

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

VOLUME DISTRIBUTORS INC.,
Petitioner,

v.

SIMPLEHUMAN LLC,
Patent Owner.

IPR2024-00050
Patent 10,683,165 B2

Before JAMESON LEE, KARL D. EASTHOM, and
KRISTEN DROESCH, *Administrative Patent Judges*.

LEE, *Administrative Patent Judge*.

TERMINATION
Due to Settlement After Institution of Trial
35 U.S.C. § 317; 37 C.F.R. § 42.74

I. INTRODUCTION

On August 6, 2024, Petitioner Volume Distributors Inc. and Patent Owner Simplehuman LLC filed a Joint Motion to Terminate (“Joint Motion”) to terminate this proceeding “in light of the parties’ settlement of their disputes regarding the involved U.S. Patent No. 10,683,165.” Paper 18. With the Joint Motion, Petitioner and Patent Owner filed Exhibit 2001 which is stated as “a true copy of any and all agreements made in connection with or in contemplation of the requested termination, including collateral agreements.” *Id.* at 1.

Petitioner and Patent Owner also filed, on August 6, 2024, a Joint Request to File Settlement Agreement as Business Confidential Information and to Keep Separate from the Patent Files Pursuant to 35 U.S.C. § 317 and 37 C.F.R. § 42.74 (“Request to Keep Confidential”), which refers to Exhibit 2001 as the confidential settlement agreement (hereinafter “Settlement Agreement”). Paper 19, 1.¹

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.” Prior to termination, the parties must file a true copy of “[a]ny agreement or understanding between the patent owner and a petitioner, including any

¹ The Request to Keep Confidential misstates 37 C.F.R. § 42.74(c) as referring to access simply by written request from “Federal Government agencies,” whereas the rules refers, instead, to access by written request from “a Government agency.” Paper 19, 1. We understand the rule as it actually states, not as incorrectly stated by the parties.

collateral agreements referred to in such agreement or understanding, made in connection with, or in contemplation of, the termination of an inter partes review.” 35 U.S.C. § 317(b).

The Joint Motion states that “all disputes between the Parties regarding U.S. Patent No. 10,683,165 have been resolved.” Paper 18, 1. The Joint Motion further states that Exhibit 2001 contains “a true copy of any and all agreements made in connection with or in contemplation of the requested termination, including collateral agreements.” *Id.* The Joint Motion additionally states that “[t]he parties further certify that there are no other collateral agreements in connection with the settlement.” *Id.*

The Board generally expects that a case “will terminate after the filing of a settlement agreement, unless the Board has already decided the merits.” *Consolidated Trial Practice Guide*, 86 (Nov. 2019) (“Consolidated TPG”)²; *see also* 35 U.S.C. § 317(a); 37 C.F.R. § 42.72. The Board has not decided the merits of these proceedings. Patent Owner has not yet filed its Patent Owner Response. Nor has an oral hearing been held. Under the circumstances present here, it is appropriate to terminate the instant proceeding. *See* 35 U.S.C. § 317(a); 37 C.F.R. §§ 42.72(a), 42.72(b), 42.74.

Further, we find that the Settlement Agreement (Exhibit 2001) contains confidential business information regarding the terms of settlement. We determine that good cause exists to treat the Settlement Agreement as business confidential information and to keep it separate from the file of U.S. Patent No. 10,683,165 B2 pursuant to 37 C.F.R. § 42.74(c).

² Available at <https://www.uspto.gov/TrialPracticeGuideConsolidated>.

III. ORDER

For the reasons discussed above, it is

ORDERED that the Joint Motion is *granted* and this proceeding is hereby terminated as to both Petitioner and Patent Owner;

FURTHER ORDERED that the Request to Keep Confidential is *granted*, and that the Settlement Agreement (Exhibit 2001) shall be kept separate from the file of U.S. Patent No. 10,683,165 B2, and made available only to a Government agency on written request, or to any person on a showing of good cause, pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

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For PETITIONER:

Qi (Peter) Tong
James Milkey
Russ, August & Kabat
ptong@raklaw.com
lruss@raklaw.com
pkroegere@raklaw.com
rak_volumedistributors@raklaw.com

For PATENT OWNER:

Ali S. Razai
Matthew S. Bellinger
Benjamin B. Anger
Christian D. Boettcher
2azr@knobbe.com
2msb@knobbe.com
2bba@knobbe.com
2cdb@knobbe.com