

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

CONVERGENT MEDIA SOLUTIONS, LLC,
Patent Owner.

Case IPR2016-01814
Case IPR2017-01237
Patent 8,914,840 B2¹

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

HORVATH, *Administrative Patent Judge.*

ORDER

Granting-in-part Joint 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 IPR2017-01237 has been joined to Case IPR2016-01814

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I. INTRODUCTION

On May 1, 2017, Netflix, Inc. (“Netflix”) and Convergent Media Solutions, Inc. (“CMS”) jointly filed a motion to terminate IPR2016-01814 (Paper 12, “Mot.”), and a request to treat settlement documents as Business Confidential Information (Paper 13, “Req.”). On May 9, 2017, we joined IPR2017-01237 to IPR2016-01814. *See* Paper 14, 29. For the reasons discussed below, the parties’ joint motion to terminate IPR2016-01814 is *granted-in-part* as to Netflix and *denied-in-part* as to CMS, 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 IPR2016-01814 because the parties have settled their dispute regarding U.S. Patent No. 8,914,840 B2 (“the ’840 patent”) in this proceeding and in *Convergent Media Solutions, LLC v. Netflix, Inc.*, No. 3:15-cv-02160 (N.D. Tex), the related District Court litigation. Mot., 3–5. The parties filed a true copy of their Settlement Agreement as an exhibit to this proceeding, and aver that the Settlement Agreement they filed constitutes the entire understanding and agreement between the parties. *Id.*; *see also* Ex. 2001.

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

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requirement for terminating this proceeding with respect to Netflix, therefore, is met.

Under 35 U.S.C. § 317(a), “If 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).” Due to the joinder of this proceeding and IPR2017-01237, AT&T Services, Inc. remains a petitioner in this proceeding after the termination of Netflix. Therefore, it is inappropriate to terminate CMS from this proceeding.

III. ORDER

It is hereby:

ORDERED that the Joint Motion to Terminate Proceeding is *granted-in-part*;

FURTHER ORDERED that this *inter partes* review is terminated as to Netflix, Inc., but is not terminated as to Convergent Media Solutions, LLC;

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

FURTHER ORDERED that Exhibit 2001 (“Settlement and License Agreement”) be maintained as business confidential information and kept separate from the files of U.S. Patent No. 8,914,840 B2.²

² The Board designated the status of Exhibit 2001 as “Board only” prior to entering the decision to institute trial in IPR2017-01237 and granting the motion to join that case to IPR2016-01814.

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