

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ACTIV FINANCIAL SYSTEMS, INC.,
Petitioner,

v.

IP RESERVOIR, LLC,
Patent Owner.

IPR2020-01006
Patent 10,121,196 B2

IPR2020-01010
Patent 10,062,115 B2

IPR2020-01013
Patent 9,047,243 B2

IPR2020-01014
Patent 7,921,046 B2

Before JAMES A. WORTH, SCOTT C. MOORE,
RICHARD H. MARSCHALL, and MICHAEL T. CYGAN,
Administrative Patent Judges.

MARSCHALL, *Administrative Patent Judge.*

TERMINATION
Due to Settlement After Institution of Trial
35 U.S.C. § 317; 37 C.F.R. § 42.74

IPR2020-01006, Patent 10,121,196 B2
IPR2020-01010, Patent 10,062,115 B2
IPR2020-01013, Patent 9,047,243 B2
IPR2020-01014, Patent 7,921,046 B2

With the Board’s authorization, Petitioner Activ Financial Systems, Inc. and Patent Owner IP Reservoir, LLC (collectively “the Parties”) filed a Joint Request for Termination Pursuant to 35 U.S.C. § 317(a) in the above proceedings. Paper 21¹ (“Request for Termination”). The Parties also filed a corresponding Confidential Settlement Agreement, Ex. 2101 (“Settlement Agreements”), as well as a corresponding Joint Request to Treat Settlement Information as Business Confidential Information Pursuant to 35 U.S.C. § 317(b). Paper 22 (“Request for Confidentiality”).

DISCUSSION

In the Request for Termination, the Parties represent that they “have settled their disputes and agreed to voluntary dismissal of the pending related district court litigation between the Parties regarding the patent-at-issue.” Request for Termination 3. In addition, the Parties state that termination is proper because (1) the Board has not yet decided the merits in this proceeding; (2) the Parties are jointly requesting termination; and (3) “all pending proceedings . . . will end” and “[n]o litigation or proceeding involving the challenged patent is contemplated between the Parties.” *Id.* at 2–3. The Parties also represent that the Settlement Agreement “resolves their disputes.” *Id.* at 2. The Parties further represent that the Settlement Agreement is a true copy of the settlement agreement between the parties. *Id.* at 3. The Parties jointly certify that there are no collateral agreements or understandings made in connection with, or in contemplation of, the termination of the IPR proceeding. *Id.*

¹ We cite to the filings in IPR2020-01006. The Parties filed similar papers in the other proceedings.

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Under 35 U.S.C. § 317(a), “[a]n inter partes review instituted under this chapter shall be terminated with respect to any petitioner upon the joint request of the petitioner and patent owner, unless the Office has decided the merits of the proceeding before the request for termination is filed.”

Because we have not yet decided the merits of the proceeding, and based upon the Parties’ representations, we determine that good cause exists to terminate the proceeding.

In the Request for Confidentiality, the Parties request that the Settlement Agreement be treated as business confidential information and be “kept separate from the files of the involved patent and *inter partes* review proceeding.” Request for Confidentiality 2. After reviewing the 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 37 C.F.R. § 42.74(c).

This Order does not constitute a final written decision pursuant to 35 U.S.C. § 318(a).

ORDER

In consideration of the foregoing, it is hereby

ORDERED that the Joint Request for Termination Pursuant to 35 U.S.C. § 317(a) is granted, and the above-identified proceedings are terminated; and

FURTHER ORDERED that the Joint Request to Treat Settlement Information as Business Confidential Information Pursuant to 35 U.S.C.

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§ 317(b) is granted, and the Settlement Agreement (Ex. 2101) shall be kept separate from the file of the corresponding patents involved in these proceedings and made available only to Federal Government agencies on written request, or to any person on a showing of good cause, pursuant to 37 C.F.R. § 42.74(c).

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