

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FEDEX CORPORATE SERVICES, INC.,
Petitioner,

v.

R2 SOLUTIONS LLC,
Patent Owner.

IPR2022-01405 (Patent 8,190,610 B2)
IPR2022-01456 (Patent 8,341,157 B2)
IPR2022-01457 (Patent 7,698,329 B2)¹

Before BARBARA A. PARVIS, NABEEL U. KHAN, and
IFTIKHAR AHMED, *Administrative Patent Judges*.

KHAN, *Administrative Patent Judge*.

DECISION
Settlement Prior to Institution of Trial and
Granting Joint Request to Treat Settlement Agreement
as Business Confidential Information
37 C.F.R. § 42.74

¹ This Order addresses issues that are the same in each of the identified proceedings. We exercise our discretion to issue one Order to be filed in each proceeding. The parties are not authorized to use this style heading in subsequent papers.

IPR2022-01405 (Patent 8,190,610 B2)
IPR2022-01456 (Patent 8,341,157 B2)
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I. INTRODUCTION

With the Board’s authorization, Petitioner and Patent Owner (collectively, “the Parties”) filed a Joint Motion to Terminate in each of the above-captioned proceedings. Paper 7 (“Joint Motion”).² Along with the Joint Motion, the Parties filed copies of Covenant Not to Sue Agreements. Ex. 1027 (“Agreements”).³ The Parties jointly request that the Agreements be treated as business confidential information and kept separate from the files of the patents involved in the above-captioned proceedings. Joint Motion 2.⁴

II. DISCUSSION

In the Joint Motion, the Parties represent that the Agreements resolve their disputes involving the patents at issue in the above-captioned proceedings. Joint Motion 2. The Parties also represent that they have filed true copies of the Agreements made in connection with, or in contemplation of, the termination of the above-captioned proceedings. *Id.* The Agreements state that they “constitute[] the entire agreement between the [P]arties.” Ex. 1027, 4, 8.

² The relevant papers and exhibits filed in the above-captioned proceedings are substantively the same. We cite to the record in IPR2022-01405, unless otherwise indicated.

³ Exhibit 1027 comprises two agreements titled “Covenant Not to Sue Agreement.” The agreement on pages 1–4 of Exhibit 1027 relates to U.S. Patent No. 8,190,610 B2. The agreement on pages 5–8 of Exhibit 1027 relates to U.S. Patent Nos. 8,341,157 B2 and 7,698,329 B2.

⁴ The Joint Motion does not include page numbers. We designate the caption page as page 1 and number the remaining pages consecutively therefrom.

IPR2022-01405 (Patent 8,190,610 B2)
IPR2022-01456 (Patent 8,341,157 B2)
IPR2022-01457 (Patent 7,698,329 B2)

The above-captioned proceedings are at an early stage, and we have not yet decided whether to institute a trial in the proceedings. In view of the early stage of the proceedings and the settlement between the Parties, we determine that good cause exists to dismiss the petitions for *inter partes* review and terminate the proceedings with respect to the Parties.

The Parties also request that the Agreements be treated as business confidential information and kept separate from the files of the patents involved in the above-captioned proceedings. Joint Motion 2. After reviewing the Agreements, we find that they contain confidential business information regarding the terms of settlement. Thus, good cause exists to treat the Agreements 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

Accordingly, it is:

ORDERED that the Joint Motion to Terminate in each of the above-captioned proceedings (IPR2022-01405, Paper 7; IPR2022-01456, Paper 6; and IPR2022-01457, Paper 6) is *granted*, and IPR2022-01405, IPR2022-01456, and IPR2022-01457 are *terminated* with respect to Petitioner and Patent Owner; and

FURTHER ORDERED that the joint request to treat the Agreements as business confidential information in each of the above-captioned proceedings is *granted*, and the Agreements (IPR2022-01405, Ex. 1027; IPR2022-01456, Ex. 1018; and IPR2022-01457, Ex. 1035) shall be kept

IPR2022-01405 (Patent 8,190,610 B2)
IPR2022-01456 (Patent 8,341,157 B2)
IPR2022-01457 (Patent 7,698,329 B2)

separate from the files of U.S. Patent Nos. 8,190,610 B2, 8,341,157 B2, and 7,698,329 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).

IPR2022-01405 (Patent 8,190,610 B2)
IPR2022-01456 (Patent 8,341,157 B2)
IPR2022-01457 (Patent 7,698,329 B2)

For PETITIONER:

Jeffrey A. Berkowitz
Daniel C. Tucker
Alexander M. Boyer
Daniel M. Jordan
Taylor L. Stark
FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, LLP
jeffrey.berkowitz@finnegan.com
daniel.tucker@finnegan.com
alexander.boyer@finnegan.com
dan.jordan@finnegan.com
taylor.stark@finnegan.com

For PATENT OWNER:

Carder W. Brooks
Brent N. Bumgardner
NELSON BUMGARDNER CONROY P.C.
carder@nelbum.com
bbumgardner@nbclaw.net