

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CIZION, LLC,
d/b/a VULCAN INDUSTRIAL MANUFACTURING,
Petitioner,

v.

KERR MACHINE CO.,
Patent Owner.

PGR2021-00052 (Patent 10,914,171 B2)
PGR2021-00053 (Patent 10,914,171 B2)¹

Before HYUN J. JUNG, JAMES J. MAYBERRY, and RYAN H. FLAX,
Administrative Patent Judges.

JUNG, *Administrative Patent Judge.*

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

¹ This order addresses issues that are the same in the identified proceedings.
We exercise our discretion to issue one order to be filed in each proceeding.

Pursuant to our authorization, on May 10, 2021, the parties filed an Amended Joint Motion to Terminate Proceeding (Paper 9, the “Joint Motion” or “Mot.”)² and an Amended Joint Request to Keep Settlement Agreements Confidential and Separate Under 37 C.F.R. § 42.74(c) (Paper 10) in each of the above-referenced proceedings. Pursuant to 37 C.F.R. § 42.74(b), the parties also filed a true copy of their written settlement agreements in each proceeding (Ex. 1070; Ex. 1071, “the Settlement Agreement”).

In each Joint Motion, the parties indicate that they have reached a confidential settlement of their dispute with respect to U.S. Patent No. 10,914,171 B2 (“the ’171 patent”). Mot. 2. The parties further indicate this settlement includes each of the above-referenced proceedings and the underlying district court litigation. *Id.*

Under 35 U.S.C. § 327(a), “a post-grant review instituted under this chapter shall be terminated with respect to any petitioner upon the joint request of the petitioner and patent owner, unless the Office has decided the merits of the proceeding before the request for termination is filed.” The parties indicate that termination is proper, because neither of the above-referenced proceedings have been instituted for trial. Mot. 3.

There are strong public policy reasons to favor settlement between the parties to a proceeding. *See Consolidated Trial Practice Guide* (“Consolidated Practice Guide”)³ at 86; *see also* 84 Fed. Reg. 64,280 (Nov. 21, 2019). When, as here, we have not rendered a Final Written Decision on

² This citation is, and subsequent citations are, to the record in PGR2021-00052, as the subsequent papers and exhibits discussed below are substantially similar in each of PGR2021-00052 and PGR2021-00053.

³ Available at <https://www.uspto.gov/TrialPracticeGuideConsolidated>.

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the merits, we generally expect that the proceeding will terminate after the filing of a settlement agreement. *See id.*

Based on the preceding, we determine that it is appropriate to terminate these proceedings without rendering a Final Written Decision as to the patentability of the challenged claims of the '171 patent.

Accordingly, it is:

ORDERED that the parties' amended requests that the settlement agreement (Exs. 1070, 1071 in both proceedings) be treated as business confidential information and kept separate from the file of U.S. Patent No. 10,914,171 B2, under the provisions of 35 U.S.C. § 327(b) and 37 C.F.R. § 42.74(c), are *granted*;

FURTHER ORDERED that previously filed motions and requests regarding Exhibit 1070 alone are moot and expunged (Papers 7, 8 in both proceedings); and

FURTHER ORDERED that each Amended Joint Motion to Terminate Proceeding is *granted*, and the proceedings in PGR2021-00052 and PGR2021-00053 are hereby terminated.

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