

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BI SCIENCE (2009) LTD.,
Petitioner,
v.
LUMINATI NETWORKS LTD.,
Patent Owner.

IPR2020-00167
Patent 9,742,866 B2

Before THOMAS L. GIANNETTI, SHEILA F. McSHANE.
and RUSSEL E. CASS, *Administrative Patent Judges*.

CASS, *Administrative Patent Judge*.

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

On April 24, 2020, Petitioner and Patent Owner filed a Joint Motion to Terminate Pursuant to 35 U.S.C. § 317 (Paper 13; “Motion to Terminate”) under 35 U.S.C. § 317(a) and 37 C.F.R. § 42.72. With that Motion to Terminate, the Parties filed a Joint Motion to File Settlement Agreement as Business Confidential Information Pursuant to 35 U.S.C. § 317(b) (Paper 14, “Motion to Seal Settlement Agreement”).

Generally, the Board expects that a proceeding will terminate after the filing of a settlement agreement, if the settlement agreement includes all parties. *See, e.g.*, PTAB Consolidated Trial Practice Guide 86 (July 2019).

The parties submit that termination of this proceeding is proper. Motion to Terminate 1. The parties indicate that they have “settled all patent matters between them” and “have agreed to terminate this IPR.” *Id.* The parties are moving to dismiss the district court proceeding relating to the ’866 patent. *Id.* at 3. Patent Owner states that it is “not contemplating any other litigation involving the challenged patent, and neither party is contemplating any other form of proceeding involving the challenged patent.” *Id.*

The parties represent that the settlement agreement between the parties “has been made in writing, and a true and correct copy will be filed with this request as Exhibit 2001.” *Id.* at 4. “The parties jointly certify that, as required by 37 C.F.R. 42.74(b) and the Board’s Email dated March 3, 2020, the settlement agreement reflects the final settlement and resolution of disputes between the parties.” *Id.*

This proceeding is at its early stages. Patent Owner has not filed a preliminary response. There has been no decision on whether to institute *inter partes* review.

The parties further jointly request that Exhibit 2001 be treated as business confidential information and kept separate from the file of the involved patent. Motion to Seal Settlement Agreement 1.

At this early stage, we determine that termination is warranted for the reasons stated in the Motion to Terminate.

We further determine that the Settlement Agreement (Ex. 2001) filed by the parties constitutes business confidential information. Therefore, we find there is good cause to grant the parties' Motion to Seal Settlement Agreement.

Accordingly, it is

ORDERED that the Motion to Terminate is *granted*;

FURTHER ORDERED that this proceeding is terminated with respect to both Petitioner and Patent Owner; and

FURTHER ORDERED that the parties' Motion to Seal Settlement Agreement is granted, and Exhibit 2001 shall be sealed and kept separate from the file of this case, consistent with 37 C.F.R. § 42.74(b).

IPR2020-00167
Patent 9,742,866 B2

PETITIONER:

Ronald Abramson
M. Michael Lewis
Ari J. Jaffess
Rebecca Rothkopf
LISTON ABRAMSON LLP
ron.abramson@listonabramson.com
michael.lewis@listonabramson.com
ari.jaffess@listonabramson
michael.lewis@listonabramson.com

PATENT OWNER:

Thomas M. Dunham
Don F. Livornese
RUYAKCHERIAN LLP
tomd@ruyakcherian.com
donl@ruyakcherian.com