

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GEOTAB INC., AND
TV MANAGEMENT, INC., D/B/A GPS NORTH AMERICA,
Petitioners,

v.

PERDIEMCO LLC,
Patent Owner.

Case IPR2016-01061 (Patent 8,223,012 B1)
Case IPR2016-01062 (Patent 8,493,207 B2)
Case IPR2016-01063 (Patent 8,717,166 B2)
Case IPR2016-01064 (Patent 9,003,499 B2)
Case IPR2016-01278 (Patent 9,072,931 B2)¹

Before WILLIAM V. SAINDON, CARL M. DEFRANCO, and
AMBER L. HAGY, *Administrative Patent Judges*.

HAGY, *Administrative Patent Judge*.

ORDER

Terminating *Inter Partes* Review After Institution
With Respect to Petitioner Geotab Inc. Due to Settlement
35 U.S.C. § 317(a) and 37 C.F.R. § 42.74

¹ This order addresses joint motions to terminate as to Petitioner Geotab Inc. based on settlement agreements filed in all five cases. We exercise our discretion to issue a single order to be entered in each case.

Case IPR2016-01061 (Patent 8,223,012 B1)
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1. Introduction

The Board has instituted review in each of these proceedings, but the trials are at an early stage. Patent Owner PerdiemCo LLC (“Patent Owner”) has not yet filed its Response to the Petition in any of these proceedings.

On December 20, 2016, pursuant to Board authorization, Patent Owner and Petitioner Geotab Inc. (“Geotab”) filed joint motions to terminate the proceedings with respect to Geotab only. IPR2016-01061, Paper 26; IPR2016-01062, Paper 23; IPR2016-01063, Paper 24; IPR2016-01064, Paper 24; IPR2016-01278, Paper 24. Along with the motion, the parties filed a copy of a document they describe as their written settlement agreement, as well as a separate joint request to treat the settlement agreement as business confidential information. IPR2016-01061, Paper 27 and Ex. 2010; IPR2016-01062, Paper 24 and Ex. 2010; IPR2016-01063, Paper 25 and Ex. 2010; IPR2016-01064, Paper 25 and Ex. 2010; and IPR2016-01278, Paper 25 and Ex. 2008. *See* 37 C.F.R. § 42.74(c) (a party to a settlement may request that the settlement agreement be treated as business confidential and be kept separate from the patent file).

2. Discussion

The Parties state the following in the Joint Motion to Terminate: “Patent Owner and Geotab settled their dispute and executed a confidential settlement agreement to terminate Geotab’s involvement in this proceeding and the Parties’ related district court litigation. . . .” IPR2016-01061, Paper 26, 2; IPR2016-01062, Paper 23, 2; IPR2016-01063, Paper 25, 2; IPR2016-01064, Paper 25, 2; IPR2016-01278, Paper 25, 2.

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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.”

Under these circumstances, we determine that it is appropriate to terminate each of these proceedings as to Geotab Inc. *See* 35 U.S.C. § 317(a) and 37 C.F.R. § 42.74.

After reviewing the parties’ settlement agreement, we find that the settlement agreement contains business confidential information regarding the terms of the settlement and good cause exists to treat the settlement agreement as business confidential information pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

3. *Order*

It is

ORDERED that the Joint Motion to Terminate the Proceedings as to Petitioner Geotab Inc. is *granted*;

FURTHER ORDERED that termination is *granted* as to Geotab Inc. only, and these proceedings shall continue with TV Management, Inc., d/b/a GPS North America, as Petitioner;

FURTHER ORDERED that the joint request to treat the parties’ settlement agreements as business confidential information is *granted* in each proceeding, and the settlement agreements (Exhibit 2010 in IPR2016-01061; Exhibit 2010 in IPR2016-01062; Exhibit 2010 in IPR2016-01063; Exhibit 2010 in IPR2016-01064; and Exhibit 2008 in IPR2015-01278) shall

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be treated as business confidential information under 37 C.F.R. § 42.74(c), kept separate from the files of U.S. Patent Nos. 8,223,012 B1; 8,493,207 B2; 8,717,166 B2; 9,003,499 B2; and 9,072,931 B2, respectively, and remain designated as “Board and Parties Only.”

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