

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TCL INDUSTRIES HOLDINGS CO., LTD., HISENSE CO., LTD., and
LG ELECTRONICS INC.,
Petitioners,

v.

PARKERVISION, INC.,
Patent Owner.

IPR2021-00990¹
Patent 7,110,444 B1

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

GERSTENBLITH, *Administrative Patent Judge*.

TERMINATION
Due to Settlement After Institution of Trial
Only as to Hisense Co., Ltd.
35 U.S.C. § 317; 37 C.F.R. § 42.74

¹ LG Electronics Inc., who filed a petition in IPR2022-00245, is joined as petitioner in this proceeding.

I. DISCUSSION

Petitioner Hisense Co., Ltd. (“Hisense”) and Patent Owner ParkerVision, Inc. (“ParkerVision”) filed (1) a Joint Motion to Terminate Hisense as Petitioner (Paper 35 (“Mot.”)) based on a settlement agreement between those entities, (2) a true copy of their written settlement agreement (Ex. 1025), and (3) a Joint Request to Treat Exhibit 1025 as Business Confidential Information (Paper 36). Hisense and ParkerVision indicate that they have settled all the disputes in this proceeding and jointly move to terminate the proceeding as to Hisense. 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. *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. § 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, the merits of the proceeding have not yet

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

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been decided. Accordingly, we are persuaded that, under these circumstances, termination of this proceeding only as to Hisense is appropriate.

Additionally, we grant the Joint Request to Treat Exhibit 1025 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 Hisense as Petitioner (Paper 35) is *granted*;

FURTHER ORDERED that the Joint Request to Treat Exhibit 1025 as Business Confidential Information (Paper 36) is *granted*;

FURTHER ORDERED that the settlement agreement (Ex. 1025) 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);

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FURTHER ORDERED that this proceeding is terminated only as to
Petitioner Hisense; and

FURTHER ORDERED that Petitioners TCL Industries Holdings Co.,
Ltd. and LG Electronics Inc. remain parties in this proceeding.

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