

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

INDEED, INC. and MONSTER WORLDWIDE, INC.  
Petitioners,

v.

CAREER DESTINATION DEVELOPMENT, LLC  
Patent Owner.

---

Case CBM2014–00068 (US 7,424,438 B2)  
Case CBM2014–00077 (US 7,424,438 B2)<sup>1</sup>

---

Before SALLY C. MEDLEY, MEREDITH C. PETRAVICK, and  
JUSTIN BUSCH, *Administrative Patent Judges*.

PETRAVICK, *Administrative Patent Judge*.

ORDER  
Conduct of the Proceeding  
37 C.F.R. § 42.5

---

<sup>1</sup> This decision addresses issues that are identical in the two cases. Therefore, we exercise our discretion to issue one decision to be entered in each of the two cases. The parties, however, are not authorized to use this style heading in their papers.

## INTRODUCTION

Counsel for both parties filed a Motion to Terminate (Paper 15<sup>2</sup>), along with a Request to Keep Separate (Paper 16), and Exhibits 2001-2004 on November 26<sup>th</sup>, 2014, without prior authorization from the Board. On December 3, 2014, a conference call was held between counsel for the respective parties and Judges Medley, Petravick, and Busch at the request of the Board.

## DISCUSSION

A motion to terminate may not be filed without prior Board authorization. *See* 37 C.F.R. § 42.20(b). The parties jointly filed the Motion to Terminate, without authorization. Therefore, the Motion to Terminate, Request to Keep Separate, and exhibits shall be expunged. *See* 37 C.F.R. § 42.7(a).

During the call, the parties sought the required authorization to refile joint motions to terminate the proceedings. 35 U.S.C. § 327(a) states:

A post-grant review instituted under this chapter shall be terminated with respect to any petitioner upon the joint request of the petitioner and the patent owner, unless the Office has decided the merits of the proceeding before the request for termination is filed. . . . If no petitioner remains in the post-grant review, the Office may terminate the post-grant review or proceed to a final written decision under section 328(a).

Generally, the Board expects that a proceeding will terminate after the filing of a settlement agreement. *See Office Patent Trial Practice Guide*, 77 Fed. Reg. 48756, 48768 (Aug. 14, 2012).

The parties were authorized to file a new joint motion to terminate, as well as, a new request to keep separate, pursuant to 37 C.F.R. § 42.74(b)(c). The joint

---

<sup>2</sup> For expediency, CBM2014–00068 is representative and all subsequent citations are to CBM2014–00068 unless otherwise noted.

CBM2014-00068 (US 7,424,438 B2)

CBM2014-00077 (US 7,424,438 B2)

motion must include an explanation why termination is appropriate at this time, which is after institution of a trial and after the expiration of DUE DATE 1 — the time period for filing a Patent Owner Response. Specifically, the joint motion must include reasons why the Board should not proceed to make a final determination on the merits. Furthermore, the joint motion should indicate whether, and to what extent, each party will continue to participate in this proceeding, if the joint motion to terminate is denied.

The joint motion must update the Board as to the status of any other matters involving U.S. Patent 7,424,438 B2. The joint motion to terminate must be accompanied by a true copy of the settlement agreement in connection with the termination of this proceeding, as required by 35 U.S.C. § 327(b) and 37 C.F.R. § 42.74(b). A redacted version of the settlement agreement is not a true copy of the settlement agreement.

With respect to having the settlement agreement treated as business confidential information under 37 C.F.R. § 42.74(c), the parties must file the confidential settlement agreement electronically via the Patent Review Processing System (PRPS) in accordance with the instructions provided on the Board’s website (uploading as “Parties and Board Only”). The parties are herein directed to FAQ G2 on the Board’s website page at <http://www.uspto.gov/ip/boards/bpai/prps.jsp> for instructions on how to file their settlement agreement as confidential. In the motion to terminate, any references made to an exhibit must be to an exhibit number, and not, for example, to “attachment A”, etc.

CBM2014-00068 (US 7,424,438 B2)  
CBM2014-00077 (US 7,424,438 B2)

## ORDER

In consideration of the foregoing, it is

ORDERED that Papers 15 and 16 and Exhibits 2001–2004 of CBM2014–00068 and Papers 13 and 14 and Exhibits 2001–2004 of CBM2014–00077 shall be expunged from the record;

FURTHER ORDERED that the parties are authorized to file a separate joint motion to terminate in each proceeding;

FURTHER ORDERED that the joint motions are due no later than December 10, 2014;

FURTHER ORDERED that the joint motions must be accompanied by a true copy, labeled as an exhibit, of the settlement agreement as required by 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b);

FURTHER ORDERED that the parties may file separate joint motions requesting that the settlement agreement(s) be treated as business confidential information as specified by 37 C.F.R. § 42.74(c); and

FURTHER ORDERED that any confidential settlement agreement must be filed electronically via PRPS in accordance with the instructions provided on the Board’s website (uploading as “Parties and Board Only”).

CBM2014-00068 (US 7,424,438 B2)  
CBM2014-00077 (US 7,424,438 B2)

For Petitioner:

Brian M. Buroker  
Peter Weinberg  
[bburoker@gibsondunn.com](mailto:bburoker@gibsondunn.com)  
[pweinberg@gibsondunn.com](mailto:pweinberg@gibsondunn.com)

For Patent Owner:

James J. Kernell  
David L. Marcus  
[jjk@kcpatentlaw.com](mailto:jjk@kcpatentlaw.com)  
[dmarcus@bmlawkc.com](mailto:dmarcus@bmlawkc.com)