

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ENERCOP SAND SOLUTIONS INC.,
Petitioner,

v.

SPECIALIZED DESANDERS INC.,
Patent Owner.

IPR2018-01748
Patent 8,945,256 B2

Before RAE LYNN P. GUEST, DONNA M. PRAISS, and
CHRISTOPER M. KAISER, *Administrative Patent Judges*.

PRAISS, *Administrative Patent Judge*.

TERMINATION
Due to Settlement After Institution of Trial
35 U.S.C. § 317; 37 C.F.R. § 42.74

On October 16, 2019, the parties filed a Joint Motion to Terminate this proceeding pursuant to 35 U.S.C. § 317(a). Paper 18. The parties also filed a copy of a written settlement agreement (Ex. 1015) along with a joint request (“Joint Request”) to treat the settlement agreement as business confidential information and to keep the settlement agreement separate from the patent files, under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c). Paper 19. We authorized the filing of these papers in an e-mail dated October 15, 2019.

Generally, the Board expects that a proceeding will terminate after the filing of a settlement agreement. *See, e.g.*, Office Patent Trial Practice Guide, 77 Fed. Reg. 48756, 48768 (Aug. 14, 2012). We instituted trial in this proceeding on February 25, 2019. Paper 7. An oral hearing in the matter is scheduled for November 10, 2019. Paper 8. A decision on the merits has not been reached.

The parties represent that Exhibit 1015 is a “true copy” of their settlement agreement. Paper 18, 3. They also represent that “there are no other collateral agreements or understandings, oral or written, between the parties made in connection with, or in contemplation of, the termination of [these proceedings].” *Id.* In addition, the parties state that even if their motion to terminate is not granted, “Petitioner will not participate further” in this or a related proceeding. *Id.* at 1.

Given the parties’ joint request, we must terminate the proceeding with respect to Petitioner unless we have decided the merits of the proceeding. *See* 35 U.S.C. § 317(a) (“An inter partes 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.”). In addition, “[i]f no petitioner remains in the inter partes review, the Office may terminate the review or proceed to a final written decision.” *Id.* Based on the facts of this case, we determine that it is appropriate to terminate this proceeding without rendering a final written decision.

Accordingly, the Joint Motion to Terminate is *granted* and the Joint Request to treat the settlement agreement as business confidential information is *granted*.

This Order does not constitute a final written decision pursuant to 35 U.S.C. § 318(a).

ORDER

Accordingly, it is

ORDERED that the Joint Request that the settlement agreement be treated as business confidential information and be kept separate from the files of the involved patent under the provisions of 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) is *granted*;

FURTHER ORDERED that the Joint Motion to Terminate the above-identified proceeding under the provisions of 35 U.S.C. § 317(a) and 37 C.F.R. § 42.74 is *granted*; and

FURTHER ORDERED that the above-identified proceeding is *terminated* with respect to both Petitioner and Patent Owner pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. § 42.72.

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Patent 8,945,256 B2

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