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Paper No. 17
Entered: December 19, 2019

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SPOTIFY USA INC.,
Petitioner,

v.

S.I.SV.EL. SOCIETA ITALIANA
PER LO SVILUPPO DELL'ELETTRONICA S.P.A.,
Patent Owner.

Case IPR2019-00521
Patent 7,035,863 B2

Before TERRENCE W. MCMILLIN, AMANDA F. WIEKER, and MONICA S. ULLAGADDI, *Administrative Patent Judges*.

WIEKER, *Administrative Patent Judge*.

TERMINATION
Due to Settlement After Institution of Trial
35 U.S.C. § 317; 37 C.F.R. § 42.74

On December 18, 2019, with Board authorization, Petitioner and Patent Owner filed a Joint Motion to Terminate *Inter Partes* Review and Joint Request to Keep Documents Separate as Business Confidential Information. Paper 16 ("Joint Motion," "Joint Mot."); *see also* 37 C.F.R. § 42.74(c) (a party to a settlement may request that the settlement agreement be treated as business confidential and be kept separate from the patent file). Along with the Joint Motion, the parties filed a copy of a Settlement and Patent License Agreement. Ex. 2006.

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 the patent owner, unless the Office has decided the merits of the proceeding before the request for termination is filed." It is also provided in 35 U.S.C. § 317(a) that if no petitioner remains, the Office may terminate the *inter partes* review.

On July 26, 2019, the Board issued a decision to institute an *inter partes* review in this proceeding. Paper 9.[1] However, the Board has not yet decided the merits of the proceeding, or entered a final written decision. In the Joint Motion, the parties state that they have settled their dispute and jointly request termination of this proceeding. Joint Mot. 3–4. Accordingly, in the circumstances present here, we determine that it is appropriate to

[1] A series of typographical errors appear on page 3, in which the Joint Motion states, "On October 18, 2019, Sisvel filed its Patent Owner's Response and Contingent Motion to Amend. (Paper 14.)." The record reflects that Patent Owner filed its Response as Paper 13, on November 1, 2019. The record does not include a Motion to Amend. Additionally, on page 6 of the Joint Motion, a typographical error indicates that Matthew I. Kreeger is "Attorney for Patent Owner." Mr. Kreeger is counsel for Petitioner. *See* Paper 1.

terminate this proceeding. 37 C.F.R. § 42.71(a). This Order does not constitute a final written decision pursuant to 35 U.S.C. § 318(a).

The parties also ask that the Settlement and Patent License Agreement be treated as business confidential information and be kept separate from the file of the challenged patent. Joint Mot. 5. We determine that it is appropriate to treat the Settlement and Patent License Agreement as business confidential information, and to keep that document separate from the files of the challenged patent, pursuant to 37 C.F.R. § 42.74(c).

For the foregoing reasons, it is:

ORDERED that the Joint Motion (Paper 16) is *granted* and this proceeding is terminated with respect to Petitioner and Patent Owner; and

FURTHER ORDERED that the Settlement and Patent License Agreement (Ex. 2006) be treated as business confidential information, to be kept separate from the patent file.

For PETITIONER:

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