

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LG ELECTRONICS, INC., ZTE (USA) INC., OLYMPUS
CORPORATION, and OLYMPUS AMERICA, INC.,
Petitioner,

v.

PAPST LICENSING GMBH & CO. KG,
Patent Owner.

Case IPR2017-00443
Patent 6,470,399 B1¹

Before JONI Y. CHANG, JENNIFER S. BISK, and JAMES B. ARPIN,
Administrative Patent Judges.

CHANG, *Administrative Patent Judge.*

DECISION

Granting Joint Motion to Terminate as to Petitioner LG Electronics, Inc.
37 C.F.R. § 42.74

¹ IPR2017-01682 has been joined with this proceeding. Paper 14.

Petitioner, LG Electronics, Inc. (“LG”), and Patent Owner, Papst Licensing GmbH & Co. KG (“Papst”), jointly move to terminate the instant *inter partes* review with respect to LG in light of the settlement between LG and Papst that resolves their dispute regarding U.S. Patent No. 6,470,399 B1 (“the ’399 patent”). Paper 23 (“Mot.”). LG and Papst also filed a true copy of their written settlement agreement in connection with the termination as required by 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b). Ex. 2011. Pursuant to 37 C.F.R. § 42.74(c), LG and Papst additionally filed a joint request to treat the Settlement Agreement as business confidential information kept separate from the file of the involved patent. Paper 24.

For the reasons set forth below, the Joint Motion to Terminate with respect to LG, and the Joint Request to File Settlement Agreement as Business Confidential Information are *granted*.

Under the Leahy-Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 284 (September 16, 2011), settlement between the parties to a proceeding is encouraged. Notably, 35 U.S.C. § 317(a), in part, provides the following (emphasis added):

(a) IN GENERAL.—An *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. If the *inter partes* review is terminated with respect to a petitioner under this section, *no estoppel under section 315(e) shall attach to the petitioner*, or to the real party in interest or privy of the petitioner, on the basis of that petitioner’s institution of that *inter partes* review.

Here, although the instant *inter partes* review has been instituted, we have not entered a final written decision in this proceeding. Upon review of the procedural posture of this proceeding and the facts before us, we

IPR2017-00443
Patent 6,470,399 B1

determine that the parties' contentions have merit, and that it is appropriate to terminate this proceeding with respect to LG. The proceeding, however, will not be terminated with respect to Papst, as other Petitioners—ZTE (USA) Inc., Olympus Corporation, and Olympus America Inc.—remain in the proceeding.

In consideration of the foregoing, it is hereby:

ORDERED that the Joint Motion to Terminate, with respect to LG, is *granted*;

FURTHER ORDERED that this review is terminated with respect to LG only; but this review continues to proceed with respect to Papst and the remaining Petitioners;

FURTHER ORDERED that the Joint Request to File Settlement Agreement as Business Confidential Information and to keep such settlement agreement separate from the patent file, and to make it available only to Federal Government agencies on written request, or to any person on a showing of good cause, pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c), is *granted*; and

FURTHER ORDERED that any subsequent papers filed in this *inter partes* review should not include LG in the caption.

IPR2017-00443
Patent 6,470,399 B1

For PETITIONER:

Dion Bregman
Andrew Devkar
MORGAN, LEWIS & BOCKIUS LLP
dion.bregman@morganlewis.com
andrew.devkar@morganlewis.com

Herbert Finn
Jonathan Giroux
GREENBERG TRAURIG LLP
finnh@gtlaw.com
girouxj@gtlaw.com

Scott Miller
Darren Franklin
SHEPPARD MULLIN RICHTER & HAMPTON LLP
smiller@sheppardmullin.com
dfranklin@sheppardmullin.com

IPR2017-00443
Patent 6,470,399 B1

For PATENT OWNER:

Gregory s. Donahue
Minghui Yang
DiNOVO PRICE ELLWANGER & HARDY LLP
gdonahue@dpelaw.com
myang@dpelaw.com
docketing@dpelaw.com

Anthony Meola
Jason. A. Murphy
Victor J. Baranowshi
Arlen L. Olsen
SCHMEISER, OLSEN & WATTS, LLP
ameola@iplawusa.com
jmurphy@iplawsa.com
vbaranowski@iplawusa.com
aolsen@iplawusa.com