

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NIKE, INC.,
Petitioner,

v.

POINT 3 BASKETBALL, LLC,
Patent Owner.

Case IPR2016-00396
Patent 8,769,716 B2

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

WOODS, *Administrative Patent Judge*.

JUDGMENT

Termination Due to Settlement after Institution of *Inter Partes* Review
35 U.S.C. § 317 and 37 C.F.R. § 42.74

I. Introduction

We instituted trial on June 16, 2016. Paper 6. On February 10, 2017, Petitioner, Nike, Inc. (“Nike”), and Patent Owner, Point 3 Basketball, LLC (“Point 3”), (collectively referred to as “the Parties”), filed a Joint Motion to Terminate Proceeding Pursuant to 35 U.S.C. § 317 and 37 C.F.R. § 42.72. Paper 17 (“Joint Motion to Terminate”).¹ Along with the Joint Motion to Terminate, the Parties filed a true copy of a Settlement, Release and License Agreement (Ex. 2026, “Settlement Agreement”), as well as a joint request to have their Settlement Agreement treated as business confidential information under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) (Papers 18, 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).

In the Joint Motion to Terminate, the Parties represent that they have settled all of their disputes involving U.S. Patent No. 8,769,716, and that their related district court litigation has been dismissed. Paper 17, 2, 3.

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

¹ Filing of the Joint Motion to Terminate was authorized in e-mail correspondence from Board personnel on February 2, 2017.

merits of the proceeding before the request for termination is filed.” The requirement for terminating review with respect to Nike 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 final written decision under section 318(a).” Nike is the sole petitioner in this *inter partes* review, such that termination with respect to Nike means that no petitioner remains in the proceeding. The Board, thus, has discretion to terminate this review with respect to Point 3.

Oral argument has not yet been held. Under these circumstances, we are persuaded that it is appropriate to terminate this proceeding with respect to both Petitioner and Patent Owner. Therefore, the joint motion to terminate the proceeding is GRANTED.

III. Orders

It is

ORDERED that the Joint Motion to Terminate IPR2016-00396 (Paper 17) is *granted*, and this proceeding is hereby *terminated*; and

FURTHER ORDERED that, as was requested timely by the parties (Papers 18, 19), the Settlement Agreement (Ex. 2026) will be treated as business confidential information under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

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