

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CORNING OPTICAL COMMUNICATIONS RF LLC,
CORNING INCORPORATED, and
CORNING OPTICAL COMMUNICATIONS LLC,
Petitioners,

v.

PPC BROADBAND, INC.
Patent Owner.

IPR2016-01573
Patent 8,075,338 B1

Before JOSIAH C. COCKS, JAMES B. ARPIN, and
SHEILA F. McSHANE, *Administrative Patent Judges*.

McSHANE, *Administrative Patent Judge*.

DECISION

Termination of the Proceeding
35 U.S.C. § 317 and 37 C.F.R. §§ 42.72, 42.74

DISCUSSION

On January 4, 2017, in response to a joint email request from the parties, we sent an email communication authorizing the parties to file joint motions to terminate in this case and in co-pending Cases IPR2016-01569, IPR2016-01570, and IPR2016-01572, as well as authorizing joint requests to file settlement agreements as business confidential information. On January 12, 2017, the parties filed a Joint Motion to Terminate (Paper 12, “Joint Mot.”) in this proceeding, and a Joint Request To Treat Settlement Agreement As Business Confidential Information Pursuant To 35 U.S.C. § 317(b) and 37 C.F.R § 42.74(c) (Paper 13, “Joint Req.”). The parties also filed a true copy of their written Settlement Agreement under 37 C.F.R. § 42.74(b). Ex. 2031. For the reasons discussed below, the Joint Motion to Terminate and the Joint Request To Treat the Settlement Agreement As Business Confidential Information are *granted*.

In the Joint Motion to Terminate, the parties indicate that termination of this proceeding is appropriate because they have reached a settlement regarding their disputes involving U.S. Patent No. Patent 8,075,338 B1 (“the ’338 patent”). Joint Mot. 1. According to the parties, the associated Settlement Agreement requires the parties to jointly request termination of this IPR. *Id.* The parties represent that, pursuant to the Settlement Agreement, all claims have been dismissed with prejudice in the related litigation by a January 3, 2017 order (Ex. 2032). *Id.* at 2. The parties represent that there are no other litigations involving the ’338 patent, and there are no pending, related *inter partes* review proceedings or U.S. Patent and Trademark Office proceedings, aside from co-pending Case IPR2016-01569. *Id.* at 2–3. The parties represent that, except for the Settlement Agreement, there are no other collateral agreements or understandings made

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that relate to the termination of this IPR. *Id.* at 3. As the parties also indicate, the proceeding is at an early stage, and trial has not been instituted. *See id.* at 2.

Under 35 U.S.C. § 317(a), “[a]n inter partes review instituted under this chapter shall be terminated with respect to any petitioner upon the joint request of the petitioner and patent owner, unless the Office has decided the merits of the proceeding before the request for termination is filed.” Further, under 37 C.F.R. § 42.74(b), “[a]ny agreement or understanding between the parties made in connection with, or in contemplation of, the termination of a proceeding shall be in writing and a true copy shall be filed with the Board before termination of the trial.”

There are strong public policy reasons to favor settlement between the parties to a proceeding. Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,768 (Aug. 14, 2012). When, as here, the proceeding is still in its preliminary stages and we have not entered a decision on whether or not to institute an *inter partes* proceeding, we generally expect that the proceeding will terminate after the filing of a settlement agreement. *See id.* Because the parties have filed their written settlement agreement, and the related district court litigation was dismissed with prejudice, we determine that it is appropriate to terminate this proceeding. *See* 37 C.F.R. §§ 42.72, 42.74.

II. ORDER

Accordingly, it is:

ORDERED that the parties’ request to treat the settlement agreement (Ex. 2031) as business confidential information under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) is GRANTED; and

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FURTHER ORDERED that the parties' Joint Motion to Terminate is GRANTED, and this proceeding is hereby terminated.

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