

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

DEFI EDUCATION FUND,
Petitioner,

v.

TRUE RETURN SYSTEMS, LLC,
Patent Owner.

IPR2023-01388
Patent 10,025,797 B1

Before Judges KEVIN F. TURNER, JEFFREY S. SMITH, and CHRISTA
P. ZADO, *Administrative Patent Judges*.

ZADO, *Administrative Patent Judge*.

TERMINATION

Due to Settlement After Institution of Trial

35 U.S.C. § 317; 37 C.F.R. § 42.74

I. INTRODUCTION

A. *Background*

Pursuant to DeFi Education Fund (“Petitioner”) and Patent Owner True Return Systems, LLC’s (“Patent Owner”) (collectively “the Parties”) joint request, the Board authorized the Parties to file a joint motion to terminate this proceeding and request to treat the settlement agreement between the Parties as business confidential and kept separate from the files of the involved patent. Ex. 3102. On August 22, 2024, Petitioner filed, on behalf of the Parties, a “Joint Motion to Terminate the Proceeding” (Paper 22) (“Joint Motion to Terminate” or “Joint Mot.”), along with a copy of the settlement agreement between the Parties (Ex. 1025) (“Settlement Agreement”).

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 317(a) also provides that if no petitioner remains in the *inter partes* review, the Office may terminate the review.

In the Joint Motion to Terminate, the Parties jointly request termination of this proceeding. Joint Mot. 2–3, 4. The Parties represent that they have reached an agreement to jointly seek termination of this *inter partes* review, and that the filed copy of the Settlement Agreement is a true copy. *Id.* The Parties argue that because the motion is submitted prior to a decision on the merits, the Board may exercise its authority pursuant to 37 C.F.R. § 42.74 to terminate this proceeding in response to the parties’ settlement agreement. *Id.* at 2–3.

We instituted *inter partes* review in this matter January 5, 2024. Paper 7. 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 termination of this proceeding is appropriate. Under these circumstances, we determine that good cause exists to terminate this proceeding.

In the Joint Motion to Terminate, the Parties also request that the Settlement Agreement be treated as business confidential and be kept separate from the files of the involved patent, pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c). Joint Mot. 1. After reviewing the Settlement Agreement between Petitioner and Patent Owner, we are persuaded 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, and to keep that document separate from the files of U.S. Patent 10,025,797 B1, pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

Accordingly, it is

ORDERED that the Joint Motion to Terminate Proceedings (Paper 22) is *granted*;

FURTHER ORDERED that IPR2023-01388 is terminated pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. § 42.72; and

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FURTHER ORDERED that the Settlement Agreement (Exhibit 1025) shall be kept separate from the file of U.S. Patent 10,025,797 B1, 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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