

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

VONAGE HOLDINGS CORP.,
VONAGE AMERICA, INC.,
VONAGE MARKETING LLC, and
NETFLIX, INC.,
Petitioner,

v.

STRAIGHT PATH IP GROUP, INC.,
Patent Owner.

Case IPR2014-01223 (Patent 6,513,066)
Case IPR2014-01224 (Patent 6,701,365)
Case IPR2014-01225 (Patent 6,009,469)
Case IPR2014-01234 (Patent 6,131,121)
Case IPR2014-01241 (Patent 6,108,704)

Before KALYAN K. DESHPANDE, THOMAS L. GIANNETTI,
TRENTON A. WARD, and BART A. GERSTENBLITH, *Administrative Patent
Judges.*

WARD, *Administrative Patent Judge.*

ORDER
Motion to Terminate
37 C.F.R. § 42.72

IPR2014-01223 (Patent 6,513,066)
IPR2014-01224 (Patent 6,701,365)
IPR2014-01225 (Patent 6,009,469)
IPR2014-01234 (Patent 6,131,121)
IPR2014-01241 (Patent 6,108,704)

Netflix, Inc. and Straight Path IP Group, Inc. have filed a joint motion in each of these proceedings to terminate the trial proceeding with respect to Netflix, Inc. only, and not with respect to the remaining parties, Vonage Holdings Corp., Vonage America, Inc., and Vonage Marketing LLC. IPR2014-01223, Paper 9; IPR2014-01224, Paper 8; IPR2014-01225, Paper 8; IPR2014-01234, Paper 8; IPR2014-01241, Paper 8. Along with each of the motions, Netflix, Inc. and Straight Path IP Group, Inc. filed a copy of a document they described as the written settlement agreement (IPR2014-01223, Ex. 1025; IPR2014-01224, Ex. 1028; IPR2014-01225, Ex. 1029; IPR2014-01234, Ex. 1028; and IPR2014-01241, Ex. 1024), as well as a separate joint request to treat the settlement agreement as business confidential information under the provisions of 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c). IPR2014-01223, Paper 10, 1; IPR2014-01224, Paper 9, 1; IPR2014-01225, Paper 9, 1; IPR2014-01234, Paper 9, 1; and IPR2014-01241, Paper 9, 1.

Separately, Vonage Holdings Corp., Vonage America, Inc., and Vonage Marketing LLC (collectively “Vonage”) have filed joint motions to terminate the trial proceedings with respect to the remaining parties. IPR2014-01223, Paper 11; IPR2014-01224, Paper 10; IPR2014-01225, Paper 10; IPR2014-01234, Paper 10; IPR2014-01241, Paper 10. Along with each of the motions, Vonage and Straight Path IP Group, Inc. filed a copy of a document they described as the written settlement agreement (IPR2014-01223, Ex. 1026; IPR2014-01224, Ex. 1029; IPR2014-01225, Ex. 1030; IPR2014-01234, Ex. 1029; and IPR2014-01241, Ex. 1025), as well as a separate joint request to treat the settlement agreement as business confidential information under the provisions of 35 U.S.C. § 317(b) and

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37 C.F.R. § 42.74(c). IPR2014-01223, Paper 12, 1; IPR2014-01224, Paper 11, 1; IPR2014-01225, Paper 11, 1; IPR2014-01234, Paper 11, 1; and IPR2014-01241, Paper 11, 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.” Netflix, Inc. and Straight Path IP Group, Inc. stated in their motions that they have settled the dispute between these two parties and reached an agreement to terminate this proceeding as to Netflix, Inc. IPR2014-01223, Paper 9, 1; IPR2014-01224, Paper 8, 1; IPR2014-01225, Paper 8, 1; IPR2014-01234, Paper 8, 1; and IPR2014-01241, Paper 8, 1. Similarly, Vonage stated in its joint motions that Patent Owner and Vonage have settled their dispute and have reached an agreement to terminate these proceedings. IPR2014-01223, Paper 11, 1; IPR2014-01224, Paper 10, 1; IPR2014-01225, Paper 10, 1; IPR2014-01234, Paper 10, 1; and IPR2014-01241, Paper 10, 1. We note that a trial has not been instituted in these proceedings and the time for the filing of a Preliminary Response in each proceeding by Straight Path IP Group, Inc. has not yet expired or been waived.

Generally, the Board expects that a proceeding will terminate after the filing of a settlement agreement. *See, e.g., Office Patent Trial Practice Guide*, 77 Fed. Reg. 48,756, 48,768 (Aug. 14, 2012). These proceedings are still in the preliminary stages, as the Board has not instituted a trial and the time for the filing of a Preliminary Response by Straight Path IP Group, Inc. has not yet expired or

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been waived. The Board is persuaded that, under these circumstances, it is appropriate to terminate these proceedings with respect to all parties.

Accordingly, it is:

ORDERED that the joint motions to terminate these proceedings are GRANTED and each of these proceedings is hereby terminated;

FURTHER ORDERED that the joint request of Netflix, Inc. and Straight Path IP Group, Inc. that the settlement agreement (IPR2014-01223, Ex. 1025; IPR2014-01224, Ex. 1028; IPR2014-01225, Ex. 1029; IPR2014-01234, Ex. 1028; and IPR2014-01241, Ex. 1024) be treated as business confidential information, kept separate from the file of the involved patent, and made available only to Federal Government agencies on written request, or to any person on a showing of good cause, under the provisions of 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c), is GRANTED; and

FURTHER ORDERED that the joint request of Vonage and Straight Path IP Group, Inc. that the settlement agreement (IPR2014-01223, Ex. 1026; IPR2014-01224, Ex. 1029; IPR2014-01225, Ex. 1030; IPR2014-01234, Ex. 1029; and IPR2014-01241, Ex. 1025) be treated as business confidential information, kept separate from the file of the involved patent, and made available only to Federal Government agencies on written request, or to any person on a showing of good cause, under the provisions of 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c), is GRANTED.

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