

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CENTRIFY CORPORATION,
Petitioner,

v.

DELL SOFTWARE, INC.,
Patent Owner.

Case IPR2014-01538
U.S. Patent No. 8,533,744 B2

Before RICHARD E. RICE, BARBARA A. PARVIS, and
TINA E. HULSE, *Administrative Patent Judges*.

PARVIS, *Administrative Patent Judge*.

DECISION
Termination of the Proceeding
35 U.S.C. § 317 and 37 C.F.R. § 42.72

I. INTRODUCTION

A. *Background*

On June 5, 2015 Centrifly Corporation (“Petitioner”) and Dell Software, Inc. (“Patent Owner”) (collectively referred to as “the Parties”) filed a joint motion to terminate this *inter partes* review involving U.S. Patent No. 8,533,744 B2 (“the ’744 Patent”). Paper 12 (“Joint Motion to Terminate”); *see* 35 U.S.C. § 317; 37 C.F.R. § 42.72. Authorization to file

the motion was given via e-mail correspondence from Board personnel on May 22, 2015. Along with the Joint Motion to Terminate, the Parties filed a true copy of their written settlement agreement (Ex. 2001), as well as a joint request (Paper 13) to have their settlement agreement treated as confidential business information under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

The Parties state in their joint motion that they “jointly request termination of *inter partes* review IPR2014-01538” because they “have reached an agreement (the ‘Settlement Agreement’).” Paper 12, 1–2. The Parties do not identify related proceedings involving the ’744 Patent. The Parties, however, do identify proceedings relating to the grandparent of the ’744 Patent, which is U.S. Patent No. 7,617,501 B2 (“the ’501 Patent”) and the parent of the ’744 Patent, which is U.S. Patent No. 8,245,242 B2 (“the ’242 Patent”).

In particular, the Parties identify, as related proceedings, a district court case involving alleged infringement of the ’501 Patent, which is *Quest Software, Inc. v. Centrifry Corp.*, No. 2:10-CV-00859-TS (C.D. Utah). Paper 12, 2. Additional related proceedings have been identified as follows: (1) the ’501 Patent is the subject of two pending reexaminations: *Inter Partes* Reexamination No. 95/001,458 and *Ex Parte* Reexamination No. 90/013,196 and (2) the ’242 Patent is the subject of *Inter Partes* Reexamination No. 95/002,115. Pet. 1–2. The lawsuit against Petitioner has been dismissed with prejudice. Paper 12, 2. Additionally, Petitioner has withdrawn from an appeal of the *inter partes* reexamination. *Id.*; see also Ex. 2003.

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 requirement for terminating review with respect to Petitioner is met.

Furthermore, under 35 U.S.C. § 317(a), “[i]f no petitioner remains in the inter partes review, the Office may terminate the review or proceed to a final written decision under section 318(a).” Termination with respect to Petitioner means that no petitioner remains in the proceeding. The Board, therefore, has discretion to terminate this review with respect to Patent Owner.

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. 48,756, 48,768 (Aug. 14, 2012). The panel also observes that briefing has not been completed in this proceeding. To that end, Patent Owner has not filed a Patent Owner Response, and, correspondingly, Petitioner has not filed a Reply.

Upon consideration of the circumstances of this case, the panel has determined that termination of this *inter partes* review is appropriate as to both Petitioner and Patent Owner without rendering a final written decision.

ORDER

For the reasons given, it is

ORDERED that, as was requested timely by the Parties (Paper 13), the settlement agreement (Ex. 2001) will be treated as business confidential information under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c); and

FURTHER ORDERED that the joint motion to terminate IPR2014-01538 (Paper 12) is *granted* and this proceeding is hereby *terminated*.

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