

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

OWENS CORNING ROOFING & ASPHALT, LLC,
Petitioner,

v.

KIRSCH RESEARCH AND DEVELOPMENT, LLC,
Patent Owner.

IPR2020-01389
Patent 6,308,482 B1

Before CHARLES J. BOUDREAU, JOHN D. HAMANN, and
KRISTI L. R. SAWERT, *Administrative Patent Judges*.

BOUDREAU, *Administrative Patent Judge*.

TERMINATION
Due to Settlement After Institution of Trial
35 U.S.C. § 317, 37 C.F.R. § 42.74

On February 18, 2021, we instituted an *inter partes* review of claims 1–34 of U.S. Patent No. 6,308,482 B1 (“the ’482 patent”). Paper 11. On November 9, 2021, with our authorization, Petitioner Owens Corning Roofing & Asphalt, LLC and Patent Owner Kirsch Research and Development, LLC (collectively, “the Parties”) filed a Joint Motion to Terminate IPR pursuant to 35 U.S.C. § 317(a) and 37 CFR §§ 42.72, 42.74. Paper 30 (“Mot.” or “Motion”). The Motion was accompanied by a copy of an agreement (Ex. 2019) that the Parties represent to be a true copy of the settlement agreement that resolves the disputes between them in this proceeding (Mot. 1), and a Joint Submission of Confidential Settlement Agreement Under 35 U.S.C. § 317 (Paper 31), requesting that Exhibit 2019 be treated as business confidential information and kept separate “from the files of this proceeding and the files of this IPR,” pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).¹

The Parties represent in the Motion that they have settled their dispute and have agreed to request termination of this proceeding and that they also would be voluntarily dismissing district court litigation involving the

¹ Because the cited statute and rule provide for agreements and understandings made in connection with or in contemplation of termination of an *inter partes* review to be kept separate “from the file of the involved patents,” rather than from the files of the “proceeding[]” or the “IPR,” we understand the parties’ request as a request to keep Exhibit 2019 separate from the file of the ’482 patent, rather than from the file of this proceeding. Paper 31 at 1; *see also* Mot. 1 (“Pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c), Kirsch and Owens Corning are concurrently filing a Submission of Confidential Settlement Agreement, which asks the Board to treat the settlement agreement as business confidential information, and to keep it separate from *the files of this proceeding and the files of the Patent-in-Suit.*” (emphasis added)).

'482 patent no later than November 10, 2021. Mot. 1–2. The parties also represent that, as required under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b), they have filed a true copy of their settlement agreement and that there are no other collateral agreements between them made in connection with, or in contemplation of, the termination sought. The parties further contend that termination is proper in view of the parties' joint request, arguing that, although briefing is complete, oral hearing in the proceeding will not be held until December 1, 2021, and a motion to strike filed by Petitioner remains pending; that Petitioner is the only petitioner in this proceeding and will not be participating further in the proceeding; and that “the Office has not yet, to the knowledge of the parties, ‘decided the merits of the proceeding.’” *Id.* at 2–3 (quoting 35 U.S.C. § 317(a)).

The Board generally expects that a case “will terminate after the filing of a settlement agreement, unless the Board has already decided the merits.” Patent Trial and Appeal Board Consolidated Trial Practice Guide 86 (Nov. 2019), *available at* <https://www.uspto.gov/sites/default/files/documents/tpgnov.pdf>; *see* 37 C.F.R. § 42.72. In this case, as noted by the parties, oral hearing has not yet been held and the Board has not yet decided the merits of the proceeding. Under the circumstances presented here, and in view of the parties' representations, we determine that it is appropriate to terminate this proceeding with respect to all parties. Accordingly, we grant the parties' Motion.

We also determine that the parties have complied with the requirements of 37 C.F.R. § 42.74(c) to have their settlement agreement treated as business confidential information. Thus, we also grant the parties' joint request to treat the agreement as business confidential information and

order that the agreements be kept separate from the patent files of the challenged patent.

Accordingly, it is

ORDERED that the parties' Joint Motion to Terminate IPR is granted;

FURTHER ORDERED that this proceeding is accordingly terminated as to all parties pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. §§ 42.72 and 42.74;

FURTHER ORDERED that the parties' joint request to treat their settlement agreement as business confidential information is granted; and

FURTHER ORDERED that Exhibit 2019 is accordingly to be kept separate from the file of the involved U.S. Patent No. 6,308,482 B1 under the provisions of 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

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