

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

TELEFONAKTIEBOLAGET LM ERICSSON,
Patent Owner.

IPR2022-00468
Patent 10,512,027

Before GEORGIANNA W. BRADEN, STEVEN M. AMUNDSON, and
STEPHEN E. BELISLE, *Administrative Patent Judges*.

BRADEN, *Administrative Patent Judge*.

TERMINATION
Due to Settlement After Institution of Trial
35 U.S.C. § 317; 37 C.F.R. § 42.74

I. INTRODUCTION

With the Board’s authorization, Petitioner and Patent Owner filed a Joint Motion that requests termination in the above-captioned proceeding. Paper 16 (“Motion”). Along with the Motion, the parties filed a copy of a Settlement and License Agreement. Ex. 1022 (“Settlement Agreement”). The parties also filed a Joint Request that the Settlement Agreement be treated as business confidential information and kept separate from the file of U.S. Patent No. 10,512,027 B2 (Ex. 1001, “the ’027 patent”). Paper 17 (“Joint Request”).

II. DISCUSSION

According to the Motion, the Settlement Agreement resolves the parties’ disputes involving the ’027 patent, and Exhibit 1022 is a true copy of the agreement or understanding made in connection with, or in contemplation of, the termination of the above-captioned proceeding. *See* Paper 16, 1–3. The proceeding is not at a late stage, and we have not yet decided the merits of the proceeding. Additionally, the Settlement Agreement settles all disputes in this proceeding and as to the ’027 patent. *See id.* at 2. Thus, we determine that good cause exists to grant the Motion and terminate the proceeding.

The parties request that the Settlement Agreement be treated as business confidential information and kept separate from the file of the ’027 patent. Paper 17, 1–2. After reviewing the Settlement Agreement, we find that it contains confidential business information about the settlement terms. Thus, good cause exists to treat the Settlement Agreement as business confidential information pursuant to 37 C.F.R. § 42.74(c), and we grant this part of the parties’ request.

The parties also “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.” Paper 17, 2. But the statute does not provide for any such notification or opportunity to respond. *See* 35 U.S.C. § 317(b). Nor does the regulation. *See* 37 C.F.R. § 42.74(c). Also, we see no persuasive reason or special circumstance here that would justify issuing an order that imposes these additional requirements. Thus, we deny that part of the parties’ joint request.

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

III. ORDER

It is
ORDERED that the Joint Motion to Terminate (Paper 16) is *granted*;
FURTHER ORDERED that the Joint Request (Paper 17) is *granted-in-part*, and the Settlement Agreement (Exhibit 1022) shall be treated as business confidential information, kept separate from the file of U.S. Patent No. 10,512,027 B2, and made available only to Federal Government agencies on written request, or to any person on a showing of good cause on written request, pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c);
and

FURTHER ORDERED that this proceeding is *terminated*.

IPR2022-000468
Patent 10,512,027

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