

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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PRONG, INC.,  
Petitioner,

v.

YEOSHUA SORIAS,  
Patent Owner.

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Case IPR2015-01317  
Patent 8,712,486 B2

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Before SALLY C. MEDLEY, GLENN J. PERRY, and  
KIMBERLY McGRAW, *Administrative Patent Judges*.

McGRAW, *Administrative Patent Judge*.

JUDGMENT

Termination of the Proceeding  
*35 U.S.C. § 317; 37 C.F.R. §§ 42.72 and 42.74*

The parties have requested that this trial proceeding be terminated pursuant to settlement of the dispute regarding U.S. Patent No. 8,712,486. Paper 40. The parties concurrently filed a joint request that the Board treat the settlement agreement as business confidential information and keep it separate from the file of the involved patent pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74. Paper 41.

The parties represent that a true copy of the parties' settlement agreement was filed as Exhibit 1030. Paper 40, 2; Ex. 1031. The parties represent that the settlement agreement also resolves three other disputes: (1) a litigation between the parties in the Eastern District of New York involving the '486 patent (1:14-cv-02897-WFK-SMG), (2) a litigation between the parties in the Southern District of New York involving U.S. Patent No. 9,130,384 ("the '384 patent)( 1:15-cv-09161-AJN), and (3) a litigation between Patent Owner and GoWireless, Inc., in the Eastern District of New York involving the '486 patent (Civil Action No. 1:16-cv-01898-WFKSMG). The parties represent that these three actions have each been dismissed upon the parties' stipulations by orders of the respective U.S. District Courts and that there are no other litigations of disputes in any court or forum involving the Patent Owner and Petitioner. Paper 40, 5. The parties represent that there are no additional active litigations or proceedings that involve the '486 Patent, or patents within the same family, at this time. *Id.*, 6. We accept the parties' representations.

This inter partes review was instituted on December 9, 2015. Paper 10. At this juncture of the proceeding, the Board does not have before it full briefing on the trial issues; the case has not been heard; and the Board has not entered a final decision. Under these circumstances, we determine that it

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is appropriate to enter judgment and terminate without rendering a final written decision. 37 C.F.R. § 42.72.

Accordingly, it is

ORDERED that the joint motion to terminate the proceeding is *granted*;

FURTHER ORDERED that the joint request that the settlement agreement (Ex. 1030) be treated as business confidential information and be kept separate from the file of the involved patents under the provisions of 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c), is *granted*.

FOR PETITIONER:

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