

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

THOMAS HECHT,
Petitioner,

v.

CARVER EDISON, INC.,
Patent Owner.

IPR2024-01135
Patent 10,445,833 B1

Before JOSIAH C. COCKS, FRANCES L. IPPOLITO, and
STEPHEN E. BELISLE, *Administrative Patent Judges*.

BELISLE, *Administrative Patent Judge*.

DECISION
Settlement Prior to Institution of Trial
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 Dismiss in the above-identified proceeding due to settlement. Paper 7 (“Motion”). In support of the Motion, Petitioner filed a Confidential Settlement Agreement. Ex. 2001 (“Settlement Agreement”). Further, because of the request in the Motion by the Parties, we will treat the Motion filed also as a Joint Request that the Settlement Agreement be treated as business confidential and be kept separate pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c). Paper 7.

II. DISCUSSION

In the Motion, the Parties represent that they have reached an agreement to jointly seek termination of the above-identified *inter partes* review proceeding, and we understand that the Parties also represent that the filed copy of the Settlement Agreement is a true and complete copy. Paper 7 (stating the parties “have reached agreement on a complete settlement of all matters between them (see Exhibit A, attached hereto)”). We further understand the Parties as representing that their Settlement Agreement resolves all currently pending Patent Office and District Court proceedings between the Parties involving the above-identified patent at issue by additionally stating that “[t]here are no other agreements, oral or written, between the parties made in connection with, or in contemplation of, the dismissal of the petition.” *Id.*

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 terminate the proceeding with respect to the Parties by dismissing the petition.

As indicated above, we treat the Motion filed also as a Joint Request that the Settlement Agreement be treated as business confidential and be kept separate pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c), because the Parties state that they “request to maintain confidentiality of the attached agreement pursuant to 37 CFR §42.74(c).” Paper 7. 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, which is sufficient to treat the Settlement Agreement between Petitioner and Patent Owner as business confidential information pursuant to 37 C.F.R. § 42.74(c).

This Decision 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 Dismiss is *granted*, and the petition is *dismissed*; and

FURTHER ORDERED that the Joint Request to Keep Confidential and Separate is *granted*, and the Settlement Agreement shall be kept separate from the files of U.S. Patent No. 10,445,833 B1 and made available only to Federal Government agencies on written request, or to any person on a showing of good cause, pursuant to 37 C.F.R. § 42.74(c).

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