

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HOYMILES USA, INC.,
Petitioner,

v.

CYBOENERGY, INC.,
Patent Owner.

IPR2024-01106
Patent 8,786,133 B2

Before KARL D. EASTHOM, MONICA S. ULLAGADDI, and
RUSSELL E. CASS, *Administrative Patent Judges*.

CASS, *Administrative Patent Judge*.

DECISION
Settlement Prior to Institution of Trial
37 C.F.R. § 42.74

I. INTRODUCTION

On October 23, 2024, after Board authorization the same day, the parties filed a “Joint Motion to Terminate Proceeding.” Paper 8 (“Mot.”, “Motion”). Along with the Motion, the parties filed a copy of a confidential “License and Settlement Agreement” (“Agreement,” Ex. 1011). The parties also filed a “Joint Motion to Treat Settlement Agreement as Business Confidential Information.” Paper 9.

II. DISCUSSION

On June 27, 2024, Petitioner filed a Petition requesting *inter partes* review of claims 15–24 of U.S. Patent No. 8,786,133 B2. Paper 1.

In the Motion, the parties represent that “Petitioner and Patent Owner have settled their dispute regarding the ’133 Patent, including this proceeding and Patent Owner’s assertion of the ’133 Patent in the related district court litigation against Petitioner.” Mot. 1. The parties further represent that the Agreement is a “true and correct copy of the parties’ settlement agreement,” and that “there are no collateral agreements or understandings made in connection with, or in contemplation of, the termination of the proceedings beyond the settlement agreement in Exhibit 1011.” Mot. 1–2.

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.

After reviewing the Agreement between Petitioner and Patent Owner, we find that the Agreement contains confidential business information

regarding the terms of settlement. We determine that good cause exists to treat the Agreement between Petitioner and Patent Owner as business confidential information pursuant to 37 C.F.R. § 42.74(c).

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 to Terminate Proceeding (Paper 8) is *granted*, the Petition is dismissed, and the above proceeding is *terminated*;

ORDERED that the parties' Joint Motion to Treat Settlement Agreement as Business Confidential Information (Paper 9) is *granted*, and the Settlement Agreement (Ex. 1011) shall remain designated as "Parties and Board Only" in Board's filing system, shall made available only to Federal Government agencies on written request, or to any person on a showing of good cause, and shall be kept separate from the files of the involved patent and associated preliminary proceeding, pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

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