

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE INC.,
Petitioner,

v.

BUYSAFE, INC.,
Patent Owner.

Case CBM2014-00122
Patent 8,515,791 B2

Before JOSIAH C. COCKS, BEVERLY M. BUNTING, and
CHRISTOPHER M. KAISER, *Administrative Patent Judges*.

BUNTING, *Administrative Patent Judge*.

DECISION
Termination of the Proceeding
35 U.S.C. § 327(a) and 37 C.F.R. § 42.72

On September 22, 2014, Google Inc., and BuySafe, Inc. (collectively referred to as “the Parties”) filed a joint motion to terminate this covered business method patent review involving Patent 8,515,791 (“the ’791 Patent”). Paper 13 (“Joint Motion to Terminate”); see 35 U.S.C. § 327(b); 37 C.F.R. § 42.72. Authorization to file the motion was given in a phone conference between the Board and the Parties on September 19, 2014. Paper 11. Along with the Joint Motion to Terminate, the Parties filed a copy of their written settlement and licensing agreement (Paper 14) covering the ’791 patent, as well as a joint request (Paper 12) to have their settlement and license agreement treated as business confidential information under 35 U.S.C. § 327(b) and 37 C.F.R. § 42.74(c). The Parties state in their joint motion that:

[T]ermination is therefore appropriate as the merits of the petition have not been determined, no motions or other matters are outstanding, and concluding this review at this early juncture promotes efficient use of the resources of the Board and saves expenses for the parties.

Paper 13, 2.

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). This proceeding is still in the preliminary stages¹, as Patent Owner, BuySafe Inc., filed a Preliminary Response on August 20, 2014, and the Board has not issued yet a decision to institute a

¹ A preliminary proceeding begins with the filing of a petition for instituting a trial and ends with a written decision as to whether a trial will be instituted. 37 C.F.R. § 42.2.

covered business method patent review. As to other district court litigation involving the subject patent, the Parties indicate that they “have stipulated to the dismissal of the litigation associated with U.S. Patent No. 8,515,791, and no litigation involving the patent remains pending.” Paper 13, 2.

Under the circumstances, based on the record before us, the Board determines that it is appropriate to terminate this proceeding without rendering either a decision to institute or a final written decision. *See* 37 C.F.R. § 42.72.

As noted above, the Parties represent that there are no motions outstanding that are necessary for the panel to decide. Accordingly, BuySafe Inc.’s Motion to Seal (Paper 8) is *dismissed* as moot. The subject papers of the Motion to Seal (Exhibits 2001 and 2002, filed August 11, 2014) are hereby expunged. BuySafe Inc. also evidently sought to seal portions of the Preliminary Response filed August 11, 2014 (Paper 7) that reproduces certain content of the above-noted exhibits. *See* Paper 8, 3. As acknowledged by BuySafe Inc. in its Motion to Seal, however, the Preliminary Response “was inadvertently filed as ‘public’ rather than ‘parties and board only.’” *Id.* at 2. BuySafe Inc. has since filed a version of the Preliminary Response that it intends to be public. Paper 9. We also expunge Paper 7.

ORDER

In consideration of the foregoing, it is

ORDERED that, as was timely requested by the parties, the settlement agreement (Paper 14) will be treated as business confidential information under 35 U.S.C. § 327(b) and 37 C.F.R. § 42.74(c);

FURTHER ORDERED that BuySafe Inc.’s Motion to Seal (Paper 8) is *dismissed* as moot;

FURTHER ORDERED that Exhibits 2001 and 2002 filed August 11, 2014 and Paper 7 are hereby expunged; and

FURTHER ORDERED that the joint motion to terminate this proceeding is GRANTED and this proceeding is hereby TERMINATED.

CBM2014-00122
Patent 8,515,791 B2

For PETITIONER:

Barry Goldsmith
bgoldsmith@milesstockbridge.com

Keith Mullervy
kmullervy@milesstockbridge.com

For PATENT OWNER:

Brian Siff
bsiff@schiffhardin.com

George Yu
gyu@schiffhardin.com

Jason Vick
jvick@sheridanross.com

Laura Brutman
lbrutman@schiffhardin.com