

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

VÄLINGE INNOVATION AB,
Petitioner,

v.

INNOVATIONS 4 FLOORING HOLDING N. V.,
Patent Owner.

Case IPR2019-00517
Patent 10,053,868 B2

Before GRACE KARAFFA OBERMANN, BENJAMIN D. M. WOOD, and
SCOTT C. MOORE, *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 Välinge Innovation AB and Patent Owner Innovations 4 Flooring Holding N. V. (collectively, “the parties”) filed a Joint Motion to Terminate Proceeding (Paper 19, “Joint Motion”) and a Joint Request to Treat Settlement Agreement as Business Confidential Information (Paper 20). The parties also filed a copy of a written settlement agreement as Exhibit 2005. Because the version of the settlement agreement filed as Exhibit 2005 is incomplete, the parties, at our request, subsequently filed a complete version of the agreement as Ex. 2006, and a joint request to treat Exhibit 2006 as Business Confidential Information (Paper 24). See Paper 23. All references to the “settlement agreement” are to Exhibit 2006.

The parties certify that, although the settlement agreement refers to ten “ancillary agreements,” these agreements involve third parties, have not yet been executed, and do not involve the patent at issue in this proceeding. Joint Motion 3-4. The parties therefore certify that there are no other collateral agreements or understandings made in connection with, or in contemplation of, the termination of this proceeding. *Id.* at 4.

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. 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 2006, as business confidential information. We further determine to expunge Exhibit 2005.

Accordingly, it is:

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

FURTHER ORDERED that the Joint Request to Treat Settlement Agreement as Business Confidential Information is *granted*, that the settlement agreement, Exhibit 2006, 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. 10,053,868 B2; and

FURTHER ORDERED that Exhibit 2005 is expunged from the record of this proceeding.

IPR2019-00517
Patent 10,053,868 B2

PETITIONER:

Andrew R. Cheslock
Erin M. Dunston
Bryan J. Cannon
BUCHANAN INGERSOLL & ROONEY PC
andrew.cheslock@bipc.com
erin.dunston@bipc.com
bryan.cannon@bipc.com

PATENT OWNER:

John W. McIlvaine, III
Anthony W. Brooks
THE WEBB LAW FIRM
jmcilvaine@webblaw.com
abrooks@webblaw.com