

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CAPTIONCALL LLC,
Petitioner,

v.

ULTRATEC, INC.,
Patent Owner.

Case IPR2019-00318 (Patent 9,967,380 B2)

Case IPR2019-00323 (Patent 9,961,196 B2)¹

Before GREGG I. ANDERSON, CHRISTOPHER M. KAISER, and
STACY B. MARGOLIES, *Administrative Patent Judges*.

ANDERSON, *Administrative Patent Judge*.

DECISION
Granting Joint Motion to Terminate
37 C.F.R. § 42.72

¹ The parties are not authorized to use this caption. The parties should use the caption applicable to the specific case.

INTRODUCTION

Per our email dated March 5, 2019, we authorized the filing of a motion to terminate the above identified proceedings (“’318 IPR” and “’323 IPR” respectively). *See* ’318 and ’323 IPR, Ex. 1036. The ’318 and ’323 IPRs respectively involve challenges to claims of U.S. Patent Nos. 9,967,380 and 9,961,196 (“’380 patent” and “’196 patent,” respectively). Per our authorization, on March 22, 2019, Caption Call LLC (“Petitioner”) and Ultratec, Inc. (“Patent Owner”) filed a Joint Motion to Terminate Proceeding (“Joint Motion”) for each proceeding. ’318 IPR and ’323 IPR, Paper 7.

The parties explain that, on March 4, 2019, the parties conferred and agreed that as a result of a terminal disclaimer filed in U.S. Application No. 15/010,199 (“’199 application,” Ex. 1037), Patent Owner disclaimed any patent term for the ’380 and ’196 patents beyond the term of the U.S. Patent No. 6,603,835 (“’835 patent,” Ex. 1038). ’318 and ’323 IPR, Paper 7, 1–2 (citing Ex. 1037, 588). The parties assert that the “’835 Patent expired on September 8, 2017,” before the ’380 or ’196 patents issued. ’318 IPR, Paper 7, 2; ’323 IPR, Paper 7, 3. Thus, according to the parties, each challenged patent “issued as an expired patent without any patent term” because of the terminal disclaimer. ’318 IPR, Paper 7, 1; ’323 IPR, Paper 7, 1.

DISCUSSION

The Joint Motion sets forth the parties’ agreement that the issuance of the ’380 and ’196 patents without any patent term means “neither the parties nor the Board will be subject to any future disputes” if the ’318 and ’323 IPRs are terminated. ’318 and ’323 IPR, Paper 7, 3. Further, the parties represent the only agreement between the parties is their understanding that the ’380 and ’196 patents issued as expired patents “on the same date that the ’835 Patent

expired, namely, September 8, 2017.” ’318 IPR Paper 7, 3; *see also* ’323 IPR, Paper 7, 4 (making similar comment on expiration). The parties assert that “there is no other agreement or understanding, oral or written, between the parties made in connection with, or in contemplation of, the termination of this proceeding.” ’318 IPR, Paper 7, 3–4; ’323 IPR, Paper 7, 4; *see* 37 C.F.R. § 42.74(b).

These proceedings are at a preliminary stage, no institution decision has been entered, and trial has not commenced. We are persuaded that, under these circumstances, it is appropriate to terminate both proceedings. *See* 37 C.F.R. § 42.72.

ORDER

Accordingly, it is:

ORDERED that the Joint Motion to terminate the ’318 and ’323 IPRs is granted and both proceedings are hereby terminated.

PETITIONER:

Ruben Munoz
John Wittenzellner
AKIN GUMP STRAUSS HAUER & FELD LLP
rmunoz@akingump.com
jwittenzellner@akingump.com

PATENT OWNER:

Michael Jaskolski
Louis Klapp
QUARLES & BRADY LLP
Michael.jaskolski@quarles.com
Louis.klapp@quarles.com