

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NOKIA OF AMERICA CORPORATION,
Petitioner,

v.

INTELLECTUAL VENTURES II LLC,
Patent Owner.

Case IPR2018-01641
Patent 8,897,828 B2

Before KRISTEN L. DROESCH, MICHAEL W. KIM, and
JASON W. MELVIN, *Administrative Patent Judges*.

MELVIN, *Administrative Patent Judge*.

ORDER

Granting Joint Motion to Terminate Proceeding Due to
Settlement after Institution and
Granting Joint Request to Treat Settlement Agreement as
Business Confidential Information
35 U.S.C. § 317; 37 C.F.R. §§ 42.72, 42.74

I. INTRODUCTION

Petitioner and Patent Owner (collectively “the Parties”) have requested that the above-identified *inter partes* review proceeding be terminated pursuant to a settlement. On April 29, 2019, we authorized the Parties via email to file a joint motion to terminate the above-identified proceeding. Exhibit 1059. On April 29, 2019, the Parties filed a Joint Motion to Terminate the above-identified proceeding (“Joint Motion”). Paper 10. The Parties filed a Patent License Agreement (Exhibit 1061, “Settlement Agreement”) and filed a Joint Request that Settlement Agreement Be Treated as Business Confidential Information and Kept Separate (“Joint Request”). Paper 11.

II. DISCUSSION

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 the patent owner, unless the Office has decided the merits of the proceeding before the request for termination is filed.” It is also provided in 35 U.S.C. § 317(a) that if no petitioner remains in the *inter partes* review, the Office may terminate the review.

In the Joint Motion, the Parties represent that they have reached an agreement to jointly seek termination of this *inter partes* review proceeding, that the filed copy of the Settlement Agreement is a true copy, and there are no other written or oral agreements. Joint Motion 1–4. Further, the Settlement Agreement indicates it is a complete agreement. Settlement Agreement 22. The Parties also represent that their settlement agreement resolves all currently pending Patent Office and District Court proceedings between the Parties involving Patent 8,897,828. Joint Motion 3.

We instituted a trial on the above-identified proceeding on March 20, 2019. Paper 7. We have not yet decided the merits of the proceeding, and a final written decision has not been entered. Notwithstanding that the proceeding has moved beyond the preliminary stage, the Parties have shown adequately that the termination of the proceeding is appropriate. Under these circumstances, we determine that good cause exists to terminate the proceeding with respect to the Parties.

The Parties also requested that the Settlement Agreement be treated as business confidential information and be kept separate from the file of Patent 8,897,828. Joint Request 1. The Parties failed to make an express showing in the Joint Request to support characterizing the Settlement Agreement as containing business confidential information. However, after reviewing the Settlement Agreement between Petitioner and Patent Owner, we find that the Settlement Agreement contains confidential business information regarding the terms of settlement. We determine that good cause exists to treat the Settlement Agreement between Petitioner and Patent Owner as business confidential information pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

This Order does not constitute a final written decision pursuant to 35 U.S.C. § 318(a).

III. ORDER

Accordingly, for the reasons discussed above, it is:

ORDERED that the Joint Motion to Terminate is *granted*, and IPR2018-01641 is *terminated* with respect to Petitioner and Patent Owner, pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. § 42.72; and

FURTHER ORDERED that the Joint Request to File Settlement

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Agreement as Business Confidential Information is *granted*, and the Settlement Agreement shall be kept separate from the file of Patent 8,897,828, and made 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).

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