

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ZTE (USA) INC., and
SAMSUNG ELECTRONICS CO., LTD.,¹

Petitioners,

v.

BELL NORTHERN RESEARCH, LLC,

Patent Owner.

Case No. IPR2019-01365
U.S. Patent No. 7,039,435

MOTION TO TERMINATE PETITIONER ZTE (USA) INC.

¹ Samsung Electronics Co., Ltd., who filed a petition in IPR2020-00697, has been joined as a petitioner in this proceeding.

I. STATEMENT OF PRECISE RELIEF REQUESTED

Under 35 U.S.C. § 317(a), Petitioner ZTE (USA) Inc. (“ZTE”) and Patent Owner Bell Northern Research, LLC (“BNR”) jointly request that the Board terminate Petitioner ZTE (USA) Inc. from this proceeding. ZTE and BNR have reached a settlement that resolves their dispute concerning the patent at issue in this proceeding. Petitioner Samsung Electronics Co., Ltd. (“Samsung”) is not a party to the settlement and will remain a petitioner in this proceeding.

II. STATEMENT OF MATERIAL FACTS

1. U.S. Patent No. 7,039,435 (the “’435 patent”) is the subject of this proceeding and is one of eight patents originally asserted against ZTE in Civil Action 3:18-cv-01786-CAB-BLM before the United States District Court for the Southern District of California.

2. On February 11, 2020, the Board instituted an *inter partes* review on claims 1–3 and 6 of the ’435 patent. (Paper 13 at 39.)

3. On July 27, 2020, ZTE and BNR reached a settlement that resolves their dispute with respect to several patents, including the ’435 patent. Samsung is not a party to the settlement agreement. Pursuant to the settlement agreement, the parties have agreed to seek termination of ZTE from this proceeding.

4. On July 30, 2020, counsel for ZTE and BNR requested authorization from the Board to file a motion to terminate ZTE from this proceeding, and to treat

the parties' settlement agreement as business confidential. On August 25, 2020, the Board authorized the parties to file a motion to terminate these proceedings as to ZTE, along with the executed written agreement and a request to treat the agreement as business confidential.

5. In accordance with 37 C.F.R. § 42.74(b), ZTE and BNR submit a true and correct copy (non-redacted) of the settlement agreement as Exhibit 1029 with the designation "Board Only."²

6. There are no other collateral agreements or understandings made between ZTE and BNR in connection with, or in contemplation of, the termination of this *inter partes* review.

III. STATEMENT OF REASONS FOR THE RELIEF REQUESTED

Termination of Petitioner ZTE from this proceeding is proper as the Board has not yet decided the merits of this proceeding. As required under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b), ZTE and BNR have provided a true and correct (non-redacted) copy of their settlement agreement (Exhibit 1029), and there is no

² Together with this motion, the parties file a joint motion requesting that the Board treat Exhibit 1029 as business confidential information, keep it separate from the files of the involved patent, and make it available only to the entities and under the conditions identified in 37 C.F.R. § 42.74(c).

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other agreement, oral or written, between ZTE and BNR made in connection with, or in contemplation of, the termination of ZTE from this proceeding. This agreement settles all litigation, including this proceeding, between ZTE and BNR with respect to the '435 patent. Accordingly, the Board should terminate Petitioner ZTE from this proceeding.

Dated: August 26, 2020

Respectfully submitted,

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