

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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HUAWEI TECHNOLOGIES CO., LTD. and HUAWEI ENTERPRISE USA,  
Petitioner,

v.

SPHERIX INCORPORATED,  
Patent Owner.

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Case IPR2015-01390  
Patent 7,664,123 B2

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Before MICHAEL R. ZECHER, JENNIFER MEYER CHAGNON, and  
DANIEL J. GALLIGAN *Administrative Patent Judges*.

CHAGNON, *Administrative Patent Judge*.

DECISION  
Termination of the Proceeding  
*37 C.F.R. §§ 42.72, 42.74*

On September 18, 2015, the parties filed a Joint Motion to Terminate this proceeding (Paper 9), a copy of the parties' settlement agreement (Ex. 1008), and a Motion to Seal the settlement agreement (Paper 8). After reviewing the settlement agreement submitted by the parties, we informed the parties via email correspondence on September 21, 2015, that these papers were insufficient because the settlement agreement was redacted. *See* 35 U.S.C. § 317(b) (requiring a "true copy" of a settlement agreement be filed in the Office before the termination of an *inter partes* review); *see also* *APTwater, Inc. v. ThinkVillage-Kerfoot, LLC*, Cases IPR2014-00132, IPR2014-00133, slip op. at 2 (PTAB June 10, 2014) (Paper 17) ("A redacted version of the settlement agreement will not be accepted as a true copy of the settlement agreement."). We instructed the parties to file a non-redacted version of the settlement agreement. On September 21, 2015, the parties complied with our instructions by filing a renewed Joint Motion to Terminate (Paper 10), and a true copy of the parties' settlement agreement (Ex. 1009).<sup>1</sup> The renewed Joint Motion to Terminate also included a joint request to treat the settlement agreement as business confidential information under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c). Paper 10, 4.

This proceeding is still in its preliminary stages. Patent Owner, Spherix Incorporated, has not filed a Preliminary Response, and we have not yet entered a decision whether or not to institute an *inter partes* review. In the renewed Joint Motion to Terminate this proceeding, the parties represent that they have also settled the related district court case involving U.S. Patent No. 7,664,123 B2 ("the '123 patent"). Paper 10, 3. The parties also indicate that the '123 patent is not involved in any other proceedings currently before the Office. *Id.* Under these

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<sup>1</sup> The first-filed Joint Motion to Terminate this proceeding (Paper 9) and redacted settlement agreement (Ex. 1008) will be expunged from the record of this proceeding.

circumstances, we determine that it is appropriate to terminate this proceeding without rendering any further decisions. *See* 37 C.F.R. § 42.72.

Accordingly, it is:

ORDERED that the Motion to Seal Exhibit 1009 is GRANTED, and the parties' request that the settlement agreement (Ex. 1009) be treated as business confidential information, under the provisions of 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c), is GRANTED;

FURTHER ORDERED that, pursuant to 37 C.F.R. § 42.7(a), Paper 9 and Exhibit 1008 are EXPUNGED from the record of the instant proceeding; and

FURTHER ORDERED that the parties' renewed Joint Motion to Terminate this proceeding is GRANTED, and this proceeding is hereby terminated.

IPR2015-01390  
Patent 7,664,123 B2

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