Trials@uspto.gov Paper 36
Tel: 571.272.7822 Entered: December 7, 2017

## UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GLOBAL TEL\*LINK CORPORATION, Petitioner,

v.

SECURUS TECHNOLOGIES, INC., Patent Owner.

IPR2014-01278 (Patent 7,860,222), IPR2014-01282 (Patent 7,860,222), IPR2016-01220 (Patent 9,007,420), IPR2016-01333 (Patent 9,094,500), IPR2016-01362 (Patent 9,083,850), CBM2017-00043 (Patent 7,529,357), CBM2017-00044 (Patent 8,340,260), IPR2017-01435 (Patent 7,529,357), IPR2017-01436 (Patent 8,340,260), IPR2017-01437 (Patent 7,916,845)<sup>1</sup>

Before KEVIN F. TURNER, BARBARA A. BENOIT, BEVERLY M. BUNTING, and GEORGIANNA W. BRADEN, *Administrative Patent Judges*.

TURNER, Administrative Patent Judge.

### **DECISION**

Granting Joint Motion to Terminate Proceedings Pursuant to Settlement 35 U.S.C. §§ 317(a), 327(a) and 37 C.F.R. §§ 42.72–42.74

<sup>&</sup>lt;sup>1</sup> We use this caption in this paper to indicate that this Order applies to, and is entered in, all of the indicated cases. The parties are not authorized to use this caption.



Cases IPR2014-01278, IPR2014-01282, IPR2016-01220, IPR2016-01333, IPR2016-01362, CBM2017-00043, CBM2017-00044, IPR2017-01435, IPR2017-01436, IPR2017-01437
Patents 7,860,222; 9,007,420; 9,094,500; 9,083,850; 7,529,357; 8,340,260; 7,916,845

On December 6, 2017, and pursuant to 35 U.S.C. §§ 317(a), 327(a), the parties filed an omnibus Joint Motion to terminate in each of the above cited proceedings. *See* Appendix ("Joint Motion"). Along with the Joint Motion, the parties filed a Settlement Agreement (Ex. 1100), <sup>2</sup> and a Joint Request to Treat the Settlement Agreement as Business Confidential Information, in each proceeding. *See* Appendix ("Joint Request"). We authorized the above filings in an email sent to the parties on December 4, 2017.

The parties represent that they have settled their disputes and memorialized their settlement in the written Settlement Agreement submitted in each case. In the Joint Motion, the parties also represent that the Settlement Agreement resolves all disputes between the parties in the post grant proceedings and the related lawsuits. The Settlement Agreement appears to be a true copy of the agreement between the parties, specifies the instant proceedings, and identifies other matters that are to be settled between the parties. Ex. 1100. On this record, no motion by any third party for joinder with these reviews is pending.

The proceedings are at different stages, with some cases being remanded from the U.S. Court of Appeals for the Federal Circuit for further consideration, other cases having a trial instituted therein, other cases where institution was denied, but where rehearing of that denial has been requested, and still other cases where no decision on institution has yet been made.

<sup>&</sup>lt;sup>2</sup> The Settlement Agreement was filed with the same exhibit number in each of the above-listed proceedings.



Cases IPR2014-01278, IPR2014-01282, IPR2016-01220, IPR2016-01333, IPR2016-01362, CBM2017-00043, CBM2017-00044, IPR2017-01435, IPR2017-01436, IPR2017-01437
Patents 7,860,222; 9,007,420; 9,094,500; 9,083,850; 7,529,357; 8,340,260; 7,916,845

Although at different stages, upon consideration of the facts before us and the arguments presented in the Joint Motion, we determine that it is appropriate to terminate the proceedings with respect to both parties. *See* 35 U.S.C. §§ 317(a), 327(a); 37 C.F.R. §§ 42.72, 42.74. Therefore, the Joint Motion is granted. This paper does not constitute a final written decision pursuant to 35 U.S.C. §§ 318(a) or 328(a).

### **ORDER**

For the foregoing reasons, it is:

ORDERED that the Omnibus Joint Motion to Terminate Proceedings in IPR2014-01278, IPR2014-01282, IPR2016-01220, IPR2016-01333, IPR2016-01362, CBM2017-00043, CBM2017-00044, IPR2017-01435, IPR2017-01436, and IPR2017-01437 is *granted*; and

FURTHER ORDERED that the Settlement Agreements, Exhibit 1100 in each proceeding, be treated as business confidential information, be designated "Board Only," and be kept separate from the file of the involved patent under the provisions of 35 U.S.C. §§ 317(b), 327(b) and 37 C.F.R. § 42.74(c).



Cases IPR2014-01278, IPR2014-01282, IPR2016-01220, IPR2016-01333, IPR2016-01362, CBM2017-00043, CBM2017-00044, IPR2017-01435, IPR2017-01436, IPR2017-01437

Patents 7,860,222; 9,007,420; 9,094,500; 9,083,850; 7,529,357; 8,340,260; 7,916,845

## **APPENDIX**

CASE	Joint Motion	Joint Request
IPR2014-01278	Paper 37	Paper 38
IPR2014-01282	Paper 35	Paper 36
IPR2016-01220	Paper 33	Paper 34
IPR2016-01333	Paper 26	Paper 27
IPR2016-01362	Paper 39	Paper 40
CBM2017-00043	Paper 9	Paper 10
CBM2017-00044	Paper 9	Paper 10
IPR2017-01435	Paper 9	Paper 10
IPR2017-01436	Paper 10	Paper 11
IPR2017-01437	Paper 9	Paper 10



Cases IPR2014-01278, IPR2014-01282, IPR2016-01220, IPR2016-01333, IPR2016-01362, CBM2017-00043, CBM2017-00044, IPR2017-01435, IPR2017-01436, IPR2017-01437

Patents 7,860,222; 9,007,420; 9,094,500; 9,083,850; 7,529,357; 8,340,260; 7,916,845

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