Trials@uspto.gov
571-272-7822

Paper 10
Entered: July 1, 2015

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FEDEX CORPORATE SERVICES, INC.,
Petitioner,

v.

CATHARON INTELLECTUAL PROPERTY, LLC,
Patent Owner.

Case IPR2015-00652
Patent 6,065,046

Before MICHAEL R. ZECHER, FRANCES L. IPPOLITO, and MINN CHUNG, *Administrative Patent Judges.*

ZECHER, *Administrative Patent Judge.*

DECISION
Termination of the Proceeding
37 C.F.R. §§ 42.72, 42.74

I. DISCUSSION

On May 27, 2015, the parties filed a Joint Motion to Terminate this proceeding (Paper 7), along with a Joint Certification regarding the Joint Motion to Terminate (Paper 9). This proceeding is still in its preliminary stages. Patent Owner, Catharon Intellectual Property, LLC ("Catharon"), did not file a Preliminary Response, and we have not entered a decision whether or not to institute an *inter partes* review. In the Joint Motion to Terminate this proceeding, the parties represent that the related district court case involving U.S. Patent No. 6,065,046 ("the '046 patent") has been dismissed with prejudice. Paper 7, 2. The parties filed a copy of the executed Stipulation of Dismissal (Ex. 1024), as well as the Order of Dismissal of the Complaint (Ex. 1025). The parties did not identify any other related proceedings involving the '046 patent. *See* Paper 7, 2.

In the Joint Certification, the parties certify that:

> there are no other written or oral agreements or understandings, including any collateral agreements, between them, including but not limited to licenses, covenants not to sue, confidentiality agreements, payment agreements, or other agreements of any kind that have been made in connection with or in contemplation of the termination of the instant proceeding or the related civil proceeding . . . .

Paper 9, 2. The parties further certify that "[t]he entire agreement between the parties related to termination of this proceeding and the related civil proceeding is memorialized in [Exhibits 1024 and 1025]." *Id.*

Generally, "[a]ny agreement or understanding between the parties made in connection with, or in contemplation of, the termination of a proceeding shall be in writing and a true copy shall be filed with the Board before termination of the trial." 37 C.F.R. § 42.74(b). The parties, however,

certify that no such written settlement agreement exists. Paper 9, 2. In addition, the related district court case has been dismissed with prejudice. Ex. 1025. Under these circumstances, we determine that it is appropriate to terminate this proceeding without rendering any further decisions. *See* 37 C.F.R. § 42.72.

II. ORDER

In consideration of the foregoing, it is hereby **ORDERED** that the parties' Joint Motion to Terminate this proceeding is GRANTED, and this proceeding is hereby terminated.

For PETITIONER:

Jeffrey Berkowitz
Jia W. Lu
Finnegan, Henderson, Farabow, Garrett & Dunner, LLP
jeffrey.berkowitz@finnegan.com
jia.lu@finnegan.com

For PATENT OWNER:

William A Meunier
Ping Hu
Mintz, Levin, Cohn, Ferris, Glovsky & Popeo, P.C.
WAMeunier@mintz.com
PHu@mintz.com