

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE, INC.,
Petitioner,

v.

CONTENTGUARD HOLDINGS, INC.,
Patent Owner.

Case IPR2015-00399
Patent 8,583,556 B2

Before JAMESON LEE, MICHAEL R. ZECHER,
and JENNIFER S. BISK, *Administrative Patent Judges*.

LEE, *Administrative Patent Judge*.

DECISION
Joint Motion to Terminate
37 C.F.R. §§ 42.71(a), 42.72, 42.74

On June 12, 2015, Petitioner (“Apple”) and Patent Owner (“ContentGuard”) filed a Joint Motion to Terminate Proceeding including a request to keep the agreement between them, filed as Exhibit 1027 also on June 12, 2015 (designated as “Parties and Board Only”), as business confidential information under 37 C.F.R. § 317(b) and 37 C.F.R. § 42.74(c). Paper 19 (“Joint Motion”).

In their Joint Motion, the parties request termination of the instant proceeding because they have settled their dispute with regard to U.S. Patent No. 8,583,556 B2 (“the ’556 patent”), they have agreed to terminate this *inter partes* review, and the Office has not yet instituted trial in this proceeding. Mot. 2–3.

Generally, the Board expects that a proceeding will terminate after the filing of a settlement agreement, if the settlement agreement includes all parties to the proceeding. *See, e.g.*, Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,768 (Aug. 14, 2012). The parties filed such a settlement agreement. Ex. 1027. The Joint Motion represents that the settlement resolves the dispute between the parties, with respect to the ’556 patent, in the related district court action as well. Mot. 2.

We are persuaded that, under these circumstances, it is appropriate to terminate this preliminary proceeding with respect to both Apple and ContentGuard, without deciding whether or not to institute an *inter partes* review. *See* 37 C.F.R. §§ 42.71(a), 42.72.

ORDER

It is

ORDERED that the Joint Motion is *granted*;

FURTHER ORDERED that this proceeding is terminated with respect to both Apple and ContentGuard; and

FURTHER ORDERED that the parties' settlement agreement, Exhibit 1027, will be kept as confidential business information under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

For PETITIONER:

Jeffrey Kushan
Michael Franzinger
Sidley Austin LLP
iprnotices@sidley.com

For PATENT OWNER:

Thomas Lebens
Tomothy Malony
Fitch, Even, Tabin & Flannery LLP
tom@fitcheven.com
tpmalo@fitcheven.com

Robert Cote
McKool Smith LLP
rcote@mckoolsmith.com