

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

IN-DEPTH GEOPHYSICAL, INC. AND
IN-DEPTH COMPRESSIVE SEISMIC, INC.,
Petitioner,

v.

CONOCOPHILLIPS COMPANY,
Patent Owner.

Case IPR2021-01010
Patent 10,823,867 B2

Before JAMES A. TARTAL, SCOTT C. MOORE, and
MATTHEW S. MEYERS, *Administrative Patent Judges*.

MOORE, *Administrative Patent Judge*.

DECISION

Settlement Prior to Institution of Trial
35 U.S.C. § 317; 37 C.F.R. §§ 42.5, 42.74, 42.74

Pursuant to our e-mail authorization on December 2, 2021, the parties filed a Joint Motion to Terminate Proceeding (Paper 10, “Motion to Terminate”) and a Joint Motion to Treat Settlement Agreement as Business Confidential and to Keep Separate (Paper 12, “Motion to Keep Separate”). Pursuant to 37 C.F.R. § 42.74(b), the parties also filed a copy of a written settlement agreement. Exhibit 1023.

Under 35 U.S.C. § 317(a), “[a]n inter partes review instituted under this chapter shall be terminated with respect to any petitioner upon the joint request of the petitioner and patent owner, unless the Office has decided the merits of the proceeding before the request for termination is filed.” Where a proceeding is terminated as to the petitioner, “the Office may terminate the review [entirely] or proceed to a final written decision.” 35 U.S.C. § 317(a); *see also* 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) . . .”). Any agreements or understandings 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 and a true copy of such agreement or understanding shall be filed in the Office before the termination.” 35 U.S.C. § 317(b); *see also* 37 C.F.R. § 42.74(b) (“Any agreement or understanding between the parties made in connection with, or in contemplation of, the termination of a proceeding shall be in writing and . . . shall be filed with the Board . . .”).

The parties filed their Motion to Terminate early in this proceeding, before the Board issued an institution decision. Accordingly, termination of this proceeding would avoid unnecessary effort and expense on the part of

Petitioner, Patent Owner, and the Board. The parties state that they “have entered into a written confidential settlement agreement that settles all disputes between them, including those relating to this proceeding.”

Paper 10, 1. The parties represent that Exhibit 1023 is a “true copy of the written settlement agreement, which includes all agreements between the Parties related to this proceeding,” and “certify 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.* at 2.

On this record, we find it appropriate to terminate this proceeding as to both Petitioner and Patent Owner, and grant the Motion to Terminate. 35 U.S.C. § 317(a); 37 C.F.R. §§ 42.5, 42.72. We also find that the parties have complied with 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b), and grant the Motion to Keep Separate. 35 U.S.C. § 317(b); 37 C.F.R. § 42.74(c).

Accordingly, it is:

ORDERED that the Motion to Terminate (Paper 10) is *granted*, and this proceeding is hereby *terminated*; and

FURTHER ORDERED that the Motion to Keep Separate (Paper 12) is *granted*, and Exhibit 1023 shall remain designated as “Parties and Board Only” in the Board’s filing system and be kept separate from the files of the challenged patent pursuant to 37 C.F.R. § 42.74(c).

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