

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

XENITH, LLC,

Petitioner,

v.

RIDDELL, INC.,

Patent Owner.

Case IPR2017-01316

Patent 8,528,118 B2

Before PHILLIP J. KAUFFMAN, BARRY L. GROSSMAN, and
JAMES J. MAYBERRY, *Administrative Patent Judges*.

MAYBERRY, *Administrative Patent Judge*.

DECISION

Granting Joint Motion to Terminate Proceeding

35 U.S.C. § 317(a); 37 C.F.R. § 42.72

Granting Joint Request to Treat Settlement Agreement

as Business Confidential Information

35 U.S.C. § 317(b); 37 C.F.R. § 42.74(c)

Pursuant to our authorization on July 31, 2017, Petitioner, Xenith, LLC, and Patent Owner, Riddell, Inc., filed a Joint Motion to Terminate Proceeding (Paper 6) and a Joint Request to Treat Settlement Agreement as Confidential Business Information (Paper 7). Pursuant to 37 C.F.R. § 42.74(b), the parties also filed a true copy of their written settlement agreement (Ex. 2001). *See* Paper 6, 3. In this proceeding, a Petition for *Inter Partes* Review of U.S. Patent No. 8,528,118 B2 (“the ’118 patent”) was filed on April 24, 2017 (the “Petition”). *See id.* at 1. We have not rendered a decision on institution in this proceeding.

In the Joint Motion to Terminate Proceeding, the parties indicate that they have reached an agreement regarding all of their disputes involving the ’118 patent. *Id.* at 1. The parties’ settlement includes dismissing a related district court proceeding involving the ’118 patent between the parties. *See* Ex. 2001, 4. The parties “certify that there are no other collateral agreements or understandings made in connection with, or in contemplation of, terminating this [*inter partes*] review.” Paper 6, 3.

The Joint Motion to Terminate Proceeding indicates that the ’118 patent is involved in a separate *inter partes* review proceeding filed by Kranos Corp. (IPR2016-01646) and related district court litigation and that the settlement between Petitioner, Xenith, LLC, and Patent Owner, Riddell, Inc. does not affect that proceeding. Paper 6, 2–3. The Joint Motion to Terminate Proceeding indicates that “[n]o other litigation or proceeding is contemplated in the foreseeable future.” *Id.* at 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

merits of the proceeding before the request for termination is filed.” The parties indicate that termination is appropriate here as we have not rendered a Final Written Decision on the merits. Paper 6, 3. Furthermore, we have not issued a decision on institution in this proceeding. In view of the circumstances presented in this proceeding, we agree that termination is appropriate. Indeed, there are strong public policy reasons to favor settlement between the parties to a proceeding. *Office Patent Trial Practice Guide*, 77 Fed. Reg. 48,756, 48,768 (Aug. 14, 2012). Accordingly, the Board determines that it is appropriate to terminate this proceeding without rendering a final written decision. *See* 37 C.F.R. § 42.72.

Accordingly, it is:

ORDERED that the parties’ request that the settlement agreement (Ex. 2001) be treated as business confidential information and kept separate from the file of U.S. Patent No. 8,528,118 B2, under the provisions of 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c), is *granted*; and

FURTHER ORDERED that the Joint Motion to Terminate Proceeding is *granted*, the pending Petition is *dismissed*, and this proceeding is hereby terminated.

IPR2017-01316
Patent 8,528,118 B2

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