

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

KOLBE & KOLBE MILLWORK CO., INC.,
Petitioner,

v.

SIERRA PACIFIC INDUSTRIES,
Patent Owner.

Case IPR2019-00933
Patent 8,561,365 B2

Before CARL M. DEFRANCO, TIMOTHY J. GOODSON, and
RYAN H. FLAX, *Administrative Patent Judges*.

FLAX, *Administrative Patent Judge*.

TERMINATION

Due to Settlement After Institution of Trial; and
Granting Joint Motion to Treat Settlement Agreement
Documents as Business Confidential Information
35 U.S.C. § 317(a); 37 C.F.R. § 42.72; 37 C.F.R. § 42.74(c)

Kolbe & Kolbe Millwork Co., Inc. is the Petitioner in this *inter partes* review of U.S. Patent No. 8,561,365 B2 (“the ’365 patent”), and Sierra Pacific Industries is the Patent Owner. Pursuant to 35 U.S.C. § 314, the Board instituted trial on October 9, 2019, on all grounds of unpatentability set forth in the Petition (Paper 1). Paper 14. A final hearing was held on August 5, 2020. Paper 78.

The parties have now filed a Joint Motion to Terminate the proceeding (Paper 84) on the basis of a settlement reached by the parties. *See* 35 U.S.C. § 317(a). Pursuant to 35 U.S.C. § 317(b):

Any agreement or understanding between the patent owner and a petitioner, including any collateral agreements referred to in such agreement or understanding, made in connection with, or in contemplation of, the termination of an *inter partes* review under this section 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.

Id. Pursuant to that statute, in connection with the Joint Motion to Terminate, the parties filed a copy of their written settlement agreement resolving this *inter partes* review and the related district court litigation. Exhibit 1073 (“Settlement Agreement”).

The parties also filed a Joint Request (Motion) that the Settlement Agreement be treated as business confidential information. Paper 85. This request is *granted*.

Generally, the Board expects that a proceeding will terminate after the filing of a settlement agreement, unless the Board has already decided the merits of the proceeding. *See* 35 U.S.C. § 317(a) (“An *inter partes* review instituted under this chapter shall be terminated with respect to any petitioner upon the joint request of the petitioner and the patent owner,

unless the Office has decided the merits of the proceeding before the request for termination is filed.”); 37 C.F.R. § 42.72 (“The Board may terminate a trial without rendering a final written decision, where appropriate, including . . . pursuant to a joint request under 35 U.S.C. 317(a)”). Here, although the Board was on track to enter a final written decision by the statutory deadline, the Board had not yet done so by the time the parties advised the Board of their intention to jointly seek termination due to settlement. Thus, we *grant* the Joint Motion to Terminate the proceedings.

This Decision does not constitute a final written decision pursuant to 35 U.S.C. § 318(a).

In consideration of the foregoing, it is hereby:

ORDERED the Joint Request to Treat the Settlement Agreement (Ex. 1073) as business confidential information is *granted*, and this agreement shall be kept separate from the public files of the ’365 patent, and made available only to Federal Government agencies on written request, or to any person on a showing of good cause, under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c); and

FURTHER ORDERED that the Joint Motion to Terminate this proceeding is *granted*, and this proceeding is hereby *terminated* under 35 U.S.C. § 317(a) and 37 C.F.R. § 42.72.

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