

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TESCO OFFSHORE SERVICES, INC.,
Petitioner,

v.

WEATHERFORD/LAMB, INC.,
WEATHERFORD TECHNOLOGY HOLDING LLC, AND
WEATHERFORD U.S., L.P.,
Patent Owner.

Case IPR2018-01308
Patent 7,249,637 B2

Before JAMES A. TARTAL, FRANCES L. IPPOLITO, and
PAUL J. KORNICZKY, *Administrative Patent Judges*.

KORNICZKY, *Administrative Patent Judge*.

DECISION

Granting Joint Motion to Terminate
35 U.S.C. § 317(a) and 37 C.F.R. § 42.72

On January 28, 2019, with Board authorization, Petitioner Tesco Offshore Services, Inc. (“Petitioner”) and Weatherford/Lamb, Inc., Weatherford Technology Holding LLC, and Weatherford U.S., L.P. (collectively, “Patent Owner”) filed a Renewed Joint Motion to Terminate Proceeding Based on Their Settlement Agreement. Paper 23 (the “Joint Motion”). With their Joint Motion, the Parties also filed a copy of their two written settlement agreements (Exs. 1035 and 1036). On the same day, the Parties also filed a motion requesting that the settlement agreements be treated as business confidential information and kept separate from the file of U.S. Patent No. 7,249,637 B2. Paper 24.

Under 35 U.S.C. § 317(a), “[a]n inter partes review . . . 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.” “Any agreement or understanding between the patent owner and a petitioner . . . made in connection with, or in contemplation of, the termination of an inter partes review . . . shall be in writing and a true copy of such agreement or understanding shall be filed in the Office before the termination of the inter partes review as between the parties.” 35 U.S.C. § 317(b); *see* 37 C.F.R. §§ 42.72, 42.74(b).

We instituted a trial in this proceeding on December 10, 2018 (Paper 19), but Patent Owner has not yet filed its Patent Owner Response, and we have not yet decided the merits of the proceeding. The Parties have filed what they indicate is a true copy of their two written settlement agreements (Exs. 1035 and 1036), which they represent “are the only ‘agreement[s] or understanding[s] between Petitioner and Patent Owner made in connection with, or in contemplation of terminating this proceeding.’” Paper 23, 4. Accordingly, we determine that it is appropriate to terminate this proceeding. *See* 35 U.S.C. § 317; 37 C.F.R. §§ 42.72, 42.74.

As requested by the Parties, the two settlement agreements (Exs. 1035 and 1036) will be treated as business confidential information and kept separate from the patent file. *See* 37 C.F.R. § 42.74(c).

Accordingly, it is

ORDERED that the Parties' Renewed Joint Motion to Terminate Proceeding (Paper 23) is *granted*; and

FURTHER ORDERED that the Parties' Joint Motion to treat the two settlement agreements (Exs. 1035 and 1036) as business confidential information (Paper 24) is *granted*.

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