

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FACEBOOK, INC., INSTAGRAM, LLC, AND WHATSAPP INC.,
Petitioner,

v.

BLACKBERRY LIMITED,
Patent Owner.

Case IPR2019-00925
Patent 8,209,634 B2¹

Before MIRIAM L. QUINN, GREGG I. ANDERSON, and
ROBERT L. KINDER, *Administrative Patent Judges*.

QUINN, *Administrative Patent Judge*.

ORDER

Termination of Snap Inc. Due to Settlement After Institution of Trial
35 U.S.C. § 317; 37 C.F.R. § 42.74

¹ Snap Inc. filed a petition and a motion for joinder in IPR2019-00938, both of which have been granted. Therefore Snap Inc. has been joined as a petitioner to IPR2019-00935. Snap Inc., however, as detailed below, is being terminated as a party to this proceeding.

Joint Petitioner, Snap Inc. (“Snap”), and Patent Owner, Blackberry Limited (“Blackberry”), jointly move to terminate the instant *inter partes* review with respect to Snap in light of the settlement that resolves their dispute regarding U.S. Patent No. 8,209,634 B2. Paper 12. Snap and Blackberry also filed a true copy of their written settlement agreement in connection with the termination as required by 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b). Ex. 1126. Pursuant to 37 C.F.R. § 42.74(c), the parties further filed a joint request to treat the Settlement Agreement as business confidential information kept separate from the file of the involved patent. Paper 13.

For the reasons set forth below, the Joint Motion to Terminate with respect to Snap, and the Joint Request to File Settlement Agreement as Business Confidential Information are *granted*.

Under the Leahy-Smith America Invents Act, settlement between the parties to a proceeding is encouraged. Notably, 35 U.S.C. § 317(a), in part, provides the following (emphasis added):

(a) IN GENERAL.—An *inter partes* review instituted under this chapter shall be *terminated with respect to any petitioner upon the joint request of the petitioner and the patent owner*, unless the Office has decided the merits of the proceeding before the request for termination is filed. If the *inter partes* review is terminated with respect to a petitioner under this section, *no estoppel under section 315(e) shall attach to the petitioner*, or to the real party in interest or privy of the petitioner, on the basis of that petitioner’s institution of that *inter partes* review.

Here, although *inter partes* review has been instituted, the proceeding is ongoing with the remaining Petitioner entities: Facebook, Inc., Instagram, LLC, and Whatsapp Inc. Upon review of the procedural posture of this proceeding and the facts before us, we determine that it is appropriate to

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terminate this proceeding with respect Snap. The proceeding, however, will not be terminated with respect to the remaining Petitioner entities identified above and Blackberry.

In consideration of the foregoing, it is hereby:

ORDERED that the Joint Motion to Terminate, with respect to Snap, is *granted*;

FURTHER ORDERED that this review is terminated with respect to Snap only; but this review continues to proceed with Blackberry and remaining Petitioner;

FURTHER ORDERED that IPR2019-00938 is hereby terminated and closed;

FURTHER ORDERED that the Joint Request to File Settlement Agreement as Business Confidential Information and to keep such settlement agreement separate from the patent file, and to make it available only to Federal Government agencies on written request, or to any person on a showing of good cause, pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c), is *granted*.

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