

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FACEBOOK, INC.,
Petitioner,

v.

BCS SOFTWARE, LLC,
Patent Owner.

IPR2021-00197
Patent 7,890,809 B2

Before JUSTIN T. ARBES, JOHN P. PINKERTON, and
SHEILA F. MCSHANE, *Administrative Patent Judges*.

PINKERTON, *Administrative Patent Judge*.

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

I. INTRODUCTION

On November 10, 2020, Facebook, Inc. (“Petitioner”) filed a Petition for *inter partes* review of claims 1–9 of U.S. Patent No. 7,890,809 B2 (“the ’809 patent”) against BCS Software, LLC (“Patent Owner”). Paper 1. On March 10, 2021, the parties filed a Joint Motion to Terminate Pursuant to 35 U.S.C. § 317 and 37 C.F.R. § 42.74 in which they jointly move to terminate this proceeding in light of the settlement of their dispute regarding the ’809 patent. Paper 4, 1 (“Joint Motion”). Concurrently, the parties also filed a Joint Request to File Settlement Agreement as Business Confidential Information Pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) (Paper 5 (“Joint Request”)) and the Settlement Agreement (Ex. 1018). We authorized the filing of the Joint Motion, the Joint Request, and the Settlement Agreement in an email to counsel for the parties dated March 10, 2021.¹

II. DISCUSSION

In the Joint Motion, the parties state they have entered into a written settlement agreement, a true and correct copy of which is being filed as Exhibit 1018, “that effectively resolves all disputes between the parties regarding the challenged patent.” Joint Motion, 1. Thus, the parties state that “termination is appropriate because all disputes between the parties regarding [the ’809 patent] have been resolved.” *Id.* The parties also “certify that there are no collateral agreements or understanding made in

¹ Patent Owner filed mandatory notice information pursuant to 37 C.F.R. § 42.8. Paper 7. Thus, we understand the Joint Motion and Joint Request to have been filed jointly by both parties.

connection with, or in contemplation of, the termination of this proceeding.”
Id. at 2.

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 Settlement Agreement as business confidential information, and have it kept separate from the file of the ’809 patent (*see* Joint Request, 1), we have reviewed the Settlement 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 Settlement Agreement as business confidential information kept separate from the file of the ’809 patent. Thus, we also grant the Joint Request.

III. CONCLUSION

For the foregoing reasons, we grant the parties’ Joint Motion to terminate this proceeding and their Joint Request to keep the Settlement Agreement confidential.

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 Request is granted, and the Settlement Agreement (Exhibit 1018) shall be treated as business

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confidential information and kept separate from the files of U.S. Patent No. 7,890,809 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).

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