

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ALARM.COM, INC.,

Petitioner,

v.

ROTHSCHILD BROADCAST DISTRIBUTION SYSTEMS, LLC,

Patent Owner.

Case IPR2018-01001
Patent 8,856,221 B2

Before KALYAN K. DESHPANDE, JUSTIN T. ARBES, and
SCOTT C. MOORE, *Administrative Patent Judges*.

MOORE, *Administrative Patent Judge*.

DECISION

Granting Joint Motion to Terminate

35 U.S.C. § 317(a); 37 C.F.R. §§ 42.5, 42.72

Granting Joint Request to File Settlement Agreement as

Business Confidential Information

35 U.S.C. § 317(b); 37 C.F.R. § 42.74(c)

Pursuant to our e-mail authorization of September 27, 2018, Petitioner and Patent Owner filed a Joint Motion to Terminate (Paper 6, “Joint Motion to Terminate”). The Parties also submitted a copy of their Settlement and License Agreement (Ex. 1012), and filed a Joint Request to File Settlement Agreement as Business Confidential Information and to be Kept Separate (Paper 7, “Joint Request to Keep Confidential”).

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.” Where a proceeding is terminated as to the petitioner, “the Office may terminate the review [entirely] or proceed to a final written decision.” 35 U.S.C. § 317(a); *see also* 37 C.F.R. § 42.72 (“The Board may terminate a trial without rendering a final written decision, where appropriate, including . . . pursuant to a joint request under 35 U.S.C. 317(a) . . .”). Any agreements or understandings between the patent owner and a petitioner “made in connection with, or in contemplation of, the termination of an *inter partes* review . . . shall be in writing and a true copy of such agreement or understanding shall be filed in the Office before the termination.” 35 U.S.C. § 317(b); *see also* 37 C.F.R. § 42.74(b) (“Any agreement or understanding between the parties made in connection with, or in contemplation of, the termination of a proceeding shall be in writing and . . . shall be filed with the Board . . .”).

The Parties filed their Joint Motion to Terminate early in this proceeding, more than a month and a half before the deadline for the Board to issue an institution decision. In their Joint Motion to Terminate, the

Parties represent that their Settlement and License Agreement resolves this dispute, as well as related litigations pending in the U.S. District Courts for the Districts of Utah and of Delaware. Paper 6, 1. The parties also represent that no other related agreements exist. *Id.*

On this record, we find that the parties have complied with 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b). In view of the early stage of this proceeding, we find it appropriate to terminate as to both Petitioner and Patent Owner. 35 U.S.C. § 317(a); 37 C.F.R. §§ 42.5, 42.72. We also grant the Parties' request to treat the Settlement and License Agreement as business confidential information to be kept separate from the file of U.S. Patent No. 8,856,221 B2. 35 U.S.C. § 317(b); 37 C.F.R. § 42.74(c).

Accordingly, it is:

ORDERED that the Joint Motion to Terminate (Paper 6) is *granted*, and this proceeding is hereby *terminated* as to both Petitioner and Patent Owner; and

FURTHER ORDERED that the Joint Request to Keep Confidential (Paper 7) is *granted*, that Exhibit 1012 shall remain designated as "Parties and Board Only" in the Board's filing system, and that Exhibit 1012 shall be kept separate from the file of U.S. Patent No. 8,856,221 B2 and made available only to Federal Government agencies on written request, or to any person on a showing of good cause, under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

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Patent 8,856,221 B2

For PETITIONER:

Stephanie Schonewald
sschonewald@choate.com

For PATENT OWNER:

Jay Johnson
jay@kjpllc.com