

Trials@uspto.gov
571.272.7822

Paper No. 10 IPR2017-01706
Paper No. 12 IPR2017-01708
Paper No. 09 IPR2017-01716
Paper No. 09 IPR2017-01717
Paper No. 09 IPR2017-01722
Entered: October 13, 2017

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

YOKOGAWA CORPORATION OF AMERICA,
Petitioner,

v.

CERTIFIED MEASUREMENT, LLC,
Patent Owner.

Case IPR2017-01706 (Patent 8,549,310 B2)
Case IPR2017-01708 (Patent 6,289,453 B1)
Case IPR2017-01716 (Patent 6,282,648 B1)
Case IPR2017-01717 (Patent 5,828,751)
Case IPR2017-01722 (Patent 5,828,751)¹

Before LYNNE E. PETTIGREW, BART A. GERSTENBLITH, and
PATRICK M. BOUCHER, *Administrative Patent Judges*.

GERSTENBLITH, *Administrative Patent Judge*.

DECISION

Termination and Settlement

35 U.S.C. § 317; 37 C.F.R. §§ 42.72, 42.74

¹ This Decision addresses issues that apply to the five cases. We, therefore, exercise our discretion to issue one Order to be filed in each of the cases. The parties are not authorized to use this heading style in their papers.

IPR2017-01706 (Patent 8,549,310 B2)
IPR2017-01708 (Patent 6,289,453 B1)
IPR2017-01716 (Patent 6,282,648 B1)
IPR2017-01717 (Patent 5,828,751)
IPR2017-01722 (Patent 5,828,751)

I. DISCUSSION

In an e-mail dated September 19, 2017, we authorized the parties to file joint motions to terminate the instant proceeding with true copies of their agreement(s) in contemplation of termination and joint motions to treat the filed copies of their agreement(s) as business confidential information under 37 C.F.R. § 42.74(c). On September 22, 2017, the parties filed a Joint Motion to Terminate Proceeding Pursuant to 35 U.S.C. § 317 and 37 C.F.R. § 42.74 (“Joint Motion to Terminate”; Paper 8²), a copy of a written Release and Settlement Agreement (“Settlement Agreement”; Ex. 1021³), and a Joint Motion to Treat Settlement Agreement as Business Confidential Information Under 37 C.F.R. § 42.74(c) (“Joint Motion to Treat as Confidential”; Paper 9).⁴

The parties indicate that they have settled and dismissed their related district court litigation and have agreed to jointly request termination of these proceedings. Paper 8 at 2. The parties filed what they represent is a true and correct copy of their written Settlement Agreement, and indicate that there are no other agreements or understandings, oral or written,

² Citations are to IPR2017-01706, unless otherwise indicated.

³ The Settlement Agreement is Exhibit 1021 in each proceeding.

⁴ The parties filed a Joint Motion to Terminate and Joint Motion to Treat as Confidential in each of the proceedings as follows: IPR2017-01706, Papers 8, 9; IPR2017-01708, Papers 10, 11; IPR2017-01716, Papers 7, 8; IPR2017-01717, Papers 7, 8; and IPR2017-01722, Papers 7, 8.

IPR2017-01706 (Patent 8,549,310 B2)
IPR2017-01708 (Patent 6,289,453 B1)
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IPR2017-01722 (Patent 5,828,751)

between the parties, made in connection with, or in contemplation of, the termination of these proceedings. *Id.*

Generally, 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). For the petitions for *inter partes* review before us, trial has not yet been instituted, and the merits of the proceedings have not been decided. *See* 35 U.S.C. § 317(a) (“An inter partes review instituted under this chapter shall be terminated with respect to any petitioner upon the joint request of the petitioner and the patent owner, unless the Office has decided the merits of the proceeding before the request for termination is filed.”); 37 C.F.R. § 42.72 (“The Board may terminate a trial without rendering a final written decision, where appropriate”). We are persuaded that, under these circumstances, termination of these proceedings is appropriate.

This Decision does not constitute a final written decision pursuant to 35 U.S.C. § 318(a).

II. ORDER

Accordingly, it is

ORDERED that the parties’ Joint Motion to Terminate Proceeding Pursuant to 35 U.S.C. § 317 and 37 C.F.R. § 42.74 (IPR2017-01706, Paper 8; IPR2017-01708, Paper 10; IPR2017-01716, Paper 7; IPR2017-01717, Paper 7; and IPR2017-01722, Paper 7) is *granted*;

FURTHER ORDERED that the parties’ Joint Motion to Treat Settlement Agreement as Business Confidential Information Under

IPR2017-01706 (Patent 8,549,310 B2)
IPR2017-01708 (Patent 6,289,453 B1)
IPR2017-01716 (Patent 6,282,648 B1)
IPR2017-01717 (Patent 5,828,751)
IPR2017-01722 (Patent 5,828,751)

37 C.F.R. § 42.74(c) (IPR2017-01706, Paper 9; IPR2017-01708, Paper 11;
IPR2017-01716, Paper 8; IPR2017-01717, Paper 8; and IPR2017-01722,
Paper 8) is *granted*;

FURTHER ORDERED that the Settlement Agreement (Exhibit 1021)
shall be kept separate from the file of the above-referenced patents, pursuant
to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c); and

FURTHER ORDERED that this proceeding is terminated.

IPR2017-01706 (Patent 8,549,310 B2)
IPR2017-01708 (Patent 6,289,453 B1)
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IPR2017-01717 (Patent 5,828,751)
IPR2017-01722 (Patent 5,828,751)

For PETITIONER:

William Mandir
Fadi Kiblawi
Andrew Ritter
SUGHRUE MION PLLC
wmandir@sughrue.com
fkiblawi@sughrue.com
aritter@sughrue.com

For PATENT OWNER:

Tarek Fahmi
Jason LaBerteaux
ASCENDA LAW GROUP, PC
tarek.fahmi@ascendalaw.com
jason.laberteaux@ascendalaw.com