

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NIKE, INC., WILLIAMS-SONOMA, INC., and STAPLES, INC.,
Petitioner,

v.

REALZOOM LLC,
Patent Owner.

IPR2020-00118
Patent 7,774,712 B2

Before MICHAEL R. ZECHER, STACEY G. WHITE, and
JOHN P. PINKERTON, *Administrative Patent Judges*.

PINKERTON, *Administrative Patent Judge*.

DECISION
Settlement Prior to Institution of Trial
37 C.F.R. § 42.74

On April 1, 2020, the parties filed a Joint Motion to Terminate this proceeding (Paper 9, “Joint Motion”), which involves claims 1, 2, and 7–10 of U.S. Patent No. 7,774,712 B2 (Ex. 1001, “the ’712 patent”). On that same day, the parties also filed a Joint Request to Keep Settlement Agreements Separate and Be Treated as Confidential Business Information (Paper 10, “Joint Request”), the Settlement Agreement and Release between Williams-Sonoma, Inc. and Staples, Inc., and Patent Owner (Ex. 1043), and the Settlement Agreement and Release between Nike, Inc. and Patent Owner (Ex. 1044) (collectively, “the Settlement Agreements”).

In the Joint Motion, the parties state that they “have now settled their dispute and have reached agreement to terminate this *inter partes* review.” Joint Motion 1. The parties also state that they “have entered into written settlement agreements that fully resolve this matter.” *Id.* In that regard, the parties state that they are “concurrently filing a copy of the settlement agreements as Exhibits 1043 and 1044 along with a request to treat the agreements as confidential business information pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).” *Id.* at 1–2. Moreover, the parties “represent that there are no other collateral agreements or understandings, oral or written, between the parties made in connection with, or in contemplation of, the termination of the present proceeding, and that Exhibits 1043 and 1044 represent a true and accurate copy of the agreement between the parties that resolves the present proceeding.” *Id.* at 2.

The parties further state that the lawsuits in which Patent Owner asserted the ’712 patent against each Petitioner entity, *realZOOM LLC v. NIKE, Inc.*, No. 5:18-cv-00139 (E.D. Tex.), *realZOOM LLC v. Staples, Inc.*, No. 5:19-cv-00063 (E.D. Tex.), and *realZOOM LLC v. Williams-Sonoma*,

Inc., No. 5:19-cv-00064 (E.D. Tex.), “have been dismissed with prejudice.”
Id.

This case is in its preliminary stages, and we have not yet decided whether to institute an *inter partes* review. The foregoing factor weighs in favor of granting the Joint Motion; and, we discern no factors weighing against dismissing the Petition, thereby terminating this proceeding.

See 37 C.F.R. § 42.71(a) (“The Board may take up petitions or motions for decision in any order, may grant, deny, or dismiss any petition or motion, and may enter any appropriate order.”). Thus, we grant the Joint Motion.

In the Joint Request, the parties request that “the Settlement and License Agreements between the parties (Ex[hibit]s 1043, 1044) . . . be treated as business confidential information, and be kept separate from the file of the involved patent.” Joint Request 1. Under these particular circumstances, we determine it is appropriate to treat the Settlement Agreements as business confidential information kept separate from the file of the ’712 patent. See 37 C.F.R. 42.74(c). Thus, we also grant the Joint Request.

For the foregoing reasons, it is:

ORDERED that the Joint Motion is GRANTED, and the Petition is dismissed resulting in termination of this proceeding; and,

FURTHER ORDERED that the Joint Request is GRANTED, and the Settlement Agreements shall be treated as business confidential information and kept separate from the file of the ’712 patent.

IPR2020-00118
Patent 7,774,712 B2

PETITIONER:

Tiffany C. Miller
James M. Heintz
DLA PIPER LLP (US)
tiffany.miller@dlapiper.com
jim.heintz@dlapiper.com

PATENT OWNER:

Stephen M. Lobbin
Joshua Osborn
SML Avvocati P.C.
sml@smlavvocati.com
jno@smlavvocati.com

Adam L. Baumli
adam@baumlilawfirm.com