

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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NU MARK LLC,  
Petitioner,

v.

FONTEM HOLDINGS 1 B.V.,  
Patent Owner.

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Case IPR2016-01299  
Patent 8,393,331 B2

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Before BRIAN J. McNAMARA, JEREMY M. PLENZLER, and  
JO-ANNE M. KOKOSKI, *Administrative Patent Judges*.

KOKOSKI, *Administrative Patent Judge*.

ORDER  
Termination of the Proceeding  
*35 U.S.C. § 317(a) and 37 C.F.R. § 42.72*

On January 3, 2017, with Board authorization, the parties filed a joint motion to terminate this proceeding (Paper 13), along with what they indicate is a true copy of their written settlement agreement (Ex. 2101). The parties indicate in their joint motion that they have “reached a settlement agreement resolving all disputes between them” involving U.S. Patent No. 8,393,331 B2 (“the ’331 patent”). Paper 13, 1. On the same day, the parties also filed a joint motion requesting that the settlement agreement be treated as business confidential information and kept separate from the file of the ’331 patent. Paper 14.

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.” We instituted a trial in this proceeding as to claims 1, 2, 4, and 5 of the ’331 patent (Paper 11) on December 14, 2016, but we have not yet decided the merits of the proceeding.

Further, 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 have filed what they indicate is a true copy of their written settlement agreement, which they represent constitutes the entire agreement between the parties with respect to this *inter partes* review. Paper 13, 1. In view of the foregoing reasons, we determine that it is appropriate to terminate this proceeding without rendering a final written decision as to the

IPR2016-01299  
Patent 8,393,331 B2

patentability of claims 1, 2, 4, and 5 of the '331 patent. *See* 37 C.F.R. §§ 42.72, 42.74.

As requested by the parties, the settlement agreement will be treated as business confidential information and kept separate from the file of the '331 patent. 37 C.F.R. § 42.74(c).

Accordingly, it is

ORDERED that the joint motion to terminate the proceeding (Paper 13) is *granted*;

FURTHER ORDERED that the parties' joint request that the settlement agreement (Ex. 2101) be treated as business confidential information (Paper 14) is *granted*; and

FURTHER ORDERED that this proceeding is hereby *terminated*.

PETITIONER:

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