

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ROKU, INC.,
Petitioner,

v.

DIVX, LLC,
Patent Owner.

IPR2021-01579 (Patent 8,832,297 B2)
IPR2021-01580 (Patent 8,832,297 B2)¹

Before BART A. GERSTENBLITH, MONICA S. ULLAGADDI, and
IFTIKHAR AHMED, *Administrative Patent Judges*.

AHMED, *Administrative Patent Judge*.

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

¹ We exercise our discretion to issue one Order to be entered in both proceedings. The parties are not authorized to use a multiple-case caption.

I. DISCUSSION

Petitioner Roku, Inc. (“Roku”) and Patent Owner DivX, LLC (“DivX”) filed (1) a Joint Motion to Terminate Pursuant to 35 U.S.C. § 317 (Paper 7 (“Mot.”)) based on a settlement agreement between them, (2) a true copy of their written settlement agreement (Ex. 2001), and (3) a Joint Request to Treat Settlement Information as Business Confidential Information and Keep Separate (Paper 8).² Roku and DivX indicate that they have resolved their underlying dispute and have agreed to terminate these proceedings. Mot. 1. The parties filed what they represent is a true and correct copy of their written settlement agreement and indicate that it resolves these proceedings as well as related ITC litigation. *Id.* at 2–3.

Generally, the Board expects that a proceeding will terminate with respect to a petitioner 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* Patent Trial and Appeal Board Consolidated Trial Practice Guide at 86 (Nov. 2019)³ (“The Board expects that a proceeding will terminate after the filing of a settlement agreement,

² Our citations to Papers and Exhibits are to those filed in IPR2021-01579. Similar Papers and Exhibits have been filed in IPR2021-01580 with identical numbers.

³ *Available at* <https://www.uspto.gov/TrialPracticeGuideConsolidated>.

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unless the Board has already decided the merits of the proceeding.” (citing 35 U.S.C. §§ 317(a), 327)). Here, trials have not yet been instituted and the merits of these proceedings not yet decided. Accordingly, we are persuaded that, under these circumstances, termination of these proceedings is appropriate.

Additionally, we grant the Joint Request to Treat Settlement Information as Business Confidential Information and Keep Separate. *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, 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) (same).

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

II. ORDER

Accordingly, it is

ORDERED that the Joint Motion to Terminate Pursuant to 35 U.S.C. § 317 (Paper 7) is *granted*;

FURTHER ORDERED that the Joint Request to Treat Settlement Information as Business Confidential Information and Keep Separate (Paper 8) is *granted*;

FURTHER ORDERED that the settlement agreement (Ex. 2001) be treated as business confidential information, kept separate from the file of the above-referenced patent, and made available only to Federal

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Government agencies on written request, or to any person on a showing of good cause, pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c); and

FURTHER ORDERED that these proceedings are terminated.

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