

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

COMCAST CABLE COMMUNICATIONS, LLC,
Petitioner,

v.

ROVI GUIDES, INC.,
Patent Owner.

IPR2019-01353
Patent 8,448,215 B2

Before KRISTEN L. DROESCH, BARBARA A. PARVIS, and
KRISTI L. R. SAWERT, *Administrative Patent Judges*.

PARVIS, *Administrative Patent Judge*.

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

On November 13, 2020, pursuant to the Board’s authorization, Comcast Communications, LLC (“Petitioner”) and Rovi Guides, Inc. (“Patent Owner”) filed a joint motion to terminate this *inter partes* review pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. § 42.72. Paper 46 (“Joint Motion” or “Mot.”). The Joint Motion was accompanied by a true, unredacted copy of a Settlement Agreement (Exhibit 2026) and a true, unredacted copy of a Patent License Agreement (Exhibit 2027). The parties also filed a joint request to treat the Settlement Agreement and the Patent License 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). Paper 47.

In its Joint Motion, the parties “jointly request that the Board terminate this proceeding in its entirety.” Mot. 2. The parties state that they “have resolved their disputes regarding” U.S. Patent No. 8,448,215 B2 (“the ’215 patent”). The parties also state that they “do not anticipate further litigation between them concerning the ’215 Patent.” *Id.* at 1. The parties state that “[t]ermination is appropriate at this stage and in view of a settlement between Petitioner and Patent Owner.” *Id.* at 2.

The Board generally expects that “a proceeding will terminate after the filing of a settlement agreement, unless the Board has already decided the merits.” Consolidated Trial Practice Guide, 86 (Nov. 2019), <https://www.uspto.gov/sites/default/files/documents/tpgnov.pdf?MURL=>; *see also* 37 C.F.R. § 42.72. Here, although the Board has instituted *inter partes* review of the ’215 patent and held an oral argument, the Board has not decided the merits of the proceeding. Under the circumstances presented here, therefore, we determine that it is appropriate to terminate this

proceeding with respect to both Petitioner and Patent Owner. Accordingly, we grant the parties' Joint Motion 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 and the Patent License Agreement treated as business confidential information and kept separate from the files of the '215 patent in this proceeding. Thus, we grant the parties' request to treat the Settlement Agreement and the Patent License Agreement as business confidential.

Accordingly, it is

ORDERED that the Joint Motion to terminate is GRANTED;

FURTHER ORDERED that the joint request to treat the parties' Settlement Agreement (Exhibit 2026) and Patent License Agreement (Exhibit 2027) as business confidential information, to be kept separate from the patent file, is GRANTED; and

FURTHER ORDERED that the instant proceeding is TERMINATED.

IPR2019-01353
Patent 8,448,215 B2

PETITIONER:

Frederic M. Meeker
Bradley C. Wright
Blair A. Silver
Charles L. Miller
Brian J. Emfinger
BANNER & WITCOFF, LTD.
fmeeker@bannerwitcoff.com
bwright@bannerwitcoff.com
bsilver@bannerwitcoff.com
cmiller@bannerwitcoff.com
bemfinger@bannerwitcoff.com

PATENT OWNER:

Jason D. Eisenberg
Ross G. Hicks
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.
jasone-PTAB@sternekessler.com
rhicks-PTAB@sternekessler.com