

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,
Petitioner,

v.

VOCALIFE LLC,
Patent Owner.

IPR2022-00005
Patent RE48,371 E

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

Google LLC (“Petitioner”) filed a petition requesting *inter partes* review of claims 22–41 of U.S. Patent No. RE48,371 E (Ex. 1001, “the ’371 patent”). Paper 1 (“Pet.”). Vocalife LLC (“Patent Owner”) filed a Preliminary Response. Paper 6 (“Prelim. Resp.”). With our authorization (Paper 7), Petitioner filed a Reply. Paper 8 (“Prelim. Reply”). We also authorized Patent Owner to file a Sur-Reply of equal length, but no sur-reply was filed. Paper 7, 5. We granted institution on April 15, 2022. Paper 10.

Through email, the Parties requested and the Board authorized “(1) a motion to terminate the proceeding, as a Paper, (2) a true copy of the written settlement agreement and any collateral agreement (including any licensing agreement) made in connection with the termination, as an Exhibit, and (3) a request to treat the written settlement agreement as business confidential under 37 CFR 42.74(c), as part of or as a separate Paper from the motion to terminate.” Ex. 3002. The Parties filed a Joint Motion to Terminate Pursuant to 35 U.S.C. § 317 on November 18, 2022. Paper 19 (“Motion”), and what they refer to as a true copy of “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” (Ex. 2006) and “a true copy of the written release agreement” between the parties (Ex. 2007). Motion 1. The Parties also filed a Joint Motion to Treat the Agreements as Business Confidential and to Keep Separate Pursuant to 35 U.S.C. § 317 and 37 C.F.R. § 42.74. Paper 20.

II. DISCUSSION

Under 35 U.S.C. § 317(a), “An inter partes review instituted under this chapter shall be terminated with respect to any petitioner upon the joint

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request of the petitioner and patent owner, unless the Office has decided the merits of the proceeding before the request for termination is filed.” We entered Decision to Institute on April 15, 2022 (Paper 10), but we have not yet held an oral hearing or entered a Final Written Decision on the merits.

“The Board expects that a proceeding will terminate after the filing of a settlement agreement, unless the Board has already decided the merits of the proceeding.” *See Consolidated Trial Practice Guide*, 86 (Nov. 2019).¹ Because the Parties state the settlement agreement that they filed “resolves all pending disputes between the Parties relating to this proceeding” (Motion 1) and we have not decided the merits, we determine that it is appropriate to terminate the proceeding without entering a Final Written Decision on the patentability of the challenged claims.

The Parties also filed a joint motion that the agreements (Exs. 2006, 2007) be treated as business confidential information and be kept separate from the file of the patent involved in this *inter partes* proceeding. Paper 20. After reviewing the agreements, we find that they contain confidential business information regarding the terms of settlement. We determine that good cause exists to treat the agreements as business confidential information pursuant to 37 C.F.R. § 42.74(c).

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

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 agreements as business confidential information is GRANTED, and the agreements (Exs. 2006, 2007) 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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