

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AMAZON.COM, INC.,
Petitioner,

v.

JUMPSPORT, INC.,
Patent Owner.

Case IPR2018-00714 (Patent 6,053,845)
Case IPR2018-00715 (Patent 6,261,207 B1)¹

Before BARRY L. GROSSMAN, KEVIN W. CHERRY, and
SCOTT B. HOWARD, *Administrative Patent Judges*.

HOWARD, *Administrative Patent Judge*.

DECISION

Granting Joint Motion to Terminate Proceeding Due to
Settlement after Institution Decision and
Granting Joint Request to File Settlement Agreement as
Business Confidential Information
35 U.S.C. § 317; 37 C.F.R. §§ 42.72, 42.74

¹ This Order addresses issues pertaining to the above-identified proceedings. We exercise our discretion to issue one Order to be filed in each case. The parties are not authorized to use this style heading for any subsequent papers.

Per our authorization provided on November 27, 2018, the parties filed a Joint Motion to Terminate the above-identified *inter partes* review proceedings due to settlement. Paper 12.² Pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b), the parties also filed a copy of their written settlement agreement. Ex. 2010.

In the Joint Motion to Terminate, the parties represent that they “have settled their dispute, and have reached agreement to terminate this *inter partes* review.” Paper 12, 1. The parties represent that they “have entered into a Settlement Agreement, and a true copy of the same is attached hereto as Exhibit 2010.” *Id.* at 2. The parties also represent that “[t]he Settlement Agreement represents the entire agreement and understanding between the parties made in connection with, or in contemplation of, the termination of this proceeding.” *Id.* The parties further represent that pending “litigation is also resolved by the parties[’] settlement agreement.” *Id.* at 4.

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.”

Although a Decision to Institute was entered on September 6, 2018 (Paper 8), we have not entered a Final Written Decision on the merits.

Under these circumstances, we determine that good cause exists to terminate the proceedings with respect to the parties. Indeed, there are strong public policy reasons to favor settlement between the parties to a proceeding. *Office Patent Trial Practice Guide*, 77 Fed. Reg. 48,756,

² We cite to the record in IPR2018-00714. Similar documents were filed in IPR2018-00715.

IPR2018-00714 (Patent 6,053,845)
IPR2018-00715 (Patent 6,261,207 B1)

48,768 (Aug. 14, 2012). When, as here, we have not entered a Final Written Decision on the merits, we generally expect that trial will terminate after the filing of a settlement agreement. *See id.* Accordingly, we determine that it is appropriate to terminate trial without entering a Final Written Decision. *See* 37 C.F.R. § 42.72.

The parties also filed a Joint Request to File Settlement Agreement as Business Confidential Information. Paper 13. The parties requested that the Settlement Agreement (Ex. 2010) be filed as business confidential information, and that the Settlement Agreement be kept separate from the file of the patent involved in the *inter partes* review and not be made available to any third party, except as provided for in 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c). *Id.* at 1.

Our rules provide as follows:

A party to a settlement may request that the settlement be treated as business confidential information and be kept separate from the files of an involved patent or application. The request must be filed with the settlement. If a timely request is filed, the settlement shall only be available: (1) To a Government agency on written request to the Board; or (2) To any other person upon written request to the Board to make the settlement agreement available, along with the fee specified in § 42.15(d) and on a showing of good cause.

37 C.F.R. § 42.74(c).

After reviewing the Settlement Agreement between Petitioner and Patent Owner, we find that the Settlement Agreement contains confidential business information regarding the terms of settlement. We determine that it is appropriate to treat the Settlement Agreement between Petitioner and Patent Owner as business confidential information pursuant to 37 C.F.R. § 42.74(c).

IPR2018-00714 (Patent 6,053,845)
IPR2018-00715 (Patent 6,261,207 B1)

ORDER

In consideration of the foregoing, it is hereby:

ORDERED that the Joint Motion to Terminate, as to both Petitioner and Patent Owner, is GRANTED, and IPR2018-00714 and IPR2018-00715 are hereby terminated; and

FURTHER ORDERED that the parties' joint request to file the settlement agreement (Ex. 2010) as business confidential information under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) is GRANTED.

IPR2018-00714 (Patent 6,053,845)
IPR2018-00715 (Patent 6,261,207 B1)

PETITIONER:

Joshua A. Griswold
Carl Bruce
Walter Renner
FISH & RICHARSON P.C.
griswold@fr.com
bruce@fr.com
axf-ptab@fr.com

PATENT OWNER:

Cabrach J. Connor
CONNOR KUDLAC LEE PLLC
cab@connorleepllc.com

John Kasha
john.kasha@kashalaw.com