

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TELULAR CORPORATION,
Petitioner,

v.

PERDIEMCO LLC,
Patent Owner.

Case IPR2017-00574
Patent 8,223,012 B1

Before WILLIAM V. SAINDON, CARL M. DeFRANCO, and
AMBER L. HAGY, *Administrative Patent Judges*.

HAGY, *Administrative Patent Judge*.

ORDER

Terminating *Inter Partes* Review Prior to Institution
Due to Settlement Agreement
37 C.F.R. §§ 42.71(a), 42.74

I. INTRODUCTION

This case is in a preliminary stage. On January 4, 2017, Petitioner Telular Corporation (“Telular” or “Petitioner”) filed a Petition requesting *inter partes* review of claims 14, 15, 16, 17, 20, 21, 25, and 26 of U.S. Patent No. 8,223,012 (Ex. 1001, “the ’012 patent”). Paper 2 (“Pet.”). On the same day, Petitioner also filed a Motion for Joinder, requesting joinder of the Petition with a related and instituted proceeding, which seeks review of the rest of the claims of the ’012 patent, IPR2016-01061. Paper 3 (“Joinder Motion”). Petitioner filed its Joinder Motion within one month after institution of the trial in IPR2016-01061, as required by 37 C.F.R. § 42.122(b). PerdiemCo LLC (“Patent Owner”) filed an Opposition to Petitioner’s Motion for Joinder (Paper 7, “Opp. to Joinder” (sealed); Paper 9 (public version)), and Petitioner filed a Reply to Opposition to Motion for Joinder (Paper 10, “Reply to Opp. to Joinder”). Patent Owner filed a Statement regarding the current petition on April 11, 2017. Paper 12. The Board has not yet issued a decision on whether to grant the motion for joinder or whether to institute the proceeding.

Pursuant to Board authorization, Patent Owner and Petitioner filed a joint motion to terminate the proceeding on June 15, 2017. Paper 14. Along with the motion, the parties filed a copy of a document they describe as their settlement agreement, and the parties included in their motion a request to treat the settlement agreement as business confidential information. Paper 14 and Ex. 1019. *See* 37 C.F.R. § 42.74(c) (a party to a settlement may request that the settlement agreement be treated as business confidential and be kept separate from the patent file).

II. DISCUSSION

The Parties state the following in the Joint Motion to Terminate: “Patent Owner and Petitioner jointly and respectfully request that IPR2017-00574 be terminated due to settlement between the parties. . . . The parties certify that there are no collateral agreements or understandings made in connection with, or in contemplation of, the termination of the IPR proceedings.” Paper 14, 2. Under these circumstances, we determine that it is appropriate to terminate this proceeding. *See* 37 C.F.R. §§ 42.5(a), 42.71(a).

After reviewing the parties’ settlement agreement, we find the settlement agreement contains business confidential information regarding the terms of the settlement and good cause exists to treat the settlement agreement as business confidential information pursuant to 37 C.F.R. § 42.74(c).

III. ORDER

It is

ORDERED that the Joint Motion to Terminate the Proceedings is *granted*;

FURTHER ORDERED that the joint request to treat the parties’ settlement agreement as business confidential information is *granted*, and the settlement agreement (Exhibit 1019) shall be treated as business confidential information under 37 C.F.R. § 42.74(c), kept separate from the file of U.S. Patent No. 8,223,012 B1, and remain designated as “Board and Parties Only.”

Case IPR2017-00574

Patent 8,223,012 B1

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