

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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AMAZON.COM, INC.,  
Petitioner,

v.

VOCALIFE LLC,  
Patent Owner.

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IPR2021-01331  
Patent RE48,371 E

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Before MONICA S. ULLAGADDI, AMBER L. HAGY, and  
JASON M. REPKO, *Administrative Patent Judges*.

HAGY, *Administrative Patent Judge*.

TERMINATION

Due to Settlement After Institution of Trial  
*35 U.S.C. § 317; 37 C.F.R. §§ 42.72, 42.74*

## I. INTRODUCTION

By way of a Petition accorded a filing date of July 30, 2021 (*see* Paper 3, mailed August 12, 2021), Petitioner Amazon.com LLC (“Petitioner”) requested an *inter partes* review of claims 22–41 of U.S. Patent No. RE48,371 (Ex. 1001, “the ’371 patent”). Paper 1 (“Pet.”). Patent Owner Vocalife LLC (“Patent Owner”) filed a Preliminary Response to the Petition on November 12, 2021. Paper 6 (“Prelim. Resp.”). With authorization from the Board, Petitioner filed a Reply to Patent Owner’s Preliminary Response (Paper 7, “Reply”), and Patent Owner filed a Sur-reply to Petitioner’s Reply (Paper 8, “Sur-reply”). We issued a decision instituting review on January 31, 2022. Paper 11.

Pursuant to Board authorization, Patent Owner and Petitioner filed a Joint Motion to Terminate Pursuant to 35 U.S.C. § 317 on November 8, 2022. Paper 25. Along with the motion, the parties filed a copy of a document they describe as a settlement agreement. Paper 25, 1–2; Ex. 2011. The parties also filed a Joint Motion to Treat Settlement Agreement as Business Confidential and to Keep Separate Pursuant to 35 U.S.C. § 317 and 37 C.F.R. § 42.74. Paper 26.

## II. DISCUSSION

The Parties state the following in the Joint Motion to Terminate:

Patent Owner has executed a confidential agreement with a third-party that resolves all pending disputes between the Parties, including all disputes relating to this proceeding and the related district court action, *Vocalife LLC v. Amazon.com, Inc. and Amazon.com Services, Inc.*, Case No. 2-20-cv-00401-JRG-RSP (E.D. Tex.). As per the agreement, Patent Owner has filed a motion to dismiss, with prejudice, the related district court action. *See Vocalife LLC v. Amazon.com, Inc. and Amazon.com Services, Inc.*, Case No. 2-20- cv-00401-JRG-RSP, Dkt. 71

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(E.D. Tex., Nov. 8, 2022). Because the agreement resolves all disputes between the Parties and Vocalife has filed a motion to dismiss the district court action with prejudice, the Parties jointly request that the Board terminate this IPR proceeding

Paper 25, 1.

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 January 31, 2022 (Paper 11), we have not yet held an oral hearing, and we have not entered a Final Written Decision on the merits.

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 Consolidated Trial Practice Guide*, 86 (Nov. 2019).<sup>1</sup> As the parties have filed a written settlement agreement that they state “resolves all disputes between the Parties” as to this proceeding, 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 22–41 of the ’371 patent.

The Parties also filed a joint motion that the settlement agreement be treated as business confidential information and be kept separate from the file of the patent involved in this *inter partes* proceeding. Paper 26. After reviewing the settlement agreement, we find that the settlement agreement

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<sup>1</sup> Available at <https://www.uspto.gov/TrialPracticeGuideConsolidated>.

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contains confidential business information regarding the terms of settlement. We determine that 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; and

FURTHER ORDERED that the joint request to treat the settlement agreement as business confidential information is GRANTED, and the settlement agreement (Exhibit 2011) shall be treated as business confidential information under 37 C.F.R. § 42.74(c), kept separate from the file of U.S. Patent RE48,371 E, and remain designated as “Board and Parties Only.”

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