

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

THERAGUN, INC.,
Petitioner,

v.

HYPER ICE, INC.
Patent Owner.

PGR2021-00057
Patent 10,729,614 B2

Before KEVIN W. CHERRY, JAMES A. WORTH, and
JAMES J. MAYBERRY, *Administrative Patent Judges*.

WORTH, *Administrative Patent Judge*.

TERMINATION
Settlement Before Institution of Trial
Granting Joint Motion to Treat Settlement Agreement
as Confidential Business Information and to Keep Separate from the File
37 C.F.R. § 42.74

On February 23, 2021, Theragun, Inc. (“Petitioner”) filed a petition for post-grant review of U.S. Patent 10,729,614 B2 (“the ’614 patent,” Ex. 1001). Paper 2. On June 8, 2021, Hyper Ice, Inc. (“Patent Owner”) filed a preliminary response. Paper 7. The Board has not instituted trial in this proceeding, and no final decision has been rendered by the Board in this proceeding.

The parties have now filed a Joint Motion to Terminate Post-Grant Review (Paper 10, “Joint Motion to Terminate”) and a Joint Request to Keep Separate Pursuant to 37 C.F.R. § 42.74(c) (Paper 11, “Joint Motion to Keep Separate”).

Section 327(b) of Title 35 U.S.C. provides:

Any agreement or understanding between the patent owner and a petitioner, including any collateral agreements referred to in such agreement or understanding, made in connection with, or in contemplation of, the termination of a post-grant review under this section shall be in writing, and a true copy of such agreement or understanding shall be filed in the Office before the termination of the post-grant review as between the parties.

Id.

The Joint Motion to Terminate represents as follows:

As required under 37 C.F.R. § 42.74(b), a true copy of the settlement agreement that resolves the dispute in this post grant review is being filed with this motion as a confidential Exhibit 1020. There are no other agreements, oral or written, between the parties that were made in connection with, or in contemplation of, the requested dismissal.

Joint Motion to Terminate, 1. The Joint Motion to Terminate further represents that the lawsuit between Petitioner and Patent Owner involving the ’614 patent is in the process of being dismissed concurrently with this

post grant review, and that the parties do not contemplate any further litigation or proceeding involving the '614 patent. *Id.* at 2.

Therefore, based on the representation of the parties in the Joint Motion to Terminate, there are no other agreements between the parties, the parties understand Exhibit 1020 to have resolved their dispute, and the parties are seeking termination of the instant proceeding. We determine that the Joint Motion to Terminate and Exhibit 1020 satisfy the requirements of 35 U.S.C. § 327(b). We determine that termination of the proceeding, as requested by the parties, is in the interest of the efficient administration of justice.

Generally, the Board expects that a proceeding will terminate after the filing of a settlement agreement, unless the Board has already decided the merits of the proceeding. *See* 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 the patent owner, unless the Office has decided the merits of the proceeding before the request for termination is filed.”); 37 C.F.R. § 42.72 (“The Board may terminate a trial without rendering a final written decision, where appropriate, including . . . pursuant to a joint request under 35 U.S.C. 327(a)”). As noted above, the Board has not yet rendered a final decision here. Thus, we *grant* the Joint Motion to Terminate the proceeding.

This Decision does not constitute a final written decision pursuant to 35 U.S.C. § 328(a).

The parties also move that the Settlement Agreement be treated as confidential business information. *See* Joint Motion to Keep Separate, 1. Based on our examination of Exhibit 1020, we determine that the Settlement

Agreement contains confidential business information. The request to keep the agreement separate is *granted*.

Accordingly, it is:

ORDERED that the Joint Motion to Keep Separate is *granted*, and the settlement agreement (Ex. 1020) shall be kept separate from the public files of the '614 patent, and made available only to Federal Government agencies on written request, or to any person on a showing of good cause, under 35 U.S.C. § 327(b) and 37 C.F.R. § 42.74(c); and

FURTHER ORDERED that the Joint Motion to Terminate this proceeding is *granted*, and this proceeding is hereby *terminated* under 35 U.S.C. § 327(a) and 37 C.F.R. § 42.72.

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