

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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BRUNSWICK CORPORATION,  
Petitioner,

v.

VOLVO PENTA OF THE AMERICAS, LLC,  
Patent Owner.

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IPR2020-01512  
Patent 9,630,692 B2

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Before JAMES J. MAYBERRY, ERIC C. JESCHKE, and  
FREDERICK C. LANEY, *Administrative Patent Judges*.

JESCHKE, *Administrative Patent Judge*.

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

After the Board issued a Final Written Decision in this proceeding, Patent Owner, Volvo Penta of the Americas, LLC, filed a notice of appeal. *See* Paper 95; *see also* Papers 87 & 94 (confidential and public versions, respectively, of the Final Written Decision).

In its decision, the United States Court of Appeals for the Federal Circuit (1) determined substantial evidence supported the Board’s determination that Petitioner had shown a motivation to combine Brandt and Kiekhäfer, (2) determined substantial evidence did not support the Board’s finding that Patent Owner had not shown a nexus between the challenged claims and the evidence of objective indicia, and (3) vacated the Final Written Decision and remanded for the Board to reassess obviousness in view of the guidance provided regarding the evidence of objective indicia of nonobviousness. *See Volvo Penta of the Ams., LLC v. Brunswick Corp.*, 81 F.4th 1202 (Fed. Cir. 2023); *see also* Paper 98 (copy of the Federal Circuit’s decision). The mandate issued on October 17, 2023. *See* Paper 97.

On October 18, 2023, the Board issued an order requesting input from the parties on the procedures following remand from the Federal Circuit. *See* Paper 96. On October 26, 2023, the parties contacted the Board to seek authorization to file a joint motion to terminate and a joint request to file a settlement agreement as business confidential information. *See* Ex. 3009 at 1–2. The Board authorized the filings (*see id.* at 1), and the parties timely filed the pending documents: (1) a Joint Motion to Terminate (Paper 99, “the Motion” or “Mot.”); (2) a Joint Request to File Settlement Agreement as Business Confidential Information (Paper 100, “the Request” or “Req.”); and (3) a true copy of the written settlement agreement made in connection with the termination of this proceeding (Ex. 2062, “the Settlement

Agreement”). For the reasons below, we grant the Motion and the Request, and we *terminate* this proceeding.

### DISCUSSION

Under 35 U.S.C. § 317(a), an instituted *inter partes* review “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.” In this proceeding, we instituted *inter partes* review and issued a Final Written Decision, but that Final Written Decision has since been vacated. *See* Papers 97 & 98. We have not decided the merits on remand from the Federal Circuit. Thus, we must terminate with respect to Petitioner. No other petitioner remains in this proceeding.

Section 317(a) also provides that, “[i]f no petitioner remains in the *inter partes* review, the Office may terminate the review or proceed to a final written decision under section 318(a).” The Board, therefore, has discretion to terminate this proceeding with respect to Patent Owner.

In the Motion, the parties state that they have settled their disputes and have reached a written agreement that resolves the disputes in this proceeding as well as the disputes in all other matters between the parties relating to the patent involved in this proceeding. Mot. 2–4; *see* 35 U.S.C. § 317(b) (requiring that “[a]ny agreement or understanding between the patent owner and a petitioner . . . made in connection with, or in contemplation of, the termination of an *inter partes* review . . . shall be in writing”). In support of the Motion, the parties submitted a true copy of the Settlement Agreement. *See* Ex. 2062. The parties certify that there are no

other written or oral agreements, including any collateral agreements, between the parties, that are made in connection with, or in contemplation of, the termination of the proceedings. Mot. 4; *see* 35 U.S.C. § 317(b).

Upon consideration of the Motion and the circumstances here, and even though the proceeding has moved beyond the preliminary stage, we determine that it is appropriate to terminate this proceeding without rendering a final written decision on remand. *See* 35 U.S.C. § 317(a); 37 C.F.R. § 42.72 (“The Board may terminate a trial without rendering a final written decision, where appropriate, including where the trial is consolidated with another proceeding or pursuant to a joint request under 35 U.S.C. 317(a) . . . .”); *see also* *See Consolidated Trial Practice Guide* 86 (Nov. 2019), <https://www.uspto.gov/TrialPracticeGuideConsolidated> (“There are strong public policy reasons to favor settlement between the parties to a proceeding. . . . 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.”); Mot. 3 n.1 (citing Board cases granting motions to terminate following remand).

The parties also request that the Settlement Agreement (1) “be filed as business confidential information” and (2) “be kept separate from the file of the patent involved in the *inter parties* review and be made available only on the showing of good cause or to Federal Government agencies on a written request.” Req. 2; *see* Mot. 4 (similar). After reviewing the Settlement Agreement between Petitioner and Patent Owner, we find that the Settlement Agreement contains confidential business information regarding the terms of settlement. We thus grant the parties’ Request.

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

It is hereby:

ORDERED that the Joint Motion to Terminate is *granted*;

FURTHER ORDERED that the Joint Request to treat the Settlement Agreement as business confidential information is *granted*; and

FURTHER ORDERED that the Settlement Agreement shall be kept separate from the file of the involved patent, and made available only to federal government agencies on written request, or to any person on a showing of good cause (35 U.S.C. § 317(b); 37 C.F.R. § 42.74(c)); and

FURTHER ORDERED that this *inter partes* reviews is hereby *terminated* (35 U.S.C. § 317(a); 37 C.F.R. § 42.72).

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