

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC. & MICROSOFT CORPORATION
Petitioner,

v.

NEODRON LTD.,
Patent Owner.

IPR2020-00998
IPR2020-01000
Patent 8,749,251 B2¹

Before MIRIAM L. QUINN, PATRICK M. BOUCHER, and
SCOTT B. HOWARD, *Administrative Patent Judges*.

HOWARD, *Administrative Patent Judge*.

TERMINATION

Due to Settlement After Institution of Trial and
*Granting Joint Request to Treat Settlement Agreement as
Business Confidential Information
35 U.S.C. § 317; 37 C.F.R. § 42.74*

¹ This Order addresses issues that are identical in each of the above identified cases. Accordingly, we exercise our discretion to issue one order to be filed in each case. The parties, however, are not authorized to use this style heading in any subsequent papers without prior authorization.

I. INTRODUCTION

Apple Inc. and Microsoft Corporation (“Petitioner”) and Neodron Ltd. (“Patent Owner”), (collectively “the Parties”) requested that the above-identified *inter partes* review proceedings be terminated pursuant to a settlement. With our authorization, the Parties filed a Joint Motion to Terminate in each of the above-identified proceedings (“Joint Motion”). Paper 10.²

The Parties also filed Settlement Agreements (Exhibit 2001; Ex. 2002, collectively “Settlement Agreements”) and filed a Joint Request to Keep Separate (Paper 11, “Joint Request”) in each of the above-identified proceedings.

II. DISCUSSION

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.” It is also provided in 35 U.S.C. § 317(a) that if no petitioner remains in the *inter partes* review, the Office may terminate the review.

In the Joint Motions, the Parties represent that they have reached an agreement to jointly seek termination of the *inter partes* review proceedings, that the filed copies of the Settlement Agreements are true copies, and there are no other collateral agreements. Joint Motion 1–3. Further, the Settlement Agreements indicate they are complete agreements. Ex. 2001, 7;

² For expediency, we cite to the Papers and Exhibits filed in IPR2020-00998, unless otherwise indicated. Similar Papers and Exhibits were filed in IPR2020-01000.

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Ex. 2002, 7. The Parties also represent that their Settlement Agreements resolve all currently pending Patent Office and District Court proceedings between the Parties involving U.S. Patent No. 8,749,251 B2 (“the ’251 patent”). Joint Motion 1–3.

We instituted a trial on the above-identified proceedings on December 15, 2020. Paper 8. We have not yet decided the merits of the proceedings, and a final written decision has not been entered. Notwithstanding that the proceedings have moved beyond the preliminary stage, the Parties have adequately shown that the termination of the proceedings is appropriate. Under these circumstances, we determine that good cause exists to terminate the proceedings with respect to the Parties.

The Parties also requested that the Settlement Agreements be treated as business confidential information and be kept separate from the file of the ’251 patent. Joint Request 1–2. After reviewing the Settlement Agreements between the Parties, we find that the Settlement Agreements contain confidential business information regarding the terms of settlement. We determine that good cause exists to treat the Settlement Agreements 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).

III. ORDER

Accordingly, for the reasons discussed above, it is:

ORDERED that the Joint Motions are *granted*, and IPR2020-00998 and IPR2020-01000 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

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FURTHER ORDERED that the Joint Requests are *granted*, and the Settlement Agreements shall be kept separate from the file of the '251 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).

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