

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INFILTRATOR WATER TECHNOLOGIES, LLC,
Petitioner,

v.

PRESBY PATENT TRUST,
Patent Owner.

Case IPR2018-00228
Patent 9,556,604 B2

Before KRISTINA M. KALAN, MICHAEL L. WOODS, and
CHRISTOPHER C. KENNEDY, *Administrative Patent Judges*.

WOODS, *Administrative Patent Judge*.

JUDGMENT
Termination of Trial
35 U.S.C. § 317; 37 C.F.R. §§ 42.72–42.74

On April 10, 2019, pursuant to our e-mail authorization, Infiltrator Water Technologies, LLC, (“Petitioner”) and Presby Patent Trust (“Patent Owner”) filed a Joint Motion to Terminate *inter partes* review of U.S. Patent No. 9,556,604 B2 (“the ’604 patent”). Paper 43 (“Joint Motion” or “Mot.”).¹ With the Joint Motion, the parties filed a copy of their written settlement agreement memorializing their resolution of all disputes with respect to the patent at issue in this proceeding. Ex. 1053 (“Settlement Agreement”) (“the Parties have jointly agreed to resolve their disputes solely with respect to the ’604 Patent”). The parties also filed a joint request that the Settlement Agreement be treated as business confidential and kept separate under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74. Paper 40 (“Confidential Request”).

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.” In this proceeding, we have not yet reached a decision on the merits with respect to the patentability of any involved claim. Accordingly, we must terminate this review with respect to Infiltrator Water Technologies, LLC, as Petitioner.

Furthermore, “[i]f no petitioner remains in the inter partes review, the Office *may* terminate the review or proceed to a final written decision under section 318(a).” 35 U.S.C. § 317(a) (emphasis added). We, therefore, have

¹ The Joint Motion to Terminate was first filed on April 10, 2019, as an appendix to Exhibit 1053 and later, pursuant to an e-mail request from the Board, filed as a separate paper (Paper 43) on April 15, 2019.

discretion to terminate this review with respect to Presby Patent Trust, as Patent Owner.

In their Joint Motion, the parties represent that the related litigation between Petitioner and Patent Owner involving the '604 patent has settled and is in the process of being dismissed, and that the Settlement Agreement resolves all remaining disputes between the parties involving the '604 patent. Mot. 2; *see* 35 U.S.C. § 317(b); 37 C.F.R. § 42.74(b).

Under these particular circumstances, we determine that it is appropriate to terminate this *inter partes* review as to both Petitioner and Patent Owner without rendering a Final Written Decision, and to keep separate the Settlement Agreement as containing confidential information. *See* 35 U.S.C. § 317; 37 C.F.R. § 42.72.

Accordingly, it is

ORDERED that the Confidential Request (Paper 40) is *granted*; and

FURTHER ORDERED that the Joint Motion to Terminate this proceeding (Paper 43) is also *granted*; and

FURTHER ORDERED that this *inter partes* review is hereby *terminated*.

IPR2018-00228
Patent 9,556,604 B2

PETITIONER:

Edward Donovan
edward.donovan@kirkland.com

Eugene Goryunov
egoryunov@kirkland.com

PATENT OWNER:

Edmund Walsh
ewalsh-ptab@wolfgreenfield.com

Stephen Finch
sfinch@finchmaloney.com

Ross Krutsinger
rkrutsinger@finchmaloney.com

Allison Dianis
adianis@finchmaloney.com