

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AT&T CORP., AT&T COMMUNICATIONS, LLC,
AT&T SERVICES, INC., and AT&T MOBILITY LLC,
Petitioner,

v.

KAIFI LLC,
Patent Owner.

IPR2020-00889
Patent 6,922,728 B2

Before KARL D. EASTHOM, JONI Y. CHANG, and
STEVEN M. AMUNDSON, *Administrative Patent Judges*.

AMUNDSON, *Administrative Patent Judge*.

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

After receiving authorization from the Board, AT&T Corp., AT&T Communications, LLC, AT&T Services, Inc., and AT&T Mobility LLC (collectively “Petitioner”) and KAIFI LLC (“Patent Owner”) filed a Joint Motion to Terminate Pursuant to 35 U.S.C. § 317 and 37 C.F.R. § 42.74. Paper 11. The parties also filed a copy of a Confidential Settlement Agreement & Patent License Agreement. Ex. 1016. In addition, the parties filed a Joint Request to File Agreement as Business Confidential Information Pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c). Paper 10.

The parties represent that they have entered into a settlement agreement that “will resolve the dispute in the above-captioned IPR if this proceeding is terminated.” Paper 11, 1. The parties also represent that “Exhibit 1016 memorializes the complete agreement of the parties, and there are no other agreements, oral or written, between the parties made in connection with, or in contemplation of, the termination of this proceeding.” *Id.* at 2–3. In addition, the parties represent that termination will “save the Board significant administrative and judicial resources in determining whether to institute an IPR proceeding, as well as potentially conducting an oral argument and issuing a final written decision to decide the patentability issues in this case.” *Id.* at 2.

This proceeding has not progressed very far. Petitioner filed the Petition on April 30, 2020. Patent Owner has not filed a Preliminary Response. The Board has not decided whether to institute an *inter partes* review. Further, “[t]here are strong public policy reasons to favor settlement between the parties to a proceeding.” *Office Patent Trial Practice Guide*, 77 Fed. Reg. 48,756, 48,768 (Aug. 14, 2012).

Under these circumstances, we determine that it is appropriate to terminate this proceeding. Further, after reviewing the parties' settlement agreement (Exhibit 1016), we find that it contains confidential business information regarding the terms of settlement. We determine that it is appropriate to treat the parties' settlement agreement (Exhibit 1016) as business confidential information under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

ORDER

Accordingly, it is

ORDERED that the parties' joint motion to terminate this proceeding is granted;

FURTHER ORDERED that this proceeding is terminated as to all parties;

FURTHER ORDERED that the parties' joint request that their settlement agreement (Exhibit 1016) be treated as business confidential information and kept separate from the file of U.S. Patent No. 6,922,728 B2 under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) is granted; and

FURTHER ORDERED that the parties' settlement agreement (Exhibit 1016) be treated as business confidential information and be kept separate from the file of U.S. Patent No. 6,922,728 B2 and made available only under the provisions of 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

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