

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ENERCOP SAND SOLUTIONS INC.,
Petitioner,

v.

SPECIALIZED DESANDERS INC.,
Patent Owner.

IPR2019-01582
Patent 9,861,921 B2

Before RAE LYNN P. GUEST, DONNA M. PRAISS, and
CHRISTOPER M. KAISER, *Administrative Patent Judges*.

PRAISS, *Administrative Patent Judge*.

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

On October 16, 2019, the parties filed a Joint Motion to Terminate in this proceeding pursuant to 37 C.F.R. § 42.74. Paper 4. With the motion to terminate, the parties filed a copy of a written settlement agreement (Ex. 1015) along with a joint request (“Joint Request”) to file the settlement agreement as business confidential information and to keep the settlement agreement separate from the patent files, under 35 U.S.C. § 317 and 37 C.F.R. § 42.74 (Paper 5). We authorized the filing of these papers in an e-mail dated October 15, 2019.

Generally, the Board expects that a proceeding will terminate after the filing of a settlement agreement. *See, e.g.*, Office Patent Trial Practice Guide, 77 Fed. Reg. 48756, 48768 (Aug. 14, 2012). A petition was filed just last month in this proceeding. Paper 1. A preliminary response from the Patent Owner is not due until December 23, 2019. Paper 3. A decision on the merits has not been reached.

The parties represent that Exhibit 1015 is a “true copy” of their settlement agreement. Paper 4, 3. They also represent that “there are no other collateral agreements or understandings, oral or written, between the parties made in connection with, or in contemplation of, the termination of [this proceeding].” *Id.* In addition, the parties explain that even if their motion to terminate is not granted, “Petitioner will not participate further” in this proceeding. *Id.* at 1. Based on the facts of this case and, particularly the preliminary stage of the proceeding, we determine that it is appropriate to terminate this proceeding.

Accordingly, the Joint Motion to Terminate is *granted* and the Joint Request to treat the settlement agreement as business confidential information is *granted*.

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

ORDER

Accordingly, it is

ORDERED that the Joint Request that the settlement agreement be treated as business confidential information and be kept separate from the files of the involved patent under the provisions of 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c), is *granted*;

FURTHER ORDERED that the Joint Motion to Terminate this proceeding is *granted*; and

FURTHER ORDERED that this proceeding is *terminated* with respect to both Petitioner and Patent Owner pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. § 42.72.

IPR2019-01582
Patent 9,861,921 B2

FOR PETITIONER:

James H. Hall
J. David Cabello
Stephen D. Zinda
Cabello Hall Zinda, PLLC
james@chzfirm.com
david@chzfirm.com
Stephen@chzfirm.com

FOR PATENT OWNER:

Parlee McLaws LLP (CGY)
3300 TD Canada Trust Tower
421-7 AVE SW
CALGARY AB T2P 4K9 CA CANADA