

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

UNIVERSITY OF WATERLOO,
Petitioner,

v.

SALIENT ENERGY INC.,
Respondent.

Case DER2018-00018
Petitioner Application 15/513,914
Respondent Patent 9,780,412 B2

Before SALLY C. MEDLEY, JAMES T. MOORE, and JUSTIN T. ARBES,
Administrative Patent Judges.

ARBES, *Administrative Patent Judge.*

DECISION

Granting Joint Motion to Terminate and
Request to Treat Settlement Agreement as
Business Confidential Information

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On July 20, 2018, Petitioner filed a petition to institute a derivation proceeding under 35 U.S.C. § 135 with respect to claims 1–16 of U.S. Patent No. 9,780,412 B2 (Ex. 1001, “the ’412 patent”). *See* Papers 1 (confidential version), 2 (public redacted version). Petitioner also filed a motion to seal the redacted portions of the petition, certain portions of Exhibits 1005 and 1006, and the entireties of Exhibits 1009, 1016, 1017, 1019, and 1021–1023. Paper 4. Respondent did not file an opposition to the motion to seal.

On January 22, 2019, the parties filed a joint motion to terminate this proceeding on the basis of a settlement reached by the parties. *See* Paper 8 (“Mot.”); 37 C.F.R. §§ 42.74, 42.409. The parties also filed a copy of their written settlement agreement (Exhibit 1025) and a request (Paper 9) that the agreement be treated as business confidential information under 35 U.S.C. § 135(e) and 37 C.F.R. § 42.74(c). The parties state in the joint motion that they have entered into a settlement agreement that “resolves all underlying disputes between the parties” and reflects the parties’ agreement to correct the inventorship of Respondent’s ’412 patent and assign the ’412 patent to Petitioner. Mot. 1–2. The parties further state that they have agreed to submit a Notice of Discontinuance in a related proceeding in the Ontario Superior Court of Justice. *Id.* at 4.

We have not yet exercised exclusive jurisdiction over Petitioner’s involved application, U.S. Patent Application No. 15/513,914 (“the ’914 application”), and Respondent’s ’412 patent or determined whether to institute a derivation proceeding. Given these facts, we determine that it is appropriate to terminate the proceeding at this time and under these circumstances, which renders moot Petitioner’s pending motion to seal.

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Finally, we note that both Petitioner's '914 application and the application that issued as Respondent's '412 patent are available to the public. The '914 application published as U.S. Patent Application Publication No. 2017/0250449 A1 on August 31, 2017. The '412 patent issued on October 3, 2017. Pursuant to 37 C.F.R. § 42.412(b)(1), "[t]he record of a Board proceeding is available to the public, unless a patent application not otherwise available to the public is involved." Thus, absent any objection from the parties, the record of this proceeding (other than the parties' settlement agreement and the documents subject to Petitioner's motion to seal) will be made publicly available in the Patent Trial and Appeal Board End to End (PTAB E2E) system.

In consideration of the foregoing, it is hereby:

ORDERED that Petitioner's motion to seal (Paper 4) is *dismissed* as moot;

FURTHER ORDERED that Paper 1; the confidential versions of Exhibits 1005 and 1006; and Exhibits 1009, 1016, 1017, 1019, and 1021–1023 will be expunged from the record of this proceeding;

FURTHER ORDERED that the record of this proceeding (other than Exhibit 1025 and the expunged documents listed above) will be made publicly available, unless either party notifies the Board, by email to *Trials@uspto.gov* by February 4, 2019, that it objects to doing so;

FURTHER ORDERED that the parties' joint request (Paper 9) that the settlement agreement (Exhibit 1025) be treated as business confidential information, kept separate from the files of the '914 application and the '412 patent, and made available only to Federal Government agencies on

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written request, or to any person on a showing of good cause, under 35 U.S.C. § 135(e) and 37 C.F.R. § 42.74(c), is *granted*;

FURTHER ORDERED that the joint motion to terminate this proceeding (Paper 8) is *granted* and the proceeding is hereby *terminated*; and

FURTHER ORDERED that a copy of this Decision be placed in the files of the '914 application and the '412 patent.

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