

Filed on behalf of Petitioners Cinmar, LLC and Frontgate Marketing, Inc. and  
Patent Owner Richell USA, Inc.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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CINMAR, LLC and  
FRONTGATE MARKETING, INC.,  
Petitioners

v.

RICHELL USA, INC.,  
Patent Owner

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Case No. IPR2020-00210  
Patent No. 7,568,449

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**JOINT MOTION TO TERMINATE THE PROCEEDING PURSUANT TO  
35 U.S.C. § 317 AND 37 C.F.R. § 42.72 AND  
JOINT REQUEST TO KEEP PAPERS SEPARATE AS BUSINESS  
CONFIDENTIAL INFORMATION**

Pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. § 42.72, Petitioners Cinmar, LLC and Frontgate Marketing, Inc. and Patent Owner Richell USA, Inc. (collectively, the “Parties”) jointly request termination of *Inter Partes* Review No. IPR2020-00210.

The Parties have settled all of their disputes involving U.S. Patent No. 7,568,449. More specifically, the Parties have agreed to settle and dismiss the related district-court litigation, *Richell USA, Inc. v. Cinmar, LLC and Frontgate Marketing, Inc.*, Case No. 4:18-cv-00847-ALM (E.D. Tex.).

Pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b), the Parties’ settlement agreement made in connection with, or in contemplation of, the termination of the proceeding is in writing, and a true and correct copy of the settlement document is being filed herewith as Exhibit 1028. No other such agreements, written or oral, exist among the Parties.

The Parties hereby jointly request that the settlement agreement be treated as business confidential information and be kept separate from the files of the above-captioned *inter partes* review pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

## **I. BACKGROUND**

On December 4, 2019, Petitioners Cinmar, LLC and Frontgate Marketing, Inc. filed a Petition for *inter partes* review of claims 1-3, 5-19, 20-21, and 24-36 of

U.S. Patent No. 7,568,449 (the “’449 patent”). *See* IPR2020-00210, Paper 1 (“Pet.”). On March 10, 2020, the Parties agreed to settle all of their disputes involving the ’449 patent. As the Parties agreed to settle their disputes involving the ’449 patent, Patent Owner did not submit a preliminary response. The Board has not decided whether to institute *inter partes* review. Accordingly, this proceeding is in its early stages.

On March 10, 2020, the Parties informed the Board of the settlement via email and requested authorization to file a joint motion to terminate the proceeding and to request to treat the settlement agreement as business confidential information. The Board authorized the Parties to file the joint motion to terminate by email on March 11, 2020.

## **II. TERMINATION AS TO PETITIONERS AND PATENT OWNER IS APPROPRIATE**

Termination of this *inter partes* review is appropriate, as the Board has not yet “decided the merits of the proceeding.” Furthermore, the Board has not decided whether to institute *inter partes* review. Neither a response or a reply has been filed, and the Parties have not engaged in discovery in this proceeding.

No dispute remains between Patent Owner and the Petitioners involving the ’449 patent, as the Parties have agreed to jointly request termination of this

proceeding and have stipulated to dismiss the district-court litigation with prejudice.

**III. REQUEST TO TREAT SETTLEMENT AGREEMENT AS BUSINESS CONFIDENTIAL INFORMATION**

Petitioners and Patent Owner hereby request that the settlement agreement filed herewith as Exhibit 1028 be treated as business confidential information, be kept separate from the file of the above-captioned *inter partes* review, and be made available only to Federal Government agencies on written request, or to any person on a showing of good cause pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c). In view of that request, the settlement agreement has been filed for access by the “Parties and Board Only.”

**IV. CONCLUSION**

For the foregoing reasons, Petitioners and Patent Owner jointly move that the Board terminate this *inter partes* review proceeding and request to treat the settlement agreement filed herewith as business confidential information and keep the agreement separate from the file of the above-captioned *inter partes* review.

Respectfully submitted,

Date: March 13, 2020

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**CERTIFICATE OF SERVICE**

The undersigned hereby certifies that the above-captioned Joint Motion to Terminate and Joint Request to Keep Papers Separate as Business Confidential Information was served on March 13, 2020 by filing this document through the Patent Trial and Appeal Board's E2E system and electronically via email to counsel of record for Patent Owner.

Dated: March 13, 2020

/Kevin P. Flynn/  
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