

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ERICSSON INC.,
Petitioner,

v.

ELECTRONICS AND TELECOMMUNICATIONS RESEARCH INSTITUTE,
Patent Owner.

IPR2020-00237 (Patent 8,320,337 B2) IPR2020-00238 (Patent 8,593,936 B2)
IPR2020-00239 (Patent 9,204,438 B2) IPR2020-00240 (Patent 9,496,976 B2)
IPR2020-00241 (Patent 9,888,435 B2) IPR2020-00242 (Patent 10,080,204 B2)
IPR2020-00243 (Patent 8,971,168 B2) IPR2020-00244 (Patent 8,971,168 B2)
IPR2020-00249 (Patent 8,270,354 B2) IPR2020-00250 (Patent 9,265,063 B2)
IPR2020-00251 (Patent 9,603,174 B2) IPR2020-00252 (Patent 9,155,066 B2)
IPR2020-00253 (Patent 8,761,814 B2)¹

Before KRISTEN L. DROESCH, TREVOR M. JEFFERSON, and
SCOTT B. HOWARD, *Administrative Patent Judges*.

DROESCH, *Administrative Patent Judge*.

DECISION
Settlement Prior to Institution of Trial
37 C.F.R. § 42.74

¹ This Decision applies to each case listed.

IPR2020-00237 (Patent 8,320,337 B2) IPR2020-00238 (Patent 8,593,936 B2)
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Pursuant to our e-mail authorization on February 27, 2020, in each of the above-captioned preliminary proceedings, Petitioner filed an Unopposed Motion to Dismiss (“Motion”) (*see* Appendix), and Petitioner and Patent Owner² filed a Joint Request to File Settlement Agreement as Business Confidential Information (“Joint Request”) (*see id.*). Pursuant to 37 C.F.R. § 42.74(b), a copy of a written settlement and license agreement (“Settlement Agreement”) has been filed in each proceeding (*see id.*).³

Petitioner represents in its Motions that it has settled its disputes with Patent Owner and memorialized the settlement in the written Settlement Agreement submitted in each case. *E.g.*, IPR2020-00237, Paper 7, 1. In each Motion, Petitioner represents that the Settlement Agreement resolves the disputes between the parties in the above-captioned preliminary proceedings and the related lawsuits.

² The parties assert that Electronics and Telecommunications Research Institute (ETRI) “is the patentee with the right to license certain patents relating to Cellular and WLAN Standards, and has granted an exclusive license in some of such patents to Sol IP,” including the patents at issue in the above-captioned preliminary proceedings. *E.g.*, IPR2020-00237, Ex. 1038, 1. Petitioner asserts that ETRI, by and through its licensing agent SOL IP, LLC, has made allegations in related district court litigation about one or more of the patents at issue in the above-captioned preliminary proceedings. *See, e.g.*, Petition for *Inter Partes* Review, IPR2020-00253, Paper 2, 1.

³ In each of the above preliminary proceedings except for IPR2020-00237, the parties filed the Settlement Agreement as a Paper rather than as an Exhibit. We deem this to be harmless error; however, the parties are reminded that such a document must be filed as an Exhibit. *See* 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.”).

IPR2020-00237 (Patent 8,320,337 B2) IPR2020-00238 (Patent 8,593,936 B2)
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Id. Petitioner asserts that the Settlement Agreement is a true and correct copy and that there are no other agreements, oral or written, between the parties made in connection with, or in contemplation of, the termination of these preliminary proceedings. *Id.* at 2. In each Motion, Petitioner asserts that it has conferred with Patent Owner and that Patent Owner does not oppose the relief requested in the Motion. *Id.* at 1.

Each of these proceedings is in its preliminary phase, Patent Owner has not yet filed a Preliminary Response, and we have not yet reached the merits in each preliminary proceeding by issuing a decision on institution.

There are strong public policy reasons to favor settlement between the parties to a proceeding. *Office Patent Trial Practice Guide*, 84 Fed. Reg. 64,280 (Nov. 21, 2019). In the circumstances present here, we determine that it is appropriate to dismiss each of these petitions without rendering a decision on institution or a final written decision. *See* 37 C.F.R. § 42.72.

We also grant the Joint Request to treat the Settlement Agreement as business confidential information filed in each case, as authorized under 37 C.F.R. § 42.74(c).

Accordingly, it is:

ORDERED that the Motion to Dismiss in each of the following preliminary proceedings is *granted*, and each of the petitions are DISMISSED:

IPR2020-00237, Paper 7,
IPR2020-00238, Paper 7,
IPR2020-00239, Paper 10,

IPR2020-00237 (Patent 8,320,337 B2) IPR2020-00238 (Patent 8,593,936 B2)
IPR2020-00239 (Patent 9,204,438 B2) IPR2020-00240 (Patent 9,496,976 B2)
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IPR2020-00253 (Patent 8,761,814 B2)

IPR2020-00240, Paper 7,
IPR2020-00241, Paper 10,
IPR2020-00242, Paper 9,
IPR2020-00243, Paper 7,
IPR2020-00244, Paper 7,
IPR2020-00249, Paper 7,
IPR2020-00250, Paper 7,
IPR2020-00251, Paper 7,
IPR2020-00252, Paper 8, and
IPR2020-00253, Paper 8; and

FURTHER ORDERED that the Joint Request to File Settlement Agreement as Business Confidential Information in each of the following preliminary proceedings is *granted*, that the Settlement Agreement shall remain designated as “Parties and Board Only” in Board’s filing system, shall made available only to Federal Government agencies on written request, or to any person on a showing of good cause, and shall be kept separate from the files of the related patent:

IPR2020-00237 (Paper 8, Ex. 1038)
IPR2020-00238 (Papers 8, 9),
IPR2020-00239 (Papers 11, 12),
IPR2020-00240 (Papers 8, 9),
IPR2020-00241 (Papers 11, 12),
IPR2020-00242 (Papers 10, 11),
IPR2020-00243 (Papers 8, 9),

IPR2020-00237 (Patent 8,320,337 B2) IPR2020-00238 (Patent 8,593,936 B2)
IPR2020-00239 (Patent 9,204,438 B2) IPR2020-00240 (Patent 9,496,976 B2)
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IPR2020-00244 (Papers 10, 11),
IPR2020-00249 (Papers 8, 9),
IPR2020-00250 (Papers 8, 9),
IPR2020-00251 (Papers 8, 9),
IPR2020-00252 (Papers 9, 10), and
IPR2020-00253 (Papers 9, 10).

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