

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

OPENTV, INC.,
Patent Owner.

Case IPR2016-00992
Patent 6,233,736 B1

Before JAMESON LEE, SALLY C. MEDLEY, and
MICHAEL R. ZECHER, *Administrative Patent Judges*.

MEDLEY, *Administrative Patent Judge*.

JUDGMENT

Granting Joint Motion to Terminate Proceeding and
Granting Request to Treat Agreements as Business Confidential Information
37 C.F.R. §§ 42.72 and 42.74

I. INTRODUCTION

On August 4, 2016, the parties filed a Joint Motion to Terminate Proceeding (Paper 8, “Mot.”), and a joint request to treat the settlement agreements as business confidential information under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) (Paper 9). A conference call was held on August 9, 2016, and we issued an Order on August 10, 2016 (Paper 11) instructing the parties that they reduce to writing any agreement or understanding between them in contemplation of termination. We observed that none of the agreements filed by the parties on August 4, 2016, i.e., Exhibits 1017, 2001, 2002, 2003, and 2004, reflects any understanding between the Petitioner and the Patent Owner. Paper 11, 2. We also observed that Exhibits 2001 and 2002 appear to be incomplete. *Id.* at 2–3.

On August 19, 2016, the parties filed Exhibit 2005, which is a writing reflecting an understanding between the Petitioner and Patent Owner in contemplation of termination of proceeding, and a joint request to treat this exhibit as confidential business information under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) (Paper 13). Also on August 17, 2016, the parties filed replacement copies of Exhibits 2001 and 2002. Further on August 17, 2016, Patent Owner filed an updated Mandatory Notice to identify its parent entities and to list additional real parties in interest. Paper 12.

II. DISCUSSION

The parties represent in the Joint Motion to Terminate Proceeding that the filed agreements “end all patent disputes between the parties, including this proceeding.” Mot. 6. The parties also indicate that all related district

court cases involving U.S. Patent No. 6,233,736 B1 have either been dismissed or are subject to pending joint motions to terminate. *Id.* at 3–5.

This proceeding is still in a preliminary stage. Patent Owner has yet to file a Preliminary Response and we have yet to decide whether to institute a trial. Under the circumstances presented here, we determine that it is appropriate to terminate this proceeding with respect to both Petitioner and Patent Owner without rendering any further decisions. *See* 37 C.F.R. § 42.72.

III. ORDER

It consideration of the foregoing, it is hereby

ORDERED that the parties’ Joint Motion to Terminate Proceeding, both as to Petitioner and Patent Owner, is *granted*;

FURTHER ORDERED that the parties’ joint request (Paper 9) to treat Exhibits 1017, 2001, 2002, 2003, and 2004 as business confidential information under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) is *granted*;

FURTHER ORDERED that the parties’ joint request (Paper 13) to treat Exhibit 2005 as business confidential information under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) is *granted*;

FURTHER ORDERED that the parties’ request to accept the filing of Exhibits 1017 and 2002 under the access category of “available only to Board” in the Board’s electronic filing system is *granted*;¹ and

FURTHER ORDERED that this proceeding is terminated with respect to both Petitioner and Patent Owner.

¹ *See* Paper 11, 3.

IPR2016-00992
Patent 6,233,736 B1

For PETITIONER:

Mark E. Miller
Ryan K. Yagura
Anne E. Huffsmith
Brian M. Cook
Xin-Yi Zhou
John Kevin Murray
O'Melveny & Myers LLP
markmiller@omm.com
ryagura@omm.com
ahuffsmith@omm.com
bcook@omm.com
vzhou@omm.com
kmurray2@omm.com

For PATENT OWNER:

Joshua L. Goldberg
Erika H. Arner
Daniel G. Chung
Finnegan, Henderson, Farabow, Garrett & Dunner, LLP
josha.goldberg@finnegan.com
erika.arner@finnegan.com
daniel.chung@finnegan.com