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Paper 9
Entered: April 21, 2020

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SPOTIFY USA, INC.,
Petitioner,

v.

EXCALIBUR IP, LLC,
Patent Owner.

IPR2020-00421 (Patent 8,160,840 B2)
IPR2020-00422 (Patent 8,392,148 B2)
IPR2020-00461 (Patent 8,352,331 B2)
IPR2020-00462 (Patent 7,454,509 B2)[1]

Before GEORGIANNA W. BRADEN, ELIZABETH M. ROESEL, and SHEILA F. McSHANE, *Administrative Patent Judges*.

ROESEL, *Administrative Patent Judge.*

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

[1] This Order applies to each of the listed cases. We exercise our discretion to issue one Order to be docketed in each case. The parties, however, are not authorized to use this caption for any subsequent papers.

With prior Board authorization, Petitioner Spotify USA, Inc. and Patent Owner Excalibur IP, LLC filed a joint motion to terminate. Paper 8 ("Mot.").[2] The parties represent that they "have settled with respect to the challenged patent and have reached agreement to terminate this IPR." Mot. 2. The parties further represent that the court in the related district court action has dismissed the claim for infringement of the challenged patent at the request of the parties. Mot. 4 (citing *Excalibur IP, LLC v. Spotify AB*, No. 1:19-cv-00165 (D. Del.) (electronic order, April 15, 2020)).

The parties filed an exhibit,[3] which they represent is "the written agreement that contemplates the termination of this proceeding." *Id.* The parties jointly request that their written agreement be treated as business confidential information pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c). Paper 7.

This proceeding is at a very early stage. The parties' request for authorization to file a joint motion to terminate was made nearly one month before the due date for a Patent Owner Preliminary Response, and the joint motion to terminate was filed more than two weeks before that due date. No Preliminary Response has been filed by Patent Owner. The Board has not yet considered the merits of the Petition and has not made a decision whether to institute an *inter partes* review.

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[2] We refer to the papers filed in IPR2020-00421. However, similar papers were filed in each of IPR2020-00422, IPR2020-00461, and IPR2020-00462, and this Order applies equally in each of these cases.

[3] The exhibit number for each case is listed in the Order below.

Under these circumstances, and in view of the parties' representations in their joint motion, we determine that it is appropriate to terminate this proceeding.

We also determine that it is appropriate that the parties' written agreement be treated as business confidential information and be kept separate from the patent files pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

ORDER

Accordingly, it is:

ORDERED that the joint motion to terminate this proceeding is *granted*, and this proceeding is terminated;

FURTHER ORDERED that the parties' joint request that their written agreement be treated as business confidential information and kept separate from the patent file is *granted*; and

FURTHER ORDERED that this order pertains to the following cases and patents and applies the business confidential designation to the following exhibits:

IPR2020-00421	Patent 8,160,840 B2	Exhibit 1012
IPR2020-00422	Patent 8,392,148 B2	Exhibit 1012
IPR2020-00461	Patent 8,352,331 B2	Exhibit 1011
IPR2020-00462	Patent 7,454,509 B2	Exhibit 1012

IPR2020-00421 (Patent 8,160,840 B2)
IPR2020-00422 (Patent 8,392,148 B2)
IPR2020-00461 (Patent 8,352,331 B2)
IPR2020-00462 (Patent 7,454,509 B2)

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