

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AT&T CORP., AT&T SERVICES, INC., and AT&T MOBILITY LLC,
Petitioner,

v.

ALEXANDER I. SOTO and WALTER G. SOTO,
Patent Owner.

IPR2024-00712
Patent 8,238,754 B2

Before THU A. DANG, JOSIAH C. COCKS, and KEVIN C. TROCK,
Administrative Patent Judges.

TROCK, *Administrative Patent Judge.*

DECISION
Dismissal Prior to Institution of Trial
35 U.S.C. § 314, 37 C.F.R. § 42.71(a)

On September 28, 2024, Petitioner and Patent Owner (collectively, “the Parties”) filed a Joint Motion to Terminate Pursuant to 35 U.S.C. § 317 and 37 C.F.R. § 42.74 combined with a Request to Treat Settlement Agreement as Business Confidential Information and Keep Separate. Paper 9 (“Joint Motion”).

In the Joint Motion the parties represent that they have reached a settlement agreement as evidenced by a written, confidential agreement (Ex. 1039 (“Agreement”)), filing a true copy of the same. Joint Motion 4. The parties represent that they have resolved their disputes regarding U.S. Patent No. 8,238,754 (“the ’754 patent”) and do not anticipate further litigation concerning the ’754 patent. *Id.* at 5. Although the parties represent that a “Long-Form Agreement” has not been finalized yet, they certify that “the parties have included all applicable agreements currently in existence,” and that as of the filing of the Joint Motion there are no other agreements or understanding between the parties made in connection with, or in contemplation of, the termination of this proceeding. *Id.* at 4–5.

This proceeding is at an early stage, and we have not yet decided whether to institute a trial in the proceeding. In view of the early stage of the proceeding and the settlement between the Parties, we determine that it is appropriate to dismiss the proceeding.

After reviewing the Agreement between the Parties, we find that the Agreement contains confidential business information regarding the terms of settlement. We find that it is appropriate to treat the Agreement as business confidential information and keep it separate from the file of the ’754 patent. *See* 37 C.F.R. § 42.74(c).

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

ORDER

In consideration of the foregoing, it is hereby
ORDERED that the Joint Motion is *granted*, and the proceeding is
dismissed; and

FURTHER ORDERED that the Agreement (Ex. 1039) shall be kept
separate from the file of U.S. Patent No. 8,238,753 B2 and made available
only to Federal Government agencies on written request, or to any person on
a showing of good cause, pursuant to 37 C.F.R. § 42.74(c).

PETITIONER:

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