

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

DAYUS REGISTER & GRILLE, INC.,
Petitioner,

v.

INV HOLDINGS INC.,
Patent Owner.

IPR2022-01472
Patent 9,765,988 B2

Before KEVIN W. CHERRY, JAMES J. MAYBERRY, and
CYNTHIA L. MURPHY, *Administrative Patent Judges*.

MURPHY, *Administrative Patent Judge*.

TERMINATION

Due to Settlement After Institution of Trial and
Granting Request to File Settlement Agreement
as Business Confidential Information
35 U.S.C. § 317; 37 C.F.R. § 42.74

I. INTRODUCTION

On August 7, 2023, with the Board’s authorization, Petitioner and Patent Owner (collectively, “the Parties”) filed a Joint Motion to terminate the above-captioned *inter partes* review proceeding. Paper 10 (“Joint Motion”). Along with the Joint Motion, the Parties filed a copy of a Perpetual Covenant Not to Sue and Settlement Agreement. Ex. 1031 (“Settlement Agreement”). The Parties jointly request to file the Settlement Agreement as business confidential information and keep it separate from the file of U.S. Patent No. 9,765,988 B2 (“the ’988 patent”). Paper 11 (“Joint Request”).

II. DISCUSSION

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 the patent owner, unless the Office has decided the merits of the proceeding before the request for termination is filed.” 35 U.S.C. § 317(a) also provides that if no petitioner remains in the *inter partes* review, the Office may terminate the review.

In the Joint Motion, the Parties represent that the Settlement Agreement resolves their disputes involving the ’988 patent. Joint Motion 3.¹ The Parties also represent that they have filed a true and correct copy of the Settlement Agreement (*id.* at 2) and that “[t]here are no other collateral agreements between the parties made in connection with, or in contemplation of, the termination sought” (*id.* at 3). The Settlement Agreement states that it “constitutes and contains the entire agreement

¹ The Joint Motion (Paper 10) does not include page numbers. We consider the title page as page 1 and then proceed from there in numerical order.

between INV-AAG and Dayus, and supersedes any and all prior negotiations, conversations, correspondence, understandings, and letters respecting the subject matter hereof.” Ex. 1031, 5.

We instituted trial for the above-identified *inter partes* review proceeding on March 6, 2023. *See* Paper 6. We have not yet decided the merits of the proceeding, and a final written decision has not been entered. Notwithstanding that the proceeding has moved beyond the preliminary stage, the Parties have shown adequately that termination of the proceeding is appropriate. Under these circumstances, we determine that good cause exists to terminate the proceeding with respect to the Parties.

The Parties jointly request that the Settlement Agreement be treated as business confidential information and kept separate from the file of the ’988 patent. Joint Request 2.² After reviewing the Settlement Agreement, we find that it contains confidential business information regarding the terms of settlement. Thus, good cause exists to treat the Settlement Agreement as business confidential information pursuant to 37 C.F.R. § 42.74(c).

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

III. ORDER

Accordingly, it is:

ORDERED that the Joint Motion to terminate (Paper 10) is *granted*, and IPR2022-01472 is *terminated* with respect to Petitioner and Patent Owner; and

² The Joint Request (Paper 11) does not include page numbers. We consider the title page as page 1 and then proceed from there in numerical order.

FURTHER ORDERED that the Parties' joint request to treat the Settlement Agreement as business confidential information (Paper 11) is *granted*, and the Settlement Agreement (Ex. 1031) shall be kept separate from the file of U.S. Patent No. 9,765,988 B2, and made available only to Federal Government agencies on written request, or to any person on a showing of good cause, pursuant to 37 C.F.R. § 42.74(c).

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