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Paper 10
Date: May 15, 2015

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE, INC.,
Petitioner,

v.

ENTERPRISE SYSTEMS TECHNOLOGIES, S.A.R.L.,
Patent Owner.

Case IPR2015-00935
Patent 7,454,201 B2

Before JAMESON LEE, PATRICK M. BOUCHER, and SCOTT C. MOORE, *Administrative Patent Judges.*

MOORE, *Administrative Patent Judge.*

DECISION

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

On May 6, 2015, counsel for Petitioner, Apple, Inc., and Patent Owner, Enterprise Systems Technologies, S.A.R.L., jointly sought authorization to file a motion to terminate this proceeding on the basis that the parties have reached a settlement agreement. On May 7, 2015, we granted the parties authorization to file a joint motion to terminate. Paper 6. The parties subsequently filed their Joint Motion to Terminate Proceedings Pursuant to 35 U.S.C. § 317 ("Mot."). Paper 9. Along with their Joint Motion to Terminate, the parties filed a Joint Request to File Settlement Agreement as Business Confidential Information Pursuant to 35 U.S.C. § 317 (Paper 7), and also filed a copy of a document they describe as a Settlement and License Agreement (Paper 8).

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." However, 35 U.S.C. § 317(b) also requires that:

> [a]ny agreement or understanding between the patent owner and a petitioner, including any collateral agreements referred to in such agreement or understanding, made in connection with, or in contemplation of, the termination of an inter partes review under this section shall be in writing and a true copy of such agreement or understanding shall be filed in the Office before the termination of the inter partes review as between the parties.

In their Joint Motion to Terminate, the parties jointly request termination of this proceeding pursuant to 35 U.S.C. § 317(a). Mot. 1. The parties indicate that dismissal is appropriate because the parties have reached a settlement agreement resolving all issues between them involving the

patent at issue in this proceeding, and because the Board has not yet decided the merits of this *inter partes* review proceeding. Mot. 1–2. The parties also represent that they have complied with 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b) by filing a true copy of the confidential settlement agreement between the parties. Mot. 1. The parties further represent that there are no "collateral agreements" that would need to be filed pursuant to 35 U.S.C. § 317(b) prior to termination of this proceeding. Mot. 1.

We recognize that a trial has not yet been instituted. However, the considerations are similar. Under these circumstances, we are persuaded that it is appropriate to terminate this proceeding as to both Petitioner and Patent Owner without rendering a final written decision. 37 C.F.R. § 42.72.

ORDER

For the foregoing reasons, it is:

ORDERED that the Joint Motion to Terminate Proceedings Pursuant to 35 U.S.C. § 317 (Paper 9) is GRANTED;

FURTHER ORDERED that this proceeding is hereby terminated as to both Petitioner and Patent Owner;

FURTHER ORDERED that the parties' Joint Request to File Settlement Agreement as Business Confidential Information Pursuant to 35 U.S.C. § 317 (Paper 7) is GRANTED; and

FURTHER ORDERED that the Settlement and License Agreement (Paper 8) be treated as business confidential information pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) and also remain designated as "Board Only" in PRPS.

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