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IPR2019-01303, Paper 11
IPR2019-01305, Paper 11
IPR2019-01357, Paper 12; IPR2019-01358, Paper 12
IPR2019-01447, Paper 12; IPR2019-01449, Paper 11
Date: January 23, 2020

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

DISH NETWORK CORPORATION, DISH NETWORK L.L.C., and
DISH NETWORK SERVICE L.L.C.,
Petitioner,

v.

WISTARIA TRADING LTD.,
Patent Owner.

IPR2019-01303 (Patent 8,739,295 B2)
IPR2019-01305 (Patent 9,934,408 B2)
IPR2019-01357, IPR2019-01358 (Patent 7,475,246 B1)
IPR2019-01447 (Patent 9,104,842 B2)
IPR2019-01449 (Patent 9,021,602 B2)¹

Before SALLY C. MEDLEY, DENISE M. POTHIER,
BART A. GERSTENBLITH, PATRICK M. BOUCHER, and
MONICA S. ULLAGADDI, *Administrative Patent Judges*.

GERSTENBLITH, *Administrative Patent Judge*.

DECISION
Settlement Prior to Institution of Trial
37 C.F.R. § 42.74

¹ We exercise our discretion to issue one combined Decision to be filed in each case. The listing of Judges includes those on each case. None of the panels have been expanded.

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I. DISCUSSION

In an e-mail dated January 22, 2020, we authorized the parties to file joint motions to terminate the instant proceedings, true copies of their settlement agreements, and joint motions to treat the filed copies of their agreements as business confidential information under 37 C.F.R. § 42.74(c). The following day, the parties filed Petitioner’s Joint Motion to Terminate Petition Pursuant to 35 U.S.C. § 317 and 37 C.F.R. § 42.74 (IPR2019-01303, Paper 9² (“Mot.”)), a copy of a written Settlement Agreement (Ex. 1031), and a Joint Request to Keep Separate Pursuant to 35 U.S.C. § 317 and 37 C.F.R. § 42.74 (Paper 10) in each proceeding.

The parties indicate that they have settled their underlying dispute and have agreed to terminate these proceedings. Mot. 2. The parties filed what they represent is a true and correct copy of their written Settlement Agreement as Exhibit 1031, and indicate that there are no other collateral agreements referred to in the Settlement Agreement, made in connection with, or in contemplation of, the termination of these proceedings. *Id.* at 4. The parties further indicate that they are moving to dismiss a related district court case between the parties involving the challenged patents. *Id.*

Generally, the Board expects that a proceeding will terminate after the filing of a settlement agreement. *See* 35 U.S.C. § 317(a) (“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,

² Citations are to IPR2019-01303 unless otherwise indicated.

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IPR2019-01449 (Patent 9,021,602 B2)

unless the Office has decided the merits of the proceeding before the request for termination is filed.”); 37 C.F.R. § 42.72 (“The Board may terminate a trial without rendering a final written decision, where appropriate, including . . . pursuant to a joint request under 35 U.S.C. 317(a)”); *see also* Patent Trial and Appeal Board Consolidated Trial Practice Guide at 86 (Nov. 2019) (“The Board expects that a proceeding will terminate after the filing of a settlement agreement, unless the Board has already decided the merits of the proceeding.” (citing 35 U.S.C. §§ 317(a), 327)). Here, a trial has not yet been instituted and the merits of the proceedings not yet decided. Accordingly, we are persuaded that, under these circumstances, termination of these proceedings is appropriate.

Additionally, we grant the parties’ Joint Request to Keep Separate. *See* 35 U.S.C. § 317(b) (“At the request of a party to the proceeding, the agreement or understanding shall be treated as business confidential information, shall be kept separate from the file of the involved patents, and shall be made available only to Federal Government agencies on written request, or to any person on a showing of good cause.”); *see also* 37 C.F.R. § 42.74(c) (same).

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

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IPR2019-01449 (Patent 9,021,602 B2)

II. ORDER

Accordingly, it is

ORDERED that Petitioner's Joint Motion to Terminate Petition Pursuant to 35 U.S.C. § 317 and 37 C.F.R. § 42.74 (IPR2019-01303, Paper 9; IPR2019-01305, Paper 9; IPR2019-01357, Paper 10; IPR2019-01358, Paper 10; IPR2019-01447, Paper 10; IPR2019-01449, Paper 9) is *granted*;

FURTHER ORDERED that the parties' Joint Request to Keep Separate Pursuant to 35 U.S.C. § 317 and 37 C.F.R. § 42.74 (IPR2019-01303, Paper 10; IPR2019-01305, Paper 10; IPR2019-01357, Paper 11; IPR2019-01358, Paper 11; IPR2019-01447, Paper 11; IPR2019-01449, Paper 10) is *granted*;

FURTHER ORDERED that the Settlement Agreement (IPR2019-01303, Ex. 1031; IPR2019-01305, Ex. 1029; IPR2019-01357, Ex. 1031; IPR2019-01358, Ex. 1030; IPR2019-01447, Ex. 1014; IPR2019-01449, Ex. 1016) be treated as business confidential information, kept separate from the file of the above-referenced patents, and made 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); and

FURTHER ORDERED that each of these proceedings is terminated.

IPR2019-01303 (Patent 8,739,295 B2)
IPR2019-01305 (Patent 9,934,408 B2)
IPR2019-01357, IPR2019-01358 (Patent 7,475,246 B1)
IPR2019-01447 (Patent 9,104,842 B2)
IPR2019-01449 (Patent 9,021,602 B2)

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