

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HEARTLAND TANNING, INC.
Petitioner

v.

SUNLESS, INC.
Patent Owner

Case IPR2014-00018
Patent 8,201,288 B2

Before FRANCISCO C. PRATS, RAMA G. ELLURU, and JAMES A. TARTAL,
Administrative Patent Judges.

ELLURU, *Administrative Patent Judge.*

ORDER
Conduct of the Proceeding
37 C.F.R. § 42.5

A conference call was held on Monday, July 28, 2014, in the above proceeding between Douglas Robinson, counsel for Petitioner; Frank M. Gasparo, counsel for Patent Owner; and Judges Prats, Elluru, and Tartal. The parties sought authorization to file a joint motion to terminate the proceeding on the basis that the parties have reached a settlement.

Generally, the Board expects that a proceeding will terminate after the filing of a settlement agreement. *See, e.g.*, Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,768 (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.

During the conference call, the Board authorized the filing of a joint motion to terminate the proceeding and provided guidance as to the procedure for filing the parties' settlement agreement and having the settlement agreement treated as business confidential information under 37 C.F.R. § 42.74(c). The joint motion must (1) include a brief explanation as to why termination is appropriate; (2) identify all parties in any related litigation involving the patents at issue; (3) identify any related proceedings currently before the Office, and (4) discuss specifically the current status of each such related litigation or proceeding with respect to each party to the litigation or proceeding.

The joint motion to terminate 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. Moreover, the settlement agreement may not be expunged after termination of the proceeding.

With respect to having the settlement agreement treated as business confidential information under 37 C.F.R. § 42.74(c), the parties must file the confidential settlement agreement 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 parties are authorized to file a joint motion to terminate this proceeding no later than August 4, 2014;

FURTHER ORDERED that the joint motion 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 filed in this proceeding, the parties may file a separate paper requesting that the settlement agreement be treated as business confidential information 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").

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FOR PETITIONER:

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