

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ZTE (USA) INC.,
SAMSUNG ELECTRONICS CO., LTD., and
SAMSUNG ELECTRONICS AMERICA, INC.,
Petitioner,

v.

PAPST LICENSING GMBH & CO. KG,
Patent Owner.

Case IPR2017-00714
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 ZTE (USA) Inc.
37 C.F.R. § 42.74

¹ IPR2017-01808 has been joined with this proceeding.

Petitioner, ZTE (USA) Inc. (“ZTE”), and Patent Owner, Papst Licensing GmbH & Co. KG (“Papst”), jointly move to terminate the instant *inter partes* review with respect to ZTE in light of the settlement between ZTE and Papst that resolves their dispute regarding U.S. Patent No. 6,470,399 B1 (“the ’399 patent”). Paper 26 (“Mot.”). ZTE 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. 2008. Pursuant to 37 C.F.R. § 42.74(c), ZTE 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 27.

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

Under the Leahy-Smith America Invents Act, 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

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determine that the parties' contentions have merit, and that it is appropriate to terminate this proceeding with respect to ZTE. The proceeding, however, will not be terminated with respect to Papst, as other Petitioners—Samsung Electronics Co., Ltd. and Samsung Electronics America, Inc.—remain in the proceeding.

In consideration of the foregoing, it is hereby:

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

FURTHER ORDERED that this review is terminated with respect to ZTE only; but this review continues with 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 ZTE in the caption.

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