

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INTEL CORPORATION,
Petitioner,

v.

UNM RAINFOREST INNOVATIONS,
Patent Owner.

IPR2020-01576 (Patent 8,265,096 B2)
IPR2020-01578 (Patent 8,249,204 B2)¹

Before KRISTEN L. DROESCH, BARBARA A. PARVIS, and
CHARLES J. BOUDREAU, *Administrative Patent Judges*.

DROESCH, *Administrative Patent Judge*.

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

¹ This order is being filed in each proceeding listed in the caption. The parties, however, are not authorized to use this style of filing in subsequent papers, without prior authorization.

IPR2020-01576 (Patent 8,265,096 B2)

IPR2020-01578 (Patent 8,249,204 B2)

Pursuant to authorization by the Board, the parties filed in each above-identified proceeding the following: (1) a joint motion to terminate the proceeding (Paper 6, “Joint Motion to Terminate,” “Mot.”)²; (2) a true copy of the parties’ settlement agreement (IPR2020-001576 Ex. 1028, IPR2020-01578 Ex. 1021); and (3) a joint request that the settlement agreement be treated as business confidential information and to keep separate pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) (Paper 7, “Request”).

The parties contend that “[t]ermination of this proceeding is proper for at least the following reasons: The parties are jointly requesting termination. . . . The Board has not yet ‘decided the merits of the proceeding before the request for termination is filed.’ . . . Patent Owner has withdrawn the claims against accused products containing Intel Wi-Fi products in the District court” Mot. 2. The parties indicate “[t]he settlement agreement between the parties has been made in writing, and a true and correct copy will be filed with this request.” *Id.* at 6. The parties state that “[t]here are no other agreements, oral or written, between the parties made in connection with, or in contemplation of, the termination of this proceeding. *See id.* In addition, each of these proceedings is in an early stage. We have not yet determined whether a trial should be instituted in these proceedings.

Upon review of the facts before us and consideration of the early stage of these proceedings, we determine it is appropriate to terminate these IPR

² For the purpose of expediency, we refer to the papers filed in IPR2020-01576. Similar papers were filed in IPR2020-01578.

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proceedings. *See* 37 C.F.R. §§ 42.2, 42.72. In addition, we have reviewed the true copy of the parties' settlement agreement (IPR2020-01576 Ex. 1028, IPR2020-01578 Ex. 1021) and determine that good cause exists to treat the settlement agreement as business confidential information and to keep it separate from the files of Patent 8,265,096 and Patent 8,249,204 pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

ORDER

In consideration of the foregoing, it is hereby:

ORDERED that the Request (Paper 7) to treat the settlement agreement (IPR2020-01576 Ex. 1028, IPR2020-01578 Ex. 1021) as business confidential information and to keep it separate from the files of the involved patents pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) is *granted*;

FURTHER ORDERED that the settlement agreement (IPR2020-01576 Ex. 1028, IPR2020-01578 Ex. 1021) accordingly shall be treated as business confidential information, kept separate from the files of the involved patents, and made available only to Federal Government agencies on written request to the Board, or to any person on a showing of good cause, under the provisions of 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c); and

FURTHER ORDERED that the Joint Motion to Terminate (Paper 6) is *granted*, and the proceedings in IPR2020-01576 and IPR2020-01578 are terminated.

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