

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

OPENTV, INC.,
Patent Owner.

Case IPR2016-00971
Patent 6,148,081

Before JAMESON LEE and SALLY C. MEDLEY,
Administrative Patent Judge.

LEE, *Administrative Patent Judge.*

ORDER
Denial of Extension of Time
37 C.F.R. § 42.5

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On July 13, 2016, 2016, the parties, by email (Exhibit 3001) requested an extension of time of the due date for Patent Owner's preliminary response from August 4, 2016, to August 31, 2016. The parties represent that they "have agreed to settlement terms ending all disputes between them involving the patents at issue in these proceedings [including IPR2016-00971], and expect to complete their settlement in the coming weeks." Ex. 3001.

The referenced settlement is not yet complete, or near complete, given that it still takes "weeks" to finalize the parties' agreement. Also, if the parties truly have settled, there would be no need for Patent Owner to file any preliminary response and, thus, the preliminary response can be waived by Patent Owner. The fact that Patent Owner still desires to preserve the opportunity to file a preliminary response indicates that the referenced settlement only is tentative and cannot be treated as complete. Generally, settlement discussions should proceed in parallel with the proceeding, not *in lieu* of the proceeding, or while the proceeding is stayed.

Accordingly, the parties have not shown good cause to extend the due date for Patent Owner's preliminary response.

Upon completion of a settlement, the parties are authorized to file (1) a Joint Motion to Terminate (as a Paper), and (2) a Joint Request to File Settlement Agreement as Business Confidential Information Pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) (as a separate Paper).

The Joint Motion to Terminate must update the Board concerning the status of any litigation or proceeding, including, but not limited to, proceedings in the U.S. Patent and Trademark Office, involving the subject patent, and advise the Board whether any litigation or proceeding involving the subject patent is contemplated in the foreseeable future. The Joint

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Motion to Terminate also must include a true copy of any agreement or understanding (as an Exhibit to the Motion) and include a statement certifying that there are no collateral agreements or understandings made in connection with, or in contemplation of, the termination of the *inter partes* review. *See* 35 U.S.C. § 317(b); 37 C.F.R. § 42.74(b). Any Joint Request to File the Settlement Agreement as Business Confidential Information must be filed with the Joint Motion to Terminate. *See* 35 U.S.C. § 317(b); 37 C.F.R. § 42.74(c).

It is

ORDERED that the request for an extension of the due date for Patent Owner's preliminary response from August 4, 2016, to August 31, 2016, is *denied*.

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