

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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TELULAR CORPORATION,  
Petitioner,

v.

PERDIEMCO LLC,  
Patent Owner.

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Case IPR2017-00969  
Patent 8,149,113 B2

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

HAGY, *Administrative Patent Judge*.

ORDER

Termination of Trial Due to Settlement Agreement  
*35 U.S.C. § 317 and 37 C.F.R. § 42.72*

## I. INTRODUCTION

By way of a Petition accorded a filing date of February 28, 2017 (*see* Paper 5, dated March 29, 2017), Petitioner Telular Corporation (“Petitioner”) requested an *inter partes* review of claims 1–62 of U.S. Patent No. 8,149,113 B2 (Ex. 1001, “the ’113 patent”). Paper 2 (“Pet.”). Patent Owner PerdiemCo LLC (“Patent Owner”) filed a Preliminary Response on June 29, 2017. Paper 7 (“Prelim. Resp.”). Patent Owner included with its Preliminary Response a Statutory Disclaimer under 37 C.F.R. § 1.321(a), wherein Patent Owner disclaimed claims 1–3, 7–44, 46–56, and 59. Ex. 2017. The claims remaining after disclaimer are claims 4–6, 45, 57, 58, and 60–62 (“the remaining challenged claims”). We issued a decision instituting review of the remaining challenged claims on September 20, 2017. Paper 14.

Pursuant to Board authorization, Patent Owner and Petitioner filed a Joint Motion To Terminate the Proceedings on May 11, 2018. Paper 29. Along with the motion, the parties filed a copy of a document they describe as their settlement agreement, and the parties included in their motion a request to treat the settlement agreement as business confidential information. Paper 30 and Ex. 1023. *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).

## II. DISCUSSION

The Parties state the following in the Joint Motion to Terminate: “Patent Owner and Telular settled their dispute and executed a confidential settlement agreement to terminate this proceeding and the Parties’ related district court litigation. A Stipulation and Order of Dismissal agreed to by

the Parties in the related district court litigation is being filed concurrently in the district court.” Paper 29, 2.

Also currently pending before the Board are trials in four related matters involving the same parties: IPR2017-00968, IPR2017-00973, IPR2017-01007, and IPR2017-01269. The Parties’ Joint Motion also states that dismissal is concurrently being sought in those matters. Paper 29, 3–4. Additional related proceedings have either been terminated (IPR2016-01062, IPR2016-01063, IPR2017-00574, IPR2017-00575, and IPR2017-00636), or have proceeded to Final Written Decision (IPR2016-01061, IPR2016-01064, and IPR2016-01278). *See id.* at 2–3.

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.”

Although a Decision to Institute was entered on September 20, 2017 (Paper 14), we have not yet held an oral hearing (which, if requested by the parties, would have been scheduled for June 21, 2018 (Paper 15, 6)), and we have not entered a Final Written Decision on the merits.

According to the Parties’ settlement agreement, termination of the proceedings would be part of resolution by the parties of all pending related matters. When, as here, we have not entered a Final Written Decision on the merits, we generally expect that trial will terminate after the filing of a settlement agreement. *See* Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,768 (Aug. 14, 2012). As the parties have filed their written settlement agreement as to this proceeding and co-pending Cases IPR2017-00968, IPR2017-00973, IPR2017-01007, and IPR2017-01269, and a

stipulation of dismissal has been filed in the co-pending district court case as part of the settlement, we determine that it is appropriate to terminate trial without entering a Final Written Decision as to the patentability of claims 4–6, 45, 57, 58, and 60–62 of the '113 patent.

After reviewing the parties' settlement agreement, we find 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 37 C.F.R. § 42.74(c).

### III. ORDER

It is

ORDERED that the Joint Motion to Terminate trial is GRANTED, and this trial is hereby terminated;

FURTHER ORDERED that the joint request to treat the parties' settlement agreement as business confidential information is GRANTED, and the settlement agreement (Exhibit 1023) shall be treated as business confidential information under 37 C.F.R. § 42.74(c), kept separate from the file of U.S. Patent 8,149,113 B2, and remain designated as "Board and Parties Only."

Case IPR2017-00969  
Patent 8,149,113 B2

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