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Paper No. 23
Entered: May 18, 2015

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HAMILTON STORAGE TECHNOLOGIES, INC.
and HAMILTON COMPANY
Petitioner

v.

UNIVERSITY OF VIRGINIA PATENT FOUNDATION
Patent Owner

Cases IPR2014-01054, -01058, -01060, -01062
Patents 6,467,285, 6,581,395, 6,688,123, 6,941,762[1]

Before GLENN J. PERRY, JEREMY M. PLENZLER, and TIMOTHY J. GOODSON, *Administrative Patent Judges.*

PERRY, *Administrative Patent Judge.*

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

[1] The parties are not authorized to use a combined caption and must file papers separately in these for proceedings.

DISCUSSION

We instituted trial[2] in each of these proceedings in December 30, 2014. On May 15-16, 2015, the parties filed a Joint Motion to terminate each of these proceedings[3], as well as a Joint Request 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)[4]. The parties also filed a true copy of their written settlement agreement.[5] The parties indicated in their Joint Motions that termination of these proceedings is appropriate because they have reached an agreement regarding their dispute with respect to U.S. Patents No. 6,467,285 ("the '285 patent"); 6,581,395 ("the '395 patent"); 6,688,123 ("the '123 patent"); and 6,941,762 ("the '762 patent"). Paper 18, 2[6]. The parties indicate that the co-pending district court case involving these patents was terminated by the U.S. District Court for the Western District of Virginia on May 12, 2015. *Id*. at 3.

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." Final Decisions in these proceedings have not yet been issued.

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[2] IPR2014-001054, Paper 11; IPR2014-001058, Paper 11; IPR2014-001060, Paper 11; and IPR2014-001062, Paper 11.
[3] IPR2014-001054, Paper 18; IPR2014-001058, Paper 21; IPR2014-001060, Paper 18; and IPR2014-001062, Paper 18.
[4] IPR2014-001054, Paper 19; IPR2014-001058, Paper 22; IPR2014-001060, Paper 19; and IPR2014-001062, Paper 19.
[5] Ex. 1045 in each proceeding.
[6] For convenience, we cite only to papers filed in IPR2014-001054. It appears that the four motions to terminate are substantively identical.

Under 37 C.F.R. § 42.74(b), "[a]ny agreement or understanding between the parties made in connection with, or in contemplation of, the termination of a proceeding shall be in writing and a true copy shall be filed with the Board before termination of the trial." As the parties have filed their written settlement agreement, and the co-pending district court cases have been dismissed, we determine that it is appropriate to terminate this proceeding without rendering a Final Written Decision as to the patentability of claims 1, 2, 4, 6, 11–21, 26, 27, and 29 of the '285 patent; claims 1–3, 5, 7, 12–22, 27, 28, 30, and 31 of the '395 patent; claims 1–3, 5, 7, 12–22, 26, 30, 31, and 33 of the '123 patent; and claims 32 and 34 of the '762 patent. *See* 37 C.F.R. §§ 42.72, 42.73, 42.74.

ORDER

Accordingly, it is:

ORDERED that the parties' Joint Requests that the settlement agreement be treated as business confidential information under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) are GRANTED; and

ORDERED that the parties' Joint Motions to terminate these proceedings are GRANTED, and this proceeding is hereby terminated.

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