

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS AMERICA, INC., APPLE INC., and
MOTOROLA MOBILITY LLC,
Petitioner,

v.

UNILOC 2017 LLC,
Patent Owner.

IPR2020-00701 (Patent 6,836,654 B2)

Before JENNIFER S. BISK, NEIL T. POWELL, and JOHN D. HAMANN,
Administrative Patent Judges.

HAMANN, *Administrative Patent Judge.*

DECISION

Settlement as to Petitioner Samsung Prior to Institution of Trial
Granting Joint Request That Settlement Agreement Be Treated
as Business Confidential Information and Keep Separate
37 C.F.R. §§ 42.71(a), 42.74

I. DISCUSSION

On June 10, 2020, Petitioner Samsung Electronics America, Inc.
("Samsung") and Patent Owner (collectively "the Settling Parties") filed,
with our authorization, a Joint Motion to Terminate as to Petitioner Samsung

IPR2020-00701
Patent 6,836,654 B2

Pursuant to 35 U.S.C. § 317 (Paper 9), a copy of their settlement agreement (Exhibit 2001, filed with Board Only confidentiality), and a Joint Request that Settlement Agreement be Treated as Business Confidential Information and Keep Separate Pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) (Paper 10).

The Settling Parties indicate that they reached an agreement to resolve their disputes. Paper 9, 2. In particular, the Settling Parties state that they reached a settlement agreement that “settles (i) this proceeding, and (ii) the related district court litigation styled *Uniloc 2017 LLC v. Samsung Electronics America, Inc. et al 2-18-cv-00508* (EDTX).” *Id.* The Settling Parties also indicate that “[a] stipulation of voluntary dismissal with prejudice was filed in the district court litigation on May 27, 2020[, and that t]he Court dismissed the case on May 28, 2020.” *Id.*

Generally, the Board expects that a proceeding will terminate after the filing of a settlement agreement. *See* 35 U.S.C. § 317(a) (“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.”); 37 C.F.R. § 42.72 (“The Board may terminate a trial without rendering a final written decision, where appropriate, including . . . pursuant to a joint request under 35 U.S.C. 317(a) . . .”).

Here, trial has not been instituted yet and the merits of the proceeding have not yet been decided. Accordingly, we are persuaded that, under these circumstances, dismissing the Petition as to Samsung is appropriate. *See* 37 C.F.R. § 42.71(a) (“The Board may take up petitions or motions for decisions in any order, may grant, deny, or dismiss any petition or motion,

and may enter any appropriate order.”). Therefore, the Settling Parties’ Joint Motion to Terminate as to Petitioner Samsung is *granted*.

In addition, the Settling Parties filed what they represent is a true and correct copy of their confidential settlement agreement as Exhibit 2001, and indicate that “there are no collateral agreements referred to in the settlement agreement; and there are no other agreements or understandings made in connection with, or in contemplation of, the termination of the inter partes review.” Paper 9, 4. The Settling Parties’ request to treat their settlement agreement as business confidential information and to keep it separate from the file of the challenged patent is *granted*. Paper 10, 2; *see* 35 U.S.C. § 317(b) (“At the request of a party to the proceeding, the agreement or understanding shall be treated as business confidential information, shall be kept separate from the file of the involved patents, and shall be made available only to Federal Government agencies on written request, or to any person on a showing of good cause.”); 37 C.F.R. § 42.74(c) (same).

This Decision does not constitute a final written decision pursuant to 35 U.S.C. § 318(a).

II. ORDER

Accordingly, it is

ORDERED that the Settling Parties’ Joint Motion to Terminate as to Petitioner Samsung Pursuant to 37 C.F.R. § 317 (Paper 9) is *granted*;

FURTHER ORDERED that the Petition is dismissed as to Petitioner Samsung and the proceeding is terminated as to Petitioner Samsung;

FURTHER ORDERED that the Settling Parties’ Joint Request that Settlement Agreement be Treated as Business Confidential Information and

IPR2020-00701
Patent 6,836,654 B2

Keep Separate Pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c)
(Paper 10) is *granted*; and

FURTHER ORDERED that the settlement agreement (Exhibit 2001) be treated as business confidential information, kept separate from the file of the challenged patent, 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).

IPR2020-00701
Patent 6,836,654 B2

For PETITIONER:

Tiffany Miller
James Heintz
DLA PIPER (US) LLP
Tiffany.miller@dlapiper.com
Jim.heintz@dlapiper.com

Naveen Modi
Joseph Palys
Philip Citroen
PAUL HASTINGS LLP
naveenmodi@paulhastings.com
josephpalys@paulhastings.com
philipcitroen@paulhastings.com

For PATENT OWNER:

Ryan Loveless
Brett Mangrum
James Etheridge
Brian Koide
Jeffrey Huang
ETHERIDGE LAW GROUP
ryan@etheridgelaw.com
brett@etheridgelaw.com
jim@etheridgelaw.com
brian@etheridgelaw.com
jeff@etheridgelaw.com