Trials@uspto.gov
571-272-7822

Paper No. 22
Entered: October 13, 2021

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LEGO SYSTEMS, INC., LEGO BRAND RETAIL, INC., WARNER BROS. HOME ENTERTAINMENT INC., and WB GAMES INC.,
Petitioner,

v.

MQ GAMING LLC,
Patent Owner.

IPR2020-01443 (Patent 9,162,149); IPR2020-01444 (Patent 9,463,380); IPR2020-01445 (Patent 9,770,652); IPR2020-01447 (Patent 8,475,275); IPR2020-01448 (Patent 8,814,688)

Before TIMOTHY J. GOODSON, RICHARD H. MARSCHALL, and FREDERICK C. LANEY, *Administrative Patent Judges*.

PER CURIAM

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

I. INTRODUCTION

On September 23, 2021, with Board authorization, the parties filed a "Joint Motion to Terminate" in each of the above-captioned proceedings. Paper 18[1] ("Mot."). Along with the Joint Motion, the parties filed two[2] Settlement Agreements, each of which describes itself as "the entire agreement between the Parties." Ex. 1018 § 14.01, Ex. 1019 § 14.01. The Joint Motion states that the "parties have settled their dispute and agreed to seek termination of these *inter partes* reviews." Mot. 2. The Settlement Agreements provide that the "terms and conditions of this Agreement constitute the entire agreement between the Parties with respect to the subject matter hereof . . . ." Ex. 1018 § 14.01, Ex. 1019 § 14.01.

The parties additionally filed in each proceeding a Joint Request to treat their agreements as business confidential information, and to maintain the agreements separate from the public file under 37 C.F.R. § 42.74(c). Paper 19.

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." The statute also provides that if no petitioner remains in the *inter partes* review, the Office may terminate the review. 35 U.S.C. § 317(a).

---

[1] Identical motions and exhibits were filed in each case. For convenience, we cite to the papers in IPR2020-01443.

[2] One Settlement Agreement is between Patent Owner and Warner Bros. and WB Games, and the other is between Patent Owner and the Lego companies.

Petitioner filed its Petitions in these proceedings in August 2020, and we issued decisions granting institution in February 2021. We have not conducted a hearing in these proceedings, and we have not decided the merits. Under these circumstances, we determine that termination of the proceedings is appropriate. *See* Consolidated Trial Practice Guide, at 86 (Nov. 2019) ("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).

We also determine that the parties have shown that the Settlement Agreements contain business confidential information, and that good cause exists to treat the Settlement Agreements as business confidential information under 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

In consideration of the foregoing, it is hereby:

ORDERED that the parties' Joint Requests (Paper 19) to treat the Settlement Agreements (Exhibits 1018 and 1019) as business confidential information under 37 C.F.R. § 42.74(c) are *granted*, and the Settlement Agreements shall be kept separate from the files of each patent, and 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); and

IPR2020-01443 (Patent 9,162,149); IPR2020-01444 (Patent 9,463,380); IPR2020-01445 (Patent 9,770,652); IPR2020-01447 (Patent 8,475,275); IPR2020-01448 (Patent 8,814,688)

FURTHER ORDERED that the parties' Joint Motions to Terminate (Paper 18) are *granted*, and each proceeding is *terminated* with respect to Petitioner and Patent Owner.

IPR2020-01443 (Patent 9,162,149); IPR2020-01444 (Patent 9,463,380); IPR2020-01445 (Patent 9,770,652); IPR2020-01447 (Patent 8,475,275); IPR2020-01448 (Patent 8,814,688)

PETITIONER:

Patrick McPherson
pdmcpherson@duanemorris.com
Manita Rawat
mrawat@duanemorris.com
Glenn Richeson
gdricheson@duanemorris.com

FOR PATENT OWNER:

Joshua Goldberg
Joshua.goldberg@finnegan.com
Elizabeth Ferrill
Elizabeth.ferrill@finnegan.com