

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
Settlement Prior to Institution of Trial
37 C.F.R. § 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 19; IPR2019-01498 (“’1498 IPR”), Paper 19; IPR2019-01499 (“’1499 IPR”), Paper 14. 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 parties represent that they have agreed to settle, the *Covenant Not to Sue* is their settlement agreement, and “there are no collateral agreements or understandings made in connection with, or in contemplation of, the termination of these [*inter partes*] review proceedings.” Joint Motion 5.¹

The above-listed proceedings are at an early stage. We have not issued an institution decision in any of those proceedings. Under the circumstances, we determine that good cause exists to terminate these proceedings. *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.”); 37 C.F.R. § 42.71(a).

In the Joint Motion, the parties also requested that the *Covenant Not to Sue* be treated as business confidential information and be kept separate from the file of the involved patent. Joint Motion 7. We are considering that request and will decide it at a later date.

¹ Unless otherwise noted, we cite to the papers in IPR2019-01497.

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ORDER

It is:

ORDERED that the above-listed proceedings are terminated.

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