

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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GOOGLE LLC,  
Petitioner,

v.

VOIP-PAL.COM, INC.,  
Patent Owner.

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IPR2023-00647 (Patent 8,630,234 B2)  
IPR2023-00648 (Patent 8,630,234 B2)  
IPR2023-00649 (Patent 10,880,721 B2)  
IPR2023-00650 (Patent 10,880,721 B2)<sup>1</sup>

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Before MITCHELL G. WEATHERLY, TERRENCE W. McMILLIN, and  
CHRISTOPHER L. OGDEN, *Administrative Patent Judges*.

PER CURIAM.

DECISION  
Settlement Prior to Institution of Trial  
*37 C.F.R. § 42.74*

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<sup>1</sup> The parties may not use a combined-case caption, unless given permission to do so.

IPR2023-00647 (Patent 8,630,234 B2)  
IPR2023-00648 (Patent 8,630,234 B2)  
IPR2023-00649 (Patent 10,880,721 B2)  
IPR2023-00650 (Patent 10,880,721 B2)

On June 12, 2023, with Board authorization on June 8, 2023, the parties filed a “Joint Motion to Terminate” the petition in each of these proceedings. Paper 12<sup>2</sup> (“Mot.”). Along with the Motion, the parties filed a “true and correct copy of the parties’ settlement agreement,” which describes itself as “the complete, final and exclusive embodiment of the entire agreement between the Parties with regard to the subject matter herein.” Mot. 2; Ex. 1032 § XIII.1. The parties assert they “have settled their dispute regarding U.S. Patent Nos. 8,630,234 and 10,880,721, including both this proceeding and Patent Owner’s assertion of U.S. Patent Nos. 8,630,234 and 10,880,721 in the related district court litigations,” and request that the Board terminate the four *inter partes* reviews. Mot. 1–2.

The parties also filed a Joint Motion to treat their agreements as business confidential information, and to maintain said agreements separate from the public file under 37 C.F.R. § 42.74(c). Paper 13.

## I. DISCUSSION

On February 28, 2023, Petitioner filed Petitions requesting *inter partes* review of several claims of U.S. Patent No. 8,630,234 B2 (Ex. 1001) and U.S. Patent No. 10,880,721 B2. Paper 1; Mot. 1. These proceedings are at an early stage, and we have not yet decided whether to institute trials in the proceedings. In view of the early stage of the proceedings, and the settlement between the Parties, we determine that good cause exists to dismiss the petitions and terminate the proceedings with respect to the

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<sup>2</sup> We refer to papers and exhibits in IPR2023-00647. Similar documents were filed in IPR2023-00648, IPR2023-00649, and IPR2023-00650.

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Parties.

After reviewing the Settlement Agreement between Petitioner and Patent Owner, 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 between Petitioner and Patent Owner as business confidential information pursuant to 37 C.F.R. § 42.74(c).

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

## II. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that the parties' Joint Request (Paper 13) to treat the Settlement Agreement (Exhibit 1032 in all four cases) as business confidential information under 37 C.F.R. § 42.74(c) is *granted*, and the Settlement Agreement shall be kept separate from the files of Patents 8,630,234 and 10,880,712, and 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. § 327(b) and 37 C.F.R. § 42.74(c); and

FURTHER ORDERED that the parties' Joint Motion to Dismiss (Paper 12) is *granted*, the Petitions in IPR2023-00647, IPR2023-00648, IPR2023-00649, and IPR2023-00650 are dismissed, and the proceedings are *terminated* with respect to Petitioner and Patent Owner, pursuant to 37 C.F.R. § 42.72.

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PETITIONER:

Naveen Modi  
Joseph E. Palys  
Daniel Zeilberger  
PAUL HASTINGS LLP  
naveenmodi@paulhastings.com  
josephpalys@paulhastings.com  
danielzeilberger@paulhastings.com  
Google-VoIP-Pal-IPR@paulhastings.com

FOR PATENT OWNER:

Lewis E. Hudnell, III  
Nicolas S. Gikkas  
Hudnell Law Group P.C.  
lewis@hudnelllaw.com  
nick@hudnelllaw.com