

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ERICSSON INC. AND
TELEFONAKTIEBOLAGET LM ERICSSON,
Petitioner,

v.

INTELLECTUAL VENTURES II LLC,
Patent Owner.

Case IPR2018-01380
Patent 8,682,357 B2

Before BRIAN J. McNAMARA, DAVID C. MCKONE, and
AMBER L. HAGY, *Administrative Patent Judges*.

HAGY, *Administrative Patent Judge*.

TERMINATION

Settlement After Institution of Trial
35 U.S.C. § 317 and 37 C.F.R. §§ 42.72, 42.74

I. DISCUSSION

Upon Board authorization, Ericsson Inc. and Telefonaktiebolaget LM Ericsson (collectively, “Ericsson” or “Petitioner”) and Intellectual Ventures II LLC (“Intellectual Ventures” or “Patent Owner”) filed a Joint Motion To Terminate this *inter partes* review on June 13, 2019. Paper 14 (“Mot.”). Along with the Joint Motion, the parties filed a copy of a document they describe as “a true copy” (*id.* at 3) of their written settlement agreement (Exhibit 1026) covering various matters, including those involving the patent at issue in this proceeding. The parties certify that there are no other agreements or understandings, oral or written, between the parties, including any collateral agreements, made in connection with, or in contemplation of, the termination of this proceeding. Mot. 4. The parties also filed 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 15.

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 Ericsson, 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 Intellectual Ventures.

Although a Decision on Institution instituting trial was entered on January 14, 2019 (Paper 7), we have not held an oral hearing and we have not entered a Final Written Decision on the merits in this proceeding. In their Joint Motion, the parties represent that the settlement agreement resolves “all the disputes in this proceeding.” Mot. 3. When, as here, we have not entered a Final Written Decision on the merits, we generally will terminate the trial after the filing of a settlement agreement. *See* Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,768 (Aug. 14, 2012). Under the particular circumstances of this case, we determine that it is appropriate to terminate this *inter partes* review as to both Ericsson and Intellectual Ventures without rendering a Final Written Decision. *See* 35 U.S.C. § 317(a); 37 C.F.R. § 42.72.

After reviewing the parties’ settlement agreement, we find the settlement agreement contains business confidential information regarding the terms of the settlement and good cause exists to treat the settlement agreement as business confidential information under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

II. ORDER

Accordingly, it is

ORDERED that the parties’ joint request (Paper 15) to treat the parties’ settlement agreement as business confidential information is *granted*;

FURTHER ORDERED that the settlement agreement (Exhibit 1026) shall be treated as business confidential information, kept separate from the file of the ’357 patent, and made available only to Federal Government

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agencies on written request to the Board, 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);

FURTHER ORDERED that the Joint Motion to Terminate this *inter partes* review (Paper 14) is *granted*; and

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

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