Trials@uspto.gov
571-272-7822

Paper 42
Entered: March 22, 2018

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

IMMERSION CORPORATION,
Patent Owner.

Case IPR2016-01907
Patent 7,808,488 B2

Before BRYAN F. MOORE, PATRICK R. SCANLON, and
MINN CHUNG, *Administrative Patent Judges.*

SCANLON, *Administrative Patent Judge.*

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

DOCKET ALARM
Find authenticated court documents without watermarks at docketalarm.com.

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 39 (“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. 2010. 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 40.

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 7,808,488 B2 (Ex. 1001, “the ’488 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

DOCKET ALARM Find authenticated court documents without watermarks at docketalarm.com.

parties and minimizing the financial and other costs associated with the various proceedings involving the ’488 patent. *Id.* at 4–5.

We note the advanced nature of this *inter partes* review proceeding. The parties have completed all briefing and the Board has held an oral hearing. The Joint Motion to Terminate, however, was filed approximately two months prior to the statutory deadline for rendering a Final Written Decision. Under the particular circumstance of this case, 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.

Accordingly, it is

ORDERED that the parties’ Joint Request (Paper 40) to have the settlement agreement (Ex. 2010) treated as confidential business information, kept separate from the file of the ’488 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 39) is *granted*; and

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

DOCKET ALARM
Find authenticated court documents without watermarks at docketalarm.com.

PETITIONER:

James Heintz
Jim.heintz@dlapiper.com

Brian Erickson
Brian.erickson@dlapiper.com

PATENT OWNER:

Michael Fleming
mfleming@irell.com

Babak Redjaian
bredjaian@irell.com

DOCKET ALARM
Find authenticated court documents without watermarks at docketalarm.com.