

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APTWATER, INC.,
Petitioner,
v.

THINKVILLAGE-KERFOOT, LLC
Patent Owner.

Case IPR2014-00132 (Patent 7,033,492 B2)
Case IPR2014-00133 (Patent 7,537,706 B2)¹

Before GRACE KARAFFA OBERMANN, MICHAEL J. FITZPATRICK, and
SHERIDAN K. SNEDDEN, *Administrative Patent Judges*.

OBERMANN, *Administrative Patent Judge*.

ORDER

Denying Without Prejudice Motions to Terminate the Proceedings
37 C.F.R. § 42.72

¹ This order addresses motions to terminate based on an alleged settlement agreement that resolves both cases. We, therefore, exercise our discretion to issue a single order to be entered in each case. The parties are not authorized to use this style heading in any filing.

Case IPR2014-00132 (Patent 7,033,492 B2)

Case IPR2014-00133 (Patent 7,537,706 B2)

On June 6, 2014, the parties filed joint motions to terminate the trial proceedings under 35 U.S.C. §317(a). That same day, the parties filed joint requests to file a settlement agreement as business confidential information under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

The parties are reminded that the Board is not a party to the settlement, and may independently identify any question of patentability. 37 C.F.R § 42.74(a). Generally, however, the Board expects that a proceeding will terminate after the filing of a settlement agreement. *See, e.g.*, Office Trial Practice Guide, 77 Fed. Reg. 48756, 48768 (Aug. 14, 2012). The rule governing settlement indicates that any agreement between the parties made in connection with, or in contemplation of, the termination of a proceeding shall be in writing and filed with the Board. 37 C.F.R. § 42.74. The parties sought, and the Board granted, authorization for the filing of joint motions to terminate these proceedings and requests to file the settlement agreement as business confidential information.

A joint motion to terminate a proceeding should include information regarding, for example, (1) the identity of all parties in any related district court case involving the patent at issue in the proceeding sought to be terminated; (2) the current status of each such related case with respect to each party to the litigation; and (3) the case numbers of any pending related *inter partes* review proceedings. The joint motions are deficient because they lack such information.

The joint motions to terminate, moreover, must be accompanied by a true copy of the parties' settlement agreement, as required by 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b). A redacted version of the settlement agreement will not be accepted as a true copy of the settlement agreement.

With respect to having the settlement agreement treated as business confidential under 37 C.F.R. § 42.74(c), the parties must file the confidential

Case IPR2014-00132 (Patent 7,033,492 B2)

Case IPR2014-00133 (Patent 7,537,706 B2)

settlement electronically in the Patent Review Processing System (PRPS) as an exhibit in accordance with the instructions provided on the Board's website (uploading as "Parties and Board Only"). The parties are directed to FAQ G2 on the Board's website at <http://www.uspto.gov/ip/boards/bpai/prps.jsp> for instructions on how to file their settlement agreement as confidential.

In consideration of the foregoing, it is hereby:

ORDERED that the motions for termination of these proceedings, as well as the requests to file a settlement agreement as business confidential information, are denied without prejudice;

FURTHER ORDERED that the parties are authorized to re-file corrected joint motions to terminate these proceedings;

FURTHER ORDERED that the corrected joint motions must be accompanied by a true copy, labeled as an exhibit, of the parties' settlement agreement as required by 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b);

FURTHER ORDERED that, for the exhibit that is the settlement agreement, the parties may request in the corrected joint motions that the settlement agreement be treated as business confidential information, to be kept separate from the patent file, as specified in 37 C.F.R. § 42.74(c); and

FURTHER ORDERED that any confidential settlement agreement must be filed electronically in PRPS in accordance with the instructions provided on the Board's website (uploading as "Parties and Board Only").

Case IPR2014-00132 (Patent 7,033,492 B2)

Case IPR2014-00133 (Patent 7,537,706 B2)

PETITIONER:

Judy Mohr

jmohr@mwe.com

Susan Harlocker

sharlocker@mwe.com

PATENT OWNER:

Justin Poplin

patent@lathropgage.com

Curtis Vock

patent@lathropgage.com