

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NETFLIX, INC. and ROKU, INC.,
and AT&T SERVICES, INC.,
Petitioners,

v.

CONVERGENT MEDIA SOLUTIONS, LLC,
Patent Owner.

Case IPR2016-01761
Case IPR2017-01235
Patent 8,850,507 B2¹

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

LEE, *Administrative Patent Judge.*

ORDER

Granting-In-Part Joint Motion to Terminate
Granting Request to Treat Agreements as Business Confidential Information
37 C.F.R. §§ 42.72, 42.74(c)

¹ Case IPR2017-01235 has been joined with IPR2016-01761.

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On March 9, 2017, we joined IPR2017-01235 with IPR2016-01761. Paper 15. Thus, there are now two petitioner entities in this joined proceeding, Netflix Inc. and Roku Inc. as one, and AT&T Services Inc., as the other. We refer to the first petitioner entity as “Netflix/Roku” and the second petitioner entity as “AT&T.” On May 1, 2017, Netflix/Roku and Patent Owner filed a joint motion to terminate this *inter partes* review, on the basis that they have settled the dispute between them regarding U.S. Patent No. 8,850,507 B2. Paper 13, 2–4. Also on May 1, 2017, Netflix/Roku and Patent Owner filed a copy of their written settlement agreement (Ex. 2001 (between Netflix Inc. and Patent Owner) and Ex. 2002 (between Roku Inc. and Patent owner)), and a joint request to have their settlement agreements treated as business confidential information under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) (Paper 14).

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.” The requirement for terminating this proceeding with respect to Netflix/Roku is met.

Under 35 U.S.C. § 317(a), “If no petitioner remains in the inter partes review, the Office may terminate the review or proceed to a final written decision under section 318(a).” AT&T, however, remains a petitioner in this

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proceeding after termination of Netflix/Roku. It is therefore inappropriate to terminate Patent Owner from this proceeding.

It is

ORDERED that the joint motion to terminate proceeding both as to Netflix/Roku and Patent Owner is *granted-in-part*, and that this *inter partes* review is hereby terminated as to Netflix Inc. and Roku Inc. but not as to Convergent Media Solution, LLC as Patent Owner; and

FURTHER ORDERED that the joint request of Netflix/Roku and Patent Owner to have their settlement agreements (Exhibits 2001 and 2002) treated as business confidential information under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) is *granted*.²

² The status of Exhibits 2001 and 2002 in the record was re-designated as “Board only” on May 9, 2017, prior to entry of a copy of the decision instituting trial in Case IPR2017-01235 and granting request for joinder of Case IPR2017-01235 with Case IPR2016-01761 (Paper 15).

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