

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CIM MAINTENANCE INC.,
Petitioner,

v.

P&RO SOLUTIONS GROUP, INC.,
Patent Owner.

Case IPR2017-00516
Patent 8,209,205 B1

Before PHILLIP J. KAUFFMAN, KEVIN W. CHERRY, and
ELIZABETH M. ROESEL, *Administrative Patent Judges*.

ROESEL, *Administrative Patent Judge*.

DECISION

Granting Joint Motion to Terminate
35 U.S.C. § 317(a) and 37 C.F.R. §§ 42.72, 42.74

On June 22, 2017, we instituted *inter partes* review. Paper 8. With the Board's prior authorization, on November 17, 2017 and pursuant to 35 U.S.C. § 317(a), the parties filed a joint motion to terminate the *inter partes* review based upon a written agreement between the parties resolving their dispute regarding U.S. Patent No. 8,209,205 ("the '205 Patent"). Paper 11. The parties concurrently filed a copy of their written agreement (Ex. 2004) and a request that the agreement be treated as business confidential information, be kept separate from the patent files, and be made available only as permitted under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c). Paper 12.

The parties represent that, in the related district court litigation, the '205 Patent was held invalid under 35 U.S.C. § 101 on March 31, 2017, the lawsuit was dismissed, and a final judgment has been entered. Paper 11, 2–3 (citing *P&RO Solutions Group, Inc. v. CiM Maintenance Inc.*, No. 6:16-cv-00095-RWS (E.D. Tex.)). The parties represent that Petitioner and Patent Owner are the only parties in the related district court litigation and that there are no other pending litigations between the parties. *Id.* The parties also represent that there are currently no other proceedings before the Office concerning the '205 Patent or involving both Petitioner and Patent Owner.

The parties represent that their written agreement includes Patent Owner's agreement not to sue Petitioner for infringement of the '205 Patent and not to appeal the final judgment of the district court in the related district court litigation in exchange for Petitioner's agreement to move to terminate this *inter partes* review. *Id.* at 3. The parties further represent that "the written covenant not to sue between the parties settles all material disputes related to the '205 Patent between the parties." *Id.*

Section 317 of Title 35 provides in relevant part:

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.

35 U.S.C. § 317(a).

Any agreement or understanding between the patent owner and a petitioner, including any collateral agreements referred to in such agreement or understanding, made in connection with, or in contemplation of, the termination of an *inter partes* review under this section shall be in writing and a true copy of such agreement or understanding shall be filed in the Office before the termination of the *inter partes* review as between the parties.

35 U.S.C. § 317(b).

In this case, the Board has not yet decided the merits of the *inter partes* review. Based on the parties' representations and our review of the parties' written agreement (Ex. 2004), we determine that the above-quoted requirements of 35 U.S.C. § 317(b) are satisfied. Under these circumstances, and in view of the final judgment in the related district court litigation and the parties' representations as set forth above, we determine that it is appropriate to terminate this proceeding pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. § 42.72. Therefore, the joint motion to terminate this proceeding is granted. This paper does not constitute a final written decision pursuant to 35 U.S.C. § 318(a).

We also determine that it is appropriate that the parties' written agreement (Ex. 2004) be treated as business confidential information and be kept separate from the patent files pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

IPR2017-00516
Patent 8,209,205 B1

ORDER

Accordingly, it is:

ORDERED that the parties' joint request that their written agreement (Ex. 2004) be treated as business confidential information and kept separate from the patent files, is *granted*; and

FURTHER ORDERED that the joint motion to terminate IPR2017-00516 is *granted*, and the proceeding is terminated.

IPR2017-00516
Patent 8,209,205 B1

PETITIONER:

Abran J. Kean
Eric A. Buresh
ERISE IP, P.A.
abran.kean@eriseip.com
eric.buresh@eriseip.com

PATENT OWNER:

Michael C. Greenbaum
Daniel Cardy
Ameya V. Paradkar
BLANK ROME LLP
Greenbaum@BlankRome.com
DCardy@BlankRome.com
AParadkar@BlankRome.com