

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NEXTIER OILFIELD SOLUTIONS INC.,
Petitioner,

v.

NEXUS PERFORATING LLC,
Patent Owner.

IPR2021-00082
Patent 10,352,136 B2

Before JAMES A. WORTH, SCOTT C. MOORE, and ERIC C. JESCHKE,
Administrative Patent Judges.

MOORE, *Administrative Patent Judge.*

TERMINATION
Due to Settlement After Institution of Trial
35 U.S.C. § 317(a),(b); 37 C.F.R. §§ 42.72, 42.74

I. INTRODUCTION

With the Board's prior authorization, Petitioner Nextier Oilfield Solutions, Inc. and Patent Owner Nexus Perforating LLC (collectively "the Parties") filed a Joint Motion to Terminate Proceeding Pursuant to 35 U.S.C. § 317. *See* Paper 38 ("Motion"). The Parties also filed a true copy of a Settlement and License Agreement (Ex. 2037, "Settlement Agreement") and an Unopposed Motion to File Settlement Agreement as Business Confidential Information and to Keep Separate Pursuant to 35 U.S.C. § 317 and 37 C.F.R. § 42.74. *See* Paper 39 ("Request").

II. DISCUSSION

The Motion states that the Parties "jointly request termination of the *Inter Partes* Review of U.S. Pat. No. 10,352,136 Case No. IPR2021-00082." Motion i. According to the Motion, "[o]n Jan. 20, 2022, the Parties settled their dispute and reached agreement to terminate this IPR," a "settlement agreement between the parties was made in writing," and "a true and correct copy is attached as Exhibit 2037." *Id.* at i, 1. The Motion further states that "[t]ermination is appropriate with respect to the parties" because "this joint request for termination is being filed before any known decision has been made on the merits," "the parties have settled their dispute," and "all judicial or administrative matters that would affect or be affected by a decision in this proceeding are also settled." *Id.* at 1.

Generally, 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. PTAB Consolidated Trial Practice Guide, 86

(November 2019).¹ Here, although the Board has instituted *inter partes* review of the challenged patent, the Board has not decided the merits of the proceeding. Under these circumstances, we grant the Motion to terminate.

Patent Owner also “requests to file the settlement agreement between the parties . . . as business confidential information in IPR2021-00082,” and “that the settlement be kept separate from the file of these proceedings and the involved patent” “[b]ecause the settlement agreement has a confidentiality provision that requires the parties to keep the agreement’s material terms confidential.” Request 1. Accordingly, Patent Owner “request[s] that the Board not make the confidential Settlement Agreement (Exhibit 1) available to any third party, except as provided in 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).” *Id.* Patent Owner states that “Petitioner Nextier Oilfield Solutions, Inc. does not oppose this request.” *Id.* at 1–2.

After reviewing the Settlement Agreement between the Parties, we find that the Settlement Agreement contains confidential business information regarding the terms of settlement. Thus, we determine that good cause exists to treat the Settlement Agreement (Ex. 2037) between the Parties as business confidential information under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c), to keep it separate from the files of the involved patent and associated proceeding, and to limit its availability as requested by the Parties.

¹ Available at <https://www.uspto.gov/TrialPracticeGuideConsolidated>.

III. ORDER

In view of the foregoing, it is:

ORDERED that the Joint Motion to Terminate Proceeding Pursuant to 35 U.S.C. § 317 is *granted*, and this proceeding is *terminated* as to all parties;

FURTHER ORDERED that the Unopposed Motion to File Settlement Agreement as Business Confidential Information and to Keep Separate Pursuant to 35 U.S.C. § 317 and 37 C.F.R. § 42.74 is *granted*; and

FURTHER ORDERED that the Settlement Agreement remain designated as “Parties and Board Only” in the Board’s electronic filing system, be kept separate from the files of U.S. Patent No. 10,352,136 B2, and be made available only under the provisions of 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

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