

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC., HP INC., AMAZON.COM, INC., AMAZON.COM
SERVICES LLC, SAMSUNG ELECTRONICS CO., LTD., SAMSUNG
ELECTRONICS AMERICA, INC., GOOGLE LLC, DELL
TECHNOLOGIES INC. and DELL INC.,
Petitioner,

v.

XR COMMUNICATIONS LLC,
Patent Owner.

IPR2022-00367¹
Patent 10,715,235 B2

Before BARBARA A. PARVIS, JAMES J. MAYBERRY, and
NORMAN H. BEAMER *Administrative Patent Judges*.

MAYBERRY, *Administrative Patent Judge*.

TERMINATION

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

¹ Amazon.com, Inc., and Amazon.com Services LLC, which filed a petition in IPR2022-01353; Samsung Electronics Co., Ltd., Samsung Electronics America, Inc., and Google LLC, which filed a petition in IPR2022-01362, and Dell Technologies Inc. and Dell Inc., which filed a petition in IPR2022-01398, were joined as Petitioner in this proceeding.

I. INTRODUCTION

With the Board’s authorization, Apple Inc., HP Inc., Amazon.com, Inc., Amazon.com Services LLC, Samsung Electronics Co., Ltd., Samsung Electronics America, Inc., Google LLC, Dell Technologies Inc., and Dell Inc. (collectively, “Petitioners”), and XR Communications (“Patent Owner”) (collectively, “the Parties”) filed a Joint Motion to Terminate the above-captioned *inter partes* review proceeding. Paper 34 (“Joint Motion”), *see id.* at 1 (“The [P]arties were authorized to file this joint motion to terminate by the Board via emails on June 12 and 13, 2023”). 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. 10,715,235 B2 (“the ’235 patent”). Paper 35 (“Joint Request to Keep Separate”).

Along with the Joint Motion and Joint Request to Keep Separate, the Parties filed a copy of Confidential Settlement Agreements. Exs. 2017–2022 (“Settlement Agreements”).

II. DISCUSSION

A. *Joint Motion to Terminate*

Under 35 U.S.C. § 317(a), “[a]n *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.”

35 U.S.C. § 317(a) also provides that if no petitioner remains in the *inter partes* review, the Office may terminate the review.

The Parties state that they have jointly moved to dismiss the pending District Court litigation between them, and that they “do not contemplate

any future litigation or proceeding involving the ['235 patent] in the foreseeable future.” Joint Motion 2. The Parties indicate Exhibits 2017–2022 represents copies of the settlement agreements between the Parties, and “[t]here are other collateral agreements between the parties made in connection with, or in contemplation of, the termination sought.” *Id.* at 1.

We instituted trial for the above-identified *inter partes* review proceeding on July 14, 2022. *See* Paper 5. We have not yet decided the merits of the proceeding, and a final written decision has not been entered. Also, the Petitioners include the original and all joined petitioners to this proceeding. Under these circumstances and in view of the Parties’ settlement, we determine that good cause exists to terminate the proceeding.

B. Joint Request to Keep Separate

In the Joint Request to Keep Separate, the Parties request that the Settlement Agreements be treated as business confidential information, be kept separate from the file of the '235 patent, and be made available only as permitted pursuant to the provisions of 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c). Joint Request 1.

After reviewing the Settlement Agreements, we determine that good cause exists to treat the Settlement Agreements as business confidential information pursuant to 37 C.F.R. § 42.74(c), and we grant the Parties’ request in that regard.

III. ORDER

Accordingly, it is:

ORDERED that the Joint Motion to Terminate (Paper 34) is *granted*, and IPR2022-00367 is *terminated*; and

FURTHER ORDERED that the Parties' request to treat the Settlement Agreement as business confidential information (Paper 35) is *granted*, and the Settlement Agreements (Exs. 2017–2022) shall be kept separate from the file of U.S. Patent No. 10,715,235 B2, and made available only to Federal Government agencies on written request, or to any person on a showing of good cause, pursuant to 37 C.F.R. § 42.74(c).

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Patent 10,715,235 B2

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