

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HORMEL FOODS CORPORATION,
Petitioner,

v.

HIP, INC.,
Patent Owner.

IPR2019-00469
Patent 9,510,610 B2

Before DONNA M. PRAISS, CHRISTOPHER L. CRUMBLEY, and
WESLEY B. DERRICK, *Administrative Patent Judges*.

CRUMBLEY, *Administrative Patent Judge*.

TERMINATION
Settlement After Institution of Trial
35 U.S.C. § 317; 37 C.F.R. § 42.74

On April 28, 2020, pursuant to Board authorization, Petitioner Hormel Foods Corporation and Patent Owner HIP, Inc., filed a Joint Motion to Terminate this *inter partes* review. Paper 59. With the Joint Motion, the parties filed a copy of a Joint Stipulation to Terminate, in which the parties agreed that this *inter partes* review trial is now moot in light of the Federal

Circuit's affirmance of the District Court for the District of Delaware's determination that the claims at issue are invalid, and HIP's agreement that it will not seek further appellate review. Ex. 1046. The parties move to terminate the *inter partes* review. Paper 59, 2.

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, the Board has not yet reached a decision on the merits with respect to the patentability of any involved claim. Accordingly, we are required by statute to terminate the proceeding with respect to Hormel.

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).” *Id.* No petitioner remains following the termination of Hormel's involvement. The Board, therefore, has discretion to terminate this review with respect to HIP. In their Joint Motion, the parties note that the District Court's determination that the claims at issue are invalid is now final, and no dispute remains between the parties in any form. Paper 59, 2.

In these circumstances, we determine that it is appropriate to terminate this *inter partes* review without rendering a final written decision. *See* 35 U.S.C. § 317(a); 37 C.F.R. § 42.72.

In light of the foregoing, it is

ORDERED that the Joint Motion to Terminate this proceeding
(Paper 59) is *granted*; and

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

For PETITIONER:

Kurt Niederluecke
Barbara Marchevsky
FREDRIKSON & BYRON, P.A.
kniederluecke@fredlaw.com
bmarchevsky@fredlaw.com

For PATENT OWNER:

Jerry Selinger
Barden Patterson
PATTERSON and SHERIDAN, LLP
jselinger@pattersonsheridan.com
tpatterson@pattersonsheridan.com