Trials@uspto.gov
Tel: 571-272-7822

Paper 13
Date: January 27, 2023

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

TELEFONAKTIEBOLAGET LM ERICSSON,
Patent Owner.

IPR2022-00648
Patent 9,860,044 B2

Before NATHAN A. ENGELS, SHARON FENICK, and STEPHEN E. BELISLE, *Administrative Patent Judges*.

ENGELS, *Administrative Patent Judge*.

TERMINATION
Due to Settlement After Institution of Trial
Granting Joint Request to Treat Settlement
Agreement as Business Confidential Information
35 U.S.C. § 317; 37 C.F.R. § 42.74

I. INTRODUCTION

Apple Inc. ("Petitioner") filed a Petition requesting an *inter partes* review of claims 1–11, 15–27, and 33–41 in U.S. Patent No. 9,860,044 B2 (Exhibit 1001, "the challenged patent") under 35 U.S.C. §§ 311–319. Paper 2. Telefonaktiebolaget LM Ericsson ("Patent Owner") filed a Preliminary Response. Paper 8.

The Board issued a Decision Granting Institution of *Inter Partes* Review. Paper 9.

After institution and after receiving Board authorization, Petitioner and Patent Owner filed a Joint Motion to Terminate Proceeding under 35 U.S.C. § 317(a) and 37 C.F.R. § 42.74. Paper 11. As Exhibit 1024, the parties filed a copy of an agreement titled "Global Patent License Agreement." The parties also filed a Joint Request to Treat Settlement Agreement as Business Confidential Information under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c). Paper 12.

II. DISCUSSION

The parties represent that they have reached a settlement as to all the disputes in this proceeding and as to the challenged patent. Paper 11, 2. The parties represent that a "true copy of the settlement agreement" is filed as Exhibit 1024. *Id.* The parties also represent that "[n]o other such agreements, written or oral, exist between or among" the parties. *Id.*

The parties assert that termination "would save significant further expenditure of resources by" the parties. *Id.* The parties assert that termination "would also further the purpose of *inter partes* review proceedings, which seek to provide an efficient and less costly alternative forum for patent disputes." *Id.* at 2–3. Additionally, the parties contend that

"maintaining the proceeding would discourage further settlements, as patent owners in similar situations would have a strong disincentive to settle if they perceived that an *inter partes* review would continue regardless of a settlement." *Id.* at 3.

This proceeding has not progressed very far. Patent Owner has not filed its Response. Terminating this proceeding will save the Board administrative and judicial resources, e.g., in conducting an oral argument and issuing a final written decision to decide the patentability issues raised in the Petition. Further, "[t]here are strong public policy reasons to favor settlement between the parties to a proceeding," and "[t]he 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." Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,768 (Aug. 14, 2012).

Under these circumstances, we determine that it is appropriate to terminate this proceeding. We also determine that it is appropriate to treat the parties' settlement agreement (Exhibit 1024) as business confidential information under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

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

III. ORDER

Accordingly, it is

ORDERED that the parties' Joint Motion to Terminate Proceeding (Paper 11) is granted;

FURTHER ORDERED that this proceeding is terminated as to all parties; and

FURTHER ORDERED that the parties' Joint Request to Treat Settlement Agreement as Business Confidential Information (Paper 12) is granted to the extent that the parties' settlement agreement (Exhibit 1024) shall be treated as business confidential information and be kept separate from the file of U.S. Patent No. 9,860,044 B2 and made available only under the provisions of 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

IPR2022-00648
Patent 9,860,044 B2

For PETITIONER:

Adam Seitz
Paul Hart
Jennifer Bailey
ERISE IP, P.A.
Adam.Seitz@eriseip.com
Paul.Hart@eriseip.com
Jennifer.Bailey@eriseip.com

For PATENT OWNER:

Peter Knops
Jason Wejnert
NOROOZI PC
peter@noroozipc.com
jason@noroozipc.com