

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TARGET CORPORATION,
Petitioner,

v.

PROXICOM WIRELESS, LLC,
Patent Owner.

IPR2020-00933
Patent 8,374,592 B2

Before BRIAN J. McNAMARA, CHARLES J. BOUDREAU, and
SEAN P. O'HANLON, *Administrative Patent Judges*.

O'HANLON, *Administrative Patent Judge*.

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

I. INTRODUCTION

Petitioner Target Corporation requested *inter partes* review of claims 19–23, 25, 26, 28, and 29 of U.S. Patent No. 8,374,592 B2 (Ex. 1001, “the ’592 patent”). Paper 2. On November 8, 2021, we issued a Final Written Decision determining that Petitioner had shown by a preponderance of the evidence that claims 19–23 were unpatentable, but failed to establish that claims 25, 26, 28, and 29 were unpatentable. Paper 30. Petitioner appealed to the Court of Appeals for the Federal Circuit (“Federal Circuit”) (Paper 31), and Patent Owner cross-appealed (Paper 32). On appeal, the Federal Circuit affirmed our Final Written Decision as to claims 19–23. Paper 35. However, the Federal Circuit vacated our Final Written Decision as to claims 25, 26, 28, and 29 and remanded the case to us for a determination as to the patentability of these claims. *Id.*

On January 19, 2024, with authorization from the Board, Petitioner and Patent Owner Proxicom Wireless, LLC (collectively, “the Parties”) filed a Joint Motion to Terminate this remanded proceeding. Paper 38 (“Motion” or “Mot.”). The Parties also filed a copy of a Confidential Settlement Agreement (Ex. 1039, “Agreement”) and a Joint Request to Keep Agreement Business Confidential and Separate Under 37 C.F.R. § 42.74(c). Paper 39 (“Joint Request” or “Req.”).

II. DISCUSSION

The Parties indicate that they have “reached an agreement resolving the dispute in [this *inter partes*] review, as well as the disputes in *Proxicom Wireless, LLC v. Target Corporation*, No. 6:19-cv-01886-RBD-LRH (M.D. Fla.),” “in which U.S. Patent No. 8,374,592 and eight other patents were

asserted.” Mot. 1–2. The Parties further indicate that they have filed “a true copy of the written Confidential Settlement Agreement resolving the dispute in [this *inter partes*] review” and “all remaining disputes,” such that “this entire proceeding should be dismissed as to both Petitioner and Patent Owner.” *Id.* at 1, 3. Accordingly, the Parties “jointly move to terminate this [*inter partes*] review proceeding.” *Id.* at 1.

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 (Nov. 2019);¹ 35 U.S.C. § 317(a). Here, although the Board has already issued a Final Written Decision, part of that decision was vacated and remanded by the Federal Circuit. The Board has not issued a decision on remand and, thus, has not decided the merits of the issues that were remanded to the Board. Under these circumstances, we determine that it is appropriate to grant the Motion and terminate this proceeding.

The Parties also jointly request that the Agreement be treated as business confidential information and be kept separate from the files of the ’592 patent. Req. 1.

After reviewing the Agreement between the Parties, we find that the Agreement contains confidential business information regarding the terms of settlement. Thus, we determine that good cause exists to treat the Agreement as business confidential information under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) and to keep it separate from the files of the ’592 patent as requested by the Parties.

¹ Available at <https://www.uspto.gov/TrialPracticeGuideConsolidated>.

III. ORDER

Accordingly, it is:

ORDERED that Joint Motion to Terminate (Paper 38) is *granted*;

FURTHER ORDERED that the Joint Request to treat the Agreement as business confidential information (Paper 39) is *granted*;

FURTHER ORDERED that the Agreement (Ex. 1039) shall remain designated as “Parties and Board Only” in the Board’s electronic filing system, be kept separate from the files of U.S. Patent No. 8,374,592 B2, and be made available only under the provisions of 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c); and

FURTHER ORDERED that IPR2020-00933 is *terminated*.

IPR2020-00933
Patent 8,374,592 B2

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