

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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NOKIA CORP. AND NOKIA OF AMERICA CORP.,  
Petitioner,

v.

PACKET INTELLIGENCE LLC,  
Patent Owner.

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Case IPR2019-01289 (Patent 6,839,751 B1)  
Case IPR2019-01290 (Patent 6,651,099 B1)  
Case IPR2019-01291 (Patent 6,665,725 B1)  
Case IPR2019-01292 (Patent 6,771,646 B1)  
Case IPR2019-01293 (Patent 6,954,789 B2)<sup>1</sup>

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Before JEFFREY S. SMITH, CHARLES J. BOUDREAU, and  
KRISTI L. R. SAWERT, *Administrative Patent Judges*.

SAWERT, *Administrative Patent Judge*.

DECISION

Granting Joint Motion to Terminate Due to Settlement Prior to Institution  
*35 U.S.C. § 317; 37 C.F.R. §§ 42.71(a), 42.74*

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<sup>1</sup> We exercise our discretion to issue a single Decision to be entered in each case using a joint caption. The parties are not permitted to use this caption. For convenience, we use the Paper and Exhibit numbers from IPR2019-01289.

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On September 25, 2019, Nokia Corp. and Nokia of America Corp. (“Petitioner”) and Packet Intelligence LLC (“Patent Owner”) filed a joint motion to terminate these proceedings pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. § 42.74. Paper 7 (“Motion” or “Mot.”). The motion was accompanied by a true, unredacted copy of a settlement agreement (Ex. 1069), and a joint request to treat the settlement agreement as business confidential information, to be kept separate from the patent file, pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) (Paper 8).

The parties represent in their joint motion that they have agreed to terminate these *inter partes* review proceedings, and that there are no other litigations or proceedings between the parties involving the patents challenged in these proceedings. Mot. 5. The parties state that the settlement agreement “resolves all of their disputes concerning” the challenged patents. *Id.* at 6. Additionally, the parties state that they have filed a stipulation and proposed order for dismissal of the related district-court case between the parties, *Packet Intelligence LLC v. Nokia of America Corporation*, Case No. 2:18-cv-00382 (E.D. Tex.). *Id.* at 5.

The Board generally expects that a case “will terminate after the filing of a settlement agreement, unless the Board has already decided the merits.” Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,768 (Aug. 14, 2012); *see also* 37 C.F.R. § 42.72. These proceedings are in a preliminary stage. Patent Owner has not yet filed any preliminary response, and no decisions on whether to institute any trial have been issued. Under the circumstances presented here, we determine that it is appropriate to dismiss

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the petitions and terminate these preliminary proceedings with respect to both Petitioner and Patent Owner. Accordingly, we grant the parties' joint motion to terminate.

We also determine that the parties have complied with the requirements of 37 C.F.R. § 42.74(c) to have the settlement agreement treated as business confidential information and kept separate from the patent files of the challenged patents. Thus, we grant the joint request to treat the settlement agreement as business confidential.

Accordingly, it is

ORDERED that the joint motion to terminate is GRANTED;

FURTHER ORDERED that Nokia Corp. and Nokia of America Corp.'s petitions for *Inter Partes* Review of U.S. Patent Nos. 6,651,099, 6,665,725, 6,771,646, 6,839,751, and 6,954,789 are DISMISSED, pursuant to 37 C.F.R. §§ 42.5(a) and 42.71(a); and

FURTHER ORDERED that the joint request to treat the parties' settlement agreement as business confidential information, to be kept separate from the patent file, is GRANTED.

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