

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

PANASONIC CORPORATION and
PANASONIC CORPORATION OF NORTH AMERICA,
Petitioner,

v.

OPTICAL DEVICES, LLC,
Patent Owner.

Case IPR2014-00303
Patent RE40,927 E

Before ERICA A. FRANKLIN, GLENN J. PERRY, and JAMES B. ARPIN,
Administrative Patent Judges.

PERRY, *Administrative Patent Judge.*

ORDER
Conduct of the Proceeding
37 C.F.R. § 42.5

A conference call was held on February 9, 2015, and attended by the above-identified panel members and respective counsel for the parties. The parties sought authorization to file a joint motion to terminate the proceeding on the basis that the parties have reached a settlement. They indicated that, thus far, the agreement is verbal and the parties intend to reduce the agreement to a signed writing by the week of February 16, 2015.

Generally, the Board expects that a proceeding will terminate after the filing of a settlement agreement. *See, e.g.*, Office Patent Trial Practice Guide, 77 Fed. Reg. 48756, 48768 (Aug. 14, 2012). The rule governing settlement indicates that any agreement between the parties made in connection with, or in contemplation of, the termination of a proceeding shall be in writing and filed with the Board. 37 C.F.R. § 42.74.

During the conference call, we authorized the filing of a joint motion to terminate the proceeding and provided guidance as to the procedure for filing the parties' settlement agreement and having the settlement agreement treated as business confidential information under 37 C.F.R. § 42.74(c). The joint motion must (1) include a brief explanation as to why termination is appropriate; (2) identify all defendants in any district court litigation related to the patent at issue in these proceeding; and (3) identify the current status of each such related litigation with respect to each party to such litigation. *See* Paper 8, 1–2; Paper 18, 1–2. The joint motion to terminate must be accompanied by a true copy of the parties' settlement agreement, as required by 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b). *See Groupon, Inc. v Maxim Integrated Products, Inc.*, CBM2014-00090, slip op. 2-3 (PTAB Aug. 12, 2014) (Paper 10) (discussing documents that may comprise an agreement). A redacted version of the settlement agreement will not be

accepted as a true copy of the settlement agreement.

With respect to having the settlement agreement treated as business confidential information under 37 C.F.R. § 42.74(c), the parties must file the confidential settlement agreement electronically in the Patent Review Processing System (PRPS) as an exhibit in accordance with the instructions provided on the Board's website (uploading as "Parties and Board Only"). The parties are directed to FAQ G2 on the Board's website at <http://www.uspto.gov/ip/boards/bpai/prps.jsp> for instructions on how to file their settlement agreement as confidential.

ORDER

Accordingly, it is hereby

ORDERED that the parties are authorized to file a joint motion to terminate this proceeding on or before February 27, 2014;

FURTHER ORDERED that the joint motion must be accompanied by a true copy, labeled as an exhibit, of the parties' settlement agreement, as required by 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b);

FURTHER ORDERED that, for the exhibit that is the settlement agreement filed in this proceeding, the parties may file a separate paper requesting that the settlement agreement be treated as business confidential information as specified in 37 C.F.R. § 42.74(c); and

FURTHER ORDERED that any confidential settlement agreement must be filed electronically in PRPS in accordance with the instructions provided on the Board's website (uploading as "Parties and Board Only").

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