

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SERVICENOW, INC.,
Petitioner,

v.

BMC SOFTWARE, INC.,
Patent Owner.

Case IPR2015-01176 (Patent 5,978,594)
Case IPR2015-01211 (Patent 7,617,073 B2)
Case IPR2015-01631 (Patent 8,674,992 B2)
Case CBM2015-00170 (Patent 8,646,093 B2)

Before JUSTIN T. ARBES, BRIAN P. MURPHY, and
JOHN A. HUDALLA, *Administrative Patent Judges*.

HUDALLA, *Administrative Patent Judge*.

ORDER
Termination of the Proceedings
37 C.F.R. § 42.72

IPR2015-01176 (Patent 5,978,594)
IPR2015-01211 (Patent 7,617,073 B2)
IPR2015-01631 (Patent 8,674,992 B2)
CBM2015-00170 (Patent 8,646,093 B2)

On April 26, 2016, the parties filed, in each of the instant proceedings, a joint motion to terminate the proceeding on the basis of a settlement reached by the parties. *See* 35 U.S.C. § 317(a); 35 U.S.C. § 327(a); 37 C.F.R. § 42.72. The parties also filed a copy of their written settlement agreement and included in each motion a request that the settlement agreement be treated as business confidential information under 35 U.S.C. § 317(b), 35 U.S.C. § 327(b), and 37 C.F.R. § 42.74(c).¹

The parties' joint motions to terminate were filed prior to the oral hearings in these cases, and the Board has not made a final decision on the merits in any of the proceedings. *See* 35 U.S.C. § 317(a); 35 U.S.C. § 327(a). The parties represent that they "agreed to settle their respective claims against each other" in two related district court cases and in a related German case, and that they "have now moved to dismiss all previously pending matters between them." Paper 19, 2–3. The parties further represent that "there is no other litigation involving the challenged patent[s]." *Id.* at 3. Given these facts, we determine that it is appropriate to terminate the proceedings, without rendering a final written decision, under 37 C.F.R. § 42.72. The oral hearings in all of the instant proceedings are canceled.

¹ *See* Case IPR2015-01176, Paper 19, Ex. 2025; Case IPR2015-01211, Paper 20, Ex. 2006; Case IPR2015-01631, Paper 17, Ex. 2005; Case CBM2015-00170, Paper 12, Ex. 2004. Because the papers are nearly identical in each proceeding, we will refer to those filed in Case IPR2015-01176 for convenience. We authorized the joint motions to terminate in an email dated April 15, 2016.

IPR2015 01176 (Patent 5,978,594)
IPR2015-01211 (Patent 7,617,073 B2)
IPR2015-01631 (Patent 8,674,992 B2)
CBM2015-00170 (Patent 8,646,093 B2)

“At the request of a party to the proceeding, the [settlement] 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.” 35 U.S.C. §§ 317(b), 327(b). After reviewing the parties’ settlement agreement, we find that the settlement agreement contains confidential business information regarding the terms of settlement. We determine that good cause exists to treat the settlement agreement as business confidential information pursuant to 35 U.S.C. §§ 317(b) and 327(b).

In consideration of the foregoing, it is hereby:

ORDERED that the parties’ joint request to treat their settlement agreement (Case IPR2015-01176, Ex. 2025; Case IPR2015-01211, Ex. 2006; Case IPR2015-01631, Ex. 2005; Case CBM2015-00170, Ex. 2004) as business confidential information under 35 U.S.C. § 317(b), 35 U.S.C. § 327(b), and 37 C.F.R. § 42.74(c) and to continue its designation as “Board Only” in PRPS is *granted*;

FURTHER ORDERED that the parties’ settlement agreement be kept separate from the files of U.S. Patent No. 5,978,594, U.S. Patent No. 7,617,073 B2, U.S. Patent No. 8,674,992 B2, and U.S. Patent No. 8,646,093 B2, and made available only to Federal Government agencies on written request, or to any person on a showing of good cause; and

FURTHER ORDERED that the joint motions to terminate the instant proceedings are *granted* and the proceedings are hereby *terminated*.

IPR2015-01176 (Patent 5,978,594)
IPR2015-01211 (Patent 7,617,073 B2)
IPR2015-01631 (Patent 8,674,992 B2)
CBM2015-00170 (Patent 8,646,093 B2)

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