

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,
Petitioner,

v.

RFCYBER CORP.,
Patent Owner.

IPR2021-00954 (Patent 8,448,855 B1)
IPR2021-00955 (Patent 9,189,787 B1)
IPR2021-00956 (Patent 9,240,009 B2)
IPR2021-00957 (Patent 8,118,218 B2)¹

Before PATRICK R. SCANLON, KEVIN W. CHERRY, and
KRISTI L. R. SAWERT, *Administrative Patent Judges*.

SAWERT, *Administrative Patent Judge*.

DECISION

Granting Joint Motion to Terminate Due to Settlement Prior to Institution
35 U.S.C. § 317; 37 C.F.R. §§ 42.71(a), 42.74

¹ We exercise our discretion to issue a single Decision to be entered in each case using a joint caption. The parties are not permitted to use this caption. For convenience, we use the Paper and Exhibit numbers from IPR2021-00954.

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On October 19, 2021, Google LLC (“Petitioner”) and RFCyber Corp. (“Patent Owner”) filed a joint motion to terminate these proceedings pursuant to 35 U.S.C. § 317 and 37 C.F.R. § 42.74. Paper 10 (“Motion” or “Mot.”). The motion was accompanied by a true, unredacted copy of a settlement and license agreement (Ex. 1040), and a joint request to treat the agreement as business confidential information, to be kept separate from the patent file, pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) (Paper 11).

The parties represent in their joint motion that they have settled their dispute regarding the patents challenged in these *inter partes* review proceedings, and have agreed to terminate these proceedings. Mot. 2. The parties state that there are no other Board proceedings between the parties involving the challenged patents. *Id.* Additionally, the parties state that they have settled their dispute in the related district court litigation, *RF Cyber Corp. v. Google LLC and Google Payment Corp.*, Case No. 2:20-cv-00274-JRG (E.D. Tex.), and “do not anticipate further litigation between them concerning the” challenged patents. *Id.*

The Board generally expects that a case “will terminate after the filing of a settlement agreement, unless the Board has already decided the merits.” Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,768 (Aug. 14, 2012); see also 37 C.F.R. § 42.72. These proceedings are in a preliminary stage, and no decisions on whether to institute any trial have been issued. Under the circumstances presented here, we determine that it is appropriate to dismiss the petitions and terminate these preliminary proceedings with

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respect to both Petitioner and Patent Owner. Accordingly, we grant the parties' joint motion to terminate.

We also determine that the parties have complied with the requirements of 37 C.F.R. § 42.74(c) to have the settlement and license agreement treated as business confidential information and kept separate from the patent files of the challenged patents. Thus, we grant the joint request to treat the settlement and license agreement as business confidential.

Accordingly, it is

ORDERED that the joint motion to terminate is GRANTED;

FURTHER ORDERED that Google LLC's petitions for *Inter Partes* Review of U.S. Patent Nos. 8,448,855 B1, 9,189,787 B1, 9,240,009 B2, and 8,118,218 B2 are DISMISSED, pursuant to 37 C.F.R. §§ 42.5(a) and 42.71(a); and

FURTHER ORDERED that the joint request to treat the parties' settlement and license agreement as business confidential information, to be kept separate from the patent file, is GRANTED.

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