

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

UNIFIED PATENTS INC.,
Petitioner,

v.

UNIVERSAL CIPHER LLC,
Patent Owner.

IPR2019-00498
Patent 8,023,647 B2

Before JAMESON LEE, MICHAEL R. ZECHER, and KEVIN W. CHERRY,
Administrative Patent Judges.

ZECHER, *Administrative Patent Judge.*

TERMINATION
Due to Settlement After Institution of Trial
35 U.S.C. § 317; 37 C.F.R. § 42.72

I. DISCUSSION

On March 5, 2020, the parties filed the following documents: (1) a Joint Motion to Terminate Proceeding Under 35 U.S.C. § 317(a) and 37 C.F.R. § 42.72 (Paper 19, “Mot.”); (2) a true copy of the settlement agreement (Paper 21¹); and (3) a Joint Request to Treat Settlement Agreement as Business Confidential Information Pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) (Paper 20). For the following reasons, we *grant* the parties’ Joint Motion to Terminate and their request to treat the settlement agreement as business confidential information.

This trial is still in its early stages. On November July 16, 2019, we entered a decision instituting an *inter partes* review of claims 1–3, 7–16, 18, and 19 of U.S. Patent No. 8,023,647 B2 (Ex. 1001, “the ’647 patent”). Paper 7. On October 21, 2019, Patent Owner, Universal Cipher LLC (“Universal Cipher”), filed a Contingent Motion to Amend, in which it requested that we provide Preliminary Guidance on the Motion to Amend in accordance with the Board’s pilot program concerning motion to amend practice and procedures. Paper 13. After Petitioner, Unified Patents, Inc. (“Unified”), filed an Opposition to the Contingent Motion to Amend (Paper 16) on January 20, 2020, we issued the Preliminary Guidance (Paper 17) on February 5, 2020, as requested by Universal Cipher. Because Universal Cipher still has the opportunity to file a Reply to Unified’s Opposition to the Contingent Motion to Amend or, alternatively, a revised motion to amend, we have not yet decided the merits of this proceeding.

In the Joint Motion to Terminate, the parties indicate that they “have settled their dispute with respect to the ’647 [p]atent and have reached agreement to

¹ The parties filed the true copy of their settlement agreement as a paper, rather than as a separate exhibit. The parties should have filed the true copy of their settlement agreement as a separate exhibit in accordance with 37 C.F.R. § 42.63(a) (“Evidence consists of affidavits, transcripts of depositions, documents, and things. All evidence must be filed in the form of an exhibit.”).

terminate this *Inter Partes Review* . . . proceeding.” Mot. 1. The parties represent the settlement agreement is “a true and correct copy” and that “[t]here are no collateral agreements or understandings made in connection with, or in contemplation of, the termination of this proceeding.” *Id.* The parties further represent that they “are not aware of any other proceedings involving the ’647 [p]atent at this time.” *Id.* at 3. Under these particular circumstances, we determine that it is appropriate to terminate this trial without rendering any further decisions. *See* 37 C.F.R. § 42.72.

We also have reviewed the true copy of the parties’ settlement agreement (Paper 21), and we determine that good cause exists to treat this settlement agreement as business confidential information under 37 C.F.R. § 317(b) and 37 C.F.R. § 42.74(c).

II. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that the parties’ request to treat the true copy of the settlement agreement (Paper 21) as business confidential information under 37 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) is *granted*; and

FURTHER ORDERED that the Joint Motion to Terminate is *granted*, and this proceeding is hereby terminated;

IPR2019-00498
Patent 8,023,647 B2

For PETITIONER:

Roshan Mansinghani
Jonathan Stroud
Jung S. Hahm
Unified Patents Inc.
roshan@unifiedpatents.com
jonathan@unifiedpatents.com
jung@unifiedpatents.com

Scott A. McKeown
Victor Cheung
Ropes & Gray LLP
scott.mckeown@ropesgray.com
victor.cheung@ropesgray.com

For PATENT OWNER:

Richard A. Baker
New England Intellectual Property, LLC
rbaker@newenglandip.com

Alexander Pokot
AP Patents
info@ap-patents.com