

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ICON HEALTH & FITNESS, INC.,
Petitioner,

v.

W.A.Y.S.S., INC.,
Patent Owner.

Case IPR2016-00121
Patent 5,785,631

Before JOSIAH C. COCKS, CARL M. DEFRANCO, and
MICHAEL L. WOODS, *Administrative Patent Judges*.

WOODS, *Administrative Patent Judge*.

DECISION

Joint Motion to Terminate the *Inter Partes* Review
35 U.S.C. § 317 and 37 C.F.R. § 42.72

I. Introduction

On July 27, 2016, Petitioner ICON Health & Fitness, Inc. and Patent Owner W.A.Y.S.S. Inc. (collectively referred to as “the parties”), filed a Revised Joint Motion to Terminate Proceeding and Notice of Settlement. Paper 12 (“Joint Motion”).¹ The parties contend that “[t]he underlying litigation between the parties . . . has been dismissed with prejudice thus settling the parties’ dispute.” Joint Motion 2. Along with the Joint Motion, the parties filed a copy of the Stipulation of Dismissal with Prejudice from their underlying litigation. *Id.* (submitting Ex. 1014).

II. Discussion

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). The Board recognizes, however, the strong public policy reasons that favor settlement. *See 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.” 35 U.S.C. § 317(b) further requires that “[a]ny agreement or understanding between the patent owner and a petitioner . . . made in connection with, or in contemplation of, the termination of an *inter partes* review under this section

¹ The Board authorized the parties to file the Joint Motion in e-mail correspondence on July 11, 2016, and the parties revised the Joint Motion from an earlier filed Joint Motion to Terminate (Paper 11) to clarify that a settlement agreement did not exist between the parties.

shall be in writing and a true copy of such agreement or understanding shall be filed in the Office.”

Here, the parties filed their Joint Motion before we decided the merits of this proceeding. Further, the parties represent jointly that no agreement exists to be filed with the Board, as required under 35 U.S.C. § 317(b). Joint Motion 2. The parties instead represent that “[t]he dismissal [of the underlying litigation with prejudice] settles the dispute between the parties with regard to the ’631 patent.” *Id.* Thus, termination of this review with respect to Petitioner is appropriate.

Furthermore, under 35 U.S.C. § 317(a), “[i]f 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).” Thus, we have discretion to terminate this review with respect to Patent Owner.

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

III. Order

It is

ORDERED that the Joint Motion to Terminate this proceeding in IPR2016-00121 (Paper 12) is *granted*, and this proceeding is hereby *terminated*.

IPR2016-00121
Patent 5,785,631

PETITIONER:

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