

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NETFLIX, INC.,
Petitioner,

v.

CONVERGENT MEDIA SOLUTIONS, LLC,
Patent Owner.

Case IPR2016-01812
Patent 8,640,183 B2

Before JAMESON LEE, KEN B. BARRETT, and JOHN F. HORVATH,
Administrative Patent Judges.

HORVATH, *Administrative Patent Judge.*

ORDER

Granting Motion to Terminate
37 C.F.R. §42.72

and

Granting Request to Treat Settlement Documents
As Business Confidential Information
37 C.F.R. § 42.74(c)

I. INTRODUCTION

On May 1, 2017, Petitioner and Patent Owner (“the parties”) jointly filed a motion to terminate this proceeding (Paper 12, “Mot.”), and a request to treat settlement documents as Business Confidential Information (Paper 13, “Req.”). For the reasons discussed below, the parties’ joint motion to terminate this proceeding is *granted*, and the parties’ joint request to treat settlement documents as Business Confidential Information is *granted*.

II. DISCUSSION

The parties’ joint motion to terminate requests termination of this proceeding because the parties have settled their dispute regarding U.S. Patent No. 8,640,183 B2 (“the ’183 patent”) in this proceeding and in *Convergent Media Solutions, LLC v. Netflix, Inc.*, No. 3:15-cv-02160 (N.D. Tex), the related District Court litigation. Mot. 3–5. The parties filed a true copy of their Settlement Agreement as an exhibit to this proceeding, and aver that the filed Settlement Agreement constitutes the entire understanding and agreement between the parties. *Id.*; *see also* Ex. 2001.

These proceedings are at a relatively early stage. Petitioner filed a Petition for *Inter Partes* Review of claims 1–5, 16, 18–20, 24, 32, 34, 35, 37, 38, 42, 44, 47, 50–55, and 58–60 (“the challenged claims”) of the ’183 patent on September 15, 2016. Paper 2. Patent Owner did not file a Preliminary Response. Mot. 4. We instituted trial on the challenged claims on March 3, 2017. *See* Paper 7, 23. Patent Owner’s Response to the Petition is due June 6, 2017. *See* Paper 8, 6. In a related proceeding, the Board found claims 1–5, 16, 18, 24–26, 32–38, 40–42, 49, 51–53, 55, 55, 58, and 59 of the ’183 patent unpatentable, and entered adverse judgment

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against claims 60 and 61 of the '183 patent at Patent Owner's request. *See Unified Patents Inc. v. Convergent Media Solutions, LLC*, Case IPR2016-00047, slip op. at 27–28 (PTAB Mar. 29, 2017) (Paper 29).

Under the foregoing circumstances, we determine it is appropriate to terminate this proceeding. *See* 37 C.F.R. § 42.72. We also determine it is appropriate to treat the parties' Settlement Agreement as Business Confidential Information, and to keep this document separate from the files of the '183 patent.

This paper does not constitute a final written decision pursuant to 35 U.S.C. § 318(a).

III. ORDER

It is hereby:

ORDERED that the Joint Motion of Petitioner and Patent Owner to Terminate Proceeding is *granted*;

FURTHER ORDERED that the trial instituted for IPR2016-01812 is terminated;

FURTHER ORDERED that the Joint Motion of Petitioner and Patent Owner to Treat Settlement Agreement as Business Confidential Information is *granted*; and

FURTHER ORDERED that Exhibit 2001 ("Settlement and License Agreement") be maintained as Business Confidential Information and kept separate from the files of U.S. Patent No. 8,640,183 B2.

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For PETITIONER:

Chun Ng
Patrick McKeever
Vinay Sathe
Miguel Bombach
Kevin Kantharia
Matthew C. Bernstein
cng@perkinscoie.com
pmckeeper@perkinscoie.com
vsathe@perkinscoie.com
mbombach@perkinscoie.com
kkantharia@perkinscoie.com
mbernstein@perkinscoie.com

For PATENT OWNER:

Matthew Juren
Barry Bumgardner
matthew@nelbum.com
barry@nelbum.com