

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD., SAMSUNG ELECTRONICS
AMERICA, INC., and QUALCOMM INCORPORATED,
Petitioner,

v.

DAEDALUS PRIME LLC,
Patent Owner.

IPR2023-00547 (Patent 10,705,588 B2)
IPR2023-00550 (Patent 8,775,833 B2)
IPR2023-00567 (Patent 10,049,080 B2)
IPR2023-00617 (Patent 8,898,494 B2)¹

Before WILLIAM V. SAINDON, THOMAS L. GIANNETTI,
ARTHUR M. PESLAK, and KRISTI L. R. SAWERT, *Administrative Patent
Judges.*²

PER CURIAM.

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

¹ The parties are not authorized to use this style caption.

² This is not an expanded panel. The panel for IPR2023-00547 and IPR2023-00550 includes Judges Saindon, Peslak, and Sawert. The panel for IPR2023-00567 and IPR2023-00617 includes Judges Saindon, Giannetti, and Sawert.

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I. INTRODUCTION

With the Board’s authorization, Petitioner (Qualcomm Incorporated) and Patent Owner (Daedalus Prime LLC) filed a Joint Motion to Terminate in each of the above-identified proceedings. Paper 21 (“Joint Motion”).³ In support of each Joint Motion, Petitioner and Patent Owner filed a copy of a Settlement Agreement (Ex. 1039) and request that the Settlement Agreement be treated as business confidential information pursuant to 37 C.F.R. § 42.74 (Paper 21, 3).

II. DISCUSSION

In the Joint Motions, Petitioner and Patent Owner represent that they have reached an agreement to jointly seek termination of the above-identified *inter partes* review proceedings and that the filed copy of the Settlement Agreement is a true and complete copy. Paper 21, 1–2; *see also* 37 C.F.R. § 42.74(b) (requiring a “true copy” of any agreement to be filed with the Board). Petitioner and Patent Owner state that “there are no other agreements or understandings between Patent Owner and Petitioner, or any collateral agreements referred to in the Agreement, made in connection with, or in contemplation of, the termination of the proceeding[s].” Paper 21, 1; *see also* 37 C.F.R. § 42.74(b) (requiring “*Any* agreement or understanding between the parties” to be filed with the Board (emphasis added)).

³ This decision cites to papers and exhibits in IPR2023-00547. Corresponding items were filed in IPR2023-00550, IPR2023-00567, and IPR2023-00617.

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Petitioner and Patent Owner also state that Settlement Agreement resolves all currently pending proceedings between Petitioner and Patent Owner involving the above-identified patents at issue. Paper 21, 1–2.

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.” Section 35 U.S.C. § 317(a) also provides that if no petitioner remains in the *inter partes* review, the Office may terminate the review. This proceeding is at an intermediate stage. The Parties have not filed substantive briefing after institution. We have not yet decided the merits of this proceeding, and a final written decision has not been entered in this proceeding. 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. Furthermore, there are strong public policy reasons to favor settlement between the parties to a proceeding. PATENT TRIAL AND APPEAL BOARD CONSOLIDATED TRIAL PRACTICE GUIDE, 84 Fed. Reg. 64,280 (Nov. 21, 2019). Under these circumstances, and in view of the Parties’ settlement and representations, we determine that good cause exists to terminate these proceedings.

Accordingly, we grant the Joint Motion in each proceeding.

Petitioner and Patent Owner also request that the Settlement Agreement be treated as business confidential information and be kept separate from the files of the patents involved in these *inter partes* review

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proceedings. Paper 21, 3. We have reviewed the Settlement Agreement, which contains confidential business information regarding the terms of settlement, and we determine that good cause exists to treat the Settlement Agreement as business confidential information and to keep them separate from the file of the patent in each the above-identified proceedings pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c). Accordingly, we grant the Parties request.

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

III. ORDER

Accordingly, for the reasons discussed above, it is:

ORDERED that the Joint Motion to Terminate in each of the above-identified proceedings is *granted*, and the proceedings are *terminated*;

FURTHER ORDERED that the Parties' request to treat the Settlement Agreement as business confidential information in each of the above-identified proceedings is *granted*, and the Settlement Agreement shall be kept separate from the files of U.S. Patents 10,705,588 B2; 8,775,833 B2; 10,049,080 B2; and 8,898,494 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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