

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,
Petitioner,

v.

HAMMOND DEVELOPMENT INTERNATIONAL, INC.,
Patent Owner.

IPR2020-00214 (Patent 9,716,732), IPR2020-00298 (Patent 9,456,040),
IPR2020-00305 (Patent 9,716,732), IPR2020-00306 (Patent 10,193,935),
IPR2020-00411 (Patent 9,420,011), IPR2020-00412 (Patent 9,456,040),
IPR2020-00413 (Patent 10,193,935), IPR2020-00414 (Patent 9,705,937),
IPR2020-00415 (Patent 9,705,937)¹

Before MICHELLE N. WORMMEESTER, AMBER L. HAGY, and
KRISTIL R. SAWERT, *Administrative Patent Judges*.

HAGY, *Administrative Patent Judge*.

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

¹ We exercise our discretion to issue one order to be entered in each case.
The parties are not authorized to use a caption identifying multiple cases.

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I. INTRODUCTION

With the Board’s authorization, Petitioner and Patent Owner (collectively referred to as “the Parties”) filed Joint Motions to Terminate the above-identified proceedings due to settlement. Paper 20 (“Joint Motion”).² In support of the Joint Motions, the Parties filed a Confidential Covenant Not to Sue (Ex. 1023, “Covenant”) and Joint Stipulation of Partial Dismissal (Ex. 1024, “Stipulation”). The Parties further filed Joint Requests to Treat the Covenant as Business Confidential Information pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c). Paper 22 (“Joint Request”).

II. DISCUSSION

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 the patent owner, unless the Office has decided the merits of the proceeding before the request for termination is filed.” It is also provided in 35 U.S.C. § 317(a) that if no petitioner remains in the *inter partes* review, the Office may terminate the review.

In the Joint Motions, the Parties represent that they have reached an agreement jointly to seek termination of these *inter partes* review proceedings, and that the filed copies of the Covenant and Stipulation are true and complete copies. Joint Motion 1. The Parties further represent that the Covenant and Stipulation resolve all currently pending Patent Office and

² All citations are to IPR2020-00214 with the understanding that the other proceedings include papers having substantially the same substantive content.

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District Court proceedings between the Parties involving the above-referenced patents. *Id.* at 1–2.

We instituted trials on the above-identified proceedings. We have not yet decided the merits of the proceedings, however, and final written decisions have not been entered. Notwithstanding that the proceedings have moved beyond the preliminary stage, the Parties have shown adequately that the termination of the proceedings is appropriate. Under these circumstances, we determine that good cause exists to terminate the proceedings with respect to the Parties.

The Parties also filed Joint Requests that the Covenant be treated as business confidential information and be kept separate from the files of the respective patents involved in these *inter partes* proceedings. Paper 22, 1. After reviewing the Covenant between Petitioner and Patent Owner, we find that the Covenant contains confidential business information regarding the terms of settlement. We determine that good cause exists to treat the Covenant between Petitioner and Patent Owner as business confidential information pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

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

III. ORDER

Accordingly, for the reasons discussed above, it is:

ORDERED that the Joint Motions to Terminate are *granted*, and IPR2020-00214, IPR2020-00298, IPR2020-00305, IPR2020-00306, IPR2020-00411, IPR2020-00412, IPR2020-00413, IPR2020-00414, IPR2020-00415 are *terminated* with respect to Petitioner and Patent Owner

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pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. § 42.72; and

FURTHER ORDERED that the Joint Requests to Treat the Settlement Agreement as Business Confidential Information are *granted*, and the Covenant shall be kept separate from the files 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).

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