

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MICROSOFT CORPORATION, HTC CORPORATION,
and HTC AMERICA, INC.,
Petitioner,

v.

NONEND INVENTIONS, N.V.,
Patent Owner.

Case IPR2016-00224 (Patent 7,779,138)
Case IPR2016-00225 (Patent 8,099,513)¹

Before GLENN J. PERRY, TREVOR M. JEFFERSON, and STACEY G. WHITE,
Administrative Patent Judges.

PERRY, *Administrative Patent Judge.*

ORDER
Motion to Terminate
37 C.F.R. §§ 42.72 and 42.74

¹ This Order addresses both captioned cases. We exercise our discretion to issue a single paper to be filed in each case. The parties are not authorized to use this style heading for any subsequent papers. For convenience we refer to paper numbers in IPR2016-00224.

On February 23, 2016, the remaining parties² filed joint motions to terminate these proceedings under 35 U.S.C. § 317 and 37 C.F.R. § 42.74. Paper 10. Along with the motions, the parties filed copies of a document they described as the written settlement agreement,³ as well as separate joint requests (Paper 11) to treat the settlement agreement as business confidential information under the provisions of 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

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 patent owner, unless the Office has decided the merits of the proceeding before the request for termination is filed.” The parties state in their motions that “[t]ermination is appropriate in the instant proceeding because the dispute between HTC and Nonend has been resolved.” Paper 10, 1. The parties note that the Petition was filed November 20, 2015, and that the Preliminary Response would not be due until early March. *Id.* at 2. Furthermore, a trial has not been instituted in this proceeding. *Id.*

The parties are reminded that the Board is not a party to the settlement, and may independently identify any question of patentability. 37 C.F.R § 42.74(a). Generally, however, 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. 48,756, 48,768 (Aug. 14, 2012). These proceedings are still in the preliminary stages, as the Board has not instituted a trial. The Board is persuaded

² The involvement of Microsoft Corporation previously was terminated. Paper 9.

³ Exhibit 1067.

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that, under these circumstances, it is appropriate to terminate these proceedings without rendering a final written decision. 37 C.F.R. § 42.72.

Accordingly, it is:

ORDERED that the joint motions to terminate these proceedings are GRANTED;

FURTHER ORDERED that the parties' joint requests (Paper 11) that the settlement agreements be treated as business confidential information, kept separate from the file of the involved patents, and made available only to Federal Government agencies on written request, or to any person on a showing of good cause, under the provisions of 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c), are GRANTED.

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