

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

UNIFIED PATENTS, LLC,
Petitioner,

v.

KIOBA PROCESSING LLC,
Patent Owner.

IPR2020-01695
Patent 6,931,382 B2

Before HYUN J. JUNG, JAMES A. TARTAL, and
JOHN P. PINKERTON, *Administrative Patent Judges*.

PINKERTON, *Administrative Patent Judge*.

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

I. INTRODUCTION

On October 1, 2020, Unified Patents, LLC (“Petitioner”) filed a Petition for *inter partes* review of claims 5–9 of U.S. Patent No. 6,931,382 B2 (“the ’382 patent”). Paper 1. On January 21, 2021, Kioba Processing LLC (“Patent Owner”) filed Patent Owner’s Preliminary Response. Paper 7. On February 4, 2021, the parties filed a Joint Motion to Terminate *Inter Partes* Review in which they jointly move to terminate this proceeding based on an agreement between the parties. Paper 8, 1 (“Joint Motion”). Concurrently, the parties also filed their Confidential Settlement and License Agreement. Ex. 1021 (“Agreement”). In addition, the parties filed their Joint Motion to Keep Confidential and Separate Under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) jointly requesting that Exhibit 1021 be treated as business confidential information and have it kept separate from the file of the ’382 patent. Paper 9, 1 (“Joint Motion to Keep Confidential”). We authorized the filing of the Joint Motion, the Joint Motion to Keep Confidential, and the Agreement in an email to counsel for the parties dated February 4, 2021.

II. DISCUSSION

In the Joint Motion, the parties state they have entered into a written confidential agreement, being filed as Exhibit 1021, “that fully resolves this matter.” Joint Motion, 1. The parties also represent that there “are no other agreements, oral or written, between the Parties made in connection with, or in contemplation of, the termination of . . . [this] proceeding and that Exhibit 1021 represents a true and accurate copy of the agreement between the Parties that resolves the present proceeding.” *Id.*

The parties jointly request that we terminate this proceeding because the Board’s Trial Practice Guide stresses that “[t]here are strong public policy reasons to favor settlement between the parties to a proceeding.” *Id.* at 2 (citing Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 46,768 (Aug. 14, 2012)). The parties state that permitting termination provides certainty and fosters an environment that promotes settlements, creating a timely, cost-effective alternative to litigation. *Id.* The parties also state that termination of the petition is appropriate as the Board has not yet “decided the merits of the proceeding.” *Id.* at 2–3 (citing Office Patent Trial Practice Guide, 77 Fed. Reg. 48756, 48768 (Aug. 14, 2012)). In addition, the parties assert that the Board “can conserve its resources through terminating now.” *Id.* at 3.

This proceeding is in its preliminary stages, and we have not yet decided whether to institute an *inter partes* review. Accordingly, we have not “decided the merits of the proceeding” prior to the parties’ request for termination. *See* 35 U.S.C. § 317(a). The foregoing factors weigh in favor of granting the Joint Motion; and, we discern no factors weighing against termination of the proceeding. Thus, we grant the Joint Motion.

With respect to the parties joint request to treat the Agreement as business confidential information, and have it kept separate from the file of the ’382 patent, we have reviewed the Agreement and find that it contains confidential business information of the parties regarding the terms of settlement. Thus, we determine that good cause exists to treat the Agreement as business confidential information kept separate from the file

of the '382 patent. Thus, we also grant the Joint Motion to Keep Confidential.

III. CONCLUSION

For the foregoing reasons, we grant the parties' Joint Motion to terminate this proceeding and their Joint Motion to Keep Confidential the Agreement.

IV. ORDER

Accordingly, it is:

ORDERED that the Joint Motion to terminate is granted, and this proceeding is hereby terminated; and,

FURTHER ORDERED that the Joint Motion to Keep Confidential is granted, and the Agreement (Exhibit 1021) shall be treated as business confidential information and kept separate from the files of U.S. Patent No. 6,931,382 B2, and made available only to Federal Government agencies on written request, or to any person on a showing of good cause, pursuant to 37 C.F.R. § 42.74(c).

IPR2020-01695
Patent 6,931,382 B2

For PETITIONER:

Michelle A. Callaghan
Roshan Mansinghani
UNIFIED PATENTS. LLC
michelle@unifiedpatents.com
roshan@unifiedpatents.com

For PATENT OWNER:

Justin B. Kimble
T. William Kennedy
Jonathan H. Rastegar
BRAGALONE CONROY PC
JKimble-IPR@bcpc-law.com
bkennedy@bcpc-law.com
jrastegar@bcpc-law.com