Trials@uspto.gov
571-272-7822

Paper 22
Date: November 1, 2016

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ARISTOCRAT TECHNOLOGIES, INC.,
Petitioner,

v.

IGT,
Patent Owner.

Case IPR2016-00305
Patent 6,702,675 B1

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

COCKS, *Administrative Patent Judge.*

ORDER
Termination of the Proceeding
37 U.S.C. § 317 and 37 C.F.R. § 42.72

Aristocrat Technologies, Inc. ("Petitioner") and IGT ("Patent Owner") filed a "Joint Motion to Terminate Pursuant to 35 U.S.C. § 317 and 37 C.F.R. §42.74," (Paper 19) jointly requesting termination of this *inter partes* review proceeding, and a joint request to file the settlement agreement as business confidential information to be maintained separate from the public file (Paper 20).[1] The parties also filed a copy of the written settlement agreement (Ex. 1018).

The parties indicate that they have settled all controversy and dispute relating to the challenged patent. Paper 19, 1. The parties also state 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.

Id. at 3.

The parties are reminded that the Board is not a party to the settlement, and may identify independently any question of patentability. 37 C.F.R. § 42.74(a). Generally, however, the Board expects that a proceeding will terminate after the filing of a settlement agreement. *See*, *e.g.*, *Office Patent Trial Practice Guide*, 77 Fed. Reg. 48,756, 48,768 (Aug. 14, 2012).

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

[1] The parties were authorized to file the noted documents in e-mail correspondence from Board personnel on October 3, 2016.

requirement for terminating review with respect to Petitioner is met. Furthermore, 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. The parties have complied with the requirements of § 317(b). Also, as noted by the parties, briefing is not yet complete, and we have not decided the merits in this proceeding.

Upon consideration of the circumstances of this case, the panel has determined to terminate this *inter partes* review as to both Petitioner and Patent Owner without rendering a final written decision.

It is

ORDERED that the Joint Motion to Terminate (Paper 19) this proceeding is *granted* and this proceeding is *terminated*; and

FURTHER ORDERED that, as was timely requested by the parties (Paper 20), the settlement agreement (Ex. 1018) will be treated as business confidential information under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

For PETITIONER:

Andrea Reister
areister@cov.com

Jay Alexander
jalexander@cov.com

For PATENT OWNER:

Robert Sterne
rsterne-PTAB@skgf.com

Michelle Holoubek
mholoubek-PTAB@skgf.com

Adam Masia
amasia@ngelaw.com

Holby Abern
habern@ngelaw.com

Kevin Cukierski
kcukierski@ngelaw.com