

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ZTE (USA) INC.,
Petitioner,

v.

PAPST LICENSING GMBH & CO. KG,
Patent Owner.

Case IPR2017-00713
Patent 6,895,449 B2

Before JONI Y. CHANG, JENNIFER S. BISK, and JAMES B. ARPIN,
Administrative Patent Judges.

BISK, *Administrative Patent Judge.*

JUDGMENT
Termination of Proceeding
37 C.F.R. § 42.73

Petitioner, ZTE (USA) Inc. (“ZTE”), and Patent Owner, Papst Licensing GmbH & Co. KG (“Papst”), jointly move to terminate this *inter partes* review in light of their settlement that resolves their dispute regarding U.S. Patent No. 6,895,449 B2 (“the ’449 patent”). Paper 14 (“Mot.”). The parties also filed a true copy of their written settlement agreement in connection with the termination as required by 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b). Ex. 2007. Pursuant to 37 C.F.R. § 42.74(c), the parties additionally filed a joint request to treat the Settlement Agreement as business confidential information kept separate from the file of the involved patent. Paper 15.

For the reasons set forth below, the Joint Motion to Terminate with respect to ZTE and the Joint Request to File Settlement Agreement as Business Confidential Information are *granted*.

Under the Leahy-Smith America Invents Act, settlement between the parties to a proceeding is encouraged. Notably, 35 U.S.C. § 317(a), in part, provides the following (emphasis added):

(a) IN GENERAL.—An 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. If the inter partes review is terminated with respect to a petitioner under this section, *no estoppel under section 315(e) shall attach to the petitioner*, or to the real party in interest or privy of the petitioner, on the basis of that petitioner’s institution of that inter partes review.

Here, the parties indicate that their Settlement Agreement resolves the controversy between the parties relating to the involved patent. Mot. 3. Although this *inter partes* review has been instituted, the proceeding is still in the briefing stage. We have not yet held an oral hearing and have not

IPR2017-00713
Patent 6,895,449 B2

entered a final written decision in this proceeding.

Upon review of the procedural posture of this proceeding and the facts before us, we determine that it is appropriate to terminate this proceeding.

In consideration of the foregoing, it is hereby:

ORDERED that the Joint Motion to Terminate is *granted*;

FURTHER ORDERED that this review is terminated as to all parties including ZTE and Papst; and

FURTHER ORDERED that the Joint Request to File Settlement Agreement as Business Confidential Information and to keep such settlement agreement separate from the patent file, and to make it available only to Federal Government agencies on written request, or to any person on a showing of good cause, pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c), is *granted*.

For PETITIONER:

Scott Miller
Darren Franklin
SHEPPARD, MULLIN, RICHTER & HAMPTON LLP
smiller@sheppardmullin.com
dfranklin@sheppardmullin.com

For PATENT OWNER:

Nicholas T. Peters
Paul Henkelmann
FITCH, EVEN, TABIN & FLANNERY LLP
ntpete@fitcheven.com
phenkelmann@fitcheven.com