

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
SAMSUNG ELECTRONICS LTD, and
SAMSUNG ELECTRONICS AMERICA, INC.,
Petitioner,

v.

E-WATCH, INC.,
Patent Owner.

Case IPR2015-00414¹
Patent 7,643,168 B2

Before JAMESON LEE, GREGG I. ANDERSON, and
MATTHEW R. CLEMENTS, *Administrative Patent Judges*.

ANDERSON, *Administrative Patent Judge*.

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

¹ Case IPR2015-00611 has been joined to this proceeding.

The parties sought authorization to file a joint motion to terminate this proceeding as to Petitioners, Samsung Electronics Ltd. and Samsung Electronics America, Inc. (collectively, “Samsung”), on the basis that those entities have settled with Patent Owner, e-Watch, Inc. (“e-Watch”). Samsung and e-Watch also sought authorization to file a request to have the settlement agreement be treated as business confidential information under 37 C.F.R. § 42.74(c). We are advised that Petitioner Apple Inc. has no objection.

Generally, the Board expects that a proceeding will terminate after the filing of a settlement agreement. *See, e.g.*, Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,768 (Aug. 14, 2012). Any 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 of the agreement shall be filed with the Board prior to termination. 37 C.F.R. § 42.74(b).

The filing of a joint motion to terminate this proceeding as to Samsung is authorized. The joint motion must specifically discuss the current status of related litigation between e-Watch, Inc., and Samsung, such as *e-Watch, Inc. v. Samsung Electronics Co. Ltd. and Samsung Telecommunications America, Inc.*, 2:13-cv-01062 (E.D. Tex.), with respect to each party to that litigation.

The joint motion to terminate as to Samsung must be accompanied by a true copy of the settlement agreement in connection with the termination of that proceeding, as required by 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b). A redacted version of the settlement agreement is not a true copy of the settlement agreement. Counsel for the parties indicated that they intend to file a confidential true copy of the settlement agreement. The

parties must file the true copy of the settlement agreement electronically via the Patent Review Processing System (PRPS) 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 page at <http://www.uspto.gov/ip/boards/bpai/prps.jsp> for instructions on how to file their settlement agreement as confidential.

ORDER

Accordingly, it is

ORDERED that the parties are authorized to file a joint motion to terminate this proceeding as to Samsung on the basis that Patent Owner has settled with Samsung;

FURTHER ORDERED that the joint motion must be accompanied by a true copy, labeled as an exhibit, of the settlement agreement as required by 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b);

FURTHER ORDERED that in the joint motion the parties may request that the settlement agreement be treated as business confidential and kept separate from the underlying patent file, as provided in 37 C.F.R. § 42.74(c); and

FURTHER ORDERED that the confidential settlement agreement must be filed electronically via PRPS in accordance with the instructions provided on the Board's website (uploading as "Parties and Board Only").

IPR2015-00414
Patent 7,643,168 B2

For PETITIONER:

Brian Buroker
BBuroker@gibsondunn.com

Blair Silver
bsilver@gibsondunn.com

For PATENT OWNER:

Robert C. Curfiss
bob@curfiss.com

Ryan Schultz
rmschultz@rkmc.com

Thomas DeSimone
trdesimone@rkmc.com