

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FOIL BOARDING COMPANY, INC. and
BOMBARDIER RECREATIONAL PRODUCTS, INC.,
Petitioner,

v.

MHL CUSTOM, INC.,
Patent Owner.

IPR2024-00085¹ (Patent No. 9,586,659 B2)
IPR2024-00086² (Patent No. 9,359,044 B2)³

Before BART A. GERSTENBLITH, KEVIN W. CHERRY, and
MICHAEL L. WOODS, *Administrative Patent Judges*.

CHERRY, *Administrative Patent Judge*.

TERMINATION
Due to Settlement After Institution of Trial
Only as to Foil Boarding Company, Inc.
35 U.S.C. § 317; 37 C.F.R. § 42.74

¹ Bombardier Recreational Products Inc., who filed a petition in IPR2024-01107, is joined as petitioner in this proceeding.

² Bombardier Recreational Products Inc, who filed a petition in IPR2024-01108, is joined as petitioner in this proceeding.

³ The Board is entering the same Order in all captioned cases. The parties are not authorized to use this caption.

I. DISCUSSION

Petitioner Foil Boarding Company, Inc. (“Foil Boarding”) and Patent Owner MHL Custom, Inc. (“MHL”) filed (1) a Joint Motion to Terminate Foil Boarding as Petitioner (Paper 30 (“Mot.”)) based on a settlement agreement between those entities, (2) a true copy of their written settlement agreement (Ex. 1025), and (3) a Joint Request to Treat Exhibit 1025 as Business Confidential Information (Paper 31) in each of the above-identified proceedings.⁴ Foil Boarding and MHL indicate that they have settled all the disputes in these proceedings and jointly move to terminate the proceedings as to Foil Boarding. Mot. 3. The parties filed what they represent is a true and correct copy of their written settlement agreement and indicate that it resolves these proceedings. *Id.*

Generally, the Board expects that a proceeding will terminate with respect to a petitioner after the filing of a settlement agreement. *See* 35 U.S.C. § 317(a) (“An 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.”); *see also* 37 C.F.R. § 42.72 (“The Board may terminate a trial without rendering a final written decision, where appropriate, including . . . pursuant to a joint request under 35 U.S.C. 317(a)”); *see also* Patent Trial and Appeal Board Consolidated Trial Practice Guide at 86 (Nov. 2019)⁵ (“The Board expects that a proceeding will terminate after the filing of a settlement agreement,

⁴ The paper and exhibit numbers for these documents are the same in each proceeding.

⁵ *Available at* <https://www.uspto.gov/TrialPracticeGuideConsolidated>.

unless the Board has already decided the merits of the proceeding.” (citing 35 U.S.C. §§ 317(a), 327)). Here, the merits of the proceedings have not yet been decided. Accordingly, we are persuaded that, under these circumstances, termination of these proceedings only as to Foil Boarding is appropriate.

Additionally, we grant the Joint Request to Treat Exhibit 1025 as Business Confidential Information. *See* 35 U.S.C. § 317(b) (“At the request of a party to the proceeding, the agreement or understanding shall be treated as business confidential information, shall be kept separate from the file of the involved patents, and shall be made available only to Federal Government agencies on written request, or to any person on a showing of good cause.”); *see also* 37 C.F.R. § 42.74(c) (same).

The parties request that they be notified if and when the Board receives and/or considers a request for access to the settlement agreement and be offered an opportunity to respond to any such request. Paper 31, 2. Such requests, however, are outside the scope of 37 C.F.R. 42.74(c)(2) and are denied.

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

II. ORDER

Accordingly, it is

ORDERED that the Joint Motion to Terminate Foil Boarding as Petitioner (Paper 30) in each proceeding is *granted*;

FURTHER ORDERED that the Joint Request to Treat Exhibit 1025 as Business Confidential Information (Paper 31) in each proceeding is *granted-in-part* and *denied-in-part*, in the manner noted above;

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FURTHER ORDERED that the settlement agreement (Ex. 1025) be treated as business confidential information, kept separate from the files of the above-referenced patents, and made available only to Federal Government agencies 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);

FURTHER ORDERED that these proceedings are terminated only as to Petitioner Foil Boarding; and

FURTHER ORDERED that Petitioner Bombardier Recreational Products, Inc. remains a party in these proceedings.

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