

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ROKU, INC.,
Petitioner,

v.

VIDEOLABS, INC.,
Patent Owner.

IPR2024-01023 (Patent 8,291,236 B2)
IPR2024-01024 (Patent 8,291,236 B2)
IPR2024-01025 (Patent 8,291,236 B2)¹

Before KARL D. EASTHOM, STACEY G. WHITE, and
BRIAN P. MURPHY, *Administrative Patent Judges*.

PER CURIAM

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

¹ This Order addresses substantively identical motions filed in each of the above-captioned proceedings. The parties must obtain prior authorization to use this caption style.

I. INTRODUCTION

With the Board’s authorization, Petitioner and Patent Owner (collectively referred to as “the Parties”) filed a Joint Motion to Terminate due to settlement in each of the above-captioned proceedings. Paper 14 (“Joint Motion”).² In support of each Joint Motion, the Parties filed a confidential settlement agreement (Ex. 1018 (“Settlement Agreement”)) and a Joint Request that Settlement Agreement be Treated as Business Confidential Information (Paper 15 (“Joint Request”)) pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74.

II. DISCUSSION

In each Joint Motion, the Parties represent that they have reached a settlement of all disputes between the Parties relating to the ’236 patent and that the filed Settlement Agreement is a true copy of the Parties’ agreement and constitutes the Parties’ entire understanding and agreement. Joint Motion 1–3.

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 trial in the above-captioned proceedings in December 2024. Paper 12. We have not yet decided the merits of these proceedings, and a final written decision has not been entered. The Parties have shown adequately that the

² This Order cites to Papers and Exhibits filed in IPR2024-01023. The parties filed corresponding items in IPR2024-01024 and IPR2024-01025.

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termination of these proceedings is appropriate. Under these circumstances, we determine that good cause exists to terminate the proceedings.

We note that ASUSTek Computer Inc. (“ASUSTek”) filed substantively identical petitions for *inter partes* review in IPR2025-00304, IPR2025-00305, and IPR2025-00306, challenging U.S. Patent No. 8,291,236 B2 and filed a motion in each case requesting that IPR2025-00304, IPR2025-00305, and IPR2025-00306 be joined with IPR2024-01023, IPR2024-01024, and IPR2024-01025, respectively. *See* IPR2025-00304, Papers 1, 4, 8; IPR2025-00305, Papers 1, 4, 8; and IPR2025-00306, Papers 1, 4, 8. We recognize that, if we terminate this proceeding, the motions for joinder may be moot and the petitions may be barred under 35 U.S.C. § 315(b). *See* IPR2025-00304, Paper 4, 3–4 (“The current [p]etition is not subject to the one-year statutory time bar because it is accompanied by a request for joinder. 35 U.S.C. § 315(b); 37 C.F.R. § 42.122(b).”); IPR2025-00305, Paper 4, 3 (same); and IPR2025-00306, Paper 4, 3 (same). However, a petitioner can avoid the § 315(b) bar by filing its petition(s) within one year after service of a complaint alleging infringement of the challenged patent. Further, “[t]here are strong public policy reasons to favor settlement between the parties to a proceeding,” and, thus, “[t]he Board expects that a proceeding will terminate after the filing of a settlement agreement, unless the Board has already decided the merits of the proceeding.” Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,768 (Aug. 14, 2012).

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

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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).

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 each Joint Motion in each of the above-captioned proceedings is *granted*, and each of the above-captioned proceedings is *terminated* pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. § 42.72; and

FURTHER ORDERED that each Joint Request to treat the Settlement Agreement as business confidential information in each of the above-captioned proceedings is *granted*, and each Settlement Agreement shall be kept separate from the files of Patent 8,291,236, 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).³

³ The Settlement Agreement is Exhibit 1018 in each proceeding.

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