

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

QUALCOMM TECHNOLOGIES, INC. and
QUALCOMM INCORPORATED,
Petitioner,

v.

PROGRESSIVE SEMICONDUCTOR SOLUTIONS LLC,
Patent Owner.

Case IPR2014-01504 (Patent 6,862,208)¹
Case IPR2014-01541 (Patent 6,473,349)

Before MATTHEW R. CLEMENTS, ZHENYU YANG, and
ROBERT J. WEINSCHENK, *Administrative Patent Judges*.

CLEMENTS, *Administrative Patent Judge*.

DECISION
Joint Motion to Terminate
37 C.F.R. § 42.72

¹ This Order addresses an issue pertaining to both cases. Therefore, we exercise our discretion to issue one Order to be filed in each case. The parties are not authorized to use this style heading for any subsequent papers.

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On December 18, 2014, the parties filed a joint motion to terminate the trial proceedings under 35 U.S.C. § 317(a). Paper 10.² Along with the motion, the parties filed a Joint Request to File a True Copy of the Settlement Agreement as Business Confidential Information Pursuant to 35 U.S.C. § 317 (Paper 11), and filed copy of a document they described as the written settlement agreement (Exhibit 3001).

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 patent owner, unless the Office has decided the merits of the proceeding before the request for termination is filed.” The parties state in their motion that they have settled their dispute and have reached agreement to terminate this inter partes review and the co-pending litigation. Paper 10, 2. The parties state that Patent Owner filed a stipulation of dismissal in the co-pending litigation on December 12, 2014, and that the district court entered an order dismissing the litigation on December 15, 2014. *Id.* The parties state that there is no other pending litigation in which either of the patents-at-issue is asserted. *Id.* at 3.

The parties are reminded that the Board is not a party to the settlement, and may independently identify any question of patentability. 37 C.F.R § 42.74(a). Generally, however, the Board expects that a proceeding will terminate after the filing of a settlement agreement. *See, e.g.,* Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,768 (Aug. 14, 2012). These proceedings are still in the preliminary stages. For example, Patent Owner’s Preliminary Responses have not yet been filed, and

² Citations are to IPR2014-01504 unless otherwise noted. Equivalent papers were filed in IPR2014-01541.

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no decision on institution has been entered. The Board is persuaded that, under these circumstances, it is appropriate to terminate this proceeding without rendering a final written decision. 37 C.F.R. § 42.72.

ORDER

Accordingly, it is:

ORDERED that the joint motion to terminate this proceeding is GRANTED and this proceeding is hereby terminated; and

FURTHER ORDERED that the parties' joint request that the settlement agreement (Exhibit 3001) be treated as business confidential information, kept separate from the file of the involved patent, and made available only to Federal Government agencies on written request, or to any person on a showing of good cause, under the provisions of 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c), is GRANTED.

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