

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

COOLIT SYSTEMS, INC.,
Petitioner,

v.

ASETEK DANMARK A/S,
Patent Owner.

IPR2021-01196
Patent 10,599,196 B2

Before MICHAEL P. TIERNEY, *Vice Chief Administrative Patent Judge*,
KEVIN W. CHERRY, and JASON W. MELVIN, *Administrative Patent
Judges*.

MELVIN, *Administrative Patent Judge*.

TERMINATION
Due to Settlement After Institution of Trial
35 U.S.C. § 317; C.F.R. § 42.74

I. INTRODUCTION

With the Board's authorization, Petitioner and Patent Owner (collectively referred to as "the Parties") filed a Joint Motion to Terminate the above-identified proceeding due to settlement. Paper 24 ("Joint Motion"). In support of the Joint Motion, the Parties filed a Confidential Settlement Agreement (Ex. 2018 ("Settlement Agreement")), as well as a Joint Request to Treat the Settlement Agreement as Business Confidential Information pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) (Paper 25 ("Joint Request")).

II. DISCUSSION

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 the patent owner, unless the Office has decided the merits of the proceeding before the request for termination is filed." Section 35 U.S.C. § 317(a) also provides that if no petitioner remains in the *inter partes* review, the Office may terminate the review.

The Parties represent that they have reached an agreement to jointly seek termination of this *inter partes* review proceeding, and that the filed copy of the Settlement Agreement is a true and complete copy. Paper 25, 2. The Parties further represent that their settlement agreement resolves all currently pending Patent Office and District Court proceedings between the Parties involving Patent 10,599,196 B2. Paper 24, 1.

We instituted a trial on the above-identified proceeding on December 28, 2021. Paper 10. We have not yet decided the merits of the proceeding, and a final written decision has not been entered.

Notwithstanding that the proceeding has moved beyond the preliminary

stage, the Parties have shown adequately that the termination of the proceeding is appropriate. Under these circumstances, we determine that good cause exists to terminate the proceeding with respect to the Parties.

The Parties also filed a Joint Request that the Settlement Agreement be treated as business confidential information and be kept separate from the file of the respective patents involved in this *inter partes* proceeding.

Paper 25, 2. After reviewing the Settlement Agreement between Petitioner and Patent Owner, we find that the Settlement Agreement contains confidential business information regarding the terms of settlement. We determine that good cause exists to treat the Settlement Agreement between Petitioner and Patent Owner as business confidential information pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

This Order does not constitute a final written decision pursuant to 35 U.S.C. § 318(a).

III. ORDER

Accordingly, for the reasons discussed above, it is:

ORDERED that the Joint Motion to Terminate (Paper 24) is *granted*, and IPR2021-01196 is *terminated* with respect to Petitioner and Patent Owner pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. § 42.72; and

FURTHER ORDERED that the Joint Request (Paper 25) to Treat the Settlement Agreement (Exhibit 2018) as Business Confidential Information is *granted*, and the Settlement Agreement shall be kept separate from the file of Patent 10,599,196 B2, and made available only to Federal Government agencies on written request, or to any person on a showing of good cause, pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

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