

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

DECORWARE INTERNATIONAL, INC.,
Petitioner,

v.

L&L CANDLE COMPANY LLC,
Patent Owner.

IPR2020-01233
Patent 9,366,402 B2

Before JUSTIN T. ARBES, JOHN F. HORVATH, and
NABEEL U. KHAN, *Administrative Patent Judges*.

KHAN, *Administrative Patent Judge*.

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

Petitioner and Patent Owner (collectively referred to as “the Parties”) have requested that the instant proceeding be terminated. In an email dated September 30, 2020, we authorized the Parties to file a joint motion to terminate the instant proceeding. On October 1, 2020, the Parties filed a Joint Motion to Terminate this proceeding. *See* Paper 6 (“Joint Motion”), 1. Along with the Joint Motion, the Parties filed a Settlement Agreement (Ex. 2001 (unredacted, confidential version) and Ex. 2002 (public, redacted version)), as well as a Joint Request to File Settlement Agreement as Business Confidential Information and to Maintain Said Agreement Separate from the Public File pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) (Paper 7 (“Joint Request”)).

In the Joint Motion, the Parties represent that they have reached an agreement to jointly seek termination of this proceeding, and that the filed copy of the Settlement Agreement is a true copy. Joint Motion 1. The Parties further represent that there are “no other agreements or understandings, oral or written, express or implied, between the parties, including any collateral agreements, made in connection with, or in contemplation of, the termination of the present proceeding with respect to Petitioner.” Joint Motion 1. The Parties also represent that there no other proceedings before the Board involving U.S. Patent No. 9,366,402 B2 (“the ’402 Patent”) and that the Parties have moved to dismiss, with prejudice, the underlying District Court litigation and the investigation before the International Trade Commission, involving the ’402 Patent. Joint Motion 4.

Generally, the Board expects that a proceeding will terminate after the filing of a settlement agreement. *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).”); *see also* Patent Trial and Appeal Board Consolidated Trial Practice Guide (Nov. 2019), 86, *available at* <https://www.uspto.gov/TrialPracticeGuideConsolidated> (“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.”). This proceeding is at an early stage. Patent Owner has not filed a preliminary response, and we have not yet decided whether to institute a trial in the proceeding. In view of the early stage of the proceeding and the settlement between the Parties, we determine that granting the Parties’ Joint Motion will lead to a “just, speedy, and inexpensive resolution” in this proceeding. 37 C.F.R. § 42.1(b). Accordingly, we terminate the instant proceeding.

The Parties also filed a Joint Request that the Settlement Agreement be treated as business confidential information and be kept separate from the file of the patent involved in this proceeding. Paper 7. We determine that good cause exists to treat the Settlement Agreement between Petitioner and Patent Owner as business confidential information pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

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

ORDER

Accordingly, for the reasons discussed above, it is:

ORDERED that the Joint Motion to Terminate (Paper 6) is granted, the proceeding is terminated; and

FURTHER ORDERED that the Joint Request (Paper 7) to Treat the Settlement Agreement (Exhibit 2001) as Business Confidential Information is granted, and the Settlement Agreement shall be kept separate from the file of Patent 9,366,402 B2, and made available only to Federal Government agencies on written request, or to any person on a showing of good cause, pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

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