

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,
Petitioner,

v.

WILDSEED MOBILE LLC,
Patent Owner.

IPR2023-00245
Patent 10,959,040 B2

Before KARL D. EASTHOM, TERRENCE W. McMILLIN, and
MICHAEL T. CYGAN, *Administrative Patent Judges*.

McMILLIN, *Administrative Patent Judge*.

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

I. BACKGROUND

On September 8, 2023, with Board authorization, Petitioner Google LLC and Patent Owner Wildseed Mobile LLC filed a “Joint Motion to Terminate *Inter Partes* Review.” Paper 20 (“Mot.”). Along with the Motion, Petitioner and Patent Owner filed Exhibit 2007, “a confidential settlement agreement that resolves all underlying disputes between Petitioner and Patent Owner with respect to U.S. Patent No. 10,959,040 (‘the ’040 patent’).” Mot. 1. The Motion states that the Agreement embodies the “entire agreement in connection with the termination of this proceeding,” and further, that Exhibit 2007 is “[a] true and correct copy of the Agreement.” *Id.* Petitioner and Patent Owner assert they “have settled their dispute regarding the ’040 patent, including both this proceeding and Patent Owner’s assertion of the ’040 patent in the related district court litigation,” and “jointly request termination.” *Id.* at 1–2.

Petitioner and Patent Owner also filed a Joint Request to treat their agreement as business confidential information, and to maintain the filed copy of the Agreement separate from the public file under 37 C.F.R. § 42.74(c). Paper 21.

II. DISCUSSION

We have not yet decided the merits of the proceedings, and a final written decision has not been entered. However, “[t]he Board expects that a proceeding will terminate after the filing of a settlement agreement, unless the Board has already decided the merits of the proceeding,” because of the “strong public policy reasons to favor settlement between the parties to a proceeding.” Consolidated Trial Practice Guide, November 2019, 86 (available at <https://www.uspto.gov/about-us/news-updates/consolidated->

trial-practice-guide-november-2019). Notwithstanding that the proceedings have moved beyond the preliminary stage, Petitioner and Patent Owner have shown adequately that termination of the proceedings is appropriate because of the resolution of their dispute. Under these circumstances, we determine that good cause exists to terminate the proceedings.

After reviewing the Settlement Agreement (Ex. 2007) between Petitioner and Patent Owner, 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 Petitioner and Patent Owner 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, for the reasons discussed above, it is

ORDERED that the Joint Motion to Terminate (Paper 20) is *granted*, and IPR2023-00245 is *terminated* pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. § 42.72; and

FURTHER ORDERED that the Joint Request to Keep Agreement Business Confidential and Separate Under 37 C.F.R. § 42.74(c) (Paper 21) is *granted*, and the Settlement Agreement (Exhibit 2007) shall remain designated as “Board Only” in Board’s filing system, shall 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 patent and associated preliminary proceeding, pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

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