

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MCP IP, LLC,
Petitioner,

v.

CRAIG T. YEHLE,
Patent Owner.

Case IPR2019-00990 Patent 7,305,979 B1
Case IPR2019-01013 Patent 7,770,568 B1¹

Before JOHN G. NEW, NEIL T. POWELL, and
CHRISTOPHER G. PAULRAJ, *Administrative Patent Judges*.

POWELL, *Administrative Patent Judge*.

DECISION

Granting Renewed Joint Motion to Terminate Proceeding and Joint Request to
Treat Settlement Agreement as Business Confidential Information

35 U.S.C. § 317; 37 C.F.R. §§ 42.72, 42.74

¹ This Decision applies to both cases. We exercise our discretion to issue one Termination to be docketed in each case. The parties may not use this caption for any subsequent papers without prior Board authorization.

With the Board’s authorization, on March 6, 2020, the parties filed in each of these proceedings a Joint Motion to Terminate. Paper 20² (“Motion” or “Mot.”). With each Motion, the parties filed a Term Sheet. IPR2019-00990, Ex. 1021; IPR2019-01013, Ex. 1022. Also with the Board’s authorization, on March 6, 2020, the parties filed in each of these proceedings a Joint Request to Treat Settlement Agreement as Business Confidential under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.72(c). Paper 21³, (“Request” or “Req.”).

In the Motion, the parties represented that they have “settled all dispute relating to” the patents challenged in these proceedings. Mot. 3. The parties also explained that their

settlement agreement is in writing in the form of a binding Term Sheet. The Parties further certify that there are no collateral agreements or understandings made in connection with, or in contemplation of, the termination of the present *inter partes* review, *other than the execution of a settlement and license agreement*, which must incorporate all terms and provisions of the binding Term Sheet.

Mot. 4 (emphasis added).

In view of this representation and the requirements of 35 U.S.C. § 317(b), we denied the Motion without prejudice, authorizing the parties to file a renewed motion to terminate. Paper 22⁴. On March 13, 2020, the parties filed, in each of these proceedings, a Renewed Joint Motion to terminate. Paper 25⁵ (“Renewed Motion”). In the Renewed Motion, the parties represent that their

settlement agreement is in writing in the form of a binding Term Sheet, which serves as the settlement and license agreement. The Parties

² The Motion is Paper 20 in both proceedings.

³ The Request is Paper 21 in both proceedings.

⁴ This Decision appears as Paper 22 in both proceedings.

⁵ The Renewed Motion is Paper 25 in both proceedings.

further certify that there are no collateral agreements or understandings made in connection with, or in contemplation of, the termination of the present *inter partes* review. A true and correct copy of the Term Sheet was submitted with the Parties' first Joint Motion to Terminate Proceeding (Paper 20) as Exhibit 1021, pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74 (b).

Id. at 4.

In view of the circumstances presented in this case, we agree that terminating these proceedings is proper at this time. Indeed, there are strong public policy reasons to favor settlement between the parties to a proceeding. *Office Patent Trial Practice Guide*, 77 Fed. Reg. 48,756, 48,768 (Aug. 14, 2012). When, as here, we have not rendered a Final Written Decision on the merits, we generally expect that the proceeding will terminate after the filing of a settlement agreement. *See id.* Based on the preceding, we determine that it is appropriate to terminate these proceedings without rendering a Final Written Decision.

It is

ORDERED that in each proceeding, the Renewed Joint Motion to Terminate to Terminate is *granted*; and

FURTHER ORDERED that in each proceeding, the parties' Joint Request to Treat Settlement Agreement as Business Confidential under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.72(c) is *granted*.

IPR2019-00990 Patent 7,305,979 B1

IPR2019-01013 Patent 7,770,568 B1

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