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IPR2017-01571, Paper 52
IPR2017-01572, Paper 52
IPR2017-01773, Paper 31
Entered: June 13, 2018

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HALLIBURTON ENERGY SERVICES, INC.,
Petitioner,

v.

SCHLUMBERGER TECHNOLOGY CORP.,
Patent Owner.

Cases IPR2017-01571, IPR2017-01572, and IPR2017-01773
Patent 8,646,529 B2

Before PATRICK R. SCANLON, HYUN J. JUNG, and JAMES J. MAYBERRY, *Administrative Patent Judges.*

JUNG, *Administrative Patent Judge.*

DECISION
Granting Joint Motion to Terminate
35 U.S.C. § 317(a); 37 C.F.R. § 42.72
Granting Request to Treat Settlement Documents
as Confidential Business Information
35 U.S.C. § 317(b); 37 C.F.R. § 42.74(c)

On December 15, 2017 and February 28, 2018, we instituted trial on claims 1–6, 8–13, and 15–20 (the "Challenged Claims") of U.S. Patent No. 8,646,529 B2 (the "'529 patent"). Paper 37, 20–21 in IPR2017-01571 (instituting review of claims 1, 2, 4, 6, 8, 15, and 17); Paper 37, 17 in IPR2017-01572 (instituting review of claims 9–12); Paper 19, 20 in IPR2017-01773 (instituting review of claims 3, 5, 13, 16, and 18–20). On May 2, 2018, we modified the Decision on Institution for IPR2017-01773 to institute review of claims 7 and 14, thus adding these claims to the Challenged Claims of the '529 patent. Paper 22 in IPR2017-01773.[1] Pursuant to our authorization, on June 4, 2018, the parties filed a Joint Motion to Terminate Proceedings (Paper 50[2]; the "Joint Motion") and a Joint Request to File Settlement Agreement as Business Confidential Information (Paper 48). Pursuant to 37 C.F.R. § 42.74(b), the parties also filed a true copy of their written settlement agreement (Ex. 2026).

In the Joint Motion, the parties indicate that they have reached an agreement regarding all of their disputes involving the '529 patent. Paper 50, 2. The parties represent that:

> Other than as indicated in the [Settlement] Agreement, there are no written or oral agreements or understandings, including any collateral agreements, between the parties, including but not limited to licenses, covenants not to sue, confidentiality agreements, or other agreements of any kind, that are made in connection with, or in contemplation of, the termination of this proceeding.

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[1] Subsequent citations are to the record in IPR2017-01571, as the subsequent papers discussed below are substantially similar in each of IPR2017-01571, IPR2017-01572, and IPR2017-01773.

[2] Paper 50 is the public version of the Joint Motion, filed on June 4, 2018. A confidential version was filed on June 1, 2018 as Paper 47.

Id.

Under 35 U.S.C. § 317(a), "[a]n *inter partes* review instituted under this chapter shall be terminated with respect to any petitioner upon the joint request of the petitioner and patent owner, unless the Office has decided the merits of the proceeding before the request for termination is filed." The parties indicate that termination is proper, "because this proceeding is still in its early stages, with the petitioner reply not due until June 25, 2018." Paper 50, 3. The parties further assert that they "are unaware of any other matter before the USPTO that would be affected by the outcome of this proceeding." *Id.*

There are strong public policy reasons to favor settlement between the parties to a proceeding. *Office Patent Trial Practice Guide*, 77 Fed. Reg. 48,756, 48,768 (Aug. 14, 2012). When, as here, we have not rendered a Final Written Decision on the merits, we generally expect that the proceeding will terminate after the filing of a settlement agreement. *See id*.

Based on the preceding, we determine that it is appropriate to terminate these proceedings without rendering a Final Written Decision as to the patentability of the Challenged Claims of the '529 patent.

Accordingly, it is:

ORDERED that the parties' request that the settlement agreements (Ex. 2026 in each proceeding) be treated as business confidential information and kept separate from the file of U.S. Patent No. 8,646,529 B2, under the provisions of 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c), is *granted*; and

FURTHER ORDERED that the Joint Motion to Terminate Proceedings is *granted*, and the proceedings in IPR2017-01571, IPR2017-01572, and IPR2017-01773 are hereby terminated.

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