

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FACEBOOK, INC.,
Petitioner,

v.

ONSTREAM MEDIA CORP.,
Patent Owner.

IPR2020-01525 (Patent 9,467,728 B2)
IPR2020-01527 (Patent 10,200,648 B2)
IPR2020-01528 (Patent 10,038,930 B2)

Before KARL D. EASTHOM, GEORGIANNA W. BRADEN, and
ARTHUR M. PESLAK, *Administrative Patent Judges*.

EASTHOM, *Administrative Patent Judge*.

TERMINATION¹

Due to Settlement After Institution of Trial
Granting Request to Keep Settlement Agreement Separate
35 U.S.C. § 317; 37 C.F.R. § 42.74

¹ This Termination Order applies to each case. The parties must obtain prior Board authorization to employ this heading style.

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DISCUSSION

On June 9, 2021, with Board authorization, the parties filed a Joint Motion to Terminate the proceeding (Paper 13, “Termination Motion”), a Settlement Agreement (Paper 14, Ex. 1036), and a Joint Request to File the Settlement Agreement as business confidential information separate from the *inter partes* review file of the relevant involved patent (Paper 16, “Joint Request”).²

The parties represent that they have agreed to settle and that Exhibit 1036 is their Settlement Agreement, and “certify that there are no other agreements, oral or written, between the parties made in connection with, or in contemplation of, the termination of the proceeding.”

Termination Motion 2.

Generally, the Board expects that a proceeding will terminate after the filing of a settlement agreement. *See* 35 U.S.C. § 317(a) (“An 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.”); 37 C.F.R. § 42.72 (“The Board may terminate a trial without rendering a final written decision, where appropriate, including . . . pursuant to a joint request under 35 U.S.C. 317(a)”); *see also* Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,768 (Aug. 14, 2012) (“The Board expects that a proceeding will

² Citations refer to Papers filed in IPR2020-01525. The parties filed materially the same Papers in each case. The parties filed the Settlement Agreement as Paper 14 but refer to it as Exhibit 1036.

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terminate after the filing of a settlement agreement, unless the Board has already decided the merits of the proceeding.”).

Each proceeding is at an intermediate stage. The parties have not filed substantive briefing after institution. The Board has not issued a final written decision and has not held an oral hearing. Under these circumstances, we grant the Termination Motion in each case.

We also grant the Joint Request in each case. See 35 U.S.C. § 317(b) (“At the request of a party to the proceeding, the agreement or understanding shall be treated as business confidential information, shall be kept separate from the file of the involved patents as business confidential information, and shall be made available only to Federal Government agencies on written request, or to any person on a showing of good cause.”); *see also* 37 C.F.R. § 42.74(c).

ORDER

It is

ORDERED that each Termination Motion is *granted*;

FURTHER ORDERED that each Joint Request is *granted*.

FURTHER ORDERED that each Settlement Agreement shall be treated as business confidential information, shall be kept separate from the file of the involved patent as business confidential information, and shall be made available only in accordance with the provisions of 35 U.S.C.

§ 317(b) and 37 C.F.R. § 42.74(c); and

FURTHER ORDERED that each proceeding is *terminated* both as to Petitioner and Patent Owner.

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