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Paper 19
Entered: February 5, 2025

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC and APPLE INC.,[1]
Petitioner,

v.

PROXENSE, LLC,
Patent Owner.

IPR2024-00232 (Patent 8,352,730 B2)
IPR2024-00233 (Patent 8,886,954 B1)
IPR2024-00782 (Patent 8,646,042 B1)
IPR2024-00783 (Patent 9,679,289 B1)[2]

Before THU A. DANG, KEVIN F. TURNER, DAVID C. MCKONE, and NORMAN H. BEAMER, *Administrative Patent Judges*.[3]

PER CURIAM.

ORDER
Settlement as to Google LLC After Institution of Trial
35 U.S.C. § 317; 37 C.F.R. § 42.74

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[1] Apple Inc. has been joined as a petitioner in each of the above-listed proceedings.
[2] The combined caption is for administrative convenience only and does not indicate that the above-listed proceedings have been joined. The parties are not authorized to use this caption without express permission from the Board.
[3] The four listed judges represent overlapping panels on several proceedings. This is not an expanded panel.

I. INTRODUCTION

With the Board's authorization, Petitioner Google LLC ("Google") and Patent Owner Proxense, LLC ("Proxense") filed a Joint Motion to Terminate *Inter Partes* Review Proceeding Pursuant to 35 U.S.C. §317(a) and 37 C.F.R. § 42.74 due to settlement in each of the above-listed proceedings. Paper 18 ("Joint Motion" or "Mot.").[4] In support of the Joint Motion, Google and Proxense filed a confidential Settlement and License Agreement (Ex. 1028 ("Settlement Agreement")), as well as a Joint Request to Treat Settlement Agreement as Business Confidential Information Pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) (Paper 19 ("Joint Request")) in each of the above-listed proceedings.

II. DISCUSSION

In the Joint Motion, Google and Proxense represent that they have reached an agreement to jointly seek termination of the above-identified *inter partes* review proceedings as to Google and have settled their dispute regarding Patent Owner's assertion of the above-listed patents "in the related district court litigation, Proxense v. Google LLC and Google Payment Corp., Civil Action No. 6:23-cv-320 in the United States District Court for the Western District of Texas." Mot. 1. Google and Proxense also represent that the filed copy of the Settlement Agreement is a true and correct copy. *Id.* at 2. The Settlement Agreement indicates that it "constitutes the

[4] This Decision cites to papers and exhibits filed in IPR2024-00232. Substantively identical papers and exhibits were filed in IPR2024-00233, IPR2024-00782, and IPR2024-00783.

complete, final and exclusive embodiment of the entire agreement between the Parties with regard to the subject matter [t]herein." Ex. 1028, 8.

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." We instituted trials in the above-identified proceedings on July 24, 2024 (*see* IPR2024-00232, Paper 10; IPR2024-00233, Paper 10) and November 18, 2024 (*see* IPR2024-00782, Paper 13; IPR2024-00783, Paper 12). We have not yet decided the merits of the proceedings, and final written decisions have not been entered. Notwithstanding that the proceedings have moved beyond the preliminary stage, Google and Proxense have shown adequately that the termination of the proceedings as to Google is appropriate. Under these circumstances, we determine that good cause exists to terminate the proceedings as to Google.

After reviewing the Settlement Agreement between Google and Proxense, 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 Google and Proxense as business confidential information pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c). Accordingly, we *grant* the Joint Request to the extent that the Board will keep the Settlement Agreement separate from the files of the above-listed patents under 35 U.S.C. § 317(b); however, we *deny* the portion of the Joint Request specifying that "disclosure by the Board and/or Office be limited according to the terms of the agreement"

(Joint Request 1) because the request is not supported by our governing statutes or rules.

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

III. ORDER

In view of the above, it is

ORDERED that the Joint Motion to Terminate *Inter Partes* Review Proceeding Pursuant to 35 U.S.C. §317(a) and 37 C.F.R. § 42.74 filed in each of the above-listed proceedings is *granted*, and each of the above-listed proceedings is *terminated* as to Google LLC pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. § 42.72;

FURTHER ORDERED that the case captions in each of the above-listed proceedings shall be changed to reflect the termination of Google LLC as a petitioner entity in accordance with the attached example; and

FURTHER ORDERED that the Joint Request to Treat Settlement Agreement as Business Confidential Information Pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) filed in each of the above-listed proceedings is *granted-in-part* and *denied-in-part* in the manner noted above, and the Settlement Agreement shall remain designated as "Board Only" in the Board's filing system, be kept separate from the files of the above-listed patents, 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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SAMPLE CASE CAPTION

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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APPLE INC.,
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PROXENSE, LLC,
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IPR2024-00[XXX]
Patent [X,XXX,XXX] B[X]

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