

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
Case IPR2015-00611
Patent 7,643,168 B2

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

ANDERSON, *Administrative Patent Judge*.

DECISION
Joint Motion to Terminate
37 C.F.R. § 42.5(a), 42.71(a)

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

On October 9, 2015, pursuant to our authorization (Paper 21), Petitioner Samsung Electronics Ltd. and Samsung Electronics America, Inc. (“Samsung”) and e-Watch, Inc. (“Patent Owner”) (collectively, “the parties”) filed a Joint Motion to Terminate (“Motion” or “Mot.,” Paper 22) with respect to Samsung only. Mot. 2. The parties have entered into a settlement agreement that resolves their disputes related to the challenged patent. *Id.* The parties filed a copy of the settlement agreement (Ex. 1012) along with a Joint Request to Treat the Settlement Agreement as Business Confidential Information. Paper 23; *see also* 37 C.F.R. § 42.74(c) (“A party to a settlement may request that the settlement be treated as business confidential information and be kept separate from the files of an involved patent or application.”).

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 the patent owner, unless the Office has decided the merits of the proceeding before the request for termination is filed.” Samsung is not the sole petitioner in these reviews, which remains pending as to Petitioner Apple Inc., who the parties represent does not oppose termination as to Samsung only. Mot. 2. No final written decision has been issued, and, apart from the instant motion, there are no outstanding motions in this proceeding.

The Board acknowledges that the written settlement agreement appears to be a true copy. All terminated and pending district court actions, including a terminated action relating to Samsung, with respect to the patent, are listed in the Motion. Mot. 3–4. The status of all pending *inter partes* reviews involving U.S. Patent No. 7,643,168 B2 is also listed. *Id.* at 4.

The parties argue termination is appropriate because § 317(a) provides the trial shall be terminated with respect to “any petitioner upon the joint

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request of the petitioner and the patent owner, unless the Office has decided the merits of the proceeding before the request for termination is filed.” Mot. 2–3. The parties also contend that strong public policy reasons favor settlement. *Id.* at 3.

The Board determines that, in the circumstances of these cases, it is appropriate to terminate the review as to Samsung. *See* 35 U.S.C. § 317(a); 37 C.F.R. § 42.72. This paper does not constitute a final written decision pursuant to 35 U.S.C. § 318(a).

ORDER

Accordingly, it is

ORDERED that the Joint Motion to Terminate with respect to Samsung only is *granted*; and

FURTHER ORDERED that the settlement agreement (Exhibit 1012) be treated as business confidential information and be kept separate from the files of the involved U.S. Patent No. 7,643,168 B2.

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