Trials@uspto.gov
571-272-7822

Entered: October 4, 2018

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INTERNATIONAL BUSINESS MACHINES CORP.,
Petitioner,

v.

GROUPON, INC.,
Patent Owner.

Case IPR2017-01451
Patent 7,856,360 B2

Before JAMES A. TARTAL, TIMOTHY J. GOODSON, and JAMES A. WORTH, *Administrative Patent Judges*.

TARTAL, *Administrative Patent Judge*.

SETTLEMENT

Granting Joint Motion to Terminate Proceedings after Institution and Granting Joint Request to Keep Settlement Agreement Confidential
35 U.S.C. § 317; 37 C.F.R. §§ 42.73 and 42.74

International Business Machines Corp. ("Petitioner") and Groupon, Inc. ("Patent Owner") jointly move to terminate this case on the basis that they have entered into a settlement agreement resolving all of their disputes involving the patent challenged in this case, U.S. Patent No. 7,856,360 B2 (Ex. 1001, "the '360 patent"). Paper 30, 1–3 ("Motion" or "Mot."). The parties also filed a copy of their written settlement agreement in support of termination, as required by 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b). Ex. 1027 (the "Settlement Agreement"). The parties further request, pursuant to 37 C.F.R. § 42.74(c), that the Settlement Agreement be treated as business confidential information and be kept separate from the files of the '360 patent. Paper 31.

Notably, 35 U.S.C. § 317(a), in part, provides the following:

> An inter partes review instituted under this chapter shall be terminated with respect to any petitioner upon the joint request of the petitioner and the patent owner, unless the Office has decided the merits of the proceeding before the request for termination is filed.

Although briefing is complete in this case and oral argument was held on September 5, 2018, a final written decision has not been entered and the merits of this case have not been decided before the request for termination was filed. The parties further represent that:

1) In the only court proceeding involving the '360 patent, *Groupon, Inc. v. Int'l Bus. Machs. Corp.*, Civil Action No. 1:16-cv-5064 (N.D. Ill.), the district court granted the parties' joint motion to dismiss on October 1, 2018. Mot. 1.
2) There are no other proceedings pending before the Office involving the '360 patent. *Id.*

3) The Settlement Agreement is a true copy of the agreement entered between the parties and there are no collateral agreements or understandings made in connection with, or in contemplation of, the termination of this case. *Id.* at 2.

Under the circumstances presented in this case, we agree with the parties that it is appropriate to terminate review without rendering a final written decision and that such action promotes the Board's policy of ensuring a "just, speedy, and inexpensive" resolution to every proceeding. *See* 35 U.S.C. § 317(a); 37 C.F.R. § 42.1(b) and 42.72; *see also* Mot. 2–3.

Accordingly, it is

ORDERED that the parties' joint request that the Settlement Agreement be treated as business confidential information, to be kept separate from the patent file, under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c), is *granted*;

FURTHER ORDERED that the joint motion to terminate the case is *granted*; and

FURTHER ORDERED that this case is *terminated* as to all parties.

PETITIONER:

Kevin K. McNish
DESMARAIS LLP
kkm-ptab@desmaraisllp.com

For PATENT OWNER:

Christopher T.L. Douglas
Bruce J. Rose
Brian C. Ellsworth
ALSTON & BIRD LLP
christopher.douglas@alston.com
bruce.rose@alston.com
brian.ellsworth @alston.com