

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HILTI AKTIENGESELLSCHAFT,
Petitioner,

v.

SPECIFIED TECHNOLOGIES INC.,
Patent Owner.

IPR2024-00192 (Patent 9,157,232 B2)
IPR2024-00193 (Patent 10,143,868 B2)¹

Before RICHARD H. MARSCHALL, TIMOTHY G. MAJORS, and
MICHAEL A. VALEK, *Administrative Patent Judges*.

MAJORS, *Administrative Patent Judge*.

DECISION

*Granting Joint Motion to Terminate Proceeding
Due to Settlement After Institution of Trial and
Granting Joint Request to Treat Settlement Agreement as
Business Confidential Information
35 U.S.C. § 317; 37 C.F.R. § 42.74*

¹ This Order applies to all of the captioned proceedings. These cases have not been consolidated or joined. We exercise our discretion to issue one Order to be filed in each case. The parties are not authorized to use this style heading for any subsequent papers.

I. INTRODUCTION

With the Board’s authorization, Petitioner and Patent Owner (collectively referred to as “the Parties”) filed a Joint Motion to Terminate the above-identified *inter partes* review proceedings due to settlement (“Joint Motion”). Paper 21.² In support of the Joint Motion, the Parties filed a Confidential Settlement and Patent License Agreement (Ex. 2009 (“Settlement Agreement”)), as well as a Joint Request to Keep the Settlement Agreement Confidential and Separate pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) (Paper 25 (“Joint Request”)), in each of the above-identified proceedings.

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.”

In the Joint Motion, the Parties represent that they have reached an agreement to jointly seek termination of this *inter partes* review proceeding. Joint Motion 1–3.³ In the Joint Request, the Parties represent that the filed copy of the Settlement Agreement is a true and correct copy. Joint Request 1. The Parties further represent that the Settlement Agreement resolves all currently pending

² For expediency, we cite to the Papers filed in IPR2024-00192, unless otherwise indicated. Similar Papers and Exhibits were filed in IPR2024-00193.

³ The Joint Motion referenced a “confidential binding term sheet,” which had been filed (Ex. 2008) at the same time as the motion, and also stated that the parties intended to memorialize the term sheet “in a formal settlement agreement.” Joint Motion 2. We held a conference call with the parties on July 24, 2024, at which time we instructed the parties to file the formal settlement agreement when it was complete, which the parties have now done, and indicated that we would consider that formal settlement agreement when resolving the Joint Motion.

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Patent Office and District Court proceedings between the Parties involving the above identified patents at issue. Joint Motion 2–3.

We instituted trial on each of the above-identified proceedings on May 14, 2024. Paper 16. We have not yet decided the merits of the proceedings, and final written decisions have not been entered. The proceedings are still at an early stage (e.g., a patent owner response has not yet been filed) and the Parties have shown adequately that termination is appropriate. Under these circumstances, good cause exists to terminate the proceedings with respect to the Parties.

The Parties also filed a Joint Request that the Settlement Agreement be treated as confidential and be kept separate from the file of the respective patents involved in each of the above-identified *inter partes* proceedings. Joint Request 1. After reviewing the Settlement Agreement between Petitioner and Patent Owner, we agree the Settlement Agreement contains confidential business information. We determine that good cause exists to treat the Settlement Agreement between Petitioner and Patent Owner as confidential information pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c). For similar reasons, we also determine that good cause exists to treat as confidential the “Binding Term Sheet” (Ex. 2008) that was filed with the Joint Motion. *See* Paper 22 (requesting the “Binding Term Sheet” be treated as business confidential).

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

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III. ORDER

Accordingly, for the reasons discussed above, it is:

ORDERED that the Joint Motion to Terminate is *granted*, and IPR2024-00192 and IPR2024-00193 are *terminated* with respect to Petitioner and Patent Owner pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. § 42.72; and

FURTHER ORDERED that the Joint Request to Treat the Settlement Agreement as Confidential Information (Papers 22 and 25) are *granted*; the Settlement Agreement (Ex. 2009) as well as the Binding Term Sheet (Ex. 2008) shall be kept separate from the files of Patent 9,157,232 B2 and Patent 10,143,868 B2 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).

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