

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

QUALCOMM INC. and QUALCOMM TECHNOLOGIES, INC.,
Petitioner,

v.

APPLE INC.,
Patent Owner.

Cases

IPR2019-00321 (Patent 8,271,812 B2)
IPR2019-00322 (Patent 8,443,216 B2)
IPR2019-00325 (Patent 8,656,196 B2)¹

Before KRISTEN L. DROESCH, MICHAEL R. ZECHER, and
TREVOR M. JEFFERSON, *Administrative Patent Judges*.

JEFFERSON, *Administrative Patent Judge*.

DECISION

Granting the Parties' Joint Motions to Dismiss Proceeding
37 C.F.R. §§ 42.71(a) and 42.74

¹ This Decision addresses an issue that is identical in all three cases. We, therefore, exercise our discretion to issue one Decision to be filed in each case.

IPR2019-00321 (Patent 8,271,812 B2)

IPR2019-00322 (Patent 8,443,216 B2)

IPR2019-00325 (Patent 8,656,196 B2)

I. DISCUSSION

The parties filed the following in each proceeding identified above: (1) a Joint Motion to Dismiss Proceeding (Case IPR2019-00321, Paper 7; Case IPR2019-00322, Paper 7; Case IPR2019-00325, Paper 8); (2) a true copy of the parties' settlement agreement (Case IPR2019-00321, Paper 8; Case IPR2019-00322, Paper 8; Case IPR2019-00325, Paper 9)²; and (3) a joint request to treat the settlement agreement as business confidential information, and to keep separate from the file of the involved patent, under 37 C.F.R. § 42.74(c) (Case IPR2019-00321, Paper 9; Case IPR2019-00322, Paper 9; Case IPR2019-00325, Paper 10).

These proceedings are still in their preliminary stages. Petitioner, Qualcomm Inc. and Qualcomm Technologies, Inc. (collectively, "Qualcomm"), filed (1) a Petition requesting an *inter partes* review of claims 8 and 9 of U.S. Patent No. 8,271,812 B2 ("the '812 patent"), (2) a Petition requesting an *inter partes* review of claims 1–3, 6, 8–10, and 13 of U.S. Patent No. 8,443,216 B2 ("the '216 patent"), and (3) a Petition requesting an *inter partes* review of claims 1–3, 7, and 8 of U.S. Patent No. 8,656,196 B2 ("the '196 patent"). Case IPR2019-00321, Paper 1; Case IPR2019-00322, Paper 1; Case IPR2019-00325, Paper 1. Patent Owner, Apple Inc. ("Apple"), filed a Preliminary Response to each Petition. Case IPR2019-00321, Paper 6; Case IPR2019-00322, Paper 6; Case IPR2019-00325, Paper 7. In each proceeding, however, we have not entered a decision whether to institute an *inter partes* review.

² In each case, the parties filed the true copy of their settlement agreement as a paper, rather than as a separate exhibit. The parties should have filed the true copy of their settlement agreement as a separate exhibit in accordance with 37 C.F.R. § 42.63(a) ("Evidence consists of affidavits, transcripts of depositions, documents, and things. All evidence must be filed in the form of an exhibit.").

IPR2019-00321 (Patent 8,271,812 B2)

IPR2019-00322 (Patent 8,443,216 B2)

IPR2019-00325 (Patent 8,656,196 B2)

In the Joint Motions to Dismiss Proceeding, the parties indicate that they have settled all their disputes regarding the '812 patent, the '216 patent, and the '196 patent, and they have agreed to dismiss each of the aforementioned Petitions. Case IPR2019-00321, Paper 7, 1; Case IPR2019-00322, Paper 7, 1; Case IPR2019-00325, Paper 8, 1. The parties represent that the settlement encompasses, among other things, these three proceedings and the related district court case where Qualcomm asserted the '812 patent, the '216 patent, and the '196 patent against Apple. Case IPR2019-00321, Paper 7, 3–4; Case IPR2019-00322, Paper 7, 3–4; Case IPR2019-00325, Paper 8, 3–4. In each case, the parties also state that “[t]here are no other pending litigations or any other proceedings between [Qualcomm] and [Apple] relating to” the patents at issue in each case. Case IPR2019-00321, Paper 7, 4; Case IPR2019-00322, Paper 7, 4; Case IPR2019-00325, Paper 8, 4.

Under these particular circumstances, we determine that it is appropriate to dismiss all three Petitions without rendering any further decisions, thereby terminating these proceedings. *See* 37 C.F.R. § 42.71(a). We also have reviewed the true copy of the parties’ settlement agreement, and we determine that good cause exists to treat this settlement agreement as business confidential information, and keep it separate from the file of the involved patent, under 37 C.F.R. § 42.74(c).

IPR2019-00321 (Patent 8,271,812 B2)

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IPR2019-00325 (Patent 8,656,196 B2)

II. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that the parties' requests to treat the true copy of their settlement agreement filed in each proceeding (Case IPR2019-00321, Paper 8; Case IPR2019-00322, Paper 8; Case IPR2019-00325, Paper 9) as business confidential information, and to keep separate from the file of the involved patent, under 37 C.F.R. § 42.74(c) are *granted*; and

FURTHER ORDERED that the parties' Joint Motions to Dismiss Proceeding are *granted*, and the Petitions filed in Case IPR2019-00321, Case IPR2019-00322, and Case IPR2019-00325 are dismissed resulting in termination of these proceedings.

IPR2019-00321 (Patent 8,271,812 B2)

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