

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LG ELECTRONICS, INC.,
Petitioner,

v.

SAINT LAWRENCE COMMUNICATIONS LLC,
Patent Owner.

Case IPR2015-01874
Patent 7,151,802 B1

Before MICHAEL P. TIERNEY, RAMA G. ELLURU, and
SCOTT C. MOORE, *Administrative Patent Judges*.

ELLURU, *Administrative Patent Judge*.

DECISION
Joint Motion to Terminate the *Inter Partes* Review
35 U.S.C. § 317 and 37 C.F.R. § 42.72

I. Introduction

On January 8, 2016, Petitioner, LG Electronics, Inc. (“LG”), and Patent Owner, Saint Lawrence Communications LLC (“Saint Lawrence”) (collectively referred to as “the parties”), filed a “Joint Motion to Terminate” this *inter partes* review proceeding. Paper 7 (“Mot.”).¹ Along with the Joint Motion to Terminate, the parties filed a true copy of their written settlement agreement and license agreement (Ex. 2002), as well as a joint request 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) (Paper 8). The parties also represent that they “have agreed to settle and jointly moved to dismiss with prejudice their related district court litigations concerning both U.S. patent 7,151,802 and U.S. Patent 7,260,521².” Mot. 2.

II. Discussion

The parties are reminded that the Board is not a party to the settlement, and may identify independently 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). 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

¹ Filing of the Motion to Terminate was authorized in e-mail correspondence from Board personnel on January 5, 2016.

² U.S. Patent No. 7,260,521 is the subject of IPR2015-01875, in which a separate Joint Motion to Terminate has been filed.

filed.” Although we have not yet issued an institution decision, the considerations here are similar. We have not decided the merits of this proceeding. Thus, the requirement for terminating review of this *inter partes* review with respect to LG is met.

Furthermore, under 35 U.S.C. § 317(a), “[i]f no petitioner remains in the *inter partes* review, the Office may terminate the review or proceed to a final written decision under section 318(a).” Thus, we also have discretion to terminate this review with respect to Saint Lawrence. In the Joint Motion to Terminate, the parties represent the following:

Because the merits of any of the IPRs have not been determined, concluding these IPR proceedings promotes the Congressional goal to establish a more efficient and streamlined patent system that, *inter alia*, limits unnecessary and counterproductive litigation costs. See “Changes to Implement Inter Partes Review Proceedings, Post-Grant Review Proceedings, and Transitional Program for Covered Business Method Patents,” Final Rule, 77 Fed. Reg., no. 157, p. 48680 (Tuesday, August 14, 2012). By permitting termination of IPR proceedings as to the parties upon settlement, the PTAB provides certainty as to the outcome of these proceedings. Terminating IPRs upon settlement fosters an environment that promotes settlements, thereby creating a timely, cost-effective alternative to litigation. Should the Board decide to continue the present proceedings, the Congressional goal of speedy dispute resolutions will be chilled.

Mot. 2–3.

Upon consideration of the circumstances of this case, the panel has determined to terminate this *inter partes* review as to both LG and Saint Lawrence without rendering a final written decision.

III. Order

It is

ORDERED that the Joint Motion to Terminate the *inter partes* review in IPR2015-1874 (Paper 7) is *granted*, and this proceeding is hereby *terminated*; and

FURTHER ORDERED that, as was requested timely by the parties (Paper 8), the settlement agreement and license agreement (Exhibit 2002) will be treated as business confidential information under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

IPR2015-01874
Patent 7,151,802 B1

For PETITIONER:

Robert Pluta
Baldine Paul
Amanda Streff
MAYER BROWN LLP
rpluta@mayerbrown.com
bpaul@mayerbrown.com
astreff@mayerbrown.com

For PATENT OWNER:

Gregory Gonsalves
gonsalves@gonsalveslawfirm.com