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Paper 10
Entered: June 17, 2015

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CHUMS, INC., and CROAKIES, INC.,
Petitioner,

v.

CABLZ, INC.,
Patent Owner.

Case IPR2015-00602
Patent 8,366,268 B2

Before JOSIAH C. COCKS, JEREMY M. PLENZLER, and KRISTINA M. KALAN, *Administrative Patent Judges.*

KALAN, *Administrative Patent Judge.*

TERMINATION
Dismissing the Proceeding
37 C.F.R. § 42.5(a), 37 C.F.R. § 42.71(a)

The parties have requested that the above-captioned proceeding be terminated. The Board authorized the parties to file a joint motion to terminate the above-captioned proceeding on June 5, 2015. The authorization included the instruction that the joint motion "must include a true copy of any agreement or understanding and include a statement certifying that there are no collateral agreements or understandings made in connection with, or in contemplation of, the termination of the *inter partes* review."

On June 15, 2015, the parties filed a "Joint Motion to Terminate Proceedings Pursuant to 35 U.S.C. § 317" in the above-captioned proceeding. Paper 8. The joint motion to terminate indicates that "[n]o agreements or understandings and no collateral agreements or understandings have been made between the parties in connection with, or in contemplation of, the termination of this proceeding." *Id.* at 1.

This case is in the preliminary proceeding stage. A preliminary proceeding begins with the filing of a petition for instituting a trial and ends with a written decision as to whether trial will be instituted. *See* 37 C.F.R. § 42.2. Petitioner filed its Petition on January 22, 2015. Patent Owner filed a Preliminary Response on May 12, 2015. A decision on institution, which has not yet been made, is due on or before August 12, 2015.

The motion states that Petitioner and Patent Owner jointly request termination of IPR2015-00602. Paper 8, 1. The parties represent that the related matters identified in the petition, namely, *Cablz, Inc. v. Chums, Inc.*, 2:14-cv-00091-SLB (N.D. Ala.) and *Cablz, Inc. v. Croakies, Inc.*, 2:14-cv-00126-SGC (N.D. Ala.) remain stayed pending the outcome of IPR2014-01240, also involving U.S. Patent No. 8,366,268 B2 ("the '268 patent"),

which is ongoing. *Id.* The parties also represent that no further litigation or proceedings involving the '268 patent are contemplated in the foreseeable future. *Id.*

Under 37 C.F.R. § 42.74(b), "[a]ny agreement or understanding between the parties made in connection with, or in contemplation of, the termination of a proceeding shall be in writing and a true copy shall be filed with the Board before the termination of the trial." The parties clearly and jointly indicate that no agreements, understandings, collateral agreements, or collateral understandings have been made between the parties in connection with or in contemplation of the termination of this proceeding. Paper 8, 1. Given the lack of ambiguity of the foregoing, and the parties' statement that there is no settlement agreement between them (Paper 9, 3–4), we construe the parties' representations as a certification that there are no other written or oral agreements or understandings, including any collateral agreements, between them in connection with or in contemplation of the termination of this proceeding. *See, e.g.*, Case No. IPR2015-00651, slip op. at 1–2 (PTAB June 1, 2015) (Paper 11); Case No. CBM2014-00090, slip op. at 2–3 (PTAB August 12, 2014) (Paper 10).

Based on the facts of the case, and in view of the parties' joint request for termination of this proceeding, we determine that it is appropriate to dismiss the petition as to both Petitioner and Patent Owner without rendering either a decision to institute or a final written decision. *See* 37 C.F.R. §§ 42.5(a); 42.71(a). Therefore, the joint motion to terminate is *granted*. This paper does not constitute a final written decision pursuant to 35 U.S.C. § 318(a).

Accordingly, it is

ORDERED that the joint motion to terminate the proceeding is *granted*; and

FURTHER ORDERED that the Petition for *Inter Partes* Review of the above-referenced patent is *dismissed*.

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