

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MUNCHKIN, INC.,
Petitioner,

v.

SKIP HOP, INC.,
Patent Owner.

Case IPR2016-00536
Patent 9,060,653 B2

Before MICHAEL R. ZECHER, BRIAN J. McNAMARA, and
DANIEL J. GALLIGAN, *Administrative Patent Judges*.

GALLIGAN, *Administrative Patent Judge*.

JUDGMENT

Termination of Trial

35 U.S.C. § 317, 37 C.F.R. §§ 42.72 and 42.74

I. DISCUSSION

On November 3, 2016, the parties filed a Joint Motion to Terminate this proceeding (Paper 18), as well as a Joint Request (Paper 20) to have their settlement agreement treated as business confidential information under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c). The parties also filed a true copy of their written settlement agreement. Ex. 2003. The parties indicate that termination of this proceeding is appropriate because they have settled their dispute with respect to U.S. Patent No. 9,060,653 B2 (“the ’653 patent”). Paper 18, 2. The parties also indicate that, pursuant to their settlement agreement, they are filing a joint stipulation of dismissal of *Skip Hop, Inc. v. Munchkin Inc.*, No. 2:15-cv-06339 (C.D. Cal.), which involves the ’653 patent. *Id.* at 3–4.

Under 35 U.S.C. § 317(a), “[a]n inter partes 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.” Generally, the Board expects that a proceeding will terminate after the filing of a settlement agreement, if the settlement agreement includes all parties. *See, e.g., Office Patent Trial Practice Guide*, 77 Fed. Reg. 48,756, 48,768 (Aug. 14, 2012). The parties have filed such an agreement. Ex. 2003.

Although we have instituted a trial as to claims 12–21 of the ’653 patent (Paper 12), the trial is in its early stages. Patent Owner did not file a Patent Owner Response, and an oral hearing has not been held. Under these circumstances, we are persuaded that it is appropriate to terminate this proceeding with respect to both Petitioner and Patent Owner.

Further, under 37 C.F.R. § 42.74(b), “[a]ny agreement or understanding between the parties made in connection with, or in contemplation of, the termination of a proceeding shall be in writing and a true copy shall be filed with the Board before termination of the trial.” As the parties have filed their written settlement agreement, we determine that it is appropriate to terminate this proceeding without rendering any further decisions as to the patentability of claims 12–21 of the ’653 patent, which are all the claims on which trial has been instituted (Paper 12, 27). *See* 35 U.S.C. § 317; 37 C.F.R. §§ 42.72, 42.74.

II. ORDER

Accordingly, it is:

ORDERED that the parties’ Joint Request that the settlement agreement (Ex. 2003) be treated as business confidential information under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) is GRANTED; and

ORDERED that the parties’ Joint Motion to Terminate this proceeding is GRANTED, and this proceeding is hereby terminated.

IPR2016-00536
Patent 9,060,653 B2

PETITIONER:

A. Justin Poplin
LATHROP & GAGE LLP
patent@lathropgage.com

Robert Z. Evora
MUNCHKIN, INC.
Robert.Evora@Munchkin.com

PATENT OWNER:

Stephen Weyer
STITES & HARBISON, PLLC
sweyer@stites.com