

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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NFL ENTERPRISES LLC,  
Petitioner,

v.

OPENTV, INC.,  
Patent Owner.

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Case IPR2017-02092  
Patent 6,233,736 B1

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Before JAMESON LEE, SALLY C. MEDLEY, and  
MICHAEL R. ZECHER, *Administrative Patent Judges*.

MEDLEY, *Administrative Patent Judge*.

ORDER  
Conduct of the Proceeding  
*37 C.F.R. § 42.5(a)*

NFL Enterprises LLC (“Petitioner”)<sup>1</sup> filed a Petition for *inter partes* review of claims 1–3 and 8 of U.S. Patent No. 6,233,736 B1 (Ex. 1001, “the ’736 patent”). Paper 1 (“Pet.”). OpenTV, Inc. (“Patent Owner”)<sup>2</sup> filed a Preliminary Response. Paper 6 (“Prelim. Resp.”). On March 19, 2018, we instituted trial as to claims 1–3 and 8 of the ’736 patent, and subsequently modified our institution decision to institute on all of the challenged claims and all of the grounds presented in the Petition. Papers 7, 13. On June 27, 2018, Patent Owner informed the Board that the parties have reached a settlement agreement and seek authorization to file a joint motion to terminate the proceeding pursuant to 35 U.S.C. § 317.

Generally, the Board expects that a proceeding will terminate after the filing of a settlement agreement. *See, e.g.*, Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,768 (Aug. 14, 2012). The rule governing settlement indicates that any agreement between the parties made in connection with, or in contemplation of, the termination of a proceeding shall be in writing and filed with the Board. 37 C.F.R. § 42.74. Based on the facts of this proceeding, the parties are authorized to file a joint motion to terminate this proceeding.

The joint motion to terminate must include a brief explanation as to why termination of the proceeding is appropriate, and also should update the Board as to the status of any other matters involving the patent at issue. The parties also must file, as an exhibit, a true copy of their settlement agreement

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<sup>1</sup> Petitioner, NFL Enterprises LLC, identifies NFL Ventures, L.P. as a real party-in-interest. Pet. 2.

<sup>2</sup> Patent Owner, OpenTV, Inc., identifies Nagra USA, Inc. and Kudelski S.A. as real parties-in-interest. Paper 4, 2.

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to terminate the proceeding. A redacted version of the settlement agreement will not be accepted as a true copy of the settlement agreement. Any request that the agreement be treated as business confidential information and be kept separate from the file of the involved patent must be filed with the settlement agreement. 37 C.F.R. § 42.74(c). The parties are directed to FAQ G2 on the Board's website page at <http://www.uspto.gov/patents-application-process/patent-trial-and-appeal-board/ptab-e2e-frequently-asked-questions> for instructions on how to file their settlement agreement as confidential (*e.g.*, uploading as "Parties and Board Only") in PTAB E2E.

The joint motion to terminate and the settlement agreement shall be filed no later than July 6, 2018. Accordingly, it is

ORDERED that the parties are authorized to file a joint motion to terminate the proceeding;

FURTHER ORDERED that the joint motion is due no later than July 6, 2018;

FURTHER ORDERED that the joint motion shall be accompanied by a true copy of the settlement agreement as required by 37 C.F.R. § 42.74(b);

FURTHER ORDERED that the parties may request that the settlement agreement be treated as business confidential information as specified by 37 C.F.R. § 42.74(c); and

FURTHER ORDERED that any confidential settlement agreement must be filed electronically in accordance with the instructions provided on the Board's website (*e.g.*, uploading as "Parties and Board Only").

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For PETITIONER:

VINSON & ELKINS LLP

Stephen C. Stout  
Hilary L. Preston  
Rachael P. McClure  
sstout@velaw.com  
hpreston@velaw.com  
rmcclure@velaw.com

For PATENT OWNER:

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, LLP

Joshua L. Goldberg  
Erika H. Arner  
Daniel C. Tucker  
Cory Bell  
joshua.goldberg@finnegan.com  
erika.arner@finnegan.com  
daniel.tucker@finnegan.com  
cory.bell@finnegan.com