

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

NAGRAVISION SA,
Patent Owner.

Case IPR2016-00961
Patent 7,725,740

Before GLENN J. PERRY, TRENTON A. WARD, and
DANIEL J. GALLIGAN, *Administrative Patent Judges*.

WARD, *Administrative Patent Judge*.

DECISION

Joint Motion to Terminate

37 C.F.R. § 42.5(a), 42.71, 42.72, and 42.74

On August 4, 2016, the parties filed (1) a Joint Motion to Terminate Proceeding (Paper 8, “Mot.”), and (2) a Joint Request to File Settlement Agreement as Business Confidential Information under 35 U.S.C. § 317 and 37 C.F.R. § 42.74(c) (Paper 9). On August 30, 2016, the parties further filed Exhibit 2005, which is a writing reflecting an understanding between the Petitioner and Patent Owner in contemplation of termination of the proceeding, and a Joint Request (Paper 12) to treat Exhibit 2005 as confidential business information under 37 C.F.R. § 42.74(c). On August 22, 2016, the parties filed replacement copies of Exhibits 2001 and 2002. Further on August 22, 2016, Patent Owner filed an updated Mandatory Notice to identify its parent entity and to list an additional real party-in-interest. Paper 11.

The parties represent in the Joint Motion that the filed agreements “end all patent disputes between the parties, including this proceeding.” Mot. 4. The parties also indicate that all related district court actions involving U.S. Patent No. 7,725,740 have either been dismissed or are subject to pending joint motions to dismiss. Mot. 3–4.

The Board generally expects that a case “will terminate after the filing of a settlement agreement, unless the Board has already decided the merits.” *Office Patent Trial Practice Guide*, 77 Fed. Reg. 48,756, 48,768 (Aug. 14, 2012); see 37 C.F.R. § 42.72. Here, the parties state that their dispute has been resolved and that the agreements provided memorialize the end of all patent disputes between the parties. Mot. 4. Additionally, this proceeding is in a preliminary stage. We have yet to decide whether to institute a trial. Under the circumstances presented here, we determine that it is appropriate to terminate this proceeding with respect to both Petitioner and Patent Owner without rendering any further decisions.

See 37 C.F.R. §§ 42.5(a), 42.71, 42.72, and 42.74.

Accordingly, it is:

ORDERED that the parties' Joint Motion to Terminate Proceeding, both as to Petitioner and Patent Owner, is granted;

FURTHER ORDERED that the parties' Joint Request (Paper 9) to treat Exhibits 1009, 2001, 2002, 2003, and 2004 as business confidential information under 37 C.F.R. § 42.74(c) is granted;

FURTHER ORDERED that the parties' Joint Request (Paper 12) to treat Exhibit 2005 as business confidential information under 37 C.F.R. § 42.74(c) is granted;

FURTHER ORDERED that the parties' request to accept the filing of Exhibits 1009 and 2003 under the access category of "available only to Board" in the Board's electronic filing system is granted; and

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

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