

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HEWLETT PACKARD ENTERPRISE COMPANY,
Petitioner,

v.

INTELLECTUAL VENTURES II LLC,
Patent Owner.

IPR2021-01376 (Patent 8,725,132 B1)
IPR2021-01377 (Patent 8,023,991 B2)
IPR2021-01378 (Patent 6,816,464 B1)
IPR2022-00211 (Patent 7,783,788 B1)¹

Before KEN B. BARRETT, NABEEL U. KHAN, and
STEPHEN E. BELISLE, *Administrative Patent Judges*.

BARRETT, *Administrative Patent Judge*.

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

¹ These cases have not been joined or consolidated. Rather, this Order addresses issues that are the same in the identified cases. We exercise our discretion to issue one order to be filed in each case. The parties, however, are not authorized to use this filing style in any subsequent papers.

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We, in each of the above-captioned cases, instituted an *inter partes* review. *E.g.*, IPR2021-01367, Paper 15. On January 25, 2023, with our authorization, the parties filed in each case a “Joint Motion to Terminate Proceeding.” Paper 38² (“Mot. to Terminate” or “Motions to Terminate”). The parties represent in the Motions to Terminate that they have settled their disputes as to the challenged patents. Mot. to Terminate 1. The Motions to Terminate were accompanied by a document (Ex. 1043) that the parties represent to be a true and correct copy of the written settlement agreement in connection with the proceedings. *Id.* at 3–4. The parties certify that “[t]here are no other agreements, oral or written, between the parties made in connection with, or in contemplation of, the termination of this proceeding.” *Id.* at 4.

The parties also filed in each case, with our authorization, a “Joint Motion to File Agreement as Business Confidential Information Pursuant to 35 U.S.C. § 317” (Paper 39), requesting that the settlement agreement be treated a business confidential information and be kept separate from the file of the respective patent, pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

The parties represent in each Motion to Terminate that “[t]he parties have resolved their disputes regarding the [respective] patent and executed an agreement which contemplates requesting termination of this proceeding and terminating or dismissing the Parties’ related [district court]

² Citations to the record refer to IPR2021-01376. Similar papers were filed in each of the other proceedings.

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proceeding.” Mot. to Terminate 2. The parties also represent that they “do not anticipate any further litigation between them concerning the [challenged] patent[s].” *Id.* at 1.

The Board generally expects that a case “will terminate after the filing of a settlement agreement, unless the Board has already decided the merits.” Patent Trial and Appeal Board Consolidated Trial Practice Guide 86 (Nov. 2019), *available at* <https://www.uspto.gov/sites/default/files/documents/tpgnov.pdf>; *see* 37 C.F.R. § 42.72. We have not decided yet the merits of the proceedings, and final written decisions have not been entered. Under the circumstances presented here, we determine that it is appropriate to terminate these proceedings with respect to both Petitioner and Patent Owner. Accordingly, we grant the parties’ Motions to Terminate the proceedings.

We also determine that the parties have complied with the requirements of 37 C.F.R. § 42.74(c) to have their settlement agreement treated as business confidential information and kept separate from the patent files of the challenged patents. Thus, we grant the parties’ joint motion to treat the settlement agreement as business confidential information.

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

Accordingly, it is

ORDERED that the “Joint Motion[s] to Terminate Proceeding[s]” are *granted*;

FURTHER ORDERED that these proceedings are *terminated*;

IPR2021-01376 (Patent 8,725,132 B1)
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IPR2022-00211 (Patent 7,783,788 B1)

FURTHER ORDERED that the “Joint Motion[s] to File Agreement as Business Confidential Information Pursuant to 35 U.S.C. § 317” are *granted*;

FURTHER ORDERED that the parties’ settlement agreement is to be kept separate from the files of the involved U.S. Patent Nos. 8,725,132 B1, 8,023,991 B2, 6,816,464 B1, and 7,783,788 B1 under the provisions of 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c); and

FURTHER ORDERED that “Petitioner’s Motion to Exclude” (Paper 31) in IPR2021-01376 is *dismissed* as moot.

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