

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

PERSONALIZED MEDIA COMMUNICATIONS LLC,
Patent Owner.

Case IPR2016-00753
Patent 7,752,649 B1

Before KARL D. EASTHOM, TRENTON WARD, and
GEORGIANNA W. BRADEN, *Administrative Patent Judges*.

BRADEN, *Administrative Patent Judge*.

ORDER
Granting Joint Motion to Terminate
37 C.F.R. §§ 42.5, 42.72, 42.74(c)

On March 9, 2017, with Board authorization, the parties filed a joint motion to terminate the proceeding (Paper 19), along with what they indicate is their written settlement agreement (Ex. 1029). According to counsel, the parties have settled their disputes, and have reached agreement to terminate this IPR proceeding, which challenged the patentability of U.S. Patent No. 7,752,649 B1 (“the ’649 patent”). *See* Paper 19, 1. The parties further request confidential treatment of the settlement agreement, pursuant to 37 C.F.R. § 42.74(c). Paper 20.

The parties state the above-identified IPR petition is related to a lawsuit filed in the Eastern District of Texas, *Personalized Media Communications LLC. V. Apple Inc.*, Case No. 2:15-cv-01366 (EDTX). Paper 19, 2. The parties state that they have resolved their disputes with regard to the ’649 patent in that district court litigation and have filed a joint stipulation of dismissal of all of the parties’ claims and counterclaims that specifically relate to the ’649 patent. *Id.* According to the parties, the other related lawsuits have either being terminated or dismissed. *Id.* The parties further indicate that the parties have moved jointly to terminate IPR2017-00141, IPR2017-00142, IPR2017-00289, and IPR2017-00290, all of which challenge the patentability of the ’649 patent. *Id.* at 2–3.

The joint request to treat the settlement agreement as business confidential information includes a request that the settlement agreement be kept separate from the patent file. Paper 20; *see also* 37 C.F.R. § 42.74(c) (“A party to a settlement may request that the settlement be treated as business confidential information and be kept separate from the files of an involved patent or application.”).

The parties indicate good cause exists to terminate the above-identified IPR Proceeding. Paper 19, 1. In addition to being unopposed, the parties state that, although a Patent Owner Response was filed, Petitioner has not filed its Reply, and the Board has not issued a decision on institution, plus the co-pending district court litigation has been dismissed with prejudice. *Id.* Based on the facts of this case, we agree it is appropriate to terminate the proceeding, because doing so will preserve the Board's and the parties' resources while also furthering the Patent Office's policy of "secur[ing] the just, speedy, and inexpensive resolution"; and this is a just and fair resolution.

Accordingly, the joint motions to terminate each of the above-identified proceedings and the joint requests to treat the settlement agreement as business confidential information are granted. As requested by the parties, the settlement agreement will be treated as business confidential information and kept separate from the patent file. 37 C.F.R. § 42.74(c). This paper does not constitute a final written decision pursuant to 35 U.S.C. § 318(a).

Therefore, it is

ORDERED that the joint motion to terminate IPR2016-00753 is granted;

FURTHER ORDERED that the proceeding in IPR2016-00753 is terminated pursuant to 37 C.F.R. §§ 42.5, 42.72, 42.74(c); and

FURTHER ORDERED that the parties' joint request that the settlement agreement (Ex. 1029) be treated as business confidential information, be kept separate from the file of the involved patent, and made

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available only to Federal Government agencies on written request, or to any person on a showing of good cause, under 37 C.F.R. § 42.74(c) is granted.

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