

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

COX COMMUNICATIONS, INC.,
Petitioner,

v.

AT&T INTELLECTUAL PROPERTY II, L.P.,
Patent Owner.

Case IPR2015-01536
Patent 8,855,147 B2

Before MICHAEL R. ZECHER, BRIAN P. MURPHY, and
SHEILA F. McSHANE, *Administrative Patent Judges*.

McSHANE, *Administrative Patent Judge*.

DECISION
Termination of Trial
35 U.S.C. § 317 and 37 C.F.R. §§ 42.72, 42.73(c)

I. DISCUSSION

On a December 7, 2016, telephonic conference, in response to a December 6, 2016, joint email request, we authorized the parties to file joint motions to terminate in this case, as well as then co-pending Case IPR2015-01273.¹ On December 7, 2016, the parties filed a Joint Motion to Terminate (Paper 63, “Joint Mot.”) in this proceeding, and a Joint Request to Keep Separate (Paper 64, “Joint Req.”), in which they request that their settlement agreement be treated as business confidential information under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c). The parties also filed a true copy of their written settlement agreement under 37 C.F.R. § 42.74(b). Ex. 2087. For the reasons discussed below, the Joint Motion to Terminate and the Joint Request to Keep Separate to treat the settlement agreement as business confidential information are *granted*.

In the Joint Motion to Terminate, the parties indicate that termination of trial is appropriate because they have reached a settlement regarding their disputes involving U.S. Patent No. Patent 8,855,147 B2 (“the ’147 patent”). Joint Mot. 1. According to the parties, the settlement requires the parties to file a stipulation of dismissal in the co-pending district court case involving the ’147 patent, and request the termination of this case and co-pending Case IPR2015-01273. *Id.* at 1–2. The parties represent that they have filed the stipulation of dismissal in the district court case (Ex. 2088), there are no other related district court cases involving the ’147 patent, and there are no pending, related *inter partes* review proceedings, aside from then co-pending

¹ The trial in Case IPR2015-01273 was terminated on December 8, 2016, by the grant of a Joint Motion to Terminate. See Case IPR2015-01273, Papers 65, 67.

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Case IPR2015-01273. *Id.* at 2. The parties also represent that, if the Joint Motion to Terminate is not granted, Petitioner will not participate further in this case, but Patent Owner will continue to participate. *Id.* at 5.

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.”

Although a Decision to Institute was entered on December 18, 2015 (Paper 8), and an oral hearing was held on August 23, 2016 (Paper 62), we have not entered a Final Written Decision on the merits. *See* Joint Mot. 3.

The parties further indicate that termination of the proceedings would save significant additional expenditures of resources by the Board and the parties, and would further serve the purpose of *inter partes* review proceedings to provide an efficient and less costly alternative forum for patent disputes. Joint Mot. 4. In view of the circumstances presented in this case, we agree. Indeed, there are strong public policy reasons to favor settlement between the parties to a proceeding. *Office Patent Trial Practice Guide*, 77 Fed. Reg. 48,756, 48,768 (Aug. 14, 2012). When, as here, we have not entered a Final Written Decision on the merits, we generally expect that trial will terminate after the filing of a settlement agreement. *See id.* As the parties have filed their written settlement agreement as to this proceeding and co-pending Case IPR2015-01273 (which has now been terminated), and a stipulation of dismissal has been filed in the co-pending district court case as part of the settlement, we determine that it is appropriate to terminate trial without entering a Final Written Decision as to the patentability of claims 1–18 of the ’147 patent.

Based on the foregoing, the record warrants treating the settlement agreement (Ex. 2087) as business confidential and entering judgment by terminating trial without entering a final written decision. *See* 35 U.S.C. § 317(a); 37 C.F.R. §§ 42.72.

II. ORDER

Accordingly, it is:

ORDERED that the parties' request to treat the settlement agreement (Ex. 2087) as business confidential information under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) is GRANTED; and

FURTHER ORDERED that the parties' Joint Motion to Terminate trial is GRANTED, and this trial is hereby terminated.

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For PETITIONER:

Steven M. Bauer
Joseph A. Capraro, Jr.
Gerald Worth
John M. Kitchura, Jr.
Scott Bertulli
PROSKAUER ROSE LLP
PTABMattersBoston@proskauer.com
jcapraro@proskauer.com
gworth@proskauer.com
jkitchura@proskauer.com
sbertulli@proskauer.com

For PATENT OWNER:

David W. O'Brien
Raghav Bajaj
Jamie McDole
James Russell Emerson
HAYNES AND BOONE, LLP
david.obrien.ipr@haynesboone.com
raghav.bajaj.ipr@haynesboone.com
Jamie.mcdole@haynesboone.com
Russell.emerson.ipr@haynesboone.com

Arnold Turk
Neil F. Greenblum
Michael J. Fink
GREENBLUM & BERSTEIN, P.L.C.
aturk@gbpatent.com
ngreenblum@gbpatent.com
mfink@gbpatent.com