

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ARISTOCRAT TECHNOLOGIES, INC.,
Petitioner,

v.

IGT,
Patent Owner.

Case IPR2016-00252
Patent 7,303,469

Before JOSIAH C. COCKS, MICHAEL W. KIM, and RICHARD E. RICE,
Administrative Patent Judges.

KIM, *Administrative Patent Judge.*

ORDER

Granting Joint Motion to Terminate Proceeding and
Granting Joint Request to Treat Agreement as Business
Confidential Information
37 C.F.R. §§ 42.72 & 42.74

On October 7, 2016, the parties filed (1) a Joint Motion to Terminate Pursuant to 35 U.S.C. § 317 and 37 C.F.R. § 42.74 (Paper 25, “Mot.”), and (2) a Joint Request to File Settlement Agreement as Business Confidential Information and to Maintain Said Agreement Separate from the Public File Pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) (Paper 26, citing Ex. 1023).

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. Further 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).” Petitioner is the sole petitioner in this review. The Board has discretion to terminate this review with respect to Patent Owner.

Under 35 U.S.C. § 317(b), any 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 the proceeding shall be in writing, and a true copy of such agreement or understanding shall be filed in the Office. We have considered the appropriate papers, and determine that the parties have complied with the requirements of § 317(b).

In the Motion, the parties signify that “the parties have settled their dispute with respect to the ’469 patent, and have agreed to terminate this *inter partes* review.” Mot. 2. The parties further represent the following:

[T]he *inter partes* review is not at a stage in which the Office would have a complete enough record on which to make a decision on the merits. The Petitioner’s Reply has not yet been filed and Petitioner has not been afforded the opportunity to depose Patent Owner’s expert or to introduce any evidence in reply.

Mot. 3.

Also in the Motion, the parties indicate that there are no other *inter partes* review proceedings for the ’469 patent currently before the U.S. Patent and Trademark Office. Mot. 4. The parties further state that their settlement agreement fully resolves all litigation and proceedings between the parties to this *inter partes* proceeding and that the parties will be filing a Stipulation and Order of Dismissal in the related district court litigation.

Mot. 4.

Under these circumstances, we determine that issuing a final written decision would not be an efficient use of judicial resources, and, thus, are persuaded that it is appropriate to exercise our discretion and terminate this proceeding with respect to both Petitioner and Patent Owner without rendering any further decisions. *See* 37 C.F.R. § 42.72.

ORDER

It is

ORDERED that the parties’ Joint Motion to Terminate (Paper 25), both as to Petitioner and Patent Owner, is *granted*;

FURTHER ORDERED that the parties’ Joint Request (Paper 26) to treat the settlement agreement (Exhibit 1023) as business confidential

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information under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) is *granted*;
and

FURTHER ORDERED that this proceeding is terminated with respect
to both Petitioner and Patent Owner.

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