

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD and
SAMSUNG ELECTRONICS AMERICA, INC.,
Petitioner,

v.

PERSONALIZED MEDIA COMMUNICATIONS, L.L.C.,
Patent Owner.

Case IPR2017-00292
Patent 7,856,649

Before KARL D. EASTHOM, LYNNE E. PETTIGREW, and
JOHN F. HORVATH, *Administrative Patent Judges*.

HORVATH, *Administrative Patent Judge*.

DECISION

Granting Motion to Terminate
37 C.F.R. §§ 42.5(a), 42.71(a)

and

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

On February 16, 2017, the parties filed a Joint Motion to Terminate Proceeding (Paper 7), a Joint Request to Treat Settlement Documents as Business Confidential Information (Paper 8), a Settlement Agreement (Paper 9), and a redacted copy of the Settlement Agreement (Paper 10) as papers to this proceeding. The Joint Request to Treat Settlement Documents as Business Confidential Information referred to several documents that were not then filed in this proceeding, including a Letter Agreement and a Term Sheet. Paper 8, 1.

The Board ordered the parties to refile the Joint Motion to Terminate and Joint Request to Treat Settlement Documents as Business Confidential Information as papers to this proceeding, and to file only true, unredacted, copies of the Settlement Agreement, Letter Agreement, and Term Sheet as exhibits to this proceeding. Paper 11, 3. The Board indicated that upon the refile of these papers and exhibits, the Board would expunge from the record the originally filed Joint Motion to Terminate (Paper 7), Joint Request to Treat Settlement Documents as Confidential Business Information (Paper 8), Settlement Agreement (Paper 9), and redacted Settlement Agreement (Paper 10).

On February 24, 2017, the parties refiled the Joint Motion to Terminate Proceeding (Paper 12), and Joint Request to Treat Settlement Documents as Confidential Business Information (Paper 13). The Joint Motion to Terminate requests termination of this proceeding because the parties have settled their dispute regarding U.S. Patent No. 7,856,649 (“the ‘649 patent”) and related patents. *Id.* at 1. The parties concurrently filed a true copy of their Settlement Agreement, including an accompanying Letter

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Agreement and Term Sheet, as exhibits in this proceeding. *Id.*; *see also* Exs. 1040–1042.

This proceeding is at an early stage. Petitioner filed a Petition for *Inter Partes* Review of claims 9 and 10 of the '649 patent on November 18, 2016. Paper 2. Patent Owner has yet to file a Preliminary Response, and we have neither considered the merits of the Petition nor decided whether to institute trial.

Under the foregoing circumstances, we determine it is appropriate to dismiss the Petition. *See* 37 C.F.R. §§ 42.5(a), 42.71(a). We also determine it is appropriate to treat the parties' Settlement Agreement, Letter Agreement, and Term Sheet as confidential business information, and to keep these documents separate from the files of the '649 patent.

This paper does not constitute a final written decision pursuant to 35 U.S.C. § 318(a).

Accordingly, it is hereby:

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

FURTHER ORDERED that the Petition for *Inter Partes* Review of U.S. Patent No. 7,856,649 is *dismissed*;

FURTHER ORDERED that the Joint Request to Treat Settlement Documents as Confidential Business Information is *granted*;

FURTHER ORDERED that Exhibit 1040 ("Settlement Agreement") be maintained as confidential business information and kept separate from the files of U.S. Patent No. 7,856,649;

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FURTHER ORDERED that Exhibit 1041 (“Letter Agreement”) be maintained as confidential business information and kept separate from the files of U.S. Patent No. 7,856,649;

FURTHER ORDERED that Exhibit 1042 (“Term Sheet”) be maintained as confidential business information and kept separate from the files of U.S. Patent No. 7,856,649;

FURTHER ORDERED that Paper 7 (“Joint Motion to Terminate Proceeding”), be *expunged* from the record;

FURTHER ORDERED that Paper 8 (“Joint Request to Treat Settlement Documents as Confidential Business Information”) be *expunged* from the record;

FURTHER ORDERED that Paper 9 (“Settlement Agreement”) be *expunged* from the record; and

FURTHER ORDERED that Paper 10 (“Redacted Settlement Agreement”) be *expunged* from the record.

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For PETITIONER:

Walter Renner
Thomas Rozylowicz
Andrew Patric
axt-ptab@fr.com
tar@fr.com
patrick@fr.com

For PATENT OWNER:

Dmitry Kheyfits
Andrey Belenky
Thomas Scott, Jr.
dkeyfits@kheyfits.com
abelenky@kheyfits.com
tscott@goodwinprocter.com