

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BARCO, INC.,
Petitioner,

v.

T-REX PROPERTY AB,
Patent Owner.

Case IPR2017-01909
Patent RE39,470

Before SALLY C. MEDLEY, THOMAS L. GIANNETTI, and
DANIEL N. FISHMAN, *Administrative Patent Judges*.

GIANNETTI, *Administrative Patent Judge*

JUDGMENT
Termination of the Proceeding
37 C.F.R. § 42.72

On June 5, 2018, Petitioner and Patent Owner filed a Joint Motion to Terminate Proceeding (Paper 9; “Motion”) under 35 U.S.C. § 317(a), and a Joint Request to File Settlement Agreement as Business Confidential Information (Paper 10) in order to have the settlement agreement kept separate from the files of the involved patent under 37 U.S.C. § 317(b) and

37 C.F.R. § 42.74(c). The settlement agreement was filed as confidential.
Ex. 1008.

Under 35 U.S.C. § 317(a), “[a]n inter partes review instituted under this chapter shall be terminated with respect to any petitioner upon the joint request of the petitioner and patent owner, unless the Office has decided the merits of the proceeding before the request for termination is filed.”

Generally, the Board expects that a proceeding will terminate after the filing of a settlement agreement, if the settlement agreement includes all parties.

See, e.g., Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,768 (Aug. 14, 2012). The parties have filed such an agreement. Ex. 1008.

In their Motion, the parties indicate that they have settled their dispute with regard to U.S. Patent No. RE39,470 and that all related litigation involving U.S. Patent No. RE39,470 between the parties has been dismissed. Motion 2.¹ In a separate communication (Ex. 3001), the parties certify that there are no other written or oral agreements or understandings, including any collateral agreements, between the parties, that are made in connection with, or in contemplation of, the termination of the proceedings. *See* 37 U.S.C. § 317(b). They further state that the district court lawsuit has been dismissed with prejudice. Ex. 3001.

The trial phase of this proceeding is in its early stage, as Patent Owner has not yet filed a Patent Owner Response and Petitioner has not yet filed a

¹ The Motion, as filed, does not include page numbering as required by our rules. The parties are reminded to format all papers and exhibits in this or any future post-grant review proceedings before the Board, in accordance with 37 C.F.R. § 42.6 and § 42.63.

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Reply. Under these circumstances, we are persuaded that it is appropriate to terminate this proceeding with respect to both Petitioner and Patent Owner.

Accordingly, it is

ORDERED that the Joint Motion to Terminate Proceeding is *granted*;

FURTHER ORDERED that this proceeding is terminated with respect to both Petitioner and Patent Owner; and

FURTHER ORDERED that the Joint Request to File Settlement Agreement as Business Confidential is *granted*, and Exhibit 1008 will be kept as confidential business information under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

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