

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

BELL NORTHERN RESEARCH, LLC,
Patent Owner

IPR2021-01590
Patent 8,416,862 B2

Before BRYAN F. MOORE, SHARON FENICK and JASON M. REPKO,
Administrative Patent Judges.

MOORE, *Administrative Patent Judge.*

DECISION
Settlement Prior to Institution of Trial
37 C.F.R. § 42.74

INTRODUCTION

With our emailed authorization, the parties filed a “Joint Motion to Dismiss Pursuant to 35 U.S.C. § 317 and 37 C.F.R. §§ 42.72 and 42.7[4].” Paper 7 (“Joint Motion to Terminate”). With our emailed authorization, the parties also filed a “Joint Motion to Keep [Settlement Agreement (Exhibit 2001)] Confidential and Separate under 35 U.S.C. § 317(B) and 37 C.F.R. § 42.74(C).” Paper 6 (“Joint Motion to Keep Separate”).

The Joint Motion to Terminate explains that the parties “have entered into a written confidential settlement agreement that fully resolves this matter.” Paper 7, 1. The Joint Motion to Terminate further states that “[t]he parties agree that neither Patent Owner nor Petitioner will be prejudiced by termination of this proceeding.” *Id.* The parties have filed a copy of their settlement agreement as Exhibit 2001. *Id.* In that regard, the Joint Motion to Terminate states: “The undersigned represents that Exhibit 2001 represents a true and accurate copy of the agreement between the parties (“Confidential Settlement Agreement”) that resolves the present proceeding.”¹ *Id.*

DISCUSSION

Generally, 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. Consolidated Trial Practice Guide, 86 (November 2019).² This proceeding is at an early stage. Patent Owner has not yet filed a Preliminary Response and we have not issued a decision on whether to

¹ Hereinafter, Exhibit 2001 is referred to as “Settlement Agreement.”

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

IPR2021-01590
Patent 8,416,862 B2

institute an *inter partes* review. Under these circumstances, we grant the Joint Motion to Terminate (Paper 7) as to both Petitioner and Patent Owner.

We also grant the Joint Motion to Keep Separate (Paper 6), which is to treat the parties' Settlement Agreement (Exhibit 2001) as business confidential information and have it kept apart from the file of Patent 8,416,862 B2 pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

ORDER

It is

ORDERED that the Joint Motion to Dismiss (Paper 7) is *granted* both as to Petitioner and to Patent Owner;

FURTHER ORDERED that the Joint Motion to Keep Separate is *granted*, under the terms of 37 C.F.R. § 42.74(c);

FURTHER ORDERED that the Settlement Agreement (Ex. 2001) shall be treated as business confidential information, shall be kept separate from the file of Patent 8,416,862 B2, and shall be made available only in accordance with the provisions of 37 C.F.R. § 42.74(c); and

FURTHER ORDERED that this proceeding is *terminated* both as to Petitioner and to Patent Owner, and the Petition is *dismissed*.

IPR2021-01590
Patent 8,416,862 B2

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