

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CSC SERVICEWORKS, INC.,
Petitioner,

v.

PAYRANGE INC.,
Patent Owner.

IPR2023-01186
Patent 8,856,045 B1

Before KEN B. BARRETT, MEREDITH C. PETRAVICK, and
STACEY G. WHITE, *Administrative Patent Judges*.

PETRAVICK, *Administrative Patent Judge*.

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

I. INTRODUCTION

With the Board's authorization, Petitioner and Patent Owner (collectively referred to as "the Parties") filed a Joint Motion to Terminate the above-identified proceeding due to settlement. Paper 19 ("Joint Motion"). In support of the Joint Motion, the Parties filed a Confidential Settlement Agreement (Ex. 1015 ("Settlement Agreement")), as well as a Joint Request That the Settlement Agreement Be Treated as Business Confidential Information and Be Kept Separate (Paper 20 ("Joint Request")) pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74.

II. DISCUSSION

In the Joint Motion, the Parties represent that they submitted "a confidential version of a true copy of the agreement or understanding (EX1015) between Petitioner and Patent Owner made in connection with, or in contemplation of, the termination of this proceeding" and "certify that there are no other agreements, oral or written, between the parties made in connection with, or in contemplation of, the termination of this proceeding." Joint Motion 2. The Parties further represent that they have resolved their disputes regarding the subject patent, "including the District Court proceeding between the parties regarding this patent and do not anticipate further litigation between them concerning this patent." *Id.*

Under 35 U.S.C. § 317(a), "[a]n 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." Section 35 U.S.C. § 317(a) also provides that if no petitioner remains in the *inter partes* review, the Office may terminate the review.

We instituted a trial on the above-identified proceeding on January 19, 2024. Paper 13. We have not yet decided the merits of the proceeding, and a final written decision has not been entered. Notwithstanding that the proceeding has moved beyond the preliminary stage, the Parties have shown adequately that the termination of the proceeding is appropriate. Under these circumstances, we determine that it is appropriate to terminate the proceeding with respect to the Parties.

After reviewing the Settlement Agreement 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 35 U.S.C. § 317(b) and 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 19) is *granted*, and IPR2023-01186 is *terminated* with respect to Petitioner and Patent Owner pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. § 42.72; and

FURTHER ORDERED that the Joint Request (Paper 20) to Treat the Settlement Agreement (Exhibit 1015) as Business Confidential Information is *granted*, and the Settlement Agreement shall be kept separate from the file of Patent 8,856,045, and made available only to Federal 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).

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