

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

Apple Inc.  
Petitioner,

v.

Telefonaktiebolaget LM Ericsson  
Patent Owner.

---

Case IPR2022-00457  
Patent No. 9,509,440

---

**JOINT REQUEST TO TREAT SETTLEMENT AGREEMENT AS  
BUSINESS CONFIDENTIAL INFORMATION**

Pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. § 42.74, and the Board’s email of December 15, 2022, Petitioner Apple Inc. (“Apple” or “Petitioner”) and Patent Owner Telefonaktiebolaget LM Ericsson (“Ericsson” or “Patent Owner”) (collectively, the “Settling Parties”) have reached a settlement and jointly move to terminate the above-captioned proceeding. As permitted by statute, Apple and Ericsson request that the Board treat as business confidential information, the true and complete copy of the Settlement Agreement (Confidential Exhibit 1017) between the parties, as referenced in the parties’ Joint Motion to Terminate Proceeding (pursuant to 35 U.S.C. § 317 and 37 C.F.R. § 42.74), filed concurrently herewith.

35 U.S.C. § 317(b) provides that:

*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.*

Likewise, 37 C.F.R. § 42.74(c) provides that:

*A party to a settlement may request that the settlement be treated as business confidential information and be kept separate from the files of an involved patent or application. The request must be filed with the settlement. If a timely request is filed, the settlement shall only be available:*

- (1) To a Government agency on written request to the Board; or*
- (2) To any other person upon written request to the Board to make the settlement agreement available, along with the fee specified in § 42.15(d) and on a showing of good cause.*

The present request, which is being filed contemporaneously with the Settlement Agreement, is timely and in accordance with the foregoing authority. Therefore, the Settling Parties request that the Settlement Agreement (Confidential Exhibit 1017) (i) be treated as business confidential information, (ii) be maintained separate from the publicly available file of the involved patent, and (iii) shall be made available only to Federal Government agencies on written request, or to persons showing good cause on written request, pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

Both parties also respectfully request that the Board inform us if anyone seeks production of the agreement and afford the parties an opportunity to address whether such request is supported by good cause.

Respectfully submitted,

Date: December 21, 2022

/s/ Adam P. Seitz  
Adam P. Seitz, Reg. No. 52,206  
Jennifer C. Bailey, Reg. No. 52,583  
Clifford T. Brazen, Reg. No. 72,927  
7015 College Boulevard, Suite 700  
Overland Park, KS 66211

Paul R. Hart, Reg. No. 59,646  
5299 DTC Boulevard, Suite 1340  
Greenwood Village, CO 80111

*Attorneys for Petitioner*

Respectfully submitted,

Date: December 21, 2022

/s/ Scott W. Hejny  
Scott W. Hejny, Reg. No. 45,882  
Nicholas Mathews, Reg. No. 66,067  
300 Crescent Court, Suite 1500  
Dallas, TX 75201

*Attorneys for Patent Owner*

**CERTIFICATE OF SERVICE**

Pursuant to 37 CFR § 42.6(e)(4), the undersigned certifies that on December 21, 2022, a complete and entire copy of this Joint Request to Treat Settlement Agreement as Business Confidential Information was provided by email, to the Patent Owner by serving the correspondence addresses of record as follows:

Scott W. Hejny (shejny@McKoolSmith.com)

Nicholas Mathews (nmathews@mckoolsmith.com)

Ericsson\_Apple\_IPRs@mckoolsmith.com

/s/ Adam P. Seitz

Adam P. Seitz, Reg. No. 52,206  
Jennifer C. Bailey, Reg. No. 52,583  
Clifford T. Brazen, Reg. No. 72,927  
7015 College Boulevard, Suite 700  
Overland Park, KS 66211

Paul R. Hart, Reg. No. 59,646  
5299 DTC Boulevard, Suite 1340  
Greenwood Village, CO 80111

*Attorneys for Petitioner*