

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MACAUTO U.S.A.
Petitioner

v.

BOS GMBH & KG
Patent Owner

Case IPR2012-00004 (TLG)
Patent 6,422,291 B1

Before HOWARD B. BLANKENSHIP, THOMAS L. GIANNETTI, and BRIAN
J. MCNAMARA, *Administrative Patent Judges*.

GIANNETTI, *Administrative Patent Judge*.

ORDER
CONDUCT OF THE PROCEEDINGS
37 C.F.R. § 42.5

A telephone conference call in this matter was held on February 1, 2013, to discuss the status of the case. The participants were Scott A. Chambers, Esq. for the Petitioner, David M. Airan, Esq. for the Patent Owner, and Administrative Patent Judges Howard B. Blankenship, Thomas L. Giannetti, and Brian McNamara. The conference was prompted by an inquiry from counsel for the Petitioner.

Counsel for both parties reported that they have a written settlement agreement calling for dismissal of the district court lawsuit pending in the Western District of New York. The agreement also calls for Petitioner to withdraw from this inter partes review proceeding under 35 U.S.C. § 317. Accordingly, the parties desire to terminate the proceeding. Counsel for both parties represented that the district court action above is the only other proceeding involving the '291 patent of which they are aware.

Counsel for both parties sought guidance on the submission of a request to terminate the proceedings under Rule 42.72 (37 C.F.R. § 42.72). In that connection, the parties are referred to the statute and the Office Patent Trial Practice Guide (77 Fed. Reg. 48756, 48768 (August 14, 2012)) for further guidance. In particular, the statute provides that “[i]f no petitioner remains in the inter partes review, the Office *may* terminate the review or proceed to a final written decision under section 318(a).” 35 U.S.C. § 317(a) (emphasis added). That termination of a proceeding is discretionary with the Board is confirmed by Rule 42.72 (“The Board may terminate a trial without rendering a final written decision”). At the same time, “the Board is not a party to the settlement and may independently determine any question of jurisdiction, patentability, or Office practice.” 37 C.F.R. § 42.74(a).

Counsel for both parties also sought guidance on the filing of the settlement agreement. Under the statute and rules such agreements must be in writing and filed in the Office before termination of a trial. *See* 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b). If requested by a party the agreement shall be treated as business confidential and kept separate from the file of the involved patents. *See* 35 U.S.C. § 317(b); 37 C.F.R. § 42.74(c). Information on the confidential filing of settlement agreements may be obtained by contacting the Board at 571-272-7822.

In consideration of the foregoing, it is therefore:

ORDERED that the parties are authorized to file a joint motion to terminate this trial under 35 U.S.C. § 317(a) and 37 C.F.R. § 42.72.

FURTHER ORDERED that the motion shall be accompanied by a true copy of the settlement agreement as required by 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b).

FURTHER ORDERED that proceedings in this trial are suspended for a period of one week from the entry date of this Order to give the parties time to prepare and file the above motion.

IPR2012-00004
Patent 6,422,291

For Patent Owner:

Dennis R. Schlemmer
David M. Airan
Leydig, Voit & Mayer, Ltd.
dschlemmer@leydig.com
dairan@leydig.com

For Petitioner:

Scott A. Chambers
Patton Boggs LLP
bdonovan@pattenboggs.com