

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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NU MARK LLC,  
Petitioner,

v.

FONTEM HOLDINGS 1 B.V.,  
Patent Owner.

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Case IPR2016-01288<sup>1</sup>  
Patent 8,893,726 B2

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Before GRACE KARAFFA OBERMANN, JOSIAH C. COCKS, BRIAN J. McNAMARA, RAMA G. ELLURU, JEREMY M. PLENZLER, JO-ANNE M. KOKOSKI, KRISTINA M. KALAN, and KIMBERLY McGRAW,  
*Administrative Patent Judges.*

KOKOSKI, *Administrative Patent Judge.*

TERMINATION  
Dismissing the Petitions  
*37 C.F.R. §§ 42.5(a) and 42.71(a)*

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<sup>1</sup> This Judgment addresses the same issues raised in the cases identified in the Appendix. Therefore, we exercise our discretion to issue one Judgment to be entered in IPR2016-01288 and in each of the cases identified in the Appendix.

On January 3, 2017, the parties filed joint motions to terminate IPR2016-01288 and the proceedings identified in the Appendix (Paper 17),<sup>2</sup> along with what they indicate is a true copy of their settlement agreement (Ex. 2019). The parties indicate in their joint motions that “they reached a settlement agreement, resolving all disputes between them involving” the patents at issue in each of these proceedings. Paper 17, 1. On the same day, the parties also filed joint requests that the settlement agreement be treated as business confidential information and kept separate from the patent files. Paper 18.

The instant proceedings are in the early stages, and decisions on whether to institute trial have not been made. The parties represent that “[t]here are no other agreements, oral or written, between Patent Owner and Petitioner Nu Mark made in connection with, or in contemplation of,” the termination of these proceedings. Paper 17, 1. The parties also represent that “[t]he settlement agreement has resolved all disputes” between the parties involving each of the patents identified in the Appendix, including the related district court cases. *Id.* at 4. The parties further represent that Exhibit 2019 is “a true copy (including counterparts) of the settlement agreement.” *Id.* at 1. Under these circumstances, it is appropriate to dismiss the Petition for *Inter Partes* Review in IPR2016-01288 and in each of the proceedings identified in the Appendix. This paper does not constitute a final written decision pursuant to 35 U.S.C. § 318(a).

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<sup>2</sup> The parties filed similar papers in each of the instant proceedings. We refer to those filed in Case IPR2016-01288 for convenience.

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As requested by the parties, the settlement agreement will be treated as business confidential information and kept separate from the patent files. 37 C.F.R. § 42.74(c).

Accordingly, it is

ORDERED that the joint motions to terminate IPR2016-01288 and the proceedings identified in the Appendix are *granted*;

FURTHER ORDERED that the Petitions for *Inter Partes* Review in IPR2016-01288 and the proceedings identified in the Appendix are *dismissed*; and

FURTHER ORDERED that a copy of this Judgment be filed in IPR2016-01288 and each of the cases identified in the Appendix; and

FURTHER ORDERED that the parties' joint requests in IPR2016-01288 and the proceedings identified in the Appendix that the settlement agreement in each proceeding be treated as business confidential information, to be kept separate from the patent files, are *granted*.

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## APPENDIX

Case No.	U.S. Patent No.
IPR2016-01288	8,893,726 B2
IPR2016-01297	8,893,726 B2
IPR2016-01298	8,689,805 B2
IPR2016-01302	8,899,239 B2
IPR2016-01303	8,365,742 B2
IPR2016-01641	9,326,548 B2
IPR2016-01642	9,370,205 B2
IPR2016-01664	9,326,549 B2
IPR2016-01668	9,364,027 B2
IPR2016-01705	9,339,062 B2
IPR2016-01706	9,326,551 B2
IPR2016-01707	9,326,550 B2
IPR2016-01773	9,320,300 B2
IPR2017-00204	9,326,548 B2
IPR2017-00205	9,326,550 B2
IPR2017-00257	9,370,205 B2
IPR2017-00303	9,339,062 B2
IPR2017-00304	9,364,027 B2
IPR2017-00342	9,326,551 B2