

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TCT MOBILE (US) INC.,
HUIZHOU TCL MOBILE COMMUNICATION CO. LTD.,
SHENZHEN TCL CREATIVE CLOUD TECHNOLOGY CO., LTD.,
SONY MOBILE COMMUNICATIONS AB, SONY MOBILE
COMMUNICATIONS, INC., SONY ELECTRONICS INC., and
SONY CORPORATION,
Petitioner,

v.

ANCORA TECHNOLOGIES, INC.,
Patent Owner.

IPR2020-01609¹
Patent 6,411,941 B1

Before THU A. DANG, JONI Y. CHANG, and KEVIN W. CHERRY,
Administrative Patent Judges.

CHANG, *Administrative Patent Judge.*

DECISION
Settlement as to TCT and TCL After Institution of Trial
37 C.F.R. § 42.74

¹ Sony Mobile Communications AB, Sony Mobile Communications, Inc., Sony Electronics Inc., and Sony Corporation, who filed a petition in IPR2021-00663 have been joined with this proceeding.

TCT Mobile (US) Inc., Huizhou TCL Mobile Communication Co., Ltd., and Shenzhen TCL Creative Cloud Technology Co., Ltd. (collectively, “Petitioner TCT”) and Ancora Technologies, Inc. (“Patent Owner”) filed a Joint Motion to Terminate. Paper 16 (“Mot.”). Petitioner TCT and Patent Owner also filed a true copy of their Settlement Agreement in connection with the termination as required by 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b). Ex. 2005. Pursuant to 37 C.F.R. § 42.74(c), Petitioner TCT and Patent Owner filed a joint request to treat the Settlement Agreement as business confidential information kept separate from the file of the involved patent. Paper 15.

For the reasons set forth below, the Joint Motion to Terminate is *granted* only with respect to Petitioner TCT, but not with respect to the Patent Owner. Also, the Joint Request to File Settlement Agreement as Business Confidential Information is *granted*.

Under the Leahy-Smith America Invents Act, settlement between the parties to a proceeding is encouraged. Notably, 35 U.S.C. § 317(a), in part, provides the following:

(a) IN GENERAL.—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. If the inter partes review is terminated with respect to a petitioner under this section, no estoppel under section 315(e) shall attach to the petitioner, or to the real party in interest or privy of the petitioner, on the basis of that petitioner’s institution of that inter partes review.

In the Joint Motion, Petitioner TCT and Patent Owner indicate that Petitioner TCT and Patent Owner “reached the mutual decision to settle this

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proceeding and their related district court litigation regarding the '941 patent.” Mot. 2. Although the instant *inter partes* review has been instituted, we have not entered a final written decision in this proceeding. *Id.* In addition, Petitioner TCT and Patent Owner “certify that there are no collateral agreements or understandings made in connection with, or in contemplation of, the termination of the present proceeding.” *Id.* at 3. Upon review of the procedural posture of this proceeding and the facts before us, we determine that the contentions presented in the Joint Motion have merit, and that it is appropriate to terminate this proceeding with respect to Petitioner TCT. The proceeding, however, will not be terminated with respect to Patent Owner, as other Petitioner—Sony Mobile communications AB, Sony Mobile Communications, Inc., Sony Electronics Inc., and Sony Corporation (“Petitioner Sony”)—remains in the proceeding.

In consideration of the foregoing, it is hereby:

ORDERED that the Joint Motion to Terminate, with respect to Petitioner TCT, is *granted*;

FURTHER ORDERED that this review is terminated with respect to Petitioner TCT only; but this review continues with Patent Owner and Petitioner Sony;

FURTHER ORDERED that the Joint Request to File Settlement Agreement as Business Confidential Information and to keep such settlement agreement separate from the patent file, and to make it 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), is *granted*; and

FURTHER ORDERED that any subsequent papers filed in this *inter partes* review should not include Petitioner TCT in the caption.

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