

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

YOZMOT 33 LTD.,
Patent Owner

Case IPR2015-00761
Patent 6,449,359 B1

Before MICHAEL R. ZECHER, PATRICK R. SCANLON, and
DANIEL J. GALLIGAN, *Administrative Patent Judges*.

GALLIGAN, *Administrative Patent Judge*.

DECISION

Termination of the Proceeding

35 U.S.C. § 317, 37 C.F.R. §§ 42.72 and 42.74

I. DISCUSSION

On March 23, 2016, the parties filed a Joint Motion to Terminate this proceeding (Paper 12), as well as a Joint Request (Paper 13) to have their settlement agreement treated as business confidential information under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c). The parties also filed a true copy of their written settlement agreement. Ex. 1014. The parties indicated in their Joint Motion that termination of this proceeding is appropriate because they settled their dispute with respect to U.S. Patent No. 6,449,359 B1 (“the ’359 patent”). Paper 12, 2. The parties did not identify any pending related United States district court litigation involving the ’359 patent, let alone any other pending proceedings before the Office. *See id.* at 1–2.

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.”

Generally, the Board expects that a proceeding will terminate after the filing of a settlement agreement, if the settlement agreement includes all parties. *See, e.g., Office Patent Trial Practice Guide*, 77 Fed. Reg. 48,756, 48,768 (Aug. 14, 2012). The parties have filed such an agreement. Ex. 1014.

Although we have instituted a trial as to claims 1, 3, 5, 7, 8, 12, and 18–20 of the ’359 patent (Paper 5) and Patent Owner has filed a Response (Paper 7), Petitioner has indicated it will not file a Reply and it will not participate in an oral hearing (Paper 12, 3). Under these circumstances, we are persuaded that it is appropriate to terminate this proceeding with respect to both Petitioner and Patent Owner.

Further, under 37 C.F.R. § 42.74(b), “[a]ny agreement or understanding between the parties made in connection with, or in contemplation of, the termination of a proceeding shall be in writing and a true copy shall be filed with the Board before termination of the trial.” As the parties have filed their written settlement agreement, we determine that it is appropriate to terminate this proceeding without rendering a Final Written Decision as to the patentability of claims 1, 3, 5, 7, 8, 12, and 18–20 of the ’359 patent, which are all the claims on which trial has been instituted (Paper 5, 19). *See* 37 C.F.R. §§ 42.72, 42.74.

II. ORDER

Accordingly, it is:

ORDERED that the parties’ Joint Request that the settlement agreement (Ex. 1014) be treated as business confidential information under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) is GRANTED; and

ORDERED that the parties’ Joint Motion to terminate this proceeding is GRANTED, and this proceeding is hereby terminated.

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