

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

WARN INDUSTRIES, INC.,
Petitioner,

v.

RAMSEY WINCH COMPANY,
Patent Owner.

Case IPR2016-00310
Patent 8,968,140 B1

Before MICHAEL P. TIERNEY, JOSIAH C. COCKS, and
MICHAEL L. WOODS, *Administrative Patent Judges*.

WOODS, *Administrative Patent Judge*.

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

I. Introduction

On October 27, 2016, Petitioner, Warn Industries, Inc. (“Warn Industries”) and Patent Owner, Ramsey Winch Company (“Ramsey Winch”) (collectively referred to as “the parties”), filed a Joint Motion to Terminate Proceeding Pursuant to 35 U.S.C. § 317. Paper 18 (“Joint Motion to Terminate”).¹ Along with the Joint Motion to Terminate, the parties filed a true copy of a Patent License Agreement (Ex. 2001) as their settlement agreement (“Settlement Agreement”), as well as a joint request to have their settlement agreement treated as business confidential information under 35 U.S.C. § 317 and 37 C.F.R. § 42.74(c) (Paper 19).

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). Generally, however, 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. 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.” The requirement for terminating review with respect to Warn Industries is met.

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

¹ Filing of the Joint Motion to Terminate was authorized in e-mail correspondence from Board personnel on October 11, 2016.

final written decision under section 318(a).” Warn Industries is the sole petitioner in this *inter partes* review, such that termination with respect to Warn Industries means that no petitioner remains in the proceeding. The Board, thus, has discretion to terminate this review with respect to Ramsey Winch. The panel entered a Decision to institute trial on May 19, 2016 (Paper 8). Ramsey Winch did not file a Patent Owner Response. In the Joint Motion to Terminate, the parties represent that the parties have settled their dispute and have reached an agreement to terminate this proceeding. Paper 18, 2. The parties further represent that there are no related district court cases or related *inter partes* review proceedings, and that the parties do not contemplate any litigation or other contested proceedings involving the subject patent in the foreseeable future. *Id.* at 3.

Upon consideration of the circumstances of this case, the panel has determined to terminate this *inter partes* review as to both Warn Industries and Ramsey Winch without rendering a final written decision.

III. Orders

It is

ORDERED that the Joint Motion to Terminate IPR2016-00310 (Paper 18) is *granted*, and this proceeding is hereby *terminated*; and

FURTHER ORDERED that, as was requested timely by the parties (Paper 19), the settlement agreement (Ex. 2001) will be treated as business confidential information under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

IPR2016-00310
Patent 8,968,140 B1

For PETITIONER:

John Russell
russell@ahmrt.com

E. Anthony Figg
efigg@rothwellfigg.com

For PATENT OWNER:

Chad Hinrichs
Paul Rossler
iplaw@gablelaw.com