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Paper 38
Entered: October 15, 2019

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

EXPEDIA, INC., HOMEAWAY.COM, INC., HOTELS.COM L.P.,
HOTWIRE, INC., AND ORBITZ, LLC.,
Petitioner,

v.

INTERNATIONAL BUSINESS MACHINES CORP.,
Patent Owner.

Case IPR2018-01134 (Patent 5,961,601)
Case IPR2018-01136 (Patent 5,796,967)
Case IPR2018-01354 (Patent 5,961,601)

Before HUBERT C. LORIN, MICHAEL W. KIM, DAVID C. McKONE, KEVIN W. CHERRY, CHARLES J. BOUDREAU, and MICHELLE N. WORMMEESTER, *Administrative Patent Judges*.[1]

BOUDREAU, *Administrative Patent Judge*.

DECISION
Granting Joint Motions to Terminate
35 U.S.C. § 317; 37 C.F.R. §§ 42.72, 42.74

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[1] This is not an expanded panel. Rather, this Decision lists judges from overlapping panels in the three above-captioned proceedings.

On October 3, 2019, Expedia, Inc., Homeaway.com, Inc., Hotels.com L.P., Hotwire, Inc., and Orbitz, LLC (collectively, "Petitioner") and International Business Machines Corp. ("Patent Owner") filed joint motions to terminate these proceedings pursuant to 35 U.S.C. § 317 and 37 C.F.R. §§ 42.72, 42.74. IPR2018-01134, Paper 42 ("1134 Mot."); IPR2018-01136, Paper 35; IPR2018-01354, Paper 36. The motions each were accompanied by a copy of a settlement agreement (IPR2018-01134, Ex. 2022; IPR2018-01136, Ex. 2119; IPR2018-01354, Ex. 2128), and a joint request to treat the settlement agreement as business confidential information, to be kept separate from the patent file, pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) (IPR2018-01134, Paper 43; IPR2018-01136, Paper 36; IPR2018-01354, Paper 37).

The parties represent in their joint motions that they have settled all of their disputes involving the patents challenged in these proceedings and that they have jointly moved to dismiss with prejudice the only pending litigation between the parties involving the patents challenged in these proceedings, *International Business Machines Corp. v. Expedia, Inc.*, Case No. 17-1875-LPS-CJB (D. Del.). *See, e.g.*, 1134 Mot. 1, 2; IPR2018-01134, Ex. 2023. The parties further represent that the filed settlement agreement is a true copy and certify that there are no collateral agreements or understandings made in connection with, or in contemplation of, the termination of these proceedings. *See, e.g.*, 1134 Mot. 2.

The Board generally expects that a case "will terminate after the filing of a settlement agreement, unless the Board has already decided the merits." Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,768 (Aug. 14,

2012); *see* 37 C.F.R. § 42.72. Under the circumstances presented here, we determine that it is appropriate to terminate these proceedings with respect to both Petitioner and Patent Owner. Accordingly, we grant the parties' joint motions to terminate.

We also determine that the parties have complied with the requirements of 37 C.F.R. § 42.74(c) to have the settlement agreement treated as business confidential information and kept separate from the patent files of the challenged patents. Thus, we grant the joint requests to treat the settlement agreement as business confidential.

Accordingly, it is

ORDERED that the joint motions to terminate are GRANTED;

FURTHER ORDERED that Cases IPR2018-01134, IPR2018-01136, and IPR2018-01354 are TERMINATED; and

FURTHER ORDERED that the joint requests to treat the parties' settlement agreement as business confidential information, to be kept separate from the patent file, are GRANTED.

IPR2018-01134 (Patent 5,961,601)
IPR2018-01136 (Patent 5,796,967)
IPR2018-01354 (Patent 5,961,601)

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