

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FACEBOOK, INC.,
Petitioner,

v.

SOUND VIEW INNOVATIONS, LLC,
Patent Owner.

Cases

IPR2017-00985 (Patent 6,125,371)
IPR2017-00986 (Patent 5,991,845)
IPR2017-01003 (Patent 8,135,860 B1)¹

Before DEBRA K. STEPHENS, DANIEL J. GALLIGAN, and
JOHN A. HUDALLA, *Administrative Patent Judges*.

STEPHENS, *Administrative Patent Judge*.

ORDER

Termination of Trial
35 U.S.C. § 317, 37 C.F.R. §§ 42.72 and 42.74

¹ This Order applies to each of the listed cases. We exercise our discretion to issue one Order to be docketed in each case. The parties are not authorized to use a multiple case caption.

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I. DISCUSSION

On January 18, 2018, with Board authorization, the parties filed in each of IPR2017-00985, IPR2017-00986, and IPR2017-01003 a Joint Motion to Terminate² along with what they indicate are true and correct copies of a patent license agreement³ and a related membership agreement.⁴ In the Joint Motions to Terminate, the parties represent that they have settled their disputes regarding the patents at issue in these proceedings, both here and before the U.S. District Court for the District of Delaware, and they “certify that there are no collateral agreements or understandings made in connection with, or in contemplation of, the termination of the *inter partes* review.”⁵

In each of these proceedings, the parties also filed a Joint Request to have the patent license agreement and the membership agreement treated as business confidential information and be kept separate from file of the respective patent and *inter partes* review proceeding pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).⁶

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

² IPR2017-00985, Paper 39; IPR2017-00986, Paper 36; IPR2017-01003, Paper 36.

³ IPR2017-00985, Ex. 1011; IPR2017-00986, Ex. 1011; IPR2017-01003, Ex. 1023.

⁴ IPR2017-00985, Ex. 1012; IPR2017-00986, Ex. 1012; IPR2017-01003, Ex. 1024.

⁵ IPR2017-00985, Paper 39, 1–2, 4; IPR2017-00986, Paper 36, 1–4; IPR2017-01003, Paper 36, 1–4.

⁶ IPR2017-00985, Paper 40; IPR2017-00986, Paper 37; IPR2017-01003, Paper 37.

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request of the petitioner and patent owner, unless the Office has decided the merits of the proceeding before the request for termination is filed.” Further, under 35 U.S.C. § 317(b),

[a]ny 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 an inter partes review under this section shall be in writing and a true copy of such agreement or understanding shall be filed in the Office before the termination.

As the parties have filed their written agreement and jointly requested termination, we determine that it is appropriate to terminate these proceedings without rendering final written decisions under 35 U.S.C. § 318(a). *See* 35 U.S.C. § 317; 37 C.F.R. §§ 42.72, 42.74.

Accordingly, the Joint Motions to Terminate the above-identified proceedings and the Joint Requests to treat the agreements as business confidential information are granted. As requested by the parties, the patent license agreement and the membership agreement will be treated as business confidential information and be kept separate from the patent file. 35 U.S.C. § 317(b); 37 C.F.R. § 42.74(c). This paper does not constitute a final written decision pursuant to 35 U.S.C. § 318(a).

II. ORDER

Therefore, it is

ORDERED that the parties’ Joint Requests that their agreements (IPR2017-00985, Exs. 1011 and 1012; IPR2017-00986, Exs. 1011 and 1012; IPR2017-01003, Exs. 1023 and 1024) be treated as business confidential

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information under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) are
GRANTED; and

FURTHER ORDERED that the parties' Joint Motions to Terminate
these proceeding are GRANTED, and these proceedings are hereby
terminated.

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