

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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APPLE INC.,  
Petitioner,

v.

COREPHOTONICS, LTD.,  
Patent Owner.

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IPR2020-00487 (Patent 9,661,233 B2)  
IPR2020-00860 (Patent 10,326,942 B2)  
IPR2020-00861 (Patent 10,230,898 B2)  
IPR2020-00862 (Patent 10,356,332 B2)  
IPR2020-00906 (Patent 10,225,479 B2)<sup>1</sup>

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Before GREGG I. ANDERSON, JOHN F. HORVATH,  
MONICA S. ULLAGADDI, SCOTT B. HOWARD, JOHN R. KENNY, and  
BRENT M. DOUGAL, *Administrative Patent Judges*.<sup>2</sup>

PER CURIAM.

TERMINATION

Due to Settlement After Institution of Trial  
*35 U.S.C. § 317; 37 C.F.R. § 42.74*

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<sup>1</sup> This Order addresses issues that are the same in each of these proceedings. We issue one Order to be entered in each proceeding. The parties are not authorized to use this style caption unless later permitted.

<sup>2</sup> This listing of Administrative Patent Judges does not represent an expanded panel for any of the above-identified proceedings.

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## I. INTRODUCTION

On March 6, 2024, with the Board’s authorization, Petitioner and Patent Owner (collectively referred to as “the Parties”) filed a Joint Motion to Terminate Proceeding (“Joint Motion”) (Paper 64<sup>3</sup>), as well as a Joint Request to Keep Separate (“Joint Request”) (Paper 65), in each of the above-identified proceedings due to settlement. In support of the Joint Requests, the Parties filed a copy of a Settlement, Disbursement and License Agreement (“Agreement”) (Ex. 2105) in each proceeding.

## II. DISCUSSION

In the Joint Motions, the Parties represent, for each of the above-identified proceedings, that “Apple no longer intends to participate in this IPR,” and that “[t]he lawsuit between Corephotonics and Apple involving the Patent-at-Issue has been dismissed.” Paper 64, 2. The Parties further represent, for each proceeding, that the Agreement is “a true copy of the settlement agreement that resolves the disputes,” and that “[t]here are no other collateral agreements between the parties made in connection with, or in contemplation of, the termination sought.” *Id.* at 1–2.

The parties originally filed an Agreement in which the settlement amount was redacted. Ex. 2105, 7. In an email dated March 14, 2024, we requested the parties to file an unredacted agreement. Ex. 3003, 2. The parties subsequently filed the unredacted Agreement. Ex. 2106; *see id.* at 7.

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<sup>3</sup> For expediency, we cite to papers in IPR2020-00487. Similar papers were filed in the other proceedings identified above.

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In our email, we also requested clarification as to whether all agreements ancillary to the settlement agreement had been filed—the parties responded in the affirmative. Ex. 3003, 1–2.

Under 35 U.S.C. § 317(a), “[a]n 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.” Section 35 U.S.C. § 317(a) also provides that if no petitioner remains in the *inter partes* review, the Office may terminate the review.

These proceedings are now on remand from the U.S. Court of Appeals for the Federal Circuit. Although the Parties have filed respective briefs on remand in each proceeding, we have not yet decided the merits, and the Parties have adequately shown that termination of the proceedings is appropriate. Under these circumstances, we determine that good cause exists to terminate the proceedings with respect to the Parties.

In the Joint Requests, the Parties request to file the Agreement “as business confidential information which shall be kept separate from the file of the involved patent” in each proceeding. Paper 65, 1. After review, we find that the Agreement contains business confidential information regarding the terms of settlement. We determine that good cause exists to treat the Agreement as business confidential information pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

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

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### III. ORDER

Accordingly, for the reasons discussed above, it is:

ORDERED that the Joint Motions are *granted*, and IPR2020-00487, IPR2020-00860, IPR2020-00861, IPR2020-00862, and IPR2020-00906 are *terminated* with respect to Petitioner and Patent Owner pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. § 42.72; and

FURTHER ORDERED that the Joint Requests are *granted*, and the Agreement shall be kept separate from the files of Patents 9,661,233 B2, 10,326,942 B2, 10,230,898 B2, 10,356,332 B2, and 10,225,479 B2, and be 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).

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