

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,
Petitioner,

v.

PROXENSE, LLC,
Patent Owner.

IPR2024-00784
Patent 10,073,960 B1

Before THU A. DANG, DAVID C. McKONE, and
NORMAN H. BEAMER, *Administrative Patent Judges*.

DANG, *Administrative Patent Judge*.

TERMINATION
Due to Settlement After Institution of Trial
35 U.S.C. § 317; 37 C.F.R. § 42.74

I. INTRODUCTION

With the Board’s authorization, Petitioner and Patent Owner (collectively referred to as “the Parties”) 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. Paper 14 (“Joint Motion” or “Mot.”). In support of the Joint Motion, the Parties filed a confidential Settlement 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 15 (“Joint Request”)).

II. DISCUSSION

In the Joint Motion, the Parties represent that they have reached an agreement to jointly seek termination of the above-identified *inter partes* review proceeding and have settled their dispute regarding “Patent Owner’s assertion of U.S. Patent No. 10,073,960 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. The Parties 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 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.”

Section 35 U.S.C. § 317(a) also provides that if no petitioner remains in the *inter partes* review, the Office may terminate the review.

We instituted a trial in the above-identified proceeding on November 18, 2024. Paper 12. 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 the termination of the proceeding is appropriate. Under these circumstances, we determine that good cause exists to terminate the proceeding with respect to the Parties.

After reviewing the Settlement Agreement between Petitioner and Patent Owner, 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 Petitioner and Patent Owner 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 file of Patent 10,073,960 B1 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 (Paper 14) is *granted*, and IPR2024-00784 is *terminated* with respect to Petitioner and Patent Owner pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. § 42.72; 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) (Paper 15) is *granted-in-part* and *denied-in-part* in the manner noted above, and the Settlement Agreement shall be kept separate from the file of Patent 10,073,960 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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