

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

PROLIME AGRICULTURAL LLC and
CAUDILL SEED AND WAREHOUSE CO., INC.,
Petitioner,

v.

SUL4R-PLUS, LLC,
Patent Owner.

IPR2024-00236
Patent 9,873,638 B2

Before DONNA M. PRAISS and JULIA HEANEY, *Administrative Patent Judges*.

HEANEY, *Administrative Patent Judge*.

DECISION

Settlement Prior to Institution of Trial

Granting-In-Part and *Denying-In-Part* Joint Request to Treat Settlement
Agreement as Business Confidential Information

37 C.F.R. § 42.74

I. INTRODUCTION

On June 10, 2024, with the Board’s authorization, Prolime Agricultural, LLC and Caudill Seed and Warehouse Co., Inc. (“Petitioner”) filed an Unopposed Motion to Dismiss Petition for *Inter Partes* Review due to settlement in the above-identified proceeding challenging U.S. Patent 9,873,638 B2 (“the ’638 Patent”). Paper 19 (“Motion” or “Mot.”). Petitioner represents that Patent Owner Sul4r-Plus, LLC does not oppose the Motion. *Id.* at 2. In support of the Motion, Petitioner filed a copy of a written Settlement and License Agreement. Ex. 1021 (“Settlement Agreement”). Petitioner and Patent Owner (collectively referred to as “the Parties”) also filed a Joint Request That Settlement Agreement Be Treated as Business Confidential Information and Be Kept Separate pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c). Paper 20 (“Joint Request”).

II. DISCUSSION

In the Motion, Petitioner represents that “[t]he parties have entered into a confidential settlement agreement (‘Settlement Agreement’) that will resolve the parties’ instant dispute regarding the challenged ’638 Patent, as well as a lawsuit in the Eastern District of Michigan captioned as *Sulf4r-Plus, LLC v. Prolime Agriculture, LLC* (Civil Action No. 2:22-cv-12798) involving the ’638 Patent.” Mot. 2. Petitioner further represents that “the parties have filed a Stipulation of Dismissal in the aforementioned district court case and anticipate that the lawsuit will be dismissed by the court in the coming days.” *Id.* at 3. Petitioner states that “a true and correct copy [of this Settlement Agreement] shall be filed with this Office as business confidential information pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b)” as “Ex. 1021.” *Id.* at 2. Petitioner also represents that “[t]here are no other agreements, oral or written, between the parties made in

connection with, or in contemplation of, the termination of this proceeding.”
Id. at 2–3.

This proceeding is at an early stage, and we have not yet decided whether to institute a trial in the proceeding. In view of the early stage of the proceeding and the settlement between the Parties, we determine that good cause exists to dismiss the petition and terminate the proceeding with respect to the Parties.

The Parties also filed a Joint Request that the Settlement Agreement be treated as business confidential information and be kept separate from the file of the patent involved in this *inter partes* proceeding. Paper 20, 2. After reviewing the Settlement Agreement between Petitioner and Patent Owner, we find that the Settlement Agreement contains confidential business information regarding the terms of settlement. We determine that good cause exists to treat the Settlement Agreement between Petitioner and Patent Owner as business confidential information, to keep it separate from the file of the involved patent, and to limit its availability pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

In the Joint Request, the Parties request that the Settlement Agreement “shall be . . . only made available to Federal Government agencies upon written request.” Paper 20, 2. The statute provides that “[a]t the request of a party to the proceeding, the agreement or understanding shall be treated as business confidential information, . . . and shall be made available only to Federal Government agencies on written request, or to any person on a showing of good cause.” 35 U.S.C. § 317(b); *see also* 37 C.F.R. § 42.74(c)(1)-(2) (“If a timely request is filed, the settlement shall only be available: (1) To a Government agency on written request to the Board; or (2) To any other person upon written request to the Board to make the

settlement agreement available, along with the fee specified in [37 C.F.R.] § 42.15(d) and on a showing of good cause.” To the extent the Joint Request seeks to limit the availability of the Settlement Agreement beyond what is provided under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c), we deny this part of the Joint Request.

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

III. ORDER

Accordingly, for the reasons discussed above, it is:

ORDERED that Petitioner’s Unopposed Motion to Dismiss Petition for *Inter Partes* Review (Paper 19) is *granted*;

FURTHER ORDERED that the Petition (Paper 1) is *dismissed*;

FURTHER ORDERED that IPR2024-00236 is *terminated*; and

FURTHER ORDERED that the Joint Request That Settlement Agreement Be Treated as Business Confidential Information and Be Kept Separate (Paper 20) is *granted-in-part* and *denied-in-part*, and the Settlement Agreement (Ex. 1021) shall be kept separate from the file of Patent 9,873,638 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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