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Paper No. 6
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BORGWARNER EMISSIONS SYSTEMS, LLC,
Petitioner,

v.

MODINE MANUFACTURING COMPANY,
Patent Owner.

Case IPR2018-00407 (Patent 8,794,299 B2)
Case IPR2018-00878 (Patent 8,794,299 B2)

Before PATRICK R. SCANLON, BART A. GERSTENBLITH, and GEORGE R. HOSKINS, *Administrative Patent Judges*.

HOSKINS, *Administrative Patent Judge*.

TERMINATION
Dismissing the Petitions
37 C.F.R. §§ 42.5(a) & 42.71(a)

On June 28, 2018, the parties sent an e-mail communication to the Board seeking "permission to file joint motions to terminate" in these two proceedings. On June 29, 2018, we authorized the parties via e-mail to file a joint motion to terminate in each of the two subject proceedings, and to file the settlement agreement as business confidential information under 37 C.F.R. § 42.74(c). Accordingly, the parties filed in both proceedings a Joint Motion for Termination ('407 IPR, Paper 10; '878 IPR, Paper 5) and a copy of the settlement agreement ('407 IPR, Ex. 1011; '878 IPR, Ex. 1014).

We have not instituted trial in either the '407 IPR or the '878 IPR. Thus, these proceedings are in their initial stages. The Motions indicate the parties "have settled all of their disputes relating to the '299 patent and reached an agreement to terminate" the two *inter partes* reviews. '407 IPR, Paper 10 at 2; '878 IPR, Paper 5 at 2. Further, "[t]he related District Court action between Patent Owner and Petitioner has been settled and dismissed with prejudice according to the terms of the Settlement Agreement." '407 IPR, Paper 10 at 3. Finally, the parties request that the settlement agreement be treated as business confidential information and be kept separate from the files of the '299 patent under 35 U.S.C. § 317(b) and 37 C.F.R § 42.74(c). '407 IPR, Paper 10 at 2; '878 IPR, Paper 5 at 2.

Under these circumstances, we determine it is appropriate to dismiss the petitions in the '407 IPR and in the '878 IPR. *See* 37 C.F.R. §§ 42.5(a) & 42.71(a). This paper does not constitute a final written decision pursuant to 35 U.S.C. § 318(a).

Accordingly, it is:

ORDERED that the parties' Joint Motion for Termination in the '407 IPR is *granted*; and

FURTHER ORDERED that the parties' Joint Motion for Termination in the '878 IPR is *granted*; and

FURTHER ORDERED that the Petitions in the '407 IPR and in the '878 IPR are both *dismissed*; and

FURTHER ORDERED that the parties' request to treat the settlement agreement as business confidential information and be kept separate from the files of the '299 patent under 35 U.S.C. § 317(b) and 37 C.F.R § 42.74(c) is *granted* in both the '407 IPR and the '878 IPR.

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