

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HTC CORPORATION and HTC AMERICA, INC.,
Petitioner,

v.

NFC TECHNOLOGY, LLC,
Patent Owner.

Case IPR2014-01198
Patent 6,700,551 B2

Before JAMES B. ARPIN, NEIL T. POWELL, and
BART A. GERSTENBLITH, *Administrative Patent Judges*.

ARPIN, *Administrative Patent Judge*.

DECISION
Termination of the Proceeding
37 C.F.R. §§ 42.72 and 42.74

I. DISCUSSION

Petitioner filed a Petition for *inter partes* review on July 24, 2014. Paper 1. We issued a Final Written Decision on February 3, 2016. Paper 56. Petitioner appealed the Final Written Decision to the U.S. Court of Appeals for the Federal Circuit (“the Federal Circuit”). See Paper 58. Petitioner filed a motion to withdraw from the Federal Circuit appeal on November 9, 2016. On November 10, 2016, the U.S. District Court for the Eastern District of Texas granted a joint motion by the Parties to dismiss, with prejudice, the action between the Parties in that court relating to U.S. Patent No. 6,700,551 B2 (Ex. 1001, “the ’551 patent”). Paper 8, 2. The Federal Circuit granted Petitioner’s motion to withdraw from the appeal on November 15, 2016. On September 30, 2017, the Federal Circuit issued its decision in *NFC Technology, LLC v. Matal*, reversing our decision with respect to the issue of inurement and remanding this case to us “to determine whether [Patent Owner] presented sufficient evidence that the prototype embodied the claimed invention.” 871 F.3d 1367, 1368 (Fed. Cir. 2017). The Federal Circuit issued the Mandate returning jurisdiction to the Board on November 13, 2017. See Paper 59, 1.

Pursuant to Patent Trial and Appeal Board Standard Operating Procedure (“PTAB SOP”) 9, we conducted a conference call with the parties on December 6, 2017, to discuss remand procedures. During that conference call, the Parties jointly requested our authorization to file (1) a joint motion to terminate this proceeding pursuant to 35 U.S.C. § 317 and 37 C.F.R. § 42.74, (2) a true copy of the Parties’ settlement agreement, and (3) a joint request to file the settlement agreement as business confidential information pursuant to 35 U.S.C. § 317(b), in this proceeding. On December 11, 2017, we granted the Parties’ authorization requests. Paper 59, 3.

On December 19, 2017, the Parties filed a Joint Motion to Terminate Proceedings (Paper 60), a true copy of the Parties' settlement agreement (Ex. 2047), and a Joint Request That Settlement Agreement be Treated as Business Confidential Information and Kept Separate Under 37 C.F.R. § 42.74(c) (Paper 61). In the Joint Motion to Terminate this proceeding, the Parties represent that they have resolved all of their underlying disputes, including those regarding the '551 patent. Paper 60, 1. The Parties further represent that "there are no other collateral agreements between Petitioner and Patent Owner and that Exhibit 2047 represents a true and accurate copy of the Confidential Agreement between the parties" that resolves all underlying disputes between the Parties, including the present proceeding. *Id.* Under these circumstances, we determine that it is appropriate to terminate this proceeding without rendering any further decision. *See* 37 C.F.R. § 42.72.

II. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that the Parties' Joint Request That Settlement Agreement [Ex. 2047] be Treated as Business Confidential Information and Kept Separate Under 37 C.F.R. § 42.74(c) (Paper 61) is *granted*; and

FURTHER ORDERED that the Joint Motion to Terminate Proceedings (Paper 60) is *granted*, and this proceeding is hereby terminated.

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PETITIONER:

Bing Ai
Matthew Bernstein
Miguel Bombach
Thomas N. Millikan
PERKINS COIE LLP
Ai-ptab@perkinscoie.com
mbernstein@perkinscoie.com
MBombach@perkinscoie.com
TMillikan@perkinscoie.com
Perkins-Service-HTC-NFC-IPR@perkinscoie.com

PATENT OWNER:

Jon E. Wright
John H. Curry
Amirali Sharifi
STERNE, KESSLER, GOLDSTAIN & FOX P.L.L.C.
Jwright-PTAB@skgf.com
jcurry-PTAB@skgf.com
asharifi-PTAB@skgf.com

Robert Auchter
MCKOOL SMITH, P.C.
rauchter@McKoolSmith.com