Trials@uspto.gov
571-272-7822

Paper 10
Date: August 3, 2021

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD.,
Petitioner,

v.

TELEFONAKTIEBOLAGET LM ERICSSON,
Patent Owner.

IPR2021-00446	IPR2021-00508	IPR2021-00587	IPR2021-00683
IPR2021-00447	IPR2021-00509	IPR2021-00588	IPR2021-00684
IPR2021-00450	IPR2021-00536	IPR2021-00613	IPR2021-00685
IPR2021-00459	IPR2021-00537	IPR2021-00614	IPR2021-00729
IPR2021-00460	IPR2021-00539	IPR2021-00615	IPR2021-00730
IPR2021-00486	IPR2021-00567	IPR2021-00643	IPR2021-00731
IPR2021-00487	IPR2021-00568	IPR2021-00644	IPR2021-00732[1]
	IPR2021-00569	IPR2021-00645	

Before MIRIAM L. QUINN, NATHAN A. ENGELS, SHEILA F. McSHANE, and JULIET MITCHELL DIRBA, *Administrative Patent Judges*.[2]

Opinion for the Board filed *per curiam*.
Opinion dissenting filed by QUINN, *Administrative Patent Judge*.

[1] We exercise our discretion to issue a single order to be entered in each of the identified proceedings. The parties are not authorized to use this style heading in subsequent papers. We do not list the patents at issue in these proceedings because this Paper does not address or depend upon the substance of any of those patents.

[2] This is not an expanded panel of the Board; rather, the four judges are paneled in various groups of three in the identified proceedings.

ORDER
Dismissal Prior to Institution of Trial
37 C.F.R. § 42.71(a)

In an e-mail dated May 14, 2021, the Board authorized Petitioner to file unopposed motions to dismiss or terminate these proceedings prior to institution. The Board's e-mail stated that if Petitioner is requesting dismissal or termination pursuant to a settlement between the parties, the parties should file a copy of any settlement agreements.

On May 19, 2021, in each proceeding identified above, Petitioner filed an Unopposed Motion to Dismiss the Petition for *Inter Partes* Review (collectively the "Motions"). IPR2021-00446, Paper 6.[3] In the Motions, Petitioner states that the parties have settled their disputes and that good cause exists for dismissal. *Id.* at 5–6. Petitioner also argues that it should not be required to file a copy of the parties' settlement agreement. *Id.*

DISCUSSION

The first of these proceedings began with a Petition filed on January 29, 2021. Paper 2; *see* Paper 3 (Notice of Filing Date Accorded entered February 9, 2021). Only a few months later, before the Board issued a decision on institution in any of the proceedings, the parties reached a settlement, and Petitioner requested dismissals. Paper 6.

The Board generally has requested that parties file copies of settlement agreements when seeking dismissal or termination of a proceeding pursuant to a settlement. Where a proceeding has passed the

[3] In the interest of expediency, we cite only to the papers in IPR2021-00446. Similar motions were also filed in each of the other proceedings.

institution stage and has entered the trial phase, that requirement arises under 35 U.S.C. § 317. Section 317 expressly requires that any agreements made in connection with termination of an "instituted" *inter partes* review shall be filed with the Office before termination. Section 317 does not apply to dismissal or termination of a proceeding prior to institution. *See* Rules of Practice for Trials Before the Patent Trial and Appeal Board and Judicial Review of Patent Trial and Appeal Board Decisions, 77 Fed. Reg. 48,612, 48,625 (Aug. 14, 2012) ("35 U.S.C. 135(e), and 317, as amended, and 35 U.S.C. 327 will govern settlements of Board trial proceedings but do not expressly govern pre-institution settlement.").

Less clear is 37 C.F.R. § 42.74, which also addresses settlement. Section 42.74(b) states: "Any agreement or understanding between the parties made in connection with, or in contemplation of, the termination of a proceeding shall be in writing and a true copy shall be filed with the Board before the termination of the trial."[4] Thus, § 42.74(b) addresses settlement and termination of a "proceeding," requiring that agreements to terminate a proceeding must be in writing. Section 42.74(b) also states that a copy of an agreement to terminate a proceeding "shall be filed with the Board before the termination of the trial." Although the term "proceeding" includes trial and preliminary proceedings, "trial" is defined in 37 C.F.R. § 42.2 as "a

[4] Relevant to that language, the Definitions in 37 C.F.R. § 42.2 provide that "*Proceeding* means a trial or preliminary proceeding"; "*Trial* means a contested case instituted by the Board [that] begins with a written decision notifying the petitioner and patent owner of the institution of the trial"; and "*Preliminary Proceeding* begins with the filing of a petition for instituting a trial and ends with a written decision as to whether a trial will be instituted."

contested case instituted by the Board" that "begins with a written decision notifying the petitioner and patent owner of the institution of the trial." As such, even though § 42.74(b) uses "proceeding" in the first instance to require that settlement agreements be in written form even for proceedings in the preliminary, pre-institution stage, in contrast, the language requiring parties to file settlement agreements is tied to, and a prerequisite for, "termination of the trial." The second requirement is consistent with § 317. Conversely, to read the language requiring parties to file settlement agreements to apply to all "proceedings" would read out the language "before termination of the trial" from the Rule.

In further contrast to "termination of the trial," the Board's regulations permit "dismissal" of a petition. Specifically, dismissal is one of three possible outcomes provided under 37 C.F.R. § 42.71(a): "The Board . . . may grant, deny, or dismiss any petition . . . ." No statute or regulation addresses settlement agreements in conjunction with "dismissals" of a petition.

Thus, although the Board has generally required parties to file settlement agreements without regard to the stage of the proceeding, the applicable statutes and regulations make a distinction: for instituted proceedings the statutes and regulations specifically require parties to file copies of written settlement agreements; for preliminary proceedings, the regulations provide for "dismissal" of a petition without specifically requiring that parties file settlement agreements. Accordingly, because there are no explicit provisions in the statutes or regulations that settlement

agreements to be filed in pre-institution dismissals, we decline to impose the requirement here.

Petitioner has shown good cause for dismissal of its Petitions. The parties have settled their dispute, the proceedings are early in the preliminary stages, Patent Owner has not filed any preliminary responses, and the Board has not issued any decisions or otherwise invested in the merits of these proceedings. Dismissing the Petitions at this stage promotes the Board's objective of achieving "just, speedy, and inexpensive resolution of every proceeding." 37 C.F.R. § 42.1(b). It also facilitates settlement. *See* PTAB Consolidated Trial Practice Guide 86 (Nov. 2019)[5] ("There are strong public policy reasons to favor settlement between the parties to a proceeding.").

Accordingly, we grant Petitioner's Unopposed Motion to Dismiss the Petition for *Inter Partes* Review in each of these proceedings. This Order does not constitute a final written decision under 35 U.S.C. § 318(a).

ORDER

In consideration of the foregoing, it is hereby:

ORDERED that Petitioner's Unopposed Motion to Dismiss Petition for *Inter Partes* Review in each of these proceedings is *granted*, the Petition in each of these proceedings is *dismissed*, and the proceedings are *terminated*.

[5] *Available at* https://www.uspto.gov/TrialPracticeGuideConsolidated.

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