

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NICE LTD.,
Petitioner,

v.

CALLMINDER, INC.,
Patent Owner.

IPR2020-00578 (Patent 7,346,509 B2)
IPR2020-00616 (Patent 8,583,434 B2)¹

Before BRYAN F. MOORE, STACEY G. WHITE, and JOHN R. KENNY,
Administrative Patent Judges.

WHITE, *Administrative Patent Judge.*

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

¹ This Order applies to each of the listed cases. Given the similarities of issues, we issue one Order to be docketed in each case. The parties, however, are not authorized to use this filing style in subsequent papers.

I. INTRODUCTION

With the Board’s authorization, Petitioner and Patent Owner (collectively referred to as “the Parties”) filed Joint Motions to Terminate the above-identified proceedings due to settlement. Paper 32² (“Joint Motion”). In support of the Joint Motion, the Parties filed a copy of a Settlement Agreement (Ex. 2010 (“Settlement Agreement”)) and Joint Stipulation of Dismissal (Ex. 2009), as well as a Joint Request to File Settlement Agreement as Business Confidential Information pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) (Paper 33 (“Joint Request”)).

II. DISCUSSION

Under 35 U.S.C. § 317(a), “[a]n inter partes review instituted under this chapter 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.” Section 35 U.S.C. § 317(a) also provides that if no petitioner remains in the *inter partes* review, the Office may terminate the review.

In the Joint Motion, the Parties represent that they have reached an agreement that resolves the co-pending district court litigation as well as IPR2020-00578 and IPR2020-00616. Joint Motion 1–2. The Parties further represent that the filed copy of the Settlement Agreement is a “true and accurate copy,” and “that there are no other agreements, oral or written,

² The parties made substantially similar filings in IPR2020-00578 and IPR2020-00616. See IPR2020-00616, Paper 32 (Joint Motion), Paper 33 (Joint Request), Ex. 2010 (Settlement Agreement), Ex. 2009 (Joint Stipulation). For ease of reference, we will be referring to the papers and exhibits filed in the 578 proceeding.

IPR2020-00578 (Patent 7,346,509 B2)
IPR2020-00616 (Patent 8,583,434 B2)

between the parties made in connection with, or in contemplation of, the termination of the proceeding.” *Id.* at 2.

We instituted a trial in the above-identified proceeding in September 2020. Paper 12. We have not yet decided the merits of the proceeding, and a final written decision has not been entered. Notwithstanding that the proceeding has moved beyond the preliminary stage, the Parties have adequately shown that termination of the proceeding is appropriate. Under these circumstances, we determine that good cause exists to terminate the proceeding with respect to the Parties.

In the Joint Request, the Parties request that the Settlement Agreement be treated as business confidential information and be kept separate from the file of the patent involved in this *inter partes* proceeding. Joint Request 1. After reviewing the Settlement Agreement between Petitioner and Patent Owner, we find that the Settlement Agreement contains confidential business information regarding the terms of settlement. We determine that good cause exists to treat the Settlement Agreement between Petitioner and Patent Owner as business confidential information pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

This Order does not constitute a final written decision pursuant to 35 U.S.C. § 318(a).

III. ORDER

Accordingly, for the reasons discussed above, it is:

ORDERED that the Joint Motions to Terminate are *granted*, and IPR2020-00578 and IPR2020-00616 are *terminated* with respect to

IPR2020-00578 (Patent 7,346,509 B2)

IPR2020-00616 (Patent 8,583,434 B2)

Petitioner and Patent Owner pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. § 42.72; and

FURTHER ORDERED that the Joint Request to File Settlement Agreement as Business Confidential Information is *granted*, and the Settlement Agreement shall be kept separate from the file of Patent 8,583,434 B2, and be made available only to Federal Government agencies on written request, or to any person on a showing of good cause, pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

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