

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NJOY, INC.,
Petitioner,

v.

FONTEM HOLDINGS 1 B.V.,
Patent Owner.

Case IPR2014-01300
Patent 8,490,628 B2

Before JACQUELINE WRIGHT BONILLA, BRIAN J. McNAMARA, and
JO-ANNE M. KOKOSKI, *Administrative Patent Judges*.

BONILLA, *Administrative Patent Judge*.

ORDER
Termination of the Proceeding
35 U.S.C. § 317(a) and 37 C.F.R. § 42.72

On November 17, 2015, the parties filed a joint motion to terminate this proceeding (Paper 36), along with a true copy of their written settlement agreement (Ex. 2096). The parties indicated in their joint motion that they have reached an agreement to terminate this proceeding pertaining to U.S. Patent No. 8,490,628 B2 (“the ’628 patent”). Paper 36, 3. On the same day, the parties also filed a joint motion requesting that the settlement agreement be treated as business confidential information and kept separate from the file of the ’628 patent. Paper 37.

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.” We instituted a trial in this proceeding as to claims 1–5, 7, and 8 of the ’628 patent (Paper 8) on February 19, 2015, but we have not decided yet the merits in relation to this proceeding.

Further, 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 the termination of the trial.” As the parties have filed a true copy of their written settlement agreement, which constitutes the entire agreement between the parties with respect to this *inter partes* review (Ex. 2096, Settlement Agreement, § 4.2, Global License Agreement, § 6.10), we determine that it is appropriate to terminate this proceeding without rendering a final written decision as to the patentability of claims 1–5, 7, and 8, of the ’628 patent. See 37 C.F.R. §§ 42.72, 42.74.

As requested by the parties, the settlement agreement will be treated as business confidential information and kept separate from the file of the '628 patent. 37 C.F.R. § 42.74(c).

Accordingly, it is

ORDERED that the parties' joint request that the settlement agreement be treated as business confidential information is GRANTED;

FURTHER ORDERED that the joint motion to terminate the proceeding is GRANTED; and

FURTHER ORDERED that the proceeding is TERMINATED.

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Patent 8,490,628 B2

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