeding is GRANTED and this proceeding is hereby terminated; and

FURTHER ORDERED that the parties' joint request that the settlement agreement (Ex. 1021) be treated as business confidential information, kept separate from the file of the involved patent, and made available only to Federal Government agencies on written request, or to any person on a showing of good cause, under the provisions of 35 U.S.C. § 327(b) and 37 C.F.R. § 42.74(c), is GRANTED.

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Patent 5,793,302

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