

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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CELLCO PARTNERSHIP D/B/A VERIZON WIRELESS, and SAMSUNG  
ELECTRONICS AMERICA, INC.,  
Petitioner,

v.

BARKAN WIRELESS IP HOLDINGS, L.P.,  
Patent Owner.

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IPR2018-01659  
IPR2019-00100  
Patent 8,014,284 B2

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Before MEREDITH C. PETRAVICK and WILLIAM V. SAINDON,  
*Administrative Patent Judges.*

SAINDON, *Administrative Patent Judge.*

ORDER

*Granting Updated Joint Motion to Terminate Proceedings  
Due to Settlement after Institution and  
Granting Joint Request to Treat Settlement Agreements as  
Business Confidential Information  
35 U.S.C. § 317; 37 C.F.R. §§ 42.72, 42.74*

We instituted *inter partes* review in IPR2018-01659 with a Decision dated March 27, 2019. IPR2018-01659, Paper 10. In a Decision dated May 1, 2019, the we instituted *inter partes* review in IPR2019-00100 and joined the proceeding with IPR2018-01659. IPR2018-01659, Paper 12.

On May 31, 2019, with our authorization, the Parties filed a Joint Motion to Terminate Under 35 U.S.C. § 317(a) and 37 C.F.R. § 42.72 (IPR2018-01659, Paper 15; IPR2019-00100, Paper 15) and included a copy of a signed agreement relating to settlement (IPR2018-01659, Ex. 2014; IPR2019-00100, Ex. 2020). On July 7, 2019, the Parties filed an Updated Joint Motion to Terminate (IPR2018-01659, Paper 21) and included countersigned copies of an additional agreement relating to settlement and termination of these proceedings (IPR2018-01659, Exs. 2015, 2016). The Parties also filed joint requests to treat the settlement agreements as business confidential information. IPR2018-01659, Paper 16, 22; IPR2019-00100, Paper 16.

The Parties assert that they have “executed a binding settlement agreement as part of a mediation that finally resolves all claims against each other” and that Petitioner has agreed to terminate its IPR petition. IPR2018-01659, Paper 21, 1; IPR2019-00100, Paper 15, 1. The Parties jointly certify that the settlement agreements filed constitute all agreements or understandings made in connection with termination of this proceeding. IPR2018-01659, Paper 21, 2.

## ANALYSIS

Under 35 U.S.C. § 317(a), an *inter partes* review shall be terminated with respect to any petitioner upon the joint request of the petitioner and

patent owner unless the Board has decided the merits of the proceeding before the request for termination. In addition, § 317(b) requires that any agreement or understanding between the patent owner and petitioner made in connection with or in contemplation of termination of an *inter partes* review shall be in writing and filed with the Office before termination of the *inter partes* review. *Accord* 37 C.F.R. § 42.74(b). We determine that the Parties' Updated Joint Motion to Terminate satisfies the requirements of § 317(b).

These proceedings are in preliminary stages, and we have not yet reached a final determination on the merits or entered a final written decision. The Parties' Updated Joint Motion to Terminate states that the Parties "jointly certify that they have now filed all agreements or understandings, . . . between the Parties that are made in connection with termination of this proceeding" and "that no other written or oral agreements or understandings, including any collateral agreements, are made in connection with, or in contemplation of, the termination of these proceedings." IPR2018-01659, Paper 21 at 2–3.

Based on the circumstances here, we determine that it is appropriate to terminate these proceedings without rendering any further decisions. *See* 37 C.F.R. § 42.71(a). We have also reviewed the Parties' agreements (IPR2018-01659, Exs. 2014, 2015, 2016; IPR2019-006100, Ex. 2020), and we determine that good cause exists to treat these agreements as business confidential information under 37 C.F.R. § 42.74(c).

Cases IPR2018-01659 and IPR2019-00100  
Patent 8,014,284 B2

ORDER

In view of the foregoing, it is hereby:

ORDERED that the Parties' joint requests for termination are *granted*; IPR2018-01659 is *terminated* as to Petitioner Cellco Partnership d/b/a Verizon Wireless and Samsung Electronics America, Inc., and IPR2019-00100 is *terminated* as to Petitioner Samsung Electronics America, Inc. pursuant to 37 C.F.R. §§ 42.72, 42.74.; and

FURTHER ORDERED that the Parties' request to treat the Settlement Agreements as Business Confidential Information is *granted*, and the Settlement Agreements (IPR2018-01659, Exs. 2014, 2015, 2016; IPR2019-00100, Ex. 2020) shall be kept separate from the files of Patent 8,014,284 B2 and made 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).

Cases IPR2018-01659 and IPR2019-00100  
Patent 8,014,284 B2

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