

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NETFLIX, INC., ROKU INC.,
and AT&T SERVICES, INC.,
Petitioners,

v.

CONVERGENT MEDIA SOLUTIONS, LLC,
Patent Owner.

Case IPR2016-01761
Case IPR2017-01235
Patent 8,850,507 B2¹

Before JAMESON LEE, KEN B. BARRETT, and JOHN F. HORVATH,
Administrative Patent Judges.

LEE, *Administrative Patent Judge.*

ORDER

Granting Joint Motion to Terminate
Granting Convergent Media Solutions Motion to Terminate
37 C.F.R. §42.72

and

Granting Request to Treat Settlement Documents
As Business Confidential Information
37 C.F.R. § 42.74(c)

¹ Case IPR2017-01235 has been joined with Case IPR2016-01761.

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I. INTRODUCTION

On June 5, 2017, AT&T Services, Inc. (“AT&T”) and Convergent Media Solutions, Inc. (“CMS”) jointly filed a motion to terminate Petitioner AT&T from IPR2017-01235 and IPR2016-01761, two proceedings which have been joined (Paper 17, “Joint Mot.”), and a request to treat settlement documents as Business Confidential Information (Paper 18, “Req.”). The same day, CMS filed an unopposed motion to terminate IPR2017-01235 and IPR2016-01761 in their entirety (Paper 19, “PO Mot.”). For the reasons discussed below, the joint motion to terminate AT&T from IPR2017-01235 and IPR2016-01761, and CMS’s unopposed motion to terminate these proceedings are *granted*, and the parties’ joint request to treat settlement documents as Business Confidential Information is *granted*.

II. DISCUSSION

The parties’ joint motion to terminate requests termination of AT&T from IPR2017-01235 and IPR2016-01761 because the parties have settled their dispute regarding U.S. Patent No. 8,850,507 B2 (“the ’507 patent”) in the joined proceedings, and in *Convergent Media Solutions, LLC v. AT&T Services, Inc.*, Case No. 3:15-cv-02156-M (N.D. Tex) (“the District Court litigation”). Joint Mot., 1. CMS’s motion to terminate requests termination of IPR2017-01235 and IPR2016-01761 for the same reasons and because with AT&T’s termination from the joined proceedings no petitioner will remain in the joined proceedings. PO Mot., 2–3. CMS avers its motion is unopposed. *Id.* at 2. The parties filed what they regard as a true and correct copy of their Settlement Agreement as an exhibit to the joined proceedings. Joint Mot., 1–2; *see also* Ex. 2003.

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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.” The requirement for terminating AT&T from the joined proceedings is therefore met, and AT&T is terminated from IPR2017-01235 and IPR2016-01761.

Under 35 U.S.C. § 317(a), “[i]f no petitioner remains in the inter partes review, the Office may terminate the review or proceed to a final written decision under section 318(a).” Given the termination of AT&T from the joined proceedings, the Board has discretion to terminate the joined proceedings. These proceedings are at an early stage, and the Board has not reached a final decision on the merits. Under these circumstances, termination of the joined proceedings in their entirety is appropriate.

III. ORDER

It is

ORDERED that the Joint Motion to Terminate AT&T from IPR2017-01235 and IPR2016-01761 is *granted*;

FURTHER ORDERED that CMS’s motion to terminate IPR2017-01235 and IPR2016-01761 in their entirety is *granted*;

FURTHER ORDERED that the Joint Motion to Treat Settlement Agreement as Business Confidential Information is *granted*; and

FURTHER ORDERED that Exhibit 2003 (“Settlement Agreement”) be maintained as Business Confidential Information and kept separate from the file of U.S. Patent No. 8,850,507 B2 under 37 C.F.R. § 42.74(b); and

FURTHER ORDERED that the joined proceedings IPR2017-01235 and IPR2016-01761 are *terminated* in their entirety.

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