Trials@uspto.gov
Tel: 571-272-7822

Paper 36
Entered: December 16, 2016

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TIANJIN SHUANGRONG PAPER PRODUCTS CO., LTD. AND SHUANG RONG AMERICA, LLC,
Petitioner,

v.

KISS NAIL PRODUCTS, INC.,
Patent Owner.

Case IPR2016-00371
Patent 8,561,619 B1

Before JOSIAH C. COCKS, MICHAEL W. KIM, and JAMES J. MAYBERRY, *Administrative Patent Judges*.

MAYBERRY, *Administrative Patent Judge*.

DECISION

Termination of the Proceeding

35 U.S.C. § 317(a) and 37 C.F.R. § 42.72

On December 13, 2016, Petitioners, Tianjin Shuangrong Paper Products Co., Ltd. and Shuang Rong America, LLC, and Patent Owner, Kiss Nail Products, Inc., (collectively, "the Parties") filed a joint motion to terminate this *inter partes* review ("IPR") involving U.S. Patent No. 8,561,619 B1 ("the '619 patent"). Paper 34 (the "Joint Motion to Terminate"); *see* 35 U.S.C. § 317(b); 37 C.F.R. § 42.72. The Board authorized this motion in an email communication to the Parties on December 12, 2016. As background, Petitioner filed a petition for *inter partes* review of the '619 patent on December 29, 2015. Paper 1 (the "Petition"). The Petition names Tianjin Shuangrong Paper Products Co., Ltd. and Shuang Rong America, LLC as the real parties-in-interest. *Id.* at 2. Patent Owner's Mandatory Notices identifies Kiss Nail Products, Inc. as the patent owner of the '619 patent. Paper 6, 1. We instituted trial on June 10, 2016 for claims 1–5 of the '619 patent. Paper 13, 28.

Along with the Joint Motion to Terminate, the Parties filed a true and correct copy of their written settlement agreement between all of the Parties covering the '619 patent (Exhibit 2013—the "Settlement Agreement"), as well as a joint motion (Paper 35) to have the Settlement Agreement treated as business confidential information under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c). The Parties represent in their Joint Motion to Terminate that the Settlement Agreement resolves the Parties' dispute in pending district court litigation in the Southern District of New York involving the '619 patent and that "[n]o litigation or proceeding involving U.S. Patent No. 8,561,619 . . . is contemplated in the foreseeable future." Paper 34, 2. Further, the Parties certify that, with respect to the Settlement Agreement, "[t]here are no collateral agreements referred to in the Parties' Settlement Agreement, and

there are no other collateral agreements or understandings made in connection with, or in contemplation of, terminating this IPR." *Id.*

The Parties are reminded that the Board is not a party to the settlement, and may identify independently 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 Patent Trial Practice Guide*, 77 Fed. Reg. 48756, 48768 (Aug. 14, 2012). Petitioner has not yet filed a reply to Patent Owner's Response (Paper 29) and neither party has requested oral hearing. Under the circumstances, based on the record before us, the Board determines that it is appropriate to terminate this proceeding without rendering a final written decision. *See* 37 C.F.R. § 42.72.

ORDER

In consideration of the foregoing, it is

ORDERED that, as was timely requested by the Parties, the Settlement Agreement (Exhibit 2013) will be treated as business confidential information under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c), and be kept separate from the file of U.S. Patent No. 8,561,619 B1 and made available only to Federal Government agencies on written request, or to any person on a showing of good cause; and

FURTHER ORDERED that the Joint Motion to Terminate this proceeding is *granted* and this proceeding is hereby *terminated*.

IPR2016-00371
Patent 8,561,619 B1

PETITIONER:

For PETITIONER:
S. Art Hasan
Kyle W. Kellar
LEWIS ROCA ROTHGERBER CHRISTIE LLP
ahasan@lrrc.com
pto@lrrc.com

For PATENT OWNER:
Geoffrey Gavin
George Phillips
JONES DAY
ggavin@jonesday.com
gphillips@jonesday.com