

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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DELL INC., ZTE (USA) INC., and ZTE CORPORATION,  
Petitioner

v.

3G LICENSING S.A.,  
Patent Owner.

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IPR2020-01157 (Patent 7,274,933 B2)  
IPR2020-01158 (Patent 7,460,868 B2)  
IPR2020-01159 (Patent 7,596,375 B2)  
IPR2020-01160 (Patent 8,275,374 B2)  
IPR2020-01161 (Patent 8,472,955 B2)  
IPR2020-01162 (Patent 8,948,756 B2)<sup>1</sup>

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Before TERRENCE W. MCMILLIN, AMANDA F. WIEKER,  
MONICA S. ULLAGADDI, and RUSSELL E. CASS,  
*Administrative Patent Judges.*

WIEKER, *Administrative Patent Judge.*

TERMINATION  
Due to Settlement After Institution of Trial  
*37 C.F.R. § 317; § 42.74*

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<sup>1</sup> This Order addresses issues that are the same in the above-captioned proceedings. The parties are not authorized to use a multi-case caption. Moreover, this is not an expanded panel. Each of the four listed judges are part of three-judge panels assigned to the listed proceedings.

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## I. INTRODUCTION

On August 24, 2021, ZTE Corporation, ZTE (USA) Inc., and Patent Owner (hereinafter “Joint Movants”) filed, in each of the above-identified proceedings, a Joint Motion to Terminate the Proceeding and Reconstitute Petitioner as Dell Inc. due to settlement. *See, e.g.*, IPR2020-01157, Paper 32 (“Motion”).<sup>2</sup> The Joint Movants also filed, on August 24, 2021, a true copy of a settlement agreement and a Joint Request that the Settlement Agreement be Treated as Business Confidential Information and be Kept Separate under 35 U.S.C. § 317(b). *See, e.g.*, IPR2020-01157, Ex. 2012 (“Settlement Agreement”), Paper 33 (“Request”).

## II. DISCUSSION

The Motion states: “[T]he ZTE entities [i.e., ZTE Corporation and ZTE (USA) Inc. (*see* Motion, 1)] and Patent Owner entered into a settlement agreement resolving their disputes in connection with the involved patent.” *Id.* at 3. The Motion also states: “Pursuant to 35 U.S.C. § 317(b), filed concurrently herewith as Ex. 2012 is a true copy of the settlement agreement entered between Patent Owner and the ZTE entities on August 4, 2021.” *Id.* at 4. The Motion further states: “The ZTE entities and Patent Owner certify that there are no collateral agreements or understandings made in connection with, or in contemplation of, the termination of the *inter partes* review.” *Id.* The Motion requests termination of the proceedings with respect to the ZTE entities. *Id.* at 5.

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<sup>2</sup> For purposes of expediency, we cite to papers and exhibits filed in IPR2020-01157, unless otherwise noted. The Parties filed similar papers and exhibits in each of the above-identified proceedings.

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Generally, the Board expects that a proceeding will terminate after the filing of a settlement agreement, unless the Board has already decided the merits of the proceeding. PTAB Consolidated Trial Practice Guide, 86 (November 2019).<sup>3</sup> Here, although the Board has instituted *inter partes* review of the challenged patents, the Board has not decided the merits of these proceedings. Under these circumstances, we grant the Motion to terminate each proceeding, with respect to the ZTE entities. Accordingly, Petitioner is reconstituted as Dell Inc.

Additionally, in the Request, the Joint Movants:

jointly request that the settlement agreement be kept as a separate paper to be made available only under the provisions of 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c). The settlement agreement has been filed for access “Access only the board.” The Joint Movants further jointly request that the Board order that in the event a person or entity makes a written request, as stated in 37 C.F.R. § 42.74(c)(1)-(2), for access to the settlement agreement, that any such written request be served upon the parties on the day the written request is provided to the Board.

Paper 33, 1. We grant-in-part the Request. The Settlement Agreement in each proceeding shall be kept separate from the files of U.S. Patent No. 7,274,933 B2, U.S. Patent No. 7,460,868 B2, U.S. Patent No. 7,596,375 B2, U.S. Patent No. 8,275,374 B2, U.S. Patent No. 8,472,955 B2, and U.S. Patent No. 8,948,756 B2, and will be made available only under the provisions of 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

However, we deny the portion of the Request seeking an order from the Board that, in the event a person or entity makes a written request as stated in

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<sup>3</sup> Available at <https://www.uspto.gov/TrialPracticeGuideConsolidated>.

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37 C.F.R. § 42.74(c)(1)–(2) for access to the Settlement Agreement, any such written request be served upon the parties on the day the written request is provided to the Board. Neither the statute nor the rule includes such a requirement.

### III. ORDER

In view of the foregoing, it is:

ORDERED that the Joint Motion to Terminate the Proceeding and Reconstitute Petitioner as Dell Inc. in each of the above-identified proceedings is *granted* with respect to ZTE Corporation and ZTE (USA) Inc., and that ZTE Corporation and ZTE (USA) Inc. are herein terminated from these proceedings;

FURTHER ORDERED that the Joint Request that the Settlement Agreement be Treated as Business Confidential Information and be Kept Separate under 35 U.S.C. § 317(b) in each of the above-identified proceedings is *granted-in-part and denied-in-part*, in the manner noted above; and

FURTHER ORDERED that the Settlement Agreement in each proceeding shall be kept separate from the files of U.S. Patent No. 7,274,933 B2, U.S. Patent No. 7,460,868 B2, U.S. Patent No. 7,596,375 B2, U.S. Patent No. 8,275,374 B2, U.S. Patent No. 8,472,955 B2, and U.S. Patent No. 8,948,756 B2, and will be made available only under the provisions of 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

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