

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

VMWARE, INC.,
Petitioner,

v.

INTELLECTUAL VENTURES I LLC,
Patent Owner.

IPR2020-00470
Patent 7,949,752 B2

Before THOMAS L. GIANNETTI, JENNIFER MEYER CHAGNON, and
JOHN R. KENNY, *Administrative Patent Judges*.

CHAGNON, *Administrative Patent Judge*.

TERMINATION

Due to Settlement After Institution of Trial
Granting Request to Treat Settlement Agreement as
Business Confidential Information
35 U.S.C. § 317; 37 C.F.R. §§ 42.72, 42.74

I. INTRODUCTION

With the Board’s authorization, Petitioner and Patent Owner (collectively “the Parties”) filed an amended¹ joint motion to terminate this *inter partes* review. Paper 22 (“Joint Motion”). In support of the Joint Motion, the Parties filed a copy of a written confidential settlement agreement. Exs. 2021, 2022 (collectively, “Settlement Agreement”). The Parties also filed an amended joint request to treat the Settlement Agreement as business confidential information and to keep it separate from the files of the challenged patent. Paper 23 (“Joint Request”).

II. DISCUSSION

In the Joint Motion, the Parties state that they have resolved their disputes regarding the challenged patent, which include this proceeding and the related district court litigation. Joint Motion 1. The Parties state that the Settlement Agreement is “a true copy of any agreement or understanding . . . between Petitioner and Patent Owner made in connection with, or in contemplation of, the termination of the proceeding under 37 CFR § 42.74(b) with this joint motion.” *Id.* Accordingly, the Parties jointly request termination of this proceeding. *Id.* at 2.

¹ The Parties originally filed a joint motion (Paper 20) to withdraw the Petition and a joint request (Paper 21) to treat the settlement agreement (Ex. 2021) as business confidential information and to keep it separate from the files of the challenged patent. Having reviewed the version of the settlement agreement filed with those papers, we determined that it references a “Schedule 1” and a “Schedule 2,” but it did not include those schedules. On January 25, 2021, Judges McKone, Hudalla, and Hamann held a teleconference with counsel for the parties to discuss the missing schedules, in connection with related IPR2020-01081. The Parties subsequently filed the amended papers (Papers 22, 23) and the missing schedules (Ex. 2022).

The Board generally expects that a case “will terminate after the filing of a settlement agreement, unless the Board has already decided the merits.” *Consolidated Trial Practice Guide*, 86 (Nov. 2019) (“Consolidated TPG”)²; *see* 35 U.S.C. §317(a); 37 C.F.R. § 42.72. Here, although the Board has instituted *inter partes* review of the challenged patent, the Board has not decided the merits of the proceeding. Under these circumstances, therefore, we determine that it is appropriate to terminate the proceeding as to the Parties, without rendering a final written decision.

In the Joint Request, the Parties jointly request to treat the Settlement Agreement as business confidential information and to have it be kept separate from the files of the challenged patent and associated proceeding. Joint Request 1. After reviewing the Settlement Agreement, we find that the Settlement Agreement contains confidential business information regarding the terms of settlement. We determine the Settlement Agreement (Exs. 2021, 2022) shall be treated as business confidential information under 37 C.F.R. § 42.74(c) and shall be kept separate from the files of the challenged patent and associated proceeding. *See* 35 U.S.C. § 317(b).

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

III. ORDER

Accordingly, it is:

ORDERED that the amended joint motion to terminate the *inter partes* review (Paper 22) is *granted*, and the above-captioned proceeding is hereby *terminated*; and

² Available at <https://www.uspto.gov/TrialPracticeGuideConsolidated>.

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FURTHER ORDERED that the amended joint request to treat the Settlement Agreement as business confidential information (Paper 23) is *granted*, and the Settlement Agreement (Exs. 2021, 2022) shall remain designated as “Parties and Board Only” in the Board’s filing system, shall made available only to Federal Government agencies on written request, or to any person on a showing of good cause, and shall be kept separate from the files of the involved patent and associated proceeding, pursuant to 37 C.F.R. § 42.74(c).

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