

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

THE SHERWIN-WILLIAMS COMPANY.,
Petitioner,

v.

ARCH CHEMICALS, INC.,
Patent Owner.

Case IPR2019-01497 (Patent 9,723,842 B2)
Case IPR2019-01498 (Patent 9,723,842 B2)
Case IPR2019-01499 (Patent 9,717,250 B2)

Before GRACE KARAFFA OBERMANN, CHRISTOPHER G.
PAULRAJ, and JOHN R. KENNY, *Administrative Patent Judges*.

KENNY, *Administrative Patent Judge*.

DECISION

*Denying Motion to Terminate and Request
to Keep the Settlement Agreement Separate*
37 C.F.R. §§ 42.71(a), 42.74

IPR2019-01497 (Patent 9,723,842 B2)
IPR2019-01498 (Patent 9,723,842 B2)
IPR2019-01499 (Patent 9,717,250 B2)

The parties filed a *Joint Motion to Terminate the Proceedings* (“Joint Motion”) in each of the above-listed proceedings. IPR2019-01497 (“’1497 IPR”), Paper 12; IPR2019-01498 (“’1498 IPR”), Paper 12; IPR2019-01499 (“’1499 IPR”), Paper 8. The parties also filed a *Covenant Not to Sue* in each of these proceedings. ’1497 IPR Paper 13; ’1498 IPR Paper 13; ’1499 IPR, Paper 9. The Joint Motion requests that the *Covenant Not to Sue* be treated as business confidential information and be kept separate from the file of the involved patents. Joint Motion 4.

We deny the Joint Motion. The parties have not certified that, besides the *Covenant Not to Sue*, there are no collateral agreements or understandings made in connection with, or in contemplation of, the termination of the *inter partes* review. Instead, the parties merely state that “Petitioner and Patent Owner provide a copy of the agreement between them resolving Patent Owner’s infringement allegations against Petitioner.” Joint Motion 3. This statement does not preclude the possibility of unfiled collateral agreements or understandings. Further, it is unclear why the *Covenant Not to Sue* should be deemed confidential. For example, the *Covenant* contains no financial terms and appears to list only patents and patent applications that have issued or published. ’1497 IPR Paper 13; ’1498 IPR Paper 13; ’1499 IPR, Paper 9.

We authorize the parties, by February 18th, to refile the Joint Motion with the missing certification¹ and with an explanation as to why the *Covenant Not to Sue* should be deemed confidential (assuming the parties

¹ Counsel for each party can make that certification if authorized by the party that counsel represents.

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still seek that designation). We note that the mere fact that the parties have designated the *Covenant Not to Sue* as confidential, or have agreed to treat it as such, is by itself insufficient to establish confidentiality. *See* Joint Motion 3.

Out of an abundance of caution, we will restrict access to this Decision to the Board and parties until February 19th. Nothing in this Decision appears confidential. If either party, however, believes anything in this Decision is confidential, that party has until February 18th to submit a short paper identifying what in the Decision should be deemed confidential and explain why it should be so designated. The party shall submit a proposed redacted version of this Decision with such a paper.

ORDER

It is:

ORDERED that the *Joint Motion to Terminate the Proceedings* in each of IPR2019-01497 (Paper 12), IPR2019-01498 (Paper 12) and IPR2019-01499 (Paper 8) is *denied*.

FURTHER ORDERED that the parties may, by February 18th, refile *Joint Motion to Terminate the Proceedings* with the certification discussed above and an explanation as to why the *Covenant Not to Sue* should be deemed confidential (assuming the parties still seek that designation).

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IPR2019-01498 (Patent 9,723,842 B2)

IPR2019-01499 (Patent 9,717,250 B2)

FURTHER ORDERED that if either party believes that anything in this Decision should not be made public, that party has until February 18th to submit a short paper identifying what should be deemed confidential and explain why. The party shall submit a proposed redacted version of this Decision with such a paper.

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