

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ATLAS ROOFING CORPORATION,
Petitioner,

v.

KIRSCH RESEARCH AND DEVELOPMENT, LLC,
Patent Owner.

IPR2021-01181
Patent 6,308,482 B1

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

BOUDREAU, *Administrative Patent Judge*.

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

On June 24, 2021, Atlas Roofing Corporation (“Atlas”) filed a Petition requesting an *inter partes* review of claims 1–34 of U.S. Patent No. 6,308,482 B1 (Ex. 1001, “the ’482 patent”). Paper 1. Along with the Petition, Atlas also filed a Motion for Joinder, seeking to be joined as a party to *GAF Materials LLC v. Kirsch Research & Development, LLC*, IPR2021-00192 (the “GAF IPR”). Paper 3. On November 15, 2021, with our authorization, Atlas and Patent Owner Kirsch Research and Development, LLC (collectively, “the Parties”) jointly filed a Joint Motion to Terminate Proceeding Pursuant to 35 U.S.C. § 317. Paper 8 (“Mot.” or “Motion”). The Motion was accompanied by a copy of an agreement (Ex. 1027) that the Parties represent to be a true copy of a Confidential Settlement Agreement that resolves the disputes between them in this proceeding (Mot. 1), and a Joint Submission of Confidential Settlement Agreement Pursuant to 35 U.S.C. § 317, requesting that Exhibit 1027 be treated as business confidential information and kept separate from “the files of this proceeding and the files of this IPR,” as well as from “the files of the ’482 patent,” citing 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74.¹

The Parties represent in the Motion that they have settled their dispute and have reached an agreement to terminate this proceeding and that

¹ Because the cited statute and rule provide for agreements to be kept separate from the files of “involved patent[,]” rather than from the files of the “proceeding” or the “IPR,” we understand the parties’ request as a request to keep Exhibit 1027 separate from the file of the ’482 patent, rather than from the file of this proceeding. Paper 9 at 1; *see also* Mot. 1–2 (“Pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c), the parties 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 ’482 patent.*” (emphasis added)).

underlying litigation involving the parties to this proceeding has already been dismissed with prejudice, with a Final Judgment having been entered on November 15, 2021. Mot. 1–2, 4 (citing Ex. 1028 (Order, *Kirsch Research & Dev., LLC v. Atlas Roofing Corp.*, No. 5:20-cv-00055-RWS (E.D. Tex. Nov. 15, 2021), ECF No. 53)). The parties also represent that, as required under 37 C.F.R. § 42.74(b), they have filed a true copy of their settlement agreement. *Id.* at 1. The parties further contend that termination is proper in view of the parties’ joint request, arguing that, no decision on the merits has been made, and indeed, neither a decision on institution nor a decision on Atlas’s motion for joinder has yet been issued; that no petitioner would remain in this proceeding, in which Atlas will no longer be participating, after termination with respect to Atlas; and that no litigation or proceeding between the parties involving the ’482 patent or any related patent is contemplated in the foreseeable future. *Id.* at 2–3, 6.

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. The present proceeding is in a preliminary stage. As noted by the parties, the Board has not issued a decision on institution or a decision on Atlas’s motion for joinder. At this early stage, we determine that termination is warranted for the reasons stated in the Motion.

We further 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 file of the '482 patent.

Accordingly, it is

ORDERED that the parties' Joint Motion to Terminate is granted, and this proceeding is hereby terminated; and

FURTHER ORDERED that the parties' joint request to treat their settlement agreement as business confidential information is granted, and Exhibit 1027 is accordingly to be kept separate from the file of the '482 patent, consistent with 37 C.F.R. § 42.74(c).

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¹ Atlas Roofing Corporation has been joined as a petitioner in this proceeding based on a petition and motion for joinder filed in IPR2021-01181.