

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SUNTRAC SOLAR MANUFACTURING LLC,
Petitioner,

v.

DZSOLAR LTD,
Patent Owner.

IPR2019-01492
Patent 9,267,713 B2

Before MICHAEL R. ZECHER, JOHN P. PINKERTON, and
MICHAEL L. WOODS, *Administrative Patent Judges*.

PINKERTON, *Administrative Patent Judge*.

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

On February 3, 2020, the parties filed a Joint Motion to Terminate Proceeding (Paper 9, “Joint Motion”), which involves claims 1–16 of U.S. Patent No. 9,267,713 B2 (Ex. 1001, “the ’713 patent”), a true copy of their Settlement Agreement (Ex. 2006, “Agreement”), and a Joint Submission of Settlement Agreement (Paper 10, “Joint Submission”).

In the Joint Motion, the parties state that they “have now settled their dispute and have agreed to request termination of this [*inter partes* review] proceeding.” Joint Motion 2. The parties also state that “[t]he settlement agreement has been made in writing and a true and correct copy thereof (Exhibit 2006) is being filed concurrently with the present motion” *Id.* at 3. The parties further state that “[t]here is no pending litigation involving the ’713 [p]atent”, and Patent Owner’s “reissue application of the ’713 [p]atent, Serial No. 16/692,576 . . . is currently pending.” *Id.*

This case is in its preliminary stages, and we have not yet decided whether to institute an *inter partes* review. Accordingly, we have not “decided the merits of the proceeding” prior to the parties’ request for termination. *See* 35 U.S.C. § 317(a). The foregoing factors weigh in favor of granting the Joint Motion; and, we discern no factors weighing against termination of the proceeding. Thus, we grant the Joint Motion.

In the Joint Submission, the parties jointly request (“Joint Request”) that the Agreement “be treated as business confidential information, kept separate from the file of the subject patent, and be made available only to Federal Government agencies on written request, or to any person on showing of good cause.” Joint Submission 2. Under these particular circumstances, we determine it is appropriate to treat the Agreement as

business confidential information kept separate from the file of the '713 patent. Thus, we also grant the Joint Request.

For the foregoing reasons, it is:

ORDERED that the Joint Motion is GRANTED, and this proceeding is hereby terminated; and,

FURTHER ORDERED that the parties' Joint Request is GRANTED, and the Agreement shall be treated as business confidential information and kept separate from the file of the '713 patent.

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