

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AMAZON.COM, INC.,
Petitioner,

v.

SIMPLEAIR, INC.,
Patent Owner.

Cases IPR2015-01371 and IPR2015-01372
Patent 8,572,279 B2

Before MICHAEL R. ZECHER, JAMES P. CALVE, and
JUSTIN T. ARBES, *Administrative Patent Judges*.

ARBES, *Administrative Patent Judge*.

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

On July 18, 2015, the parties filed a Joint Motion to Terminate in each of the instant proceedings (Paper 6),¹ a binding term sheet that memorializes the parties' settlement agreement (Ex. 2001), and a request (Paper 7) to treat the agreement as business confidential information under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c). After reviewing the binding term sheet, we informed the parties via email correspondence on July 27, 2015, that the papers were insufficient because the binding term sheet references a long form settlement agreement. *See* Paper 8, 1; 35 U.S.C. § 317(b) (“[a]ny agreement or understanding between the patent owner and a petitioner, including any collateral agreements referred to in such agreement or understanding, made in connection with, or in contemplation of, the termination of an inter partes 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 inter partes review as between the parties”). We instructed the parties to file the long form settlement agreement once it had been executed, and, if they so choose, a request to treat the long form settlement agreement as business confidential information under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c). On August 21, 2015, the parties complied with our instructions by filing in each proceeding a Renewed Joint Motion to Terminate (Paper 8), a true copy of the long form settlement agreement (Ex. 2002), and a request (Paper 9) to treat the long form settlement agreement as business confidential information under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

¹ The parties filed similar papers in each of the instant proceedings. We refer to those filed in Case IPR2015-01371 for convenience.

The instant proceedings are still in the preliminary stages. Patent Owner has not yet filed a preliminary response in either proceeding and we have not yet entered a decision whether or not to institute an *inter partes* review. In the Renewed Joint Motions to Terminate, the parties represent that the related district court case involving U.S. Patent No. 8,572,279 B2 (“the ’279 patent”) will be dismissed without prejudice upon execution of the long form settlement agreement. Paper 8, 2–4. The parties also identified a number of other proceedings involving the ’279 patent or related patents that are pending, dismissed, or on appeal to the U.S. Court of Appeals for the Federal Circuit. *Id.* at 2–3. Under these circumstances, we determine that it is appropriate to terminate the instant proceedings without rendering any further decisions. *See* 37 C.F.R. § 42.72.

On August 23, 2015, the parties submitted, via email to *Trials@uspto.gov*, a request for authorization to file a motion to expunge the long form settlement agreement if the proceedings are terminated “to ensure that the confidential settlement agreement will remain confidential in the future,” citing 37 C.F.R. §§ 42.20 and 42.56. Pursuant to 35 U.S.C. § 317(b), a true copy of the parties’ settlement agreement “shall be filed in the Office,” and “shall be made available only to Federal Government agencies on written request, or to any person on a showing of good cause.” *See* Rules of Practice for Trials Before the Patent Trial and Appeal Board and Judicial Review of Patent Trial and Appeal Board Decisions; Final Rule, 77 Fed. Reg. 48,612, 48,649–50 (Aug. 14, 2012). Thus, we see no sufficient basis to expunge the long form settlement agreement from the record, and order that the parties are not authorized to file a motion to expunge.

In consideration of the foregoing, it is hereby:

ORDERED that the requests that the binding term sheet (Ex. 2001) and long form settlement agreement (Ex. 2002) be treated as business confidential information, kept separate from the file of U.S. Patent No. 8,572,279 B2, and made available only to Federal Government agencies on written request, or to any person on a showing of good cause, under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c), are *granted*;

FURTHER ORDERED that the Renewed Joint Motions to Terminate (Paper 8 in each proceeding) are *granted* and the instant proceedings are hereby *terminated*; and

FURTHER ORDERED that the parties are not authorized to file a motion to expunge the long form settlement agreement.

IPR2015-01371, IPR2015-01372
Patent 8,572,279 B2

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