Trials@uspto.gov
571-272-7822

Paper 9
Entered: February 23, 2022

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NV5, INC.,
Petitioner,

v.

TERRACON CONSULTANTS, INC.,
Patent Owner.

IPR2021-01508 (Patent 7,533,505 B2)
IPR2021-01509 (Patent 7,618,217 B2)
IPR2021-01510 (Patent 7,707,797 B2)[1]

Before MICHAEL L. WOODS, ERIC C. JESCHKE, and PAUL J. KORNICZKY, *Administrative Patent Judges*.

JESCHKE, *Administrative Patent Judge*.

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

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[1] Because this Order addresses issues common to all three proceedings, we issue one Order to be entered in each proceeding. The parties are not authorized to use this caption.

BACKGROUND

On September 10, 2021, Petitioner, NV5, Inc., filed three petitions to institute *inter partes* review of certain claims in three different patents owned by Patent Owner, Terracon Consultants, Inc. IPR2021-01508, Paper 2[2]; IPR2021-01509, Paper 2; IPR2021-01510, Paper 2. Patent Owner timely filed Preliminary Responses in each proceeding. Paper 8.[3]

On February 22, 2022, with the Board's prior authorization (Ex. 3001), the parties filed, in each proceeding, a Joint Motion to Dismiss Petition for *Inter Partes* Review (Paper 9 (the "Motion" or "Mot.")) and a Joint Request to Keep Separate (Paper 10 (the "Request" or "Req.")). Upon consideration of the arguments presented and for the reasons below, we *grant* the Motions, *grant* the Requests, and *terminate* the proceedings.

DISCUSSION

Joint Motions to Dismiss

Under the applicable regulations, the parties may agree to settle any issue in a proceeding.[4] 37 C.F.R. § 42.74(a) (2021). In addition, "[a]ny agreement or understanding between the parties made in connection with, or

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[2] Petitioner filed corrected Petitions in IPR2021-01508 (Paper 6) and IPR2021-01510 (Paper 6), both on December 16, 2021.

[3] Similar papers were filed in each proceeding. For the remainder of this Order, we cite to papers in IPR2021-01508 only.

[4] We construe the Joint Motions to Dismiss Petitions as Joint Motions to Terminate. *Compare* 37 C.F.R. § 42.71(a) (discussing dismissing petitions), *with* 37 C.F.R. § 42.74 (discussing terminating proceedings due to settlement).

in contemplation of, the termination of a proceeding shall be in writing and a true copy shall be filed with the Board before the termination of the trial." 37 C.F.R. ¶ 42.74(b).

The parties state that each of these proceedings is "in its preliminary stage and the Board has not rendered a decision on institution." Mot. 2.[5] The parties contend that it is appropriate to grant the Motions "at this early juncture, to preserve the Board's and parties' resources and promote a speedy and inexpensive resolution to this dispute." Mot. 2–3 (citing *Samsung Elecs. Co. v. NVIDIA Corp.*, IPR2015-01270, Paper 11 at 3 (PTAB Dec. 9, 2015)). The parties also state that they have settled their disputes and have reached a written agreement that resolves the disputes in these proceedings and that the parties are currently seeking dismissal of the related district court litigation. Mot. 1–3; *see also* Ex. 1100, Ex. B (stipulation for the district court). In support, the parties submitted in each proceeding a true copy of the Settlement Agreement. *See* Ex. 1100. 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. 1.

Because the parties have satisfied the requirements to terminate the proceedings based on settlement, we *grant* the Motions and *terminate* the proceedings.[6]

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[5] The Motions and the Requests lack page numbering; we begin numbering each on the first page of substantive text.

[6] This paper does not constitute a final written decision under 35 U.S.C. § 318(a).

Joint Requests to Keep Separate

As part of the pending filings, the parties also request that the Board

> (i) treat the settlement agreement as business confidential information; (ii) keep the settlement agreement separate from the files of th[ese] proceeding[s] and the files of the [the challenged patents]; (iii) keep the settlement agreement confidential from any third party; and (iv) make the settlement agreement "available only to Federal Government agencies on written request, or to any person on a showing of good cause" in accordance with 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74.

Req. 1. We *grant* the parties' joint request.

ORDER

Accordingly, it is hereby:

ORDERED that the Joint Motions to Dismiss Petition for *Inter Partes* Review in each of these three proceedings are *granted*;

FURTHER ORDERED that the Joint Requests to Keep Separate are *granted*;

FURTHER ORDERED that the Settlement Agreement (e.g., IPR2021-01508, Ex. 1100) (1) shall be treated as business confidential information; (2) shall be kept separate from the files of U.S. Patent No. 7,533,505 B2, U.S. Patent No. 7,618,217 B2, and U.S. Patent No. 7,707,797 B2; and (3) shall be made available only to Federal Government agencies on written request to the Board, or to any person on a showing of good cause; and;

FURTHER ORDERED that the proceedings are *terminated*.

IPR2021-01508 (Patent 7,533,505 B2)
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IPR2021-01510 (Patent 7,707,797 B2)

FOR PETITIONER:

Christopher Tyson
Patrick D. McPherson
Paul H. Belnap
DUANE MORRIS LLP
cjtyson@duanemorris.com
pdmcpherson@duanemorris.com
phbelnap@duanemorris.com

FOR PATENT OWNER:

Colin W. Turner
James J. Cronin
Jonathan Pollmann
STINSON LLP
colin.turner@stinson.com
james.cronin@stinson.com
jonathan.pollmann@stinson.com