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Paper No. 30
Date: November 19, 2020

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

COMCAST CABLE COMMUNICATIONS, LLC,
Petitioner,

v.

ROVI GUIDES, INC.,
Patent Owner.

IPR2019-01375
Patent 9,055,319 B2

Before KARL D. EASTHOM, ROBERT J. WEINSCHENK, and CHRISTOPHER L. OGDEN, *Administrative Patent Judges.*

OGDEN, *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, the parties filed a Joint Motion to Terminate *Inter Partes* Review (Paper 28 ("Motion")) of U.S. Patent 9,055,319 B2, Settlement and Licensing Agreements (Exs. 2010, 2011) (collectively "Agreements"), and a Joint Request that the Settlement and Licensing Agreements be Treated as Business Confidential Information and Kept Separate Under 35 U.S.C. § 317(a) ("Request") (Paper 29).

Under 35 U.S.C. § 317(a), applicable to *inter partes* review proceedings, an "inter partes review . . . 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." The Board has not "decided the merits of the proceeding." *See id.*

Under 35 U.S.C. § 317(b), "[a]ny agreement or understanding between the patent owner and a petitioner, including any collateral agreements referred to in such agreement or understanding, made in connection with, or in contemplation of, the termination of an inter partes review . . . shall be in writing and a true copy of such agreement or understanding shall be filed in the Office." The Agreements appear to be a true copy of the agreement between the parties, specify the instant proceeding, and identify other matters that are to be settled between the parties. *See* Ex. 2010; Ex. 2011.

Under these circumstances, we determine that it is appropriate to grant the Motion to terminate the trial without rendering a final written decision pursuant to 35 U.S.C. § 318(a) and to grant the Request as the Agreements contain sensitive business confidential information. *See* 37 C.F.R. §§ 42.5(a), 42.72.

Accordingly, it is

ORDERED that the Motion and Request are *granted*;

FURTHER ORDERED that the Agreements, Exhibit 2010 and Exhibit 2011, be treated as business confidential information, designated "Board Only," and kept separate from the file of the involved patent under the provisions of 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c); and

FURTHER ORDERED that the *inter partes* review is terminated.

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