

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

COMCAST CABLE COMMUNICATIONS, LLC,
Petitioner,

v.

TOUCHSTREAM TECHNOLOGIES, INC.,
Patent Owner.

IPR2024-00326
Patent 11,086,934 B2

Before GEORGIANNA W. BRADEN, MICHELLE N. WORMMEESTER,
and MATTHEW S. MEYERS, *Administrative Patent Judges*.

MEYERS, *Administrative Patent Judge*.

TERMINATION

Termination Due to Settlement and
Dismissing Petitioner's Request for Rehearing
35 U.S.C. § 317; 37 C.F.R. § 42.74

I. INTRODUCTION

With the Board’s authorization, Comcast Cable Communications, LLC (“Petitioner”) and Touchstream Technologies, Inc. (“Patent Owner”) (collectively “the Parties”) filed a joint motion to withdraw Petitioner’s pending rehearing request and terminate this case based on an agreement the Parties reached concerning settlement. Paper 16 (“Joint Motion”). Along with the Joint Motion, the Parties filed a copy of their confidential settlement agreement (Ex. 1187, “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 17, “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 “resolves all underlying disputes” involving the patent at issue 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. *Id.* at 1–2. The Parties further represent that the litigation between the Parties regarding this proceeding have “been dismissed with prejudice pursuant to settlement and no further litigation between the Parties is contemplated.” *Id.* at 2. Accordingly, the Parties jointly request termination of the above-captioned proceeding. *Id.*

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)¹; *see* 35 U.S.C. § 317(a); 37 C.F.R. § 42.72. Here, the Board has not decided the merits of this proceeding, and Petitioner requests dismissal of its pending request for rehearing. Joint Motion 1. Patent Owner does not object to this request. *Id.* Under these circumstances, we determine it is appropriate to dismiss Petitioner’s request for rehearing and terminate this proceeding.

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. However, our regulations 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.

This Order does not constitute a final written decision pursuant to 35 U.S.C. § 318(a).

¹ Available at <https://www.uspto.gov/TrialPracticeGuideConsolidated>.

III. ORDER

Accordingly, for the reasons discussed above, it is:

ORDERED that Petitioner's request for rehearing is *dismissed*;

FURTHER ORDERED that the Joint Motion is *granted*; and

FURTHER ORDERED that the Joint Request is *granted-in-part* to treat the Settlement Agreement (Ex. 1083) as business confidential, keep it separate from the file of U.S. Patent No. 11,086,934 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).

IPR2024-00326
Patent 11,086,934 B2

For PETITIONER:

Frederic Meeker
John Fleming
Paul Qualey
John Hutchins
Joshua Davenport
BANNER & WITCOFF, LTD.
fmeeker@bannerwitcoff.com
jfleming@bannerwitcoff.com
pqualey@bannerwitcoff.com
jhutchins@bannerwitcoff.com
jdavenport@bannerwitcoff.com

For PATENT OWNER:

Kyle Friesen
Jason Mudd
Ryan Dykal
Robert Reckers
SHOOK, HARDY & BACON L.L.P.
kfriesen@shb.com
jmudd@shb.com
rdykal@shb.com
rreckers@shb.com