

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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HARLAND CLARKE CORP.  
Petitioner,

v.

EZSHIELD, INC.  
Patent Owner.

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Case CBM2013-00016  
Patent 8,346,637

Before JAMESON LEE, JONI Y. CHANG, and MICHAEL R. ZECHER,  
*Administrative Patent Judges.*

CHANG, *Administrative Patent Judge.*

ORDER  
Conduct of the Proceeding  
*37 C.F.R. § 42.5*

On September 27, 2013, a telephone conference call was held between respective counsel for the parties and Judges Lee, Chang, and Zecher.

The parties requested a delay or suspension of the issuance of a decision on whether to institute *inter partes* review for at least some time during which the parties can arrive at a settlement agreement. As explained by the Board during the conference call, the Board is required, under 35 U.S.C. § 324(c), to determine whether to institute a review within 3 months from the filing of the preliminary response (July 30, 2013). In other words, the Board will issue a decision on the petition before or on October 30, 2013. A covered business method review proceeding is conducted in accordance with the rules in Part 42 of Title 37, Code of Federal Regulations, which are construed to secure the just, *speedy*, and inexpensive resolution of every proceeding. 37 C.F.R. § 42.1(b).

Accordingly, the parties' joint request to delay or suspend the issuance of a decision on the petition until October 30, 2013 is *denied*.

The parties sought authorization to file a joint motion to terminate the instant proceeding on the basis that the parties have reached a stand-still agreement in connection with the instant proceeding and two related district court litigations. The parties indicated that they have been in the process of negotiating a definitive settlement agreement.

The Board authorized the parties to file a joint motion to terminate the instant proceeding. Such a joint motion must be accompanied by *a true copy of the parties' settlement agreement in connection with the termination of this proceeding*, as required by 35 U.S.C. § 327(b) and 37 C.F.R. § 42.74(b). A stand-still agreement generally will not be sufficient. The

joint motion to terminate also must include a brief explanation as to why termination is appropriate.

With respect to having the settlement agreement treated as business confidential information under 37 C.F.R. § 42.74(c), the parties must file the confidential settlement agreement electronically in the Patent Review Processing System (“PRPS”) as an exhibit in accordance with the instructions provided on the Board’s website (uploading as “Parties and Board Only”). The parties are directed to FAQ G2 on the Board’s website at <http://www.uspto.gov/ip/boards/bpai/prps.jsp> for instructions on how to file their settlement agreement as confidential.

Accordingly, it is

ORDERED that the parties are authorized to file a joint motion to terminate this proceeding; the due date for the joint motion is October 4, 2013;

FURTHER ORDERED that the joint motion must be accompanied by a true copy of the parties’ settlement agreement in connection with the termination of this proceeding, as required by 35 U.S.C. § 327(b) and 37 C.F.R. § 42.74(b);

FURTHER ORDERED that the parties may file a separate paper requesting that the settlement agreement be treated as business confidential information as specified in 37 C.F.R. § 42.74(c); and

FURTHER ORDERED that any confidential settlement agreement must be filed, as an exhibit, electronically in PRPS in accordance with the instructions provided on the Board’s website (uploading as “Parties and Board Only”).

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