

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ROKU, INC.,
Petitioner,

v.

FLEXIWORLD TECHNOLOGIES, INC.,
Patent Owner.

IPR2021-00715
Patent 10,346,114 B2

Before TERRENCE W. McMILLIN, CHRISTOPHER L. OGDEN, and
BRENT M. DOUGAL, *Administrative Patent Judges*.

OGDEN, *Administrative Patent Judge*.

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

Petitioner Roku, Inc. and Patent Owner Flexiworld Technologies, Inc. jointly request that the above-referenced *inter partes* review proceeding be terminated pursuant to the parties' agreement. On October 24, 2022, with our authorization, the parties filed a Joint Motion to Terminate (Paper 34), a copy of a Settlement and Patent License Agreement (Ex. 2036), and a Joint Request to Keep Separate (Paper 35). Exhibit 2036 contained a redacted exhibit, and on October 25, 2022, the parties filed an unredacted version of the Settlement and Patent License Agreement as Exhibit 2037.

In the Motion to Terminate, the parties make the following representations: (1) that "the parties have settled their entire dispute concerning the '114 patent and the Board has not yet decided the merits of this proceeding"; (2) that the parties are "filing true copies of their Agreement in connection with this matter as required by statute"; and (3) that "there are no other agreements or understandings, oral or written, between [the parties], including any collateral agreements, made in connection with, or in contemplation of, the termination of this proceeding as set forth in 35 U.S.C. § 317(b)" Paper 34, 1, 4.

"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." Patent Trial and Appeal Board Consolidated Trial Practice Guide 86 (PTAB Nov. 19), <https://go.usa.gov/xpvPF>. We instituted trial in this proceeding on October 26, 2021. Paper 18. A hearing was held on July 20, 2022. *See* Paper 32 (transcript).

"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.” 35 U.S.C. § 317(a). In addition, “[i]f no petitioner remains in the inter partes review, the Office may terminate the review or proceed to a final written decision.” *Id.* Under these circumstances, we determine that it is appropriate to terminate this proceeding without rendering a final written decision.

Regarding the joint Request to Keep Separate (Paper 35), we have reviewed the Settlement and Patent License Agreement (Exs. 2036, 2037) and find that it contains confidential business information regarding the terms of the parties’ agreement. We determine that good cause exists to treat the Settlement and Patent License Agreement as business confidential information pursuant to 37 C.F.R. § 42.74(c).

ORDER

Accordingly, it is

ORDERED that the joint Request to Keep Separate (Paper 35) is *granted*, and that the settlement agreement (Exhibits 2036 and 2037) be treated as business confidential information and be kept separate from the files of the above-identified proceedings and from the files of the ’114 patent under the provisions of 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c);

FURTHER ORDERED that the Joint Motion to Terminate (Paper 34) the above-identified proceeding is *granted*; and

FURTHER ORDERED that this proceeding is *terminated* with respect to both Petitioner and Patent Owner pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. § 42.72.

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