

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GROUPON, INC.,
Petitioner,

v.

MAXIM INTEGRATED PRODUCTS, INC.,
Patent Owner.

Case CBM2014-00090
Patent 5,805,702

Before SALLY C. MEDLEY and MIRIAM L. QUINN
Administrative Patent Judges.

MEDLEY, *Administrative Patent Judge.*

Order
Conduct of the Proceeding
37 C.F.R. § 42.73

On August 5, 2014, we authorized the parties to file a joint motion to terminate the proceeding pursuant to 35 U.S.C. § 327, and explained that the Board expects that a proceeding will terminate after the filing of a settlement agreement pursuant to 35 U.S.C. § 327. Paper 7, 1-2. On August 7, 2014,

and pursuant to 35 U.S.C. § 327 and 37 C.F.R. § 42.74, the parties filed a joint motion to terminate the proceeding. Paper 8. In the joint motion, the parties represent that Petitioner and Patent Owner have settled their dispute with respect to the involved patent. According to the motion, the parties jointly filed a stipulation of dismissal in the related district court case, *Maxim Integrated Products, Inc. v. Groupon, Inc.*, No. 2:12-cv-881-JFC (W.D. Pa.). Ex. 1012. The parties represent that the joint stipulation dismisses all claims against Petitioner relating to the involved patent and serves as the written agreement between the parties to settle their dispute. Paper 8, 1. On August 1, 2014, the related case was dismissed with prejudice. Ex. 1013. Lastly, the motion indicates that there is no other pending litigation based on the involved patent.

The parties jointly represent, on page 1 of the motion, that the “joint stipulation serves as the written agreement between the parties to settle their dispute regarding the ’702 patent.” This “settlement agreement” is somewhat ambiguous, and not the typical settlement agreement that is submitted in compliance with 35 U.S.C. § 327(b).

The parties are reminded that any agreement or understanding between the patent owner and the petitioner, including any collateral agreements referred to in such agreement or understanding, made in connection with, or in contemplation of, the termination of the proceeding shall be in writing, and a true copy of that agreement or understanding shall be filed in the Office. 35 U.S.C. § 327(b). In order to ensure compliance with 35 U.S.C. § 327(b), and based on the facts of this proceeding, the parties are required to certify in writing that there are no other written or oral agreements or understandings, including any collateral agreements, between

them, including but not limited to licenses, covenants not to sue, confidentiality agreements, payment agreements, or other agreements of any kind, that are made in connection with, or in contemplation of, the termination of the instant proceeding. To the extent that there are other agreements as outlined immediately above, the parties shall file such agreements and may request that any such agreement be treated as business confidential information and be kept separate from the files of the involved patent. 37 C.F.R. § 42.74(c).

If the parties do not so certify, or do not file a settlement agreement as outlined in this order, the parties must arrange a conference call with the Board to discuss termination of this proceeding.

It is

ORDERED that the parties shall, no later than August 18, 2014, certify in writing that there are no other written or oral agreements or understandings, including any collateral agreements, between them, including but not limited to licenses, covenants not to sue, confidentiality agreements, payment agreements, or other agreements of any kind, that are made in connection with, or in contemplation of, the termination of the instant proceeding; and

FURTHER ORDERED that to the extent that there are other agreements as outlined immediately above, the parties shall file such agreements no later than August 18, 2014, and may request that any such agreement be treated as business confidential information and be kept separate from the files of the involved patent; and

FURTHER ORDERED that if the parties do not certify, or file a settlement agreement in accordance with this order, the parties must arrange

Case CBM2014-00090
Patent 5,805,702

a conference call with the Board to discuss termination of this proceeding.

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