

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CLIM-A-TECH INDUSTRIES, INC.
Petitioner,

v.

WILLIAM A. EBERT,
Patent Owner.

Case IPR2017-01863
Patent RE46,212 E

Before KRISTINA M. KALAN, JON B. TORNQUIST, and
KIMBERLY McGRAW, *Administrative Patent Judges*.

KALAN, *Administrative Patent Judge*.

DECISION
Dismissing the Proceeding
37 C.F.R. § 42.5(a), 37 C.F.R. § 42.71(a)

The parties have requested that the above-captioned proceeding be terminated pursuant to a settlement. The Board authorized the parties to file a joint motion to terminate or dismiss the above-captioned proceeding on September 26, 2018.

On September 28, 2018, and pursuant to 35 U.S.C. § 317, the parties filed a joint motion to terminate *inter partes* review and dismiss proceedings in the above-captioned proceeding, and a joint request to treat the settlement agreement as business confidential information, to be kept separate from the patent file pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) (Paper 15, “Joint Motion”), along with a copy of the settlement agreement (Ex. 1019) and the order dismissing the related civil action (Ex. 1018).

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. 48756, 48768 (Aug. 14, 2012). In this case, Petitioner filed a Petition (Paper 1), and Patent Owner filed a Revised Preliminary Response (Paper 8), and Petitioner filed a Reply (Paper 10). We declined to institute *inter partes* review (Paper 13), and Petitioner filed a Request for Rehearing (Paper 14). Accordingly, the decision of whether to institute a trial remained open pending resolution of Petitioner’s request for rehearing. *See* 37 C.F.R. §§ 42.2, 42.5.

With this filing, the parties jointly request that IPR2017-01863 be terminated. Paper 15. The parties represent that they “have agreed to settle their dispute with respect to the patent challenged in this proceeding, including reaching an agreement to terminate this review.” *Id.* at 2. Pursuant to the settlement agreement (Ex. 1019), they have agreed to terminate not only the present proceeding but also the related district court

litigation in the United States District Court for the District of Arizona, which has been dismissed. *Id.* (citing Ex. 1018). The parties “certify that there are no other collateral agreements or understandings made in connection with the termination of the present *inter partes* review proceeding.” *Id.* at 3.

Based on the facts of this case, and in view of the parties’ Joint Motion in this proceeding, we determine that it is appropriate to dismiss the Petition in the above-captioned case as to both Petitioner and Patent Owner without rendering either a decision on the request for rehearing or a final written decision. *See* 37 C.F.R. §§ 42.5(a); 42.71(a). Therefore, the Joint Motion and the joint request to treat the settlement agreement as business confidential information are *granted*. This paper does not constitute a final written decision pursuant to 35 U.S.C. § 318(a).

Accordingly, it is

ORDERED that the joint request to treat the settlement agreement as business confidential information, to be kept separate from the patent file, is *granted*;

FURTHER ORDERED that the Joint Motion is *granted*; and

FURTHER ORDERED that the Petition for *Inter Partes* Review of the above-referenced patent is *dismissed*.

IPR2017-01863
Patent RE46,212 E

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