

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

RAPAK, LLC,
Petitioner,

v.

SCHOLLE CORPORATION,
Patent Owner.

Case IPR2014-00847
Patent 8,448,799 B2

Before JOSIAH C. COCKS, PHILLIP J. KAUFFMAN,
and JAMES P. CALVE, *Administrative Patent Judges*.

COCKS, *Administrative Patent Judge*.

DECISION
Termination of the Proceeding
35 U.S.C. § 317 and 37 C.F.R. § 42.72

On March 2, 2015, Petitioner, Rapak, LLC (“Rapak”), and Patent Owner, Scholle Corporation (“Scholle”), (collectively referred to as “the Parties”), filed a joint motion to terminate this *inter partes* review involving U.S. Patent No. 8,448,799. Paper 19 (“Joint Motion to Terminate”). Authorization to file the Motion was given by e-mail correspondence from Board personnel on February 27, 2015. Along with the Joint Motion to Terminate, the Parties filed a true copy of their written settlement agreement (Ex. 1014), as well as a joint request (Paper 20) to have their settlement agreement treated as business confidential information under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

The Parties state in their joint motion:

Termination of this proceeding is appropriate as the Parties have agreed to settle their dispute.

U.S. Patent No. 8,448,799 is being litigated in the following civil action, all claims of which will be dismissed with prejudice as a result of the Settlement Agreement: *Scholle Corporation v. Rapak LLC*, 1:13-cv-03976 (N.D.Ill.). There are no pending related *Inter Partes* Reviews.

Paper 19, 2.

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

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.” The

requirement for terminating review with respect to Rapak is met.

Furthermore, under 35 U.S.C. § 317(a), “If 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).” Rapak is the sole petitioner in this review. The Board has discretion to terminate this review with respect to Scholle.

Upon consideration of the circumstances of this case, the panel has determined to terminate this *inter partes* review as to both Rapak and Scholle without rendering a final written decision.

It is

ORDERED that, as was requested timely by the Parties (Paper 20), the settlement agreement (Ex. 1014) will be treated as business confidential information under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c); and

FURTHER ORDERED that the joint motion to terminate IPR2014-00847 (Paper 20) is *granted* and this proceeding is hereby *terminated*.

IPR2014-00847
Patent 8,448,799 B2

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