

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

IMMERSION CORPORATION,
Patent Owner.

Case IPR2016-01603
Patent 8,581,710 B2

Before MICHAEL R. ZECHER, BRYAN F. MOORE, and MINN CHUNG,
Administrative Patent Judges.

CHUNG, *Administrative Patent Judge.*

JUDGMENT
Termination of Trial
37 C.F.R. §§ 42.72 and 42.73

On February 8, 2018, pursuant to our authorization, Petitioner, Apple Inc. (“Apple”), and Patent Owner, Immersion Corporation (“Immersion”), filed a Joint Motion to Terminate this *inter partes* review. Paper 38 (“Mot.”). With the Joint Motion, the parties filed a copy of their written settlement agreement covering various matters, including those involving the patent at issue in this proceeding. Ex. 2012. The parties concurrently filed a Joint Request to have the settlement agreement treated as confidential business information under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c). Paper 39.

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 patent owner, unless the Office has decided the merits of the proceeding before the request for termination is filed.” In this proceeding, we have not yet reached a decision on the merits with respect to the patentability of any involved claim. Accordingly, we must terminate the review with respect to Apple, as Petitioner.

Furthermore, “[i]f no petitioner remains in the *inter partes* review, the Office may terminate the review or proceed to a final written decision under section 318(a).” 35 U.S.C. § 317(a). We, therefore, have discretion to terminate this review with respect to Immersion.

In their Joint Motion, the parties assert that the settlement agreement resolves all underlying disputes between the parties involving U.S. Patent 8,581,710 B2 (Ex. 1001, “the ’710 patent”) at issue in this proceeding. Mot. 1. The parties also contend that termination of this proceeding will serve judicial economy by preserving the resources of the Board and the

parties and minimizing the financial and other costs associated with the various proceedings involving the '710 patent. *Id.* at 4–5.

At the outset, we note the extremely advanced nature of this *inter partes* review proceeding. The parties have completed all briefing, the Board has held an oral hearing, and the statutory deadline for rendering a Final Written Decision is approximately two weeks away. Nonetheless, under the particular circumstances of this case, we determine that termination with respect to Immersion is appropriate.

On January 29, 2018, the parties contacted the Board by email correspondence to inform the Board that the parties have reached an agreement to resolve their disputes, including settlement of the matters in controversy in this proceeding and other proceedings, and that they expect to seek authorization to file joint motions to terminate in the coming weeks. Hence, although the Joint Motion to Terminate this *inter partes* review was not filed until February 8, 2018, the parties informed the Board regarding the anticipated settlement in approximately one month prior to the statutory deadline for rendering a Final Written Decision. We do not suggest that a joint motion to terminate filed within a month from the statutory deadline will always be granted. Under the particular circumstance of this case, however, we determine that it is appropriate to terminate this *inter partes* review as to both Apple and Immersion without rendering a Final Written Decision. *See* 35 U.S.C. § 317(a); 37 C.F.R. § 42.72.

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Accordingly, it is

ORDERED that the parties' Joint Request (Paper 39) to have the settlement agreement (Ex. 2012) treated as confidential business information, kept separate from the file of the '710 patent, and made available only to Federal Government agencies on written request, or to any person on a showing of good cause, under the provisions of 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c), is *granted*;

FURTHER ORDERED that the Joint Motion to Terminate this proceeding (Paper 38) is *granted*; and

FURTHER ORDERED that this *inter partes* review is hereby *terminated*.

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