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Paper No. 11
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD. and
SAMSUNG ELECTRONICS AMERICA, INC.,
Petitioner,

v.

TIVO INC.
Patent Owner.

Case IPR2016-01524 Patent 6,233,389
Case IPR2016-01552 Patent 7,558,472
Case IPR2016-01553 Patent 7,558,472
Case IPR2016-01554 Patent 8,457,476
Case IPR2016-01555 Patent 8,457,476
Case IPR2016-01712 Patent 6,233,389

Before JENNIFER S. BISK, GEORGIANNA W. BRADEN, and CARL L. SILVERMAN, *Administrative Patent Judges.*

SILVERMAN, Administrative Patent Judge

ORDER
Termination of the Proceeding
37 C.F.R. §§ 42.5, 42.71(a), 42.74(c)

On January 5, 2017, with Board authorization, the parties filed a joint motion to terminate the proceeding, notice of settlement, and joint request to treat the settlement agreement as business confidential (Papers 8, 9), along with what they indicate is their written settlement agreement (Paper 10).

On November 9, 2016, the parties referred to "Pending settlement in IPR2016-01524, IPR 2016-01552, IPR 2016-01553, IPR 2016-01554, and IPR 2016-01555" and stated:

> The Parties have reached an agreement in principle to resolve their disputes, including settlement of all matters in controversy between the Parties related thereto. The Parties are now working on detailed written agreements that implement the terms of this agreement. *See* Paper 6.

The parties state the above-identified IPR petitions are related to a lawsuit filed in the Eastern District of Texas (*TiVo Inc. v. Samsung Electronics Co.*, LTD., et al., Civil Action No. 2:15-cv- 01503). Paper 8. On January 4, 2017, the parties filed a Stipulation of Dismissal of the lawsuit. *Id.* All parties involved in the litigation are as follows: TIVO INC., SAMSUNG ELECTRONICS CO., LTD., and SAMSUNG ELECTRONICS AMERICA, INC. *Id.*

The joint request to treat the settlement agreement as business confidential information includes a request that the settlement agreement be kept separate from the patent file. Paper 9; *see also* 37 C.F.R. § 42.74(c) ("A party to a settlement may request that the settlement be

treated as business confidential information and be kept separate from the files of an involved patent or application.").

The parties state good cause exists to dismiss the Petition and terminate the above-identified IPR Petitions. Paper 8. In addition to being unopposed, the parties state: no Preliminary Response has been filed and the Board has not issued a decision on institution; dismissal will preserve the Board's resources and the parties' resources while also epitomizing the Patent Office's policy of "secur[ing] the just, speedy, and inexpensive resolution"; and this is a just and fair resolution. *Id.*

We agree that this proceeding is at an early stage. The Patent Owner, TIVO INC., has not filed a preliminary response, and the Board has not issued a decision on whether to institute trial. Based on the facts of this case, it is appropriate to dismiss the Petition for *Inter Partes* Review. Therefore, the joint motion to terminate the proceeding and the joint request to treat the settlement agreement as business confidential information are granted. As requested by the parties, the settlement agreement will be treated as business confidential information and kept separate from the patent file. 37 C.F.R. § 42.74(c). 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 above-captioned proceedings is granted;

FURTHER ORDERED that the proceedings in IPR2016-01524, IPR2016-01552, IPR2016-01553, IPR2016-01554, IPR2016-01555, and IPR2016-01712 are terminated pursuant to 37 C.F.R. §§ 42.5, .71; and

FURTHER ORDERED that the parties' joint request that the settlement agreement (Paper 10) be treated as business confidential information, be kept separate from the file of each involved patent, and made available only to Federal Government agencies on written request, or to any person on a showing of good cause, under 37 C.F.R. § 42.74(c) is granted.

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Case IPR2016-01554 Patent 8,457,476
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Case IPR2016-01712 Patent 6,233,389

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