

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SKYWALKER HOLDINGS, LLC
Petitioner,

v.

BOARD & BATTEN INTERNATIONAL INC.
Patent Owner.

IPR2023-00350
Patent 7,854,687 B2

Before WILLIAM V. SAINDON, KEVIN W. CHERRY, 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 November 6, 2023, Petitioner and Patent Owner (collectively, “the Parties”) filed a Joint Motion to terminate the above-captioned *inter partes* review proceeding. Paper 13 (“Joint Motion”). Along with the Joint Motion, the Parties filed a copy of a Confidential Settlement and License Agreement. Ex. 1015 (“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. 7,854,687 B2 (“the ’687 patent”). Paper 14 (“Joint Request”).

I. 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 ’687 patent. Joint Motion 2.¹ The Parties also represent that they have filed a true and correct copy of the Settlement Agreement (*id.* at 3) and that “[t]here are no other agreements or understandings between” the Parties “made in connection with, or in contemplation of, the termination of the instant *inter partes*

¹ The Joint Motion (Paper 13) does not include page numbers. We consider the title page as page 1 and then proceed from there in numerical order.

review” (*id.* at 3). The Settlement Agreement states that it “embodies the entire understanding of the Parties and shall supersede all previous communications, representations or understandings, either oral or written, between the Parties relating to the subject matter hereof.” Ex. 1015 ¶ 11.7.

We instituted trial for the above-identified *inter partes* review proceeding on July 18, 2023. *See* Paper 10. In view of settlement discussions, the Parties provided notice of an amended schedule on October 4, 2023. *See* Paper 12. 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 ’687 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).

II. ORDER

B. Accordingly, it is:

ORDERED that the Joint Motion to terminate (Paper 13) is *granted*,

² The Joint Request (Paper 14) does not include page numbers. We consider the title page as page 1 and then proceed from there in numerical order.

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and IPR2023-00350 is *terminated* with respect to Petitioner and Patent Owner; and

FURTHER ORDERED that the Parties' joint request to treat the Settlement Agreement as business confidential information (Paper 14) is *granted*, and the Settlement Agreement (Ex. 1015) shall be kept separate from the file of U.S. Patent No. 7,854,687 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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