

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HALLIBURTON ENERGY SERVICES, INC.,
Petitioner,

v.

SCHLUMBERGER TECHNOLOGY CORP.,
Patent Owner.

Case IPR2017-02071
Patent 7,055,604 B2

Before PATRICK R. SCANLON, HYUN J. JUNG, and
JAMES J. MAYBERRY, *Administrative Patent Judges*.

JUNG, *Administrative Patent Judge*.

DECISION

Granting Joint Motion to Terminate
35 U.S.C. § 317(a); 37 C.F.R. § 42.72
Granting Request to Treat Settlement Documents
as Confidential Business Information
35 U.S.C. § 317(b); 37 C.F.R. § 42.74(c)

On April 17, 2018, we instituted trial on claims 1, 2, 4–16, and 18–20 (the “Challenged Claims”) of U.S. Patent No. 7,055,604 B2 (the “’604 patent”). Paper 11, 23–24. On May 2, 2018, we modified the Decision on Institution to institute review of claims 3 and 17, thus adding these claims to the Challenged Claims of the ’604 patent. Paper 13. Pursuant to our authorization, on June 5, 2018, the parties filed a Joint Motion to Terminate Proceedings (Paper 19¹; the “Joint Motion”) and a Joint Request to File Settlement Agreement as Business Confidential Information (Paper 16). Pursuant to 37 C.F.R. § 42.74(b), the parties also filed a true copy of their written settlement agreement (Ex. 1013).

In the Joint Motion, the parties indicate that they have reached an agreement regarding all of their disputes involving the ’604 patent. Paper 19, 1. The parties represent that:

Other than as indicated in the [Settlement] Agreement, there are no written or oral agreements or understandings, including any collateral agreements, between the parties, including but not limited to licenses, covenants not to sue, confidentiality agreements, or other agreements of any kind, that are made in connection with, or in contemplation of, the termination of this proceeding.

Id.

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 proper, “because this proceeding is still in

¹ Paper 19 is the public version of the Joint Motion. A confidential version was filed concurrently as Paper 15.

its early stages, with the patent owner response not due until July 10, 2018.” Paper 19, 2. The parties further assert that they “are unaware of any other matter before the USPTO that would be affected by the outcome of this proceeding.” *Id.*

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). When, as here, we have not rendered a Final Written Decision on the merits, we generally expect that the proceeding will terminate after the filing of a settlement agreement. *See id.*

Based on the preceding, we determine that it is appropriate to terminate this proceeding without rendering a Final Written Decision as to the patentability of the Challenged Claims of the ’604 patent.

Accordingly, it is:

ORDERED that the parties’ request that the settlement agreement (Ex. 1013) be treated as business confidential information and kept separate from the file of U.S. Patent No. 7,055,604 B2, under the provisions of 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c), is *granted*; and

ORDERED that the Joint Motion to Terminate Proceedings is *granted*, and this proceeding is hereby terminated.

IPR2017-02071
Patent 7,055,604 B2

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