

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

**TCL INDUSTRIES HOLDINGS CO., LTD., HISENSE CO., LTD., AND ZYXEL
COMMUNICATIONS CORP.**

Petitioners

v.

PARKERVISION, INC.

Patent Owner

**Case No. IPR2021-00985
Patent No. 7,292,835**

**JOINT MOTION TO TERMINATE PROCEEDING AS TO
PETITIONER ZYXEL COMMUNICATIONS CORP.**

Petitioner ZyXEL Communications Corp. (“ZyXEL Corp.” or “Petitioner”) and Patent Owner ParkerVision, Inc. (“ParkerVision”) have reached a settlement. Pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. § 42.74, Petitioner ZyXEL Corp. and Patent Owner ParkerVision jointly move to terminate the present *inter partes* review proceeding with respect to Petitioner ZyXEL Corp.

I. Statement of Facts

ZyXEL Corp. and ParkerVision have reached an agreement to resolve the Parties’ disputes. The settlement agreement settles (i) this proceeding and (ii) the related district court litigation styled *ParkerVision, Inc. v. ZyXEL Communications Corporation*, No. 6:20-cv-01010 (W.D. Tex.). Pursuant to 37 C.F.R. § 42.74(b), the Parties’ settlement agreement is in writing, and a true and correct copy is being filed as Exhibit 2010. The settlement agreement is being filed electronically with access to “Board Only.” A “Joint Request to File Settlement Agreement as Business Confidential Information Pursuant to 35 U.S.C. § 317 and 37 C.F.R. § 42.74” is being filed concurrently with this Joint Motion to Terminate to treat the settlement agreement as business confidential information and to keep it separate from the files of the involved patent pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

II. Relief Requested

Termination of this *inter partes* review as to Petitioner ZyXEL Corp. is respectfully requested, and the Parties submit that such termination is justified. “There are strong public policy reasons to favor settlement between the parties to a proceeding.” Consolidated Trial Practice Guide 86 (Nov. 2019). “The Board expects that a proceeding will terminate after the filing of a settlement agreement, unless the Board has already decided the merits of the proceeding.” *Id.* (citing 35 U.S.C. §§317(a)).

The Board should terminate this proceeding as to Petitioner ZyXEL Corp., as the Parties jointly request, for the following reasons:

First, ZyXEL Corp. and ParkerVision have met the statutory requirement that they file a “joint request” to terminate before the Office “has decided the merits of the proceeding.” 35 U.S.C. § 317(a). Under section 317(a), an *inter partes* review shall be terminated upon such joint request “unless the Office has decided the merits of the proceeding before the request for termination is filed.” There are no other preconditions of 35 U.S.C. § 317(a). At the time of this paper, the Board has not issued its decision on whether to institute trial.

Second, ZyXEL Corp. and ParkerVision have reached a settlement as to all the disputes in this proceeding and as to U.S. Patent No. 7,292,835. A true copy of the settlement agreement is filed concurrently herewith. See Confidential Exhibit

2010. ZyXEL Corp. and Patent Owner request that the settlement agreement be treated as business confidential information and be kept separate from the files of this proceeding in accordance with 37 C.F.R. § 42.74(c). No other such agreements, written or oral, exist between or among the Parties.

Third, termination would save significant further expenditure of resources by the Parties. Termination upon settlement as requested would also further the purpose of *inter partes* review proceedings to provide an efficient and less costly alternative forum for patent disputes. Further, maintaining the proceeding as to Petitioner ZyXEL Corp. would discourage further settlements, as patent owners in similar situations would have a strong disincentive to settle if they perceived that an *inter partes* review would continue regardless of a settlement.

III. Conclusion

For the foregoing reasons, ZyXEL Corp. and ParkerVision respectfully request termination of this *inter partes* review with respect to Petitioner ZyXEL Corp. only. The IPR petition will remain in force with respect to the non-ZyXel Corp. petitioners, who continue to be represented by currently designated counsel.

Dated: September 27, 2021

Respectfully submitted,

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