

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ROKU, INC.,
Petitioner,

v.

R2 SOLUTIONS LLC,
Patent Owner.

IPR2021-01581 (Patent 7,698,329 B2)
IPR2021-01582 (Patent 8,341,157 B2)
IPR2021-01583 (Patent 8,341,157 B2)¹

Before SCOTT A. DANIELS, JOHN A. HUDALLA, and
IFTIKHAR AHMED, *Administrative Patent Judges*.

HUDALLA, *Administrative Patent Judge*.

DECISION
Settlement Prior to Institution of Trial
Granting Requests to Keep Settlement Agreement Confidential
37 C.F.R. § 42.74

¹ This Order applies to all of the identified cases. We exercise our discretion to issue one Order to be filed in each case. The parties are not authorized to use this filing style for any subsequent papers.

IPR2021-01581 (Patent 7,698,329 B2)
IPR2021-01582 (Patent 8,341,157 B2)
IPR2021-01583 (Patent 8,341,157 B2)

I. INTRODUCTION

With the Board’s authorization, Petitioner and Patent Owner (collectively, “the Parties”) filed a joint motion to dismiss the Petition in each of the above-identified proceedings. Paper 6 (“Joint Motions”).² The Parties also filed copies of a Settlement Agreement (Ex. 1100, “Settlement Agreement”), as well as joint requests (Paper 7, “Joint Requests”) to treat the Settlement Agreement as business confidential information and to keep the Settlement Agreement separate from the files of the challenged patents.

II. DISCUSSION

In the Joint Motions, the Parties represent that they have reached an agreement that settles all disputes between them relating to the challenged patents. Joint Motions 3. The Parties also represent that they have filed true copies of the Settlement Agreement and that “there are no collateral agreements or understandings made in connection with, or in contemplation of, the dismissal of the Petition[s].” Joint Motions 1–2 (citing 37 C.F.R. § 42.74(b)).

These proceedings are at an early stage. We have not considered the merits of the Petitions, and we have not yet instituted trials in these proceedings. In view of the early stage of these proceedings and the settlement between the Parties, we determine that good cause exists to dismiss the Petitions and terminate the proceedings with respect to the Parties.

² For expediency, we cite to papers and exhibits filed in IPR2021-01581, unless otherwise indicated. The Parties filed similar papers and exhibits in IPR2021-01582 and IPR2021-01583.

IPR2021-01581 (Patent 7,698,329 B2)
IPR2021-01582 (Patent 8,341,157 B2)
IPR2021-01583 (Patent 8,341,157 B2)

The Parties also request that the Settlement Agreement be treated as business confidential information and be kept separate from the files of the challenged patents. Joint Requests 1. After reviewing the Settlement Agreement, we find that the Settlement Agreement contains confidential business information regarding the terms of settlement. We determine that good cause exists to treat the Settlement Agreement between the Parties as business confidential information pursuant to 37 C.F.R. § 42.74(c).

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

III. ORDER

For the reasons discussed above, it is

ORDERED that the Joint Motions in IPR2021-01581 (Paper 6), IPR2021-01582 (Paper 7), and IPR2021-01583 (Paper 7) are *granted*, the Petitions in IPR2021-01581, IPR2021-01582, and IPR2021-01583 are *dismissed*, and the proceedings in IPR2021-01581, IPR2021-01582, and IPR2021-01583 are *terminated* with respect to Petitioner and Patent Owner; and

FURTHER ORDERED that the Joint Requests in IPR2021-01581 (Paper 7), IPR2021-01582 (Paper 8), and IPR2021-01583 (Paper 8) are *granted*, and the Settlement Agreement shall be kept separate from the files of Patent 7,698,329 B2 and Patent 8,341,157 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).

IPR2021-01581 (Patent 7,698,329 B2)

IPR2021-01582 (Patent 8,341,157 B2)

IPR2021-01583 (Patent 8,341,157 B2)

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