

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

OWENS CORNING,
Petitioner,

v.

CERTAINTIED CORPORATION,
Patent Owner.

Cases IPR2015-01159 (Patent 8,950,161 B2)
IPR2015-01160 (Patent 8,959,875 B2)
IPR2015-01161 (Patent 8,959,876 B2)¹

Before BENJAMIN D. M. WOOD, JAMES A. TARTAL, and
KRISTINA M. KALAN, *Administrative Patent Judges*.

KALAN, *Administrative Patent Judge*

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

¹ This termination addresses the same issues in each of the three proceedings. Therefore, we exercise our discretion to issue one order to be filed in each proceeding. The parties, however, are not authorized to use this style of heading.

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The parties have requested that the above-captioned proceedings be terminated pursuant to a settlement. The Board authorized the parties to file a joint motion to terminate the above-captioned proceedings on September 23, 2015.

On September 25, 2015, and pursuant to 35 U.S.C. § 317, the parties filed a joint motion to terminate in each of the above-captioned proceedings. IPR2015-001159, Paper 6; IPR2015-01160, Paper 6; IPR2015-01161, Paper 6. The joint motion to terminate in each case included a joint request to treat the settlement agreement as business confidential information, to be kept separate from the patent file pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c), along with a copy of the settlement agreement. IPR2015-001159, Ex. 2001; IPR2015-01160, Ex. 2001; IPR2015-01161, Ex. 2001.

Generally, 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. 48756, 48768 (Aug. 14, 2012). This case is in the preliminary proceeding stage. A preliminary proceeding begins with the filing of a petition for instituting a trial and ends with a written decision as to whether trial will be instituted. *See* 37 C.F.R. § 42.2. Petitioner filed a Petition in each case on May 11, 2015. IPR2015-001159, Paper 1; IPR2015-01160, Paper 1; IPR2015-01161, Paper 1. Patent Owner has not filed Preliminary Responses. No decisions whether to institute a trial have been made.

The joint motions to terminate indicate that, on September 21, 2015, the parties resolved their disputes involving the patents at issue in the above-captioned proceedings before the Board. Paper 6, 1–2. The parties represent

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that “related litigation is pending in the U.S. District Court for the District of Delaware (Civ. A. No. 1:14-cv-00510-SLR) involving the patents-at-issue in IPR Nos. 2014-01397, 2014-01401, 2014-01402, 2014-01403, and 2014-01404” but that the litigation has been stayed pending the outcome of those instituted IPR proceedings. *Id.* at 3. The parties further represent that they “do not contemplate litigation” related to the patents at issue in the above-captioned proceedings “unless and until permitted to do so pursuant to the terms of the Confidential Limited Settlement Agreement.” *Id.* at 4.

Based on the facts of the case, and in view of the parties’ joint request for termination of these proceedings, we determine that it is appropriate to dismiss the petitions as to both Petitioner and Patent Owner without rendering either a decision to institute or a final written decision. *See* 37 C.F.R. §§ 42.5(a); 42.71(a). Therefore, the joint motions to terminate and the joint requests to treat the settlement agreements as business confidential information are *granted*. This paper does not constitute a final written decision pursuant to 35 U.S.C. § 318(a).

Accordingly, it is

ORDERED that the joint requests to treat the settlement agreements as business confidential information, to be kept separate from the patent file, are *granted*;

FURTHER ORDERED that the joint motions to terminate the proceedings are *granted*; and

FURTHER ORDERED that the Petitions for *Inter Partes* Review of the above-referenced patents are *dismissed*.

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