

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NELSON PRODUCTS, INC.,
Petitioner,

v.

BAL SEAL ENGINEERING, INC.,
Patent Owner.

Case IPR2019-00310
Patent 8,166,623 C1

Before BENJAMIN D. M. WOOD, HYUN J. JUNG, and
JAMES A. WORTH, *Administrative Patent Judges*.

WOOD, *Administrative Patent Judge*.

TERMINATION

Due to Settlement after Institution of Trial

35 U.S.C. § 317; 37 C.F.R. § 42.74

Granting Joint Request to Treat Settlement Agreement as

Business Confidential Information

35 U.S.C. § 317(b); 37 C.F.R. § 42.74(c)

With our prior authorization, Petitioner Nelson Products, Inc. and Patent Owner Bal Seal Engineering, Inc. (collectively, “the parties”) filed a Joint Motion to Terminate Proceeding (Paper 13, “Joint Motion”) and a Joint Request that the Settlement Agreement be Treated as Business Confidential (Paper 14). The parties also filed a copy of a written settlement agreement. Ex. 2014. The settlement agreement indicates that there are no other collateral agreements or understandings between the parties made in connection with, or in contemplation of, the termination of this proceeding. *Id.* § 3.A.

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.” Generally, the Board expects that a proceeding will terminate as to settling parties after the filing of a settlement agreement. *See, e.g., Office Patent Trial Practice Guide*, 77 Fed. Reg. 48,756, 48,768 (Aug. 14, 2012). In this case, the Board has instituted review, but has not yet issued a final written decision. *See also* Joint Motion 3 (explaining that “[t]ermination is appropriate in this case because . . . the Board has not reached any final written decision in this proceeding”). Under these circumstances we are persuaded that it is appropriate to terminate this proceeding. We also determine that it is appropriate to treat the settlement agreement, Exhibit 2014, as business confidential information.

Accordingly, it is:

ORDERED that the Joint Request to Treat Settlement Agreement as Business Confidential Information is *granted*, and that the settlement

IPR2019-00310
Patent 8,166,623 C1

agreement, Exhibit 2014, shall remain designated as “Parties and Board Only” in the Board’s filing system and be kept separate from the files of U.S. Patent No. 8,166,623 C1; and

FURTHER ORDERED that the Joint Motion to Terminate the proceeding is *granted*, and the proceeding is hereby TERMINATED.

IPR2019-00310
Patent 8,166,623 C1

For PETITIONER:

Joseph Andelin
FISH IP LAW LLP
jandelin@fishiplaw.com

For PATENT OWNER:

Glen Nuttall
Tom Dao
KLEIN, O'NEILL & SINGH, LLP
gnuttall@koslaw.com
tdao@koslaw.com