

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INNOVATIONS4FLOORING NV,
Petitioner,

v.

FLOORING INDUSTRIES LIMITED, SARL,
Patent Owner.

IPR2019-01133
Patent 9,200,460 B2

Before GEORGE R. HOSKINS, CHRISTOPHER G. PAULRAJ, and
TIMOTHY G. MAJORS, *Administrative Patent Judges*.

PAULRAJ, *Administrative Patent Judge*.

DECISION
Settlement Prior to Institution of Trial
37 C.F.R. § 42.74

I. INTRODUCTION

On November 21, 2019, Petitioner Innovations4Flooring, NV and Patent Owner Flooring Industries Limited SARL (collectively, “the Parties”) filed a Joint Motion to Terminate IPR2019-01133 pursuant to a settlement agreement. Paper 8 (“Joint Motion”). Along with the Joint Motion, the Parties filed confidential versions of their Settlement Agreement (Exhibit 1017), five executed “Ancillary Agreements” (Exhibits 1018–1022) that are referred to in the Settlement Agreement (collectively with Ex. 1017, “the Settlement Materials”), along with Joint Requests to treat the filed Settlement Materials as business confidential information pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c). Paper 9 (Joint Request to Treat Exhibit 1017 as Business Confidential Information); Paper 12 (Joint Request to Treat Exhibits 1018–1022 as Business Confidential Information).

This case is at the preliminary proceeding stage and no decision has been made regarding instituting trial. Based on the present record, we determine that good cause exists to terminate this proceeding without deciding whether trial should be instituted.

II. DISCUSSION

In the Joint Motion, the Parties stipulated that they reached an agreement to seek termination of this *inter partes* review proceeding. Paper 8, 2. The Parties also provided a summary of the eleven Ancillary Agreements referenced in the Settlement Agreement. *Id.* at 2–4. During a November 25, 2019 conference call and in a subsequent Order, the Board required the parties to file all executed Ancillary Agreements in order to comply with the statutory requirement in 35 U.S.C. § 317(b) to file “any collateral agreements referred to in” the parties’ Settlement Agreement.

Paper 10, 3. The Parties clarified that only Ancillary Agreement Nos. 2, 3, 4(i), 4(ii), 5, and 9 have been executed to date. Paper 11, 1.

To comply with 35 U.S.C. §317(b) and our Order, the Parties filed a Joint Submission of Exhibits 1018–1022 (“Joint Submission”), which included previously executed Ancillary Agreement Nos. 2, 3, 4(i), 4(ii), and 5. Paper 11, 1–2. The Parties, however, did not file Ancillary Agreement 9 because that agreement is only between two third parties. Paper 11, 2. The Parties stated that the third parties are not parties to the Settlement Agreement, that Ancillary Agreement 9 does not involve the Parties, and the third parties refused consent to file Ancillary Agreement 9 in this proceeding. *Id.* The Parties also expressed that Ancillary Agreement 9 is not in their possession. *Id.* Further, the Parties stated that Ancillary Agreement 9 was referenced in the Settlement Agreement (Exhibit 1017) by mistake given the Parties’ lack of involvement in the agreement and the third parties’ lack of involvement in the Settlement Agreement. *Id.*

On this record, the Board accepts the Parties’ undisputed representations regarding Ancillary Agreement 9. As such, we do not require the Parties to file Ancillary Agreement 9 because we do not consider it to be a “collateral agreement” under 35 U.S.C. §317(b). We determine that the Parties have otherwise complied with the requirements of 35 U.S.C. §317(b) by filing the Settlement Materials.

The Parties also filed Joint Requests that Exhibits 1017–1022 be treated as business confidential information and kept separate from the publicly available file of the patent involved in this proceeding. Paper 9, 2–3; Paper 12, 2. We have reviewed Exhibits 1017–1022 and find that they contain confidential business information regarding the terms of the settlement and/or agreements with third parties. We, therefore, determine

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that good cause exists to treat Exhibits 1017–1022 as business confidential information pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

Accordingly, for the reasons discussed above, it is:

III. ORDER

ORDERED that the Joint Motion to Terminate is granted, and IPR2019-01133 is hereby terminated; and

FURTHER ORDERED that the Joints Request that Exhibits 1017–1022 be treated as business confidential information and kept separate from the file of Patent 9,200,460 B2, pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c), is granted.

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