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Paper 72
Entered: July 21, 2020

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FIDELITY INFORMATION SERVICES, LLC,
Petitioner,

v.

MIRROR IMAGING, LLC,
Patent Owner.

CBM2017-00064 (Patent 6,963,866 B2);
CBM2017-00065 (Patent 7,552,118 B2);
CBM2017-00066 (Patent 7,836,067 B2);
CBM2017-00067 (Patent 9,141,612 B2)

Per Curiam.

TERMINATION
Due to Settlement After Institution of Trial
35 U.S.C. § 327; 37 C.F.R. § 42.74

CBM2017-00064 (Patent 6,963,866 B2);
CBM2017-00065 (Patent 7,552,118 B2);
CBM2017-00066 (Patent 7,836,067 B2);
CBM2017-00067 (Patent 9,141,612 B2)

I. INTRODUCTION

With the Board's authorization, Petitioner and Patent Owner ("Parties") filed Joint Motions to Terminate these proceedings due to settlement. CBM2017-00064, Paper 67; CBM2017-00065, Paper 69; CBM2017-00066, Paper 70; CBM2017-00067, Paper 70. In support of these motions, the Parties filed a copy of a confidential settlement agreement (CBM2017-00064, Ex. 1062; CBM2017-00065, Ex. 1062; CBM2017-00066, Ex. 1062; CBM2017-00067, Ex. 1062 ("Settlement Agreement")), as well as joint requests to file the settlement agreement as business confidential information pursuant to 35 U.S.C. § 327(b) and 37 C.F.R. § 42.74(c) (CBM2017-00064, Paper 68; CBM2017-00065, Paper 70; CBM2017-00066, Paper 71; CBM2017-00067, Paper 71). For simplicity, we refer below only to the filings in CBM2017-00064, which are representative of the filings in all of the proceedings.

II. DISCUSSION

Under 35 U.S.C. § 327(a), a covered business method review[1] "shall be terminated with respect to any petitioner upon the joint request of the petitioner and the patent owner, unless the Office has decided the merits of the proceeding before the request for termination is filed." Section 35 U.S.C. § 327(a) also provides that if no petitioner remains in the covered

[1] *See* Leahy-Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 284, 329–31 (2011) (providing that the transitional program for covered business method patents will be regarded as a post-grant review under Chapter 32 of Title 35 of the United States Code, and will employ the standards and procedures of a post-grant review, subject to certain exceptions not relevant here).

business method review, the Office may terminate the review. Section 327(b) requires that any agreement between the parties, including collateral agreements, made in connection with the termination of a covered business method review "shall be in writing and a true copy of such agreement or understanding shall be filed in the Office before the termination of the post-grant review as between the parties."

The Parties represent that they have reached an agreement to seek termination of these covered business method review proceedings jointly. *E.g.*, CBM2017-00064 Joint Motion 1. "The parties jointly certify that, aside from the Settlement Agreement, there are no other agreements or understandings, oral or written, between the parties, including any collateral agreements or understandings, made in connection with, or in contemplation of, the termination of the present proceeding," and the filed copy of the Settlement Agreement is a true and correct copy. *E.g.*, *id.* The Parties further represent that the Settlement Agreement resolves all currently pending Patent Office and District Court proceedings between the Parties involving the patents at issue. *E.g.*, *id.* at 2–3.

We instituted trials on the above-identified proceedings. Although we decided the merits of the proceedings and entered final written decisions, the Federal Circuit vacated those final written decisions. *Mirror Imaging, LLC v. Fidelity Information Services, LLC*, Nos. 19-2026, -2027, -2028, -2029 (Fed. Cir. Jan. 15, 2020) (order granting motion to vacate and remand). Notwithstanding that the proceedings have moved beyond the preliminary stages, the Parties have shown adequately that the termination of the proceedings is appropriate. Under these circumstances, we determine that

good cause exists to terminate the proceedings. We further determine that the Settlement Agreement complies with the requirements for written agreements regarding termination set forth in 35 U.S.C. § 327(b).

The Parties also filed Joint Requests that the Settlement Agreement be treated as business confidential information and be kept separate from the file of the respective patents involved in this covered business method proceeding. *E.g.*, CBM2017-00064 Joint Request. After reviewing the Settlement Agreement between Petitioner and Patent Owner, we find that the Settlement Agreement contains confidential business information regarding the terms of settlement. We determine that good cause exists to treat the Settlement Agreement between Petitioner and Patent Owner as business confidential information pursuant to 35 U.S.C. § 327(b) and 37 C.F.R. § 42.74(c).

This Order does not constitute a final written decision pursuant to 35 U.S.C. § 328(a).

III. ORDER

Accordingly, for the reasons discussed above, it is

ORDERED that, for each proceeding, the Joint Motion to Terminate is *granted*, and CBM2017-00064, CBM2017-00065, CBM2017-00066, and CBM2017-00067 are *terminated* pursuant to 35 U.S.C. § 327(a) and 37 C.F.R. § 42.72; and

FURTHER ORDERED that, for each proceeding, the Joint Request to Treat the Settlement Agreement as Business Confidential Information is *granted*, and the Settlement Agreement shall be kept separate from the files of U.S. Patent Nos. 6,963,866 B2; 7,552,118 B2; 7,836,067 B2 and

CBM2017-00064 (Patent 6,963,866 B2);
CBM2017-00065 (Patent 7,552,118 B2);
CBM2017-00066 (Patent 7,836,067 B2);
CBM2017-00067 (Patent 9,141,612 B2)

9,141,612 B2, and made available only to Federal Government agencies on written request, or to any person on a showing of good cause, pursuant to 35 U.S.C. § 327(b) and 37 C.F.R. § 42.74(c).

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