

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

H&S MANUFACTURING COMPANY, INC.,
Petitioner,

v.

OXBO INTERNATIONAL CORPORATION,
Patent Owner.

Case IPR2016-00950
Patent 8,166,739 B2

Before PHILLIP J. KAUFFMAN, JAMES A. TARTAL, and
KEVIN W. CHERRY, *Administrative Patent Judges*.

TARTAL, *Administrative Patent Judge*.

DECISION

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

I. DISCUSSION

On August 10, 2017, Petitioner, H&S Manufacturing Company, Inc., and Patent Owner, Oxbo International Corporation, (collectively, “the parties”), filed a Joint Motion to Terminate Proceeding in this *inter partes* review proceeding (Paper 52) and a Joint Request to Treat Settlement Agreement Documents as Business Confidential Information (Paper 53) under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c). The parties also filed, with Board only accessibility, true copies of their Term Sheet and Settlement Agreement. Ex. 2023 and Ex. 2024.

We instituted trial in this proceeding on November 2, 2016, with respect to U.S. Patent No. 8,166,739 B2 (“the ’739 patent”). Paper 9. Oral argument in this proceeding, previously scheduled for August 1, 2017, was cancelled upon receipt of notification from the parties that they had reached a settlement agreement resolving their dispute both in this proceeding and in a related case in district court. Paper 50. The parties further indicate in their Joint Motion to Terminate Proceeding that termination of this proceeding is appropriate because they have reached an agreement regarding all outstanding disputes with respect to the ’739 patent. See Paper 52, 2.

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.” This proceeding has not yet been the subject of oral argument and we have made no final decision as to the parties’ contentions with respect to the ’739 patent. Additionally, under 37 C.F.R. § 42.74(b), “[a]ny agreement or

understanding between the parties made in connection with, or in contemplation of, the termination of a proceeding shall be in writing and a true copy shall be filed with the Board before termination of the trial.” The parties filed their written settlement agreements in support of their Joint Motion to Terminate Proceeding. Ex. 2023 and Ex. 2024. Under the circumstances presented, and based on the representations of the parties presented in the Joint Motion to Terminate Proceeding, we determine that it is appropriate to terminate this proceeding. See 35 U.S.C. § 317(a); 37 C.F.R. § 42.72.

II. ORDER

Accordingly, it is:

ORDERED that the parties’ Joint Request to Treat Settlement Agreement Documents as Business Confidential Information pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) is GRANTED; and

FURTHER ORDERED that the parties’ Joint Motion to Terminate Proceeding in this *inter partes* review proceeding is GRANTED.

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PETITIONER

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