

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SCOUT ENERGY MANAGEMENT, LLC, and CHEVRON U.S.A. INC.,
Petitioner,

v.

PILOT INTELLECTUAL PROPERTY, LLC,
Patent Owner.

IPR2024-00385
Patent 8,505,332 B1

Before KEN B. BARRETT, MICHAEL L. WOODS, and
ALYSSA A. FINAMORE, *Administrative Patent Judges*.

WOODS, *Administrative Patent Judge*.

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

I. INTRODUCTION

With the Board's authorization, Petitioner and Patent Owner (collectively referred to as "the Parties") filed a Joint Motion to Terminate Proceeding. Paper 39 ("Joint Motion" or "Mot."). In support of the Joint Motion, the Parties filed a copy of their Settlement Agreement. *See* Ex. 1027 ("Settlement Agreement"); *see also* Mot. 1 ("The confidential settlement agreement between Petitioner and Patent Owner has been made in writing via e-mail communications between counsel, and a true and correct copy of the settlement e-mail communications between the Parties is filed concurrently with this motion as Exhibit 1027"); *see also* Ex. 3001 ("[T]he parties will not be executing a formal settlement agreement. The submitted e-mail communications are, and will be, the only memorialization of the settlement terms."). With respect to the Settlement Agreement, the parties also filed a Joint Request to Treat as Confidential and Keep Separate Pursuant to 37 C.F.R. § 42.74(c). Paper 40 ("Joint Request" or "Req.").

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 the *inter partes* review proceeding. *See* Mot. 1.

The Parties have shown adequately that termination of this proceeding is appropriate. Good cause exists to terminate the proceeding.

The Parties also filed a Joint Request to treat the Settlement Agreement as business confidential information and to keep the Settlement Agreement separate from the file of the patent at issue. *See* Req. 1.

The Settlement Agreement contains confidential business information regarding the terms of settlement and good cause exists to treat the Settlement Agreement confidential and separate from the patent file. 35 U.S.C. § 317(b); 37 C.F.R. § 42.74(c).

The parties also state that, “[d]ue to the confidential nature of the settlement agreement, in the event that a third party submits a written request to the Board for a copy of the settlement agreement along with a purported showing of good cause, the Parties request that they be notified of the third party request and be given the opportunity to respond thereto.” Req. 2. However, the statute does not provide for any such notification or opportunity to respond. *See* 35 U.S.C. § 317(b). Nor does the regulation. *See* 37 C.F.R. § 42.74(c). We see no persuasive reason or special circumstance here that would justify issuing an order that imposes this additional requirement. Thus, we deny that part of the 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 the Joint Motion (Paper 39) is *granted* and IPR2024-00385 is *terminated* pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. § 42.72; and

FURTHER ORDERED that the Joint Request (Paper 40) is also *granted* to the extent that the Settlement Agreement (Ex. 1027) shall be kept separate from the file of U.S. Patent No. 8,505,332 and made available only to Federal Government

IPR2024-00385

Patent 8,505,332 B1

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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IPR2024-00385

Patent 8,505,332 B1