

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

UNIFIED PATENTS INC.,
Petitioner,

v.

SHIPPING AND TRANSIT, LLC,
Patent Owner.

Case IPR2016-01465
Patent 6,415,207 B1

Before NEIL T. POWELL, FRANCES L. IPPOLITO, and
MICHAEL L. WOODS, *Administrative Patent Judges*.

WOODS, *Administrative Patent Judge*.

JUDGMENT

Termination Due to Settlement after Institution of *Inter Partes* Review
35 U.S.C. § 317 and 37 C.F.R. § 42.74

I. Introduction

We instituted trial on February 1, 2017 (Paper 14). On March 6, 2017, Petitioner, Unified Patents Inc. (“Unified”), and Patent Owner, Shipping and Transit, LLC (“Shipping”), (collectively referred to as “the parties”), filed a Joint Motion to Terminate Under 35 U.S.C. § 317(a). Paper 17 (“Joint Motion to Terminate”).¹ Along with the Joint Motion to Terminate, the parties filed a true copy of a Confidential Settlement and License Agreement (Ex. 1013, “Settlement Agreement”), as well as a Joint Motion to Keep Confidential and Separate Under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) (Paper 18 (“Joint Motion to Keep Confidential”)).

II. Discussion

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).

In the Joint Motion to Terminate, the parties represent that they have settled their dispute and have reached an agreement “that fully resolves all underlying disputes between the parties,” including this *inter partes* review. Paper 17, 1. The parties further represent that other than the Settlement Agreement, there are no agreements between the parties made in connection with, or in contemplation of, the termination of the present proceeding. *Id.*

¹ Filing of the Joint Motion to Terminate was authorized in e-mail correspondence from Board personnel on March 2, 2017.

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 Unified 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).” Unified is the sole petitioner in this *inter partes* review, such that termination with respect to Unified means that no petitioner remains in the proceeding. The Board, thus, has discretion to terminate this review with respect to Shipping.

At this stage of the proceeding, Shipping has not filed a patent owner response, and such a response is not due until May 2, 2017. Paper 15, 7. Upon consideration of the circumstances of this case, the panel has determined to terminate this *inter partes* review as to both Unified and Shipping without rendering a final written decision.

III. Orders

It is

ORDERED that the Joint Motion to Terminate (Paper 17) is *granted*, and this proceeding is hereby *terminated*; and

FURTHER ORDERED that the Joint Motion to Keep Confidential (Paper 18) is also *granted*, and the Settlement Agreement (Ex. 1013) will be treated as business confidential information under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

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