

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

WHATSAPP LLC,
Petitioner,

v.

AGIS SOFTWARE DEVELOPMENT LLC,
Patent Owner.

IPR2021-01177 (Patent 7,031,728 B2)
IPR2021-01178 (Patent 7,630,724 B2)
IPR2021-01327 (Patent 9,467,838 B2)
IPR2021-01357 (Patent 9,749,829 B2)
IPR2021-01482 (Patent 9,445,251 B2)

Before CHARLES J. BOUDREAU, DANIEL J. GALLIGAN, and
FREDERICK C. LANEY, *Administrative Patent Judges*.

Per Curiam.

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

IPR2021-01177 (Patent 7,031,728 B2)
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In each of the above-captioned proceedings, Petitioner and Patent Owner (collectively “the Parties”) filed a joint motion to terminate. Paper 6 (“Joint Motion”).¹ In support of the Joint Motion, the Parties filed a copy of a written confidential settlement agreement. Ex. 1033 (“Settlement Agreement”). The Parties also filed a joint request to keep the Settlement Agreement separate and confidential. Paper 7 (“Joint Request”). We authorized the filing of these papers in an e-mail sent on October 4, 2021.

In the Joint Motion, the Parties state that termination of the proceeding is appropriate because they have settled their disputes regarding the patents involved in each of these proceedings. Joint Motion 1. With respect to the Settlement Agreement, the parties “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.” Joint Motion 2.

There are strong public policy reasons to favor settlement between the parties to a proceeding. *Office Patent Trial Practice Guide*, 84 Fed. Reg. 64,280 (Nov. 21, 2019). These proceedings are in the preliminary phase, and we have not yet decided whether to institute trials in the proceedings. In view of the early stage of the proceedings and the settlement between the Parties, we determine that it is appropriate to dismiss the petitions and terminate the proceedings, without rendering decisions on institution or final written decisions.

¹ We refer to papers and evidence filed in IPR2021-01177. The parties filed the Settlement Agreement and similar motions in the other cases to which this Order pertains.

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In the Joint Request, the Parties jointly request to have the Settlement Agreement be treated as business confidential information and be kept separate from the files of the patents involved in these proceedings. Joint Request 1.

After reviewing the Settlement Agreement between the Parties, we find that the Settlement Agreement contains confidential business information regarding the terms of settlement. We determine the Settlement Agreement between the Parties shall be treated as business confidential information under 37 C.F.R. § 42.74(c) and shall be kept separate from the files of the involved patents and associated proceedings.

This Order does not constitute a final written decision pursuant to 35 U.S.C. § 318(a).

Accordingly, it is:

ORDERED that the Joint Motions are *granted*;

FURTHER ORDERED that the petitions in the above-captioned proceedings are *dismissed* and the proceedings are *terminated*; and

FURTHER ORDERED that the Settlement Agreement shall remain designated as “Parties and Board Only” in the Board’s filing system, shall be made available only to Federal Government agencies on written request, or to any person on a showing of good cause, and shall be kept separate from the files of the involved patents and associated proceedings, pursuant to 37 C.F.R. § 42.74(c).

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