

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NORWEX USA, INC. and
NORWEX CANADA, INC.
Petitioner,

v.

UMF CORP. and SWEPORTS, LTD.,
Patent Owner.

Case IPR2014-00151
Patent No. 6,258,455 B1

Before FRANCISCO C. PRATS, MICHAEL J. FITZPATRICK, and
CHRISTOPHER L. CRUMBLEY, *Administrative Patent Judges*.

CRUMBLEY, *Administrative Patent Judge*.

JUDGMENT
Termination of the Proceeding
37 C.F.R. § 42.72

On July 15, 2014, pursuant to Board authorization, Petitioner Norwex USA, Inc. and Norwex Canada, Inc. (collectively, “Norwex”) and Patent Owner UMF Corp. and Sweports, Ltd. (collectively, “UMF”), filed a joint motion to terminate

this *inter partes* review. Paper 22. With the joint motion, the parties filed a copy of their written settlement agreement covering various matters involving Patent No. 6,258,455 B1, the subject of the review. Ex. 1024. The parties concurrently filed a joint request to have the settlement agreement treated as confidential business information under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c). Paper 23.

Under 35 U.S.C. § 317(a), “[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 patent owner, unless the Office has decided the merits of the proceeding before the request for termination is filed.” In this proceeding, the Board instituted trial on May 14, 2014 (Paper 12), but has not yet reached a decision on the merits with respect to the patentability of any involved claim. Accordingly, the requirement for terminating review with respect to Norwex, as Petitioner, is met.

Also under 35 U.S.C. § 317(a), “[i]f no petitioner remains in the *inter partes* review, the Office may terminate the review or proceed to a final written decision under section 318(a).” Norwex is the sole Petitioner.¹ The Board, therefore, has discretion to terminate this review with respect to Patent Owner UMF. In their joint motion, the parties note the early stage of this trial and state that they have filed a stipulation of dismissal to resolve the co-pending district court action *UMF*

¹ Although Norwex USA, Inc. and Norwex Canada, Inc. are distinct corporate entities, they jointly filed a Petition (Paper 1) and thus are considered, for the purposes of this *inter partes* review, to be a single Petitioner. 37 C.F.R. § 42.2 (“Petitioner means the party filing a petition requesting that a trial be instituted.”); *see also Agilsys, Inc. v. Ameranth, Inc.*, slip. op. 3, CBM21014-00016 (PTAB Feb. 11, 2014) (Paper 11).

Corp. v. Norwex USA, Inc., involving the patent and parties before us here. Paper 22, 2.

Based on the present record, we determine that it is appropriate to terminate this *inter partes* review both as to Petitioner Norwex and Patent Owner UMF without rendering a final written decision. See 35 U.S.C. § 317(a); 37 C.F.R. § 42.72.

In light of the foregoing, it is

ORDERED that the parties' joint request to have their settlement agreement (Exhibit 1024) treated as business confidential information, to be kept separate from the patent file, is *granted*;

FURTHER ORDERED that the joint motion to terminate this proceeding is *granted*; and

FURTHER ORDERED that this *inter partes* review is hereby *terminated*.

Case IPR2014-00151
Patent No. 6,258,455 B1

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