

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC., MICROSOFT CORPORATION,
SAMSUNG ELECTRONICS CO., LTD, and
SAMSUNG ELECTRONICS AMERICA, INC.,
Petitioner,

v.

NEODRON LTD.,
Patent Owner.

IPR2020-00778¹
Patent 7,821,425 B2

Before MIRIAM L. QUINN, PATRICK M. BOUCHER, and
CHRISTOPHER L. OGDEN, *Administrative Patent Judges*.

QUINN, *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 IPR2020-01119 has been joined with IPR2020-00778.

I. INTRODUCTION

Petitioner and Patent Owner (collectively “the Parties”) have requested that the above-identified joined *inter partes* review proceeding be terminated pursuant to a settlement. On February 8, 2021, the Parties filed a Joint Motion to Terminate in the joined proceeding (“Joint Motion”). Paper 15. On February 1, 2021, we authorized the Parties, via email, to file a joint motion to terminate the joined proceeding. Joint Motion 1. The Parties also filed copies of Settlement Agreements, Patent License Agreements, an Escrow Agreement, and an Exhibit A to the Escrow Agreement (Ex. 2004; Ex. 2005; Ex. 2006; Ex. 2007; Ex. 2008; IPR2020-01119 Paper 9,² collectively “Settlement Agreements”) and filed a Joint Request to Keep Separate (Paper 16, “Joint Request”) in the joined proceeding.

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 Motion, the Parties represent that they have reached an agreement to jointly seek termination of the joined *inter partes* review proceeding, that the filed copies of the Settlement Agreements are true copies, and there are no other collateral agreements between the parties made in connection with, or in contemplation of, the termination. Joint

² Exhibit A to the Escrow Agreement was filed as a paper in IPR2020-01119 instead of as an exhibit in IPR2020-00778.

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Motion 1–3. Further, the Settlement Agreements indicate they are complete agreements. Ex. 2004, 7; Ex. 2005, 7; Ex. 2006, 12; Ex. 2007, 12; Ex. 2008, 13. The Parties also represent that their Settlement Agreements resolve all currently pending Patent Office and District Court proceedings between the Parties involving Patent 7,821,425. Joint Motion 1–3.

We instituted a trial on the joined proceeding on November 23, 2020. Paper 12. We have not yet decided the merits of the joined proceeding, and a final written decision has not been entered. Notwithstanding that the joined proceeding has moved beyond the preliminary stage, the Parties have shown adequately that the termination of the joined proceeding is appropriate. Under these circumstances, we determine that good cause exists to terminate the joined proceeding 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 Patent 7,821,425. 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 Motion is *granted*, and that IPR2020-00778 is hereby *terminated* and IPR2020-01119 (the joined proceeding) is closed;

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and

FURTHER ORDERED that the Joint Request is *granted*, and the Settlement Agreements shall be kept separate from the file of Patent 7,821,425, 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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