

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

VIZIO, INC.,
Petitioner,

v.

PERSONALIZED MEDIA
COMMUNICATIONS, LLC.
Patent Owner.

Case IPR2017-00141 Patent 7,752,649

Case IPR2017-00142 Patent 7,752,649

Case IPR2017-00143 Patent 7,752,650

Before SALLY C. MEDLEY, KARL D. EASTHOM, and
GEORGIANNA W. BRADEN, *Administrative Patent Judges*.

PER CURIAM

ORDER
Granting Joint Motion to Terminate
37 C.F.R. §§ 42.5, 42.72, 42.74(c)

Case IPR2017-00141 Patent 7,752,649

Case IPR2017-00142 Patent 7,752,649

Case IPR2017-00143 Patent 7,752,650

On January 5, 2017, with Board authorization, the parties filed a joint motion to terminate the proceeding (Paper 7¹), along with what they indicate is their written settlement agreement (Ex. 1032). The parties informed the Board that the settlement affects the Petitions filed in IPR2017-000141, IPR2017-000142, and IPR2017-000143. According to counsel, the parties have settled their disputes, and have reached agreement to terminate these IPR proceedings. *See* Paper 7, 2. The parties further request confidential treatment of the settlement agreement, pursuant to 37 C.F.R. § 42.74(c). Paper 8.

The parties state the above-identified IPR petitions are related to a lawsuit filed in the Eastern District of Texas (Envision Peripherals, Inc., et al. v. Personalized Media Communications, LLC, Civil Action No. 2:15-cv-01206 consolidated with Civil Action No. 2:15-cv-01366). Paper 7, 2–3. The parties further indicate that the patent challenged in IPR2017-000141 and IPR2017-000142 also is pending currently before the Board in IPR2016-00753 (trial instituted September 20, 2016), IPR 2017-00142 (petition filed October 26, 2016), IPR2017-00289 (petition filed November 18, 2016), and IPR2017-00290 (petition filed November 18, 2016). *Id.* at 3.

The joint request to treat the settlement agreement as business confidential information includes a request that the settlement agreement be kept separate from the patent file. Paper 8; *see also* 37 C.F.R. § 42.74(c) (“A party to a settlement may request that the settlement be treated as

¹ Citations are to the record in IPR2016-00141. Similar corresponding documents are in the records for IPR2017-000142 and IPR2017-000143.

Case IPR2017-00141 Patent 7,752,649

Case IPR2017-00142 Patent 7,752,649

Case IPR2017-00143 Patent 7,752,650

business confidential information and be kept separate from the files of an involved patent or application.”).

The parties indicate good cause exists to terminate the above-identified IPR Proceedings. Paper 7, 2. In addition to being unopposed, the parties state: no Preliminary Response has been filed, the Board has not issued a decision on institution, and co-pending district court litigation has been dismissed with prejudice. *Id.* We agree that this proceeding is at an early stage. The Patent Owner, Personalized Media Communications, LLC, has not filed a preliminary response, and the Board has not issued a decision on whether to institute trial. Based on the facts of this case, it is appropriate to terminate the proceedings, because doing so will preserve the Board’s resources and the parties’ resources while also epitomizing the Patent Office’s policy of “secur[ing] the just, speedy, and inexpensive resolution” (37 CFR §42.1(b)), and this is a just and fair resolution.

Accordingly, the joint motions to terminate each of the above-identified proceedings and the joint requests to treat the settlement agreement as business confidential information are granted. As requested by the parties, the settlement agreement will be treated as business confidential information and kept separate from the patent file. 37 C.F.R. § 42.74(c). This paper does not constitute a final written decision pursuant to 35 U.S.C. § 318(a).

Therefore, it is

ORDERED that the joint motions to terminate the above-captioned proceedings are granted;

Case IPR2017-00141 Patent 7,752,649

Case IPR2017-00142 Patent 7,752,649

Case IPR2017-00143 Patent 7,752,650

FURTHER ORDERED that the proceedings in IPR2017-000141, IPR2017-000142, and IPR2017-000143 are terminated pursuant to 37 C.F.R. §§ 42.5, 42.72, 42.74(c); and

FURTHER ORDERED that the parties' joint request that the settlement agreement (Ex. 1032) be treated as business confidential information, be kept separate from the file of each involved patent, and made available only to Federal Government agencies on written request, or to any person on a showing of good cause, under 37 C.F.R. § 42.74(c) is granted.

PETITIONER:

Cono Carrano

David Vondle

Ruben Munoz

AKIN GUMP STRAUSS HAUER & FELD LLP

ccarrano@akingump.com

dvondle@akingump.com

rmunoz@akingump.com

PATENT OWNER:

Dmitry Kheyfits

Andrey Belenky

KHEYFITS P.C

dkheyfits@hkeyfits.com

abelenky@hkeyfits.com