

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NATIONAL OILWELL VARCO, L.P.,
Petitioner,

v.

PARALLEL SEPARATION INNOVATIONS, LLC,
Patent Owner.

Case IPR2015-01138
Patent 5,593,582

Before MEREDITH C. PETRAVICK, SCOTT A. DANIELS, and
BARRY L. GROSSMAN, *Administrative Patent Judges*.

DANIELS, *Administrative Patent Judge*.

TERMINATION
Dismissing the Petition
37 C.F.R. §§ 42.5(a), 42.71(a)

Pursuant to our authorization, the parties filed on August 5, 2015 a “Joint Motion to Terminate Proceeding” (Paper 7 (“Joint Motion”)), and a settlement agreement (Ex. 2002 (“Agreement”)). Because the Agreement contained no settlement terms or conditions apart from “agree[ing] to . . . terminate” this IPR proceeding. On October 22, 2015 we issued an Order to

Clarify Motion to Terminate (Paper 8, (“Order”)), instructing the parties to “jointly certify in writing that there are no other written or oral agreements or understandings between them made in connection with, or in contemplation of, the termination of IPR2015-01138 or the challenge to the patentability of U.S. Patent No. 5,593,582.” On October 22, 2015, the parties filed their “Joint Certification re Settlement Agreement in Support of Joint Motion to Terminate,” (Paper 9) signed by counsel of record stating among other things that “there are no other written or oral agreements or understandings, including any collateral agreements, between them.” We are persuaded on this record that the Agreement complies with 35 U.S.C. 317(b) and 37 C.F.R. 42.74(b).

We have not instituted trial in this proceeding. Thus, this proceeding is in its initial stages. The parties indicate with respect to their dispute involving U.S. Patent 5,593,582 (“the ’582 patent”) that they have settled their differences and agree to terminate the IPR and that:

no co-pending litigation remains. The District Court granted the petitioner and patent owner’s joint motion to dismiss the last remaining district court litigation. Ex. 2001, *Parallel Separation Innovations, Inc. v. National Oilwell Varco, Inc.*, No. 4:15-cv-00920 (S.D. Tex. filed July 23, 2015) (Doc. 86); *see also* Dkt. 5, Related Matters (showing other related litigations to have settled prior to the petition in this proceeding). As such, there are no current litigants in the District Court to ask the PTAB to revisit the same issues. *See Interthinx Inc. v. CoreLogic Solutions LLC*, No. CBM2012–00007, slip op. at 2 (Nov. 12, 2013) (Paper 47).

Paper 7, 1, *see* Ex. 2002. Under these circumstances, we determine that it is appropriate to dismiss the petition. *See* 37 C.F.R. §§ 42.5(a), 42.71(a). This

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paper does not constitute a final written decision pursuant to 35 U.S.C.
§ 318(a).

It is

ORDERED that the parties' "Joint Motion to Terminate Proceeding"
is granted to the extent that proceeding IPR2015-01138 is terminated; and

FURTHER ORDERED that the Petition for *Inter Partes* Review of
the above-referenced patent is dismissed.

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