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Paper 12
Date: February 27, 2023

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FEDEX CORPORATION,
Petitioner,

v.

TRANSCEND SHIPPING SYSTEMS, LLC,
Patent Owner.

IPR2022-01117 (Patent 7,253,731 B2)
IPR2022-01219 (Patent 7,482,920 B2)
IPR2022-01252 (Patent 9,847,029 B2)
IPR2022-01261 (Patent 10,181,109 B2)
IPR2022-01314 (Patent 10,796,268 B2)

Before CHARLES J. BOUDREAU, ELIZABETH M. ROESEL, and FREDERICK C. LANEY, *Administrative Patent Judges.*

BOUDREAU, *Administrative Patent Judge*.

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

On January 5, 2023, we instituted *inter partes* review proceedings with respect to certain claims of U.S. Patent Nos. 7,253,731 B2, 7,482,920 B2, 9,847,029 B2, 10,181,109 B2, and 10,796,268 B2 ("the subject patents"). IPR2022-01117, Paper 11; IPR2022-01219, Paper 8; IPR2022-01252, Paper 7; IPR2022-01261, Paper 7; IPR2022-01314, Paper 6. On February 21, 2023, with our authorization, Petitioner FedEx Corporation and Patent Owner Transcend Shipping Systems, LLC (collectively, "the Parties") filed joint motions to terminate the proceedings pursuant to 35 U.S.C. § 317 and 37 C.F.R. § 42.74. IPR2022-01117, Paper 14 ("1117 Mot."); IPR2022-01219, Paper 10; IPR2022-01252, Paper 9; IPR2022-01261, Paper 9; IPR2022-01314, Paper 10.

The parties represent in the joint motions that litigation between them involving the subject patents, previously pending in the United States District Court for the Eastern District of Texas, was voluntarily dismissed without prejudice at Patent Owner's behest in August 2022 and that the Parties have now reached an agreement to resolve their disputes. *See, e.g.*, 1117 Mot. 6–7. The parties contend that termination is appropriate because the Board has not yet decided the merits of the proceeding and termination would preserve significant resources for the Parties and the Board, pointing out, among other considerations, that the Board's institution decisions were entered less than two months ago, Patent Owner's deadline to file responses to the Petitions is still more than a month away, and oral argument is not scheduled to take place in the proceedings until October 5, 2023. *Id.* at 7.

Pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b), the joint motions each were accompanied by a copy of a settlement agreement that the Parties represent to be a true and correct copy of the written settlement agreement that resolves the disputes between them in these proceedings. IPR2022-01117, Ex. 1057; IPR2022-01219, Ex. 1060; IPR2022-01252, Ex. 1060; IPR2022-01261, Ex. 1060; IPR2022-01314, Ex. 1061. The parties further represent that there are no other agreements, oral or written, between them made in connection with, or in contemplation of, the termination of the proceedings. *See, e.g.*, 1117 Mot. 8.

The Board generally expects that a case "will terminate after the filing of a settlement agreement, unless the Board has already decided the merits." Patent Trial and Appeal Board Consolidated Trial Practice Guide 86 (Nov. 2019), *available at* https://www.uspto.gov/sites/default/files/documents/tpgnov.pdf; *see also* 37 C.F.R. § 42.72 ("The Board may terminate a trial without rendering a final written decision, where appropriate, ..."). As noted by the Parties, these proceedings are at an early stage, oral hearing has not yet been held, and the Board has not yet decided the merits of the proceedings. *See, e.g.*, 1117 Mot. 7–8; IPR2022-01117, Paper 13 (Scheduling Order). Under the circumstances presented here, and in view of the Parties' representations, we determine that it is appropriate to terminate these proceedings with respect to all parties, and we, accordingly, grant the Parties' joint motions to terminate.

Accordingly, it is

ORDERED that the joint motions to terminate are GRANTED; and

FURTHER ORDERED that Cases IPR2022-01117, IPR2022-01219, IPR2022-01252, IPR2022-01261, and IPR2022-01314 are hereby TERMINATED.

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