

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.,
Petitioner,

v.

PARKERVISION, INC.,
Patent Owner.

IPR2021-00985
Patent 7,292,835 B2

Before MICHAEL R. ZECHER, BART A. GERSTENBLITH, and
IFTIKHAR AHMED, *Administrative Patent Judges*.

GERSTENBLITH, *Administrative Patent Judge*.

DECISION

Settlement Prior to Institution of Trial
Only as to ZyXEL Communications Corp.
37 C.F.R. § 42.74

I. DISCUSSION

Petitioner ZyXEL Communications Corp. (“ZyXEL”) and Patent Owner ParkerVision, Inc. (“ParkerVision”) filed (1) a Joint Motion to Terminate Proceeding as to Petitioner ZyXEL Communications Corp. (Paper 10 (“Mot.”)) based on a settlement agreement between those entities, (2) a true copy of their written settlement agreement (Ex. 2010), and (3) a Joint Request to Treat Settlement Agreement as Business Confidential Information (Paper 11).¹ ZyXEL and ParkerVision indicate that they have settled their underlying dispute and have agreed to terminate this proceeding only with respect to ZyXEL. Mot. 1. The parties filed what they represent is a true and correct copy of their written settlement agreement and indicate that it resolves this proceeding as well as related district court litigation. *Id.*

Generally, the Board expects that a proceeding will terminate with respect to a petitioner after the filing of a settlement agreement. *See* 35 U.S.C. § 317(a) (“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.”); 37 C.F.R.

¹ Section 42.20(b) of Title 37 of the United States Code of Federal Regulations, which refers to “[p]rior authorization,” specifies that “[a] motion will not be entered without Board authorization. Authorization may be provided in an order of general applicability or during the proceeding.” 37 C.F.R. § 42.20(b) (2020). Joint motions to terminate as to a petitioner generally require prior authorization. Although neither party sought authorization, we *sua sponte* waive that requirement *in this particular instance* pursuant to our authority under 37 C.F.R. § 42.5(b). In the future, any motion not expressly authorized by an order of general applicability or during this proceeding *may be rejected*.

§ 42.72 (“The Board may terminate a trial without rendering a final written decision, where appropriate, including . . . pursuant to a joint request under 35 U.S.C. 317(a)”); *see also* Patent Trial and Appeal Board Consolidated Trial Practice Guide at 86 (Nov. 2019)² (“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.” (citing 35 U.S.C. §§ 317(a), 327)). Here, a trial has not yet been instituted and the merits of the proceeding not yet decided. Accordingly, we are persuaded that, under these circumstances, termination of this proceeding only as to ZyXEL is appropriate.

Additionally, we grant the Joint Request to Treat Settlement Agreement as Business Confidential Information. *See* 35 U.S.C. § 317(b) (“At the request of a party to the proceeding, the agreement or understanding shall be treated as business confidential information, shall be kept separate from the file of the involved patents, and shall be made available only to Federal Government agencies on written request, or to any person on a showing of good cause.”); *see also* 37 C.F.R. § 42.74(c) (same).

This Decision does not constitute a final written decision pursuant to 35 U.S.C. § 318(a).

II. ORDER

Accordingly, it is

ORDERED that the Joint Motion to Terminate Proceeding as to Petitioner ZyXEL Communications Corp. (Paper 10) is *granted*;

² Available at <https://www.uspto.gov/TrialPracticeGuideConsolidated>.

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FURTHER ORDERED that the Joint Request to Treat Settlement Agreement as Business Confidential Information (Paper 11) is *granted*;

FURTHER ORDERED that the settlement agreement (Ex. 2010) be treated as business confidential information, kept separate from the file of the above-referenced 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);

FURTHER ORDERED that this proceeding is terminated only as to Petitioner ZyXEL Communications Corp; and

FURTHER ORDERED that Petitioner TCL Industries Holdings Co., Ltd. and Hisense Co., Ltd. remain parties in this proceeding.

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