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Paper 10
Entered: August 21, 2020

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

WALMART INC. AND VUDU, INC.,
Petitioner,

v.

SOUND VIEW INNOVATIONS, LLC,
Patent Owner.

IPR2020-00816
Patents 7,426,715 B2

Before JAMESON LEE, DANIEL J. GALLIGAN, and JOHN A. HUDALLA, *Administrative Patent Judges.*

LEE, *Administrative Patent Judge*.

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

DISCUSSION

On August 19, 2020, with Board authorization, the parties filed a Joint Motion to Terminate (Paper 9, "Motion to Terminate"), a settlement agreement between the parties (Ex. 2101, "Settlement Agreement"), and a request to keep the Agreement as business confidential information and separate from the file of Patent No. 7,426,715 B2 (Paper 8, "Request to Keep Settlement Agreement Confidential and Separate").

Petitioner and Patent Owner represent that they have resolved their disputes concerning four patents including Patent No. 7,426,715 B2, the patent underlying this proceeding. Paper 9, 1. The Motion to Terminate states: "[P]ursuant to a Patent License and Settlement Agreement ('Settlement Agreement') that resolves their disputes, [the parties] now move to terminate this IPR." *Id.* The parties represent that they have "agreed to voluntary dismissal of the pending related district court litigation between the Parties regarding the Patents-at-issue." *Id.* at 2. The parties identify that related litigation as *Sound View Innovations, LLC v. Walmart Inc. et al.*, No. 1-19-cv-00660 (D. Del.). *Id*.

A copy of the Settlement Agreement has been filed as Exhibit 2101. The parties represent that aside from the Settlement Agreement, "there are no other agreements or understandings, oral or written, between the Parties and made in connection with, or in contemplation of, the termination of the *inter partes* review." *Id.* at 5. "[T]he parties jointly and respectfully request that the Board terminate the instant proceeding." *Id.*

Generally, the Board expects that a proceeding will terminate after the filing of a settlement agreement, unless the Board has already decided the merits of the proceeding. PTAB Consolidated Trial Practice Guide, 86

(November 2019). This proceeding is at an early stage. We have not issued a decision on whether to institute an *inter partes* review. Under these circumstances, we grant the Motion to Terminate (Paper 9) as to both Petitioner and Patent Owner.

We also grant the Request to Keep Settlement Agreement Separate (Paper 8). *See* 37 C.F.R. § 42.74(c).

Order

It is

ORDERED that the Motion to Terminate (Paper 9) is *granted*;

FURTHER ORDERED that the Request to Keep Settlement Agreement Confidential and Separate (Paper 8) is *granted*;

FURTHER ORDERED that the Settlement Agreement (Ex. 2101) shall be treated as business confidential information, shall be kept separate from the file of Patent No. 7,426,715 B2, and shall be made available only in accordance with the provisions of 37 C.F.R. § 42.74(c); and

FURTHER ORDERED that this proceeding is *terminated* both as to Petitioner and Patent Owner, and the Petition is *dismissed*.

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