

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

RUBICON COMMUNICATIONS, LP,
Petitioner,

v.

LEGO A/S,
Patent Owner.

Case IPR2016-01187
Patent 8,894,066 B2

Before SCOTT A. DANIELS, NEIL T. POWELL, and
TIMOTHY J. GOODSON, *Administrative Patent Judges*.

POWELL, *Administrative Patent Judge*.

DECISION

Denying Joint Motion to Terminate

35 U.S.C. §§ 317 and 318 and 37 C.F.R. §§ 42.20, 42.72, and 42.74

Pursuant to our authorization, on December 12, 2017, Petitioner and Patent Owner filed a Joint Motion for Termination. Paper 93 (“Motion” or “Mot.”). With the Motion, the parties have filed a Settlement Agreement. Ex. 2108. The parties have requested that the Settlement Agreement be treated as business confidential information and be kept separate from the files of this *inter partes* review proceeding. Mot. 2.

Pursuant to 35 U.S.C. § 317(a),

An *inter partes* 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 *inter partes* review, the Office may terminate the review or proceed to a final written decision under section 318(a).

In order for us to terminate these proceedings, the parties must persuade us that they are entitled to the relief requested. *See* 37 C.F.R. §§ 42.20(a), 42.20(c).

The parties have filed their Motion very near the conclusion of the proceeding. All briefing has been completed, and an oral hearing was conducted on October 11, 2017. Indeed, the parties first requested authorization to file their Motion on December 11, 2017, less than one week prior to the statutory due date to enter a final written decision—December 16, 2017. Thus, the public’s interest in the status of the challenged claims of each patent is at its peak. *See Apple, Inc. v. Smartflash LLC*, Case CBM2015-00015, slip op. at 6 (PTAB Nov. 4, 2015) (Paper 49) (“There is a public interest in resolving the issues raised by these challenges because the record is fully developed.”). We note that, consistent with that public interest, the Board has in previous cases denied motions to terminate that were filed late in the proceedings, after the hearing was completed. *See*,

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e.g., *Apple Inc. v. OpenTV, Inc.*, Case IPR2015-00969, slip op. at 4–5 (PTAB Sept. 10, 2016) (Paper 29); *Kinetic Technologies, Inc. v. Skyworks Solutions, Inc.*, Case IPR2014-00690, slip op. at 20–21 (PTAB Oct. 19, 2015) (Paper 43). Here, although the panel has not yet issued a final written decision, the panel deliberated and decided the merits of the proceeding before the parties filed their Motion.

Regarding the timing of their Motion, the parties explain that:

With many events and issues arising from two Federal Court litigations and an *Inter Partes* Review proceeding, it was only with the assistance of a court-scheduled settlement conference on December 11, 2017 where the Parties were able to settle after an extended session with the United States Magistrate Judge, Robert A. Richardson, ending at 9 P.M. Eastern Time. The Parties would not have been able to reach an agreement without the court’s assistance, and the settlement conference could not have been scheduled earlier than December 11, 2017.

Mot. 4.

The timing of the parties’ Motion, coming as it does relative to the related proceeding in district court and in the final days of this proceeding, provides no compelling reason for terminating this *inter partes* review. Accordingly, given that we have decided the merits of the proceeding, and given the public’s interest in the status of the challenged claims, the Motion does not persuade us to grant the parties’ request for termination at this very late stage in the proceeding. Accordingly, the parties’ request for termination is *denied*, and a final written decision will issue. The parties’ request that the Settlement Agreement be treated as business confidential information and kept separate from the file of this proceeding is *granted*.

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It is

ORDERED that the parties' request for termination of the instant proceeding is *denied* and the Board will proceed to a final written decision pursuant to 35 U.S.C. §§ 317(a) and 318(a); and

FURTHER ORDERED that the parties' request that the Settlement Agreement be treated as business confidential information and kept separate from the file of this proceeding is *granted*.

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PETITIONER:

Dean Munyo
Anthony Petro
Ryan Beard
Geoffrey Heaven
MEYERTONS, HOOD, KIVLIN, KOWERT & GOETZEL, P.C.
dmunyon@intprop.com
tpetro@intprop.com
rtbpto@intprop.com
gheaven@intprop.com

PATENT OWNER:

Andrew Riddles
Elizabeth Alquist
DAY PITNEY, LLP
ariddles@daypitney.com
eaalquist@daypitney.com