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Paper No. 15
Entered: December 18, 2018

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ZURN INDUSTRIES, LLC,
Petitioner,

v.

SIOUX CHIEF MFG. CO., INC.,
Patent Owner.

Case IPR2018-00975
Patent 8,347,906 B1

Before RAE LYNN P. GUEST, TINA E. HULSE, and AVELYN M. ROSS, *Administrative Patent Judges*.

ROSS, *Administrative Patent Judge*.

ORDER
Dismissing the Proceedings
37 C.F.R. §§ 42.5(a), 42.72(a)

On December 17, 2018, Petitioner Zurn Industries, LLC ("Petitioner") and Patent Owner Sioux Chief Manufacturing Company, Inc. ("Patent Owner") (collectively, "the Parties") filed a Joint Motion to Terminate the *Inter Partes* Review. Paper 13, ("Joint Motion to Terminate"). Together with the Joint Motion to Terminate, the Parties filed a copy of their written Settlement Agreement and Covenant Not To Sue (Ex. 2030, "Agreement") and a Joint Request to File the Settlement Agreement as Business Confidential Information Pursuant to 35 U.S.C. § 317(b). Paper 14, ("Joint Request").

The Board generally expects that a case "will terminate after the filing of a settlement agreement, unless the Board has already decided the merits." *Office Patent Trial Practice Guide*, 77 Fed. Reg. 48,756, 48,768 (Aug. 14, 2012); *see also* 35 U.S.C. §317(a) and 37 C.F.R. § 42.72. Here, the case remains at a preliminary stage—one where the Patent Owner has yet to file its Patent Owner Response. The Petitioner and Patent Owner indicate that the Settlement Agreement fully resolves all litigation and proceedings between the Parties to this *inter partes* review proceeding relating to the '906 Patent.[1] Joint Motion to Terminate 2; Ex. 2030, 2. The Parties also indicate that "this IPR is [now] the only existing litigation or proceeding between the parties involving the '906 patent and that no litigation or proceeding between the parties involving the '906 patent is contemplated in the foreseeable future." *Id.* at 3.

[1] The copending district court litigation, styled *Sioux Chief Manufacturing Co., Inc. v. Zurn Industries, LLC et al.*, Case No. 1:18-cv-163-RGA, was dismissed on December 12, 2018. Joint Motion to Terminate 2.

Under these circumstances, we determine that it is appropriate to terminate this proceeding. *See* 37 C.F.R. §§42.5(a) and 42.72. We also determine that it is appropriate to treat the Agreement (Ex. 1035) as business confidential information to be kept separate from the patent file. *See* 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

ORDER

In view of the foregoing, it is

ORDERED that the Parties Joint Motion to Terminate the *Inter Partes* Review (Paper 13) is *granted* and this proceeding is hereby terminated; and

FURTHER ORDERED that the Joint Request to File the Settlement Agreement as Business Confidential Information (Paper 14) is *granted*.

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