

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CAMEL MANUFACTURING COMPANY, LLC,
Petitioner,

v.

DLX ENTERPRISES, LLC,
Patent Owner.

PGR2024-00033
Patent 11,732,496 B2

Before BARRY L. GROSSMAN, ERIC C. JESCHKE, and ARTHUR M.
PESLAK, *Administrative Patent Judges*.

GROSSMAN, *Administrative Patent Judge*.

DECISION

Settlement Prior to Institution of Trial

37 C.F.R. § 42.74

Granting Joint Request to Treat Agreements
as Business Confidential Information

35 U.S.C. § 327(b); 37 C.F.R. § 42.74(c)

I. INTRODUCTION

On October 3, 2024, Petitioner and Patent Owner (collectively referred to as “the Parties”) filed a Joint Motion to Terminate Post-Grant Review. Paper 7 (“Joint Motion”). Along with the Joint Motion, the Parties filed a Settlement Agreement (Ex. 1025), as well as a Joint Request to Treat Settlement Agreement as Confidential Business Information (Paper 8 (“Joint Request”)) pursuant to 37 C.F.R. § 42.74(c).

We notified the Parties that the Settlement Agreement referred to a second agreement (the “Second Agreement”) between the Parties that was to be executed “simultaneously with” the Settlement Agreement. *See* Ex. 3001 (citing 35 U.S.C. § 327(b); *DTN, LLC v. Farms Tech., LLC*, IPR2018-01412, Paper 21 (PTAB June 14, 2019) (precedential) (discussing collateral agreements). Section 327(b) of Title 35 of the United States Code states:

“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.”

35 U.S.C. § 327(b).

We determined that the Second Agreement is “referred to” in the Settlement Agreement and “made in connection with” the Settlement Agreement, and, thus, is a “collateral agreement.” Ex. 3001. Accordingly, we advised the Parties that the Second Agreement must be submitted as an exhibit in this proceeding before termination of this proceeding. Ex. 3001. The Second Agreement has been filed as Exhibit 1027. We also consider the Second Agreement, executed “simultaneously with” the Settlement Agreement, to be part of the Settlement Agreement and thus included in the

Joint Request to treat the Settlement Agreement as business confidential information and kept separate from the file of the involved patent.

Pursuant to 37 C.F.R. § 42.20, a party must obtain Board authorization to file a motion. The parties did not seek prior authorization to file their joint motion to terminate. The Board, however, may waive or suspend any requirement of part 42. 37 C.F.R. § 42.5(b). Given the particular circumstances of this case, we exercise our authority and waive the requirement for prior Board authorization to file the joint motion to terminate.

II. DISCUSSION

In the Joint Motion, the Parties represent that they have reached an agreement to jointly seek termination of this post-grant review proceeding (Joint Motion 1), and that the filed copy of the Settlement Agreement is a true and complete copy. *Id.* at 3. The Parties further represent that their Settlement Agreement resolves all currently pending Patent Office proceedings between the Parties involving Patent 11,732,496 B2. *Id.* at 1. We also understand the Parties to represent that all collateral agreements and understandings required for termination under 35 U.S.C. § 327(b) have been filed.

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.

The Parties also filed a Joint Request that the Settlement Agreement be treated as confidential business information and be kept separate from the file of the patent involved in this post-grant proceeding. Paper 8. After

reviewing the Settlement Agreement and Second Agreement between Petitioner and Patent Owner, we find that these two Agreements contain business confidential information regarding the terms of settlement. We determine that good cause exists to treat these two Agreements 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. § 328(a).

III. ORDER

Accordingly, for the reasons discussed above, it is:

ORDERED that the Joint Motion to Terminate (Paper 7) is *granted*, and PGR2024-00033 is *terminated* with respect to Petitioner and Patent Owner pursuant to 37 C.F.R. § 42.72; and

FURTHER ORDERED that the Joint Request (Paper 8) to Treat Settlement Agreement (Exhibit 1025) and the Second Agreement (Ex. 1027) as Confidential Business Information is *granted*, and the Settlement Agreement and the Second Agreement shall be kept separate from the file of Patent 11,732,496 B2, 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).

PGR2024-00033
Patent 11,732,496 B2

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