

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TELULAR CORPORATION,
Petitioner,

v.

PERDIEMCO LLC,
Patent Owner.

Case IPR2017-01007
Patent 9,119,033 B2

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 March 17, 2017 (*see* Paper 4, dated April 5, 2017), Petitioner Telular Corporation (“Petitioner”) requested an *inter partes* review of claims 1–20 of U.S. Patent No. 9,119,033 B2 (Ex. 1001, “the ’033 patent”). Paper 2 (“Pet.”). Patent Owner PerdiemCo LLC (“Patent Owner”) filed a Preliminary Response on July 5, 2017. Paper 7 (“Prelim. Resp.”). We issued a decision instituting review of the all challenged claims on October 4, 2017. Paper 14.

Pursuant to Board authorization, Patent Owner and Petitioner filed a Joint Motion To Terminate the Proceedings on May 11, 2018. Paper 24. 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 25 and Ex. 1021. *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 24, 2.

Also currently pending before the Board are trials in four related matters involving the same parties: IPR2017-00968, IPR2017-00969, IPR2017-00973, and IPR2017-01269. The Parties’ Joint Motion also states

that dismissal is concurrently being sought in those matters. Paper 24, 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 October 4, 2017 (Paper 13), we have not yet held an oral hearing (which, if requested by the parties, would have been scheduled for June 21, 2018 (Paper 14, 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, IPR2017-00969, IPR2017-00973, 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 1–20 of the ’033 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 1021) shall be treated as business confidential information under 37 C.F.R. § 42.74(c), kept separate from the file of U.S. Patent 9,119,033 B2, and remain designated as "Board and Parties Only."

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