

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC., HTC CORPORATION, HTC AMERICA, INC.,
ZTE CORPORATION, AND ZTE (USA), INC.,
Petitioners,

v.

CELLULAR COMMUNICATIONS EQUIPMENT LLC,
Patent Owner.

Case IPR2016-01493¹
Patent 8,457,676 B2

Before BRYAN F. MOORE, GREGG I. ANDERSON, and
JOHN A. HUDALLA, *Administrative Patent Judges*.

MOORE, *Administrative Patent Judge*.

DECISION

Joint Motion to Terminate with Respect to Apple Inc.
37 C.F.R. § 42.72

¹ HTC Corporation, HTC America, Inc., ZTE Corporation, and ZTE (USA), Inc. filed a petition in (now terminated) IPR2017-01081, and have been joined to the instant proceeding.

INTRODUCTION

On February 13, 2017, we instituted an *inter partes* review in this proceeding. A final hearing will be held on November 8, 2017. *See* Scheduling Order, Paper 8. The Board has not yet issued a Final Written Decision. On October 9, 2017, Petitioner Apple Inc. (“Apple”) and Patent Owner Cellular Communications Equipment LLC (“CCE”) filed a joint motion to terminate this proceeding as to Apple under 35 U.S.C. § 317 and 37 C.F.R. § 42.74 (Paper 21), a true copy of the written settlement agreement (Ex. 1022), and a joint request to maintain confidentiality and to keep separate pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) (Paper 22).

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.” The grant of the motion to terminate will not result in the termination of the instant proceeding, because HTC Corporation, HTC America, Inc., ZTE Corporation, and ZTE (USA), Inc. remain as Petitioners. The parties are reminded that the Board is not a party to the settlements, and may identify independently any question of patentability. 37 C.F.R. § 42.74(a).

Generally, however, the Board expects that a proceeding will terminate as to settling parties 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). The Board is persuaded that, under these circumstances, it is appropriate to terminate this proceeding only as to Apple. *See* 37 C.F.R. § 42.72.

Given that Apple has been terminated from this IPR, Petitioners HTC Corporation, HTC America, Inc., ZTE Corporation, and ZTE (USA), Inc. shall take over an active role in these proceedings. Petitioners HTC Corporation, HTC America, Inc., ZTE Corporation, and ZTE (USA), Inc. shall file all papers as single joint filings. Additionally, Petitioners HTC Corporation, HTC America, Inc., ZTE Corporation, and ZTE (USA) in this joined proceeding shall designate attorney(s) to present argument at the oral hearing in the joined proceeding, if scheduled, in a consolidated argument.

ORDER

Accordingly, it is:

ORDERED that the joint motion to terminate this proceeding with respect to Apple is GRANTED, and this proceeding is hereby terminated only as to Apple;

FURTHER ORDERED that the parties' joint request that the written settlement agreement (Ex. 1022) be: (i) treated as business confidential information; (ii) kept separate from the file of U.S. Patent No. 8,457,676 B2; (iii) kept confidential from any third party (including from the non-settling Petitioners); and (iv) made available only to Federal Government agencies on written request, or to any person on a showing of good cause, under the provisions of 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c), is GRANTED;

FURTHER ORDERED Petitioners HTC Corporation, HTC America, Inc., ZTE Corporation, and ZTE (USA), Inc. shall take over an active role in these proceedings and shall file all papers as joint filings; and

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FURTHER ORDERED Petitioners HTC Corporation, HTC America, Inc., ZTE Corporation, and ZTE (USA) in this joined proceeding shall designate attorney(s) to present argument at the oral hearing in the joined proceeding in a consolidated argument.

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