Trials@uspto.gov
571-272-7822

Paper 9
Entered: April 12, 2023

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AMAZON.COM, INC. and AMAZON.COM SERVICES LLC,
Petitioners,

v.

COUNTERFLO AB,
Patent Owner.

IPR2023-00362
Patent 8,791,829 B2

Before ST. JOHN COURTENAY III, PATRICK M. BOUCHER, and STACEY G. WHITE, *Administrative Patent Judges*.

COURTENAY, *Administrative Patent Judge*.

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

With our authorization, Amazon.com, Inc. and Amazon.com Services LLC (collectively "Petitioner") and Patent Owner Counterflo AB ("Patent Owner") (collectively, the "Parties") filed a Joint Motion to Terminate this

proceeding. Paper 7. The Parties assert that "[o]n March 1, 2023, the parties entered into a settlement agreement to resolve their disputes regarding U.S. Patent No. 8,791,829, including an agreement to terminate this inter partes review." *Id.* at 1–2. The Parties direct us to their Confidential Settlement Agreement, filed as confidential Exhibit 1028, which we have reviewed.

The Parties further state:

> On March 2, 2023, the Parties filed a joint motion to dismiss Patent Owner's patent infringement lawsuit against Petitioner, with Patent Owner's claims dismissed with prejudice and Petitioner's defenses dismissed without prejudice. An amended order to this effect was issued on March 7, 2023. Order, 2:22-cv-00050- JRG-RSP, ECF No. 63. Also on March 7, 2023, the Parties[] contacted the Board by email seeking permission to file this motion and a corresponding request to treat Confidential Exhibit 1028 as business confidential information. The Board authorized these filings in a responsive email on March 29, 2023. There is no litigation contemplated between Patent Owner and Petitioner in view of the settlement agreement.

Paper 7, 2. The Parties represent that "[t]here are no other agreements or understandings, oral or written, between the Parties made in connection with, or in contemplation of, the termination of the Proceeding." *Id.* at 3.

In a separate paper (Paper 8), the Parties also jointly request that the Board treat Exhibit 1028 as "confidential business information," and keep it "separate from the publicly available file of the involved patent." Paper 8, 1.

The Board has not yet decided whether to institute a trial, and we determine that good cause exists to dismiss the Petition (Paper 2) and to

terminate the preliminary proceeding. *See* 37 C.F.R. § 42.74. After reviewing the Parties' settlement agreement, we find that the settlement agreement contains confidential business information regarding the terms of settlement, and we determine that good cause exists to treat the settlement agreement as business confidential information. *See id.* But we deny the portion of the Parties' request that "they be notified if and when the Board receives and/or considers a request for access to Confidential Exhibit 1028 and be offered an opportunity to respond" because our regulations do not contemplate such a practice. *See* Paper 8, 1.

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

It is

ORDERED that the Joint Motion to Terminate is *granted*;

FURTHER ORDERED that the Petition (Paper 1) is *dismissed* and the preliminary proceeding is *terminated*; and

FURTHER ORDERED that Exhibit 1028 be treated as business confidential information pursuant to 37 C.F.R. § 42.74(c) and also remain designated as available only to "Parties and Board" in the Board's P-TACTS system.

IPR2023-00362
Patent 8,791,829 B2

PETITIONER:

John D. Vandenberg
Tucker Mottl
Andrew Mason
KLARQUIST SPARKMAN, LLP
john.vandenberg@klarquist.com
tucker.mottl@klarquist.com
Andrew.mason@klarquist.com

PATENT OWNER:

Jeffrey Mann
Ryan J. Singer
STROOCK & STROOCK & LAVAN LLP
jmann@stroock.com
rsinger@stroock.com