

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HP INC.,
Petitioner,

v.

MEMJET TECHNOLOGY LIMITED,
Patent Owner.

Case IPR2016-00873
Patent 7,156,492 B2

Before JAMESON LEE, LYNNE E. PETTIGREW, and
JOHN F. HORVATH, *Administrative Patent Judges*.

HORVATH, *Administrative Patent Judge*.

DECISION
Granting Joint Motion to Terminate
37 C.F.R. §§ 42.72, 42.74

On July 6, 2016, the parties filed a joint motion to terminate this proceeding (Paper 9, “Mot.”), as well as a joint request (Paper 10, “Req.”) to have their settlement agreement treated as business confidential information under 37 C.F.R. § 42.74(c). The parties also filed a copy of their settlement agreement (Ex. 1009), which the parties represent is a true copy pursuant to 37 C.F.R. § 42.74(b). Mot. 1.

The parties indicate in their joint motion that they have reached an agreement resolving their dispute involving U.S. Patent No. 7,156,492 (“the ’492 patent”). *Id.* The parties further indicate they will move to dismiss a district court proceeding involving the ’492 patent that is also the subject of the parties’ settlement agreement, and that there are no other pending proceedings between the parties involving the ’492 patent. *Id.* at 2.

This proceeding is in a preliminary stage. No decision on whether to institute trial has been made. Under the circumstances presented here, we determine that it is appropriate to terminate this preliminary proceeding with respect to both Petitioner and Patent Owner. Accordingly, we grant the parties’ joint motion to terminate.

We also grant the parties’ joint request to treat the settlement agreement as business confidential information, to be kept separate from the patent file. The parties further request that, “due to the highly sensitive nature of the agreement,” they be notified of any written request by a third party to the Board for a copy of the settlement agreement and be given an opportunity to respond. Mot. 1–2; Req. 1. That request is denied. No such notification or opportunity to respond is provided by the Board’s rules, and the parties have not shown any special circumstance that applies to them as compared to all other parties filing settlement agreements with the Board.

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Accordingly, it is:

ORDERED that the parties' joint motion to terminate this proceeding is *granted*;

FURTHER ORDERED that the parties' joint request that the settlement agreement (Ex. 1009) be treated as business confidential information, to be kept separate from the patent file, under 37 C.F.R. § 42.74(c), is *granted*;

FURTHER ORDERED that the parties' joint request to be given notice and opportunity to respond when a third party submits a written request for a copy of the settlement agreement is *denied*; and

FURTHER ORDERED that this proceeding is *terminated*.

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