

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

COMCAST CABLE COMMUNICATIONS LLC, CHARTER
COMMUNICATIONS, INC.¹, and ALTICE USA, INC.²,
Petitioner,

v.

TOUCHSTREAM TECHNOLOGIES, INC.,
Patent Owner.

IPR2024-00322
Patent 8,356,251 B2

Before GEORGIANNA W. BRADEN, MATTHEW S. MEYERS, and
AARON W. MOORE, *Administrative Patent Judges*.

BRADEN, *Administrative Patent Judge*.

TERMINATION
Termination Due to Settlement
35 U.S.C. § 317; 37 C.F.R. § 42.74

¹ Charter Communications, Inc. (“Charter”), which filed a petition in IPR2024-01231, has been joined as a party to this proceeding. *See* Paper 25.

² Altice USA, Inc. (“Altice”), which filed a petition in IPR2024-01262, has been joined as a party to this proceeding. *See* Paper 28.

I. INTRODUCTION

With the Board’s authorization, Comcast Cable Communications, LLC (“Petitioner” or “Comcast”) and Touchstream Technologies, Inc. (“Patent Owner”) (collectively “the Parties”) filed a joint motion to terminate this case, with respect to Comcast’s participation, based on an agreement the Parties reached concerning settlement. Paper 38 (“Joint Motion”). Along with the Joint Motion, the Parties filed a copy of their confidential settlement agreement (Ex. 1199, “Settlement Agreement”), as well as a joint request that the Settlement Agreement be treated as business confidential information and kept separate from the file of this proceeding (Paper 39, “Joint Request”). For the reasons that follow, the Joint Motion is *granted*.

II. DISCUSSION

In the Joint Motion, the Parties represent that the Settlement Agreement “resolved their disputes” involving the patent at issue, with respect to Comcast’s participation, in the above captioned proceeding. Joint Motion 1. The Parties also represent that they have filed a true and accurate copy of the Settlement Agreement and that the Settlement Agreement represents the entire agreement or understanding between the Parties made in connection with, or in contemplation of, the termination of this proceeding with respect to Comcast’s participation. *Id.* The Parties further represent that the litigation between the Parties regarding this proceeding has “been dismissed with prejudice pursuant to settlement and no further litigation between the Parties is contemplated.” *Id.* Accordingly, the Parties jointly request termination of the above-captioned proceeding with respect to Comcast’s participation. *Id.* at 2–3.

The Board generally expects that a case “will terminate after the filing of a settlement agreement, unless the Board has already decided the merits of the proceeding.” Consolidated Trial Practice Guide, 86 (Nov. 2019)³; *see* 35 U.S.C. § 317(a); 37 C.F.R. § 42.72. Here, the Board has not decided the merits of this proceeding. Under these circumstances, we determine it is appropriate to terminate this proceeding with respect to Comcast. The remaining Petitioners in IPR2024-00322, Charter and Altice, are not parties to the Settlement Agreement and did not join the Joint Motion. Accordingly, IPR2024-00322 remains pending as to Charter and Altice.

In the Joint Request, the Parties request that the Settlement Agreement be treated as business confidential information and kept separate from the file of the patent at issue in this proceeding. Joint Request 1. After reviewing the Settlement Agreement, we find that it contains confidential business information regarding the terms of settlement. Thus, good cause exists to treat the Settlement Agreement as business confidential information pursuant to 37 C.F.R. § 42.74(c). Therefore, the Parties’ request is granted.

In the Joint Request, the Parties also

jointly request that the Board order that in the event a person or entity makes a written request, as stated in 37 C.F.R. § 42.74(c)(1)–(2), for access to the term sheet, that any such written request be served upon the parties on the day the written request is provided to the Board.

Joint Request 1. Our regulations, however, do not require the Board to serve any written requests for the Settlement Agreement on the parties. *See, e.g.,* 37 C.F.R. § 42.74(c). We, therefore, decline to issue an order mandating such action. Thus, the Parties’ additional request is denied.

³ Available at <https://www.uspto.gov/TrialPracticeGuideConsolidated>.

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 is *granted* with respect to Comcast's participation;

ORDERED that this proceeding is terminated with respect to Comcast only;

ORDERED that Charter and Altice will remain as Petitioners in the proceeding, and the case will continue to proceed;

ORDERED that the Joint Request is *granted-in-part* to treat the Settlement Agreement (Ex. 1199) as business confidential, keep it separate from the file of U.S. Patent No. 8,356,251 B2, and make it 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); and

FURTHER ORDERED that the case caption for future submissions in IPR2022-00322 shall not list Comcast as a petitioner as set forth on the attached Sample Case Caption.

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Sample Case Caption

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