

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ZTE (USA) INC.,
Petitioner,

v.

PAPST LICENSING GMBH & CO. KG,
Patent Owner.

Case IPR2017-00443
Patent 6,470,399 B1¹

Before JONI Y. CHANG, JENNIFER S. BISK, and JAMES B. ARPIN,
Administrative Patent Judges.

CHANG, *Administrative Patent Judge.*

JUDGMENT
Termination of Proceeding
37 C.F.R. § 42.73

¹ IPR2017-01682 has been joined with this proceeding.

Petitioner, ZTE (USA) Inc. (“ZTE”), and Patent Owner, Papst Licensing GmbH & Co. KG (“Papst”), jointly move to terminate the instant *inter partes* review in light of their settlement that resolves their dispute regarding U.S. Patent No. 6,470,399 B1 (“the ’399 patent”). Paper 30 (“Mot.”). The parties also filed a true copy of their written settlement agreement in connection with the termination as required by 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b). Ex. 2013. Pursuant to 37 C.F.R. § 42.74(c), the parties additionally filed a joint request to treat the Settlement Agreement as business confidential information kept separate from the file of the involved patent. Paper 31.

For the reasons set forth below, the Joint Motion to Terminate this proceeding and the Joint Request to File Settlement Agreement as Business Confidential Information are *granted*.

Under the Leahy-Smith America Invents Act, settlement between the parties to a proceeding is encouraged. Notably, 35 U.S.C. § 317(a), in part, provides the following (emphasis added):

(a) IN GENERAL.—An inter partes review instituted under this chapter shall be *terminated with respect to any petitioner upon the joint request of the petitioner and the patent owner*, unless the Office has decided the merits of the proceeding before the request for termination is filed. If the inter partes review is terminated with respect to a petitioner under this section, *no estoppel under section 315(e) shall attach to the petitioner*, or to the real party in interest or privy of the petitioner, on the basis of that petitioner’s institution of that inter partes review.

Generally, the Board expects that a proceeding will terminate after the filing of a settlement agreement. See Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,768 (Aug. 14, 2012). Here, the parties indicates that their Settlement Agreement completely resolves the controversy between the

parties relating to the involved patent and that, on December 29, 2017, the parties filed a joint motion to dismiss in the related district court proceedings.² Mot. 2–3. Although the instant *inter partes* review has been instituted, the proceeding is still in the briefing stage. We have not yet held an oral hearing and have not entered a final written decision in this proceeding.

Upon review of the procedural posture of this proceeding and the facts before us, we determine that the parties’ requests have merit, and that it is appropriate to terminate this proceeding.

In consideration of the foregoing, it is hereby:

ORDERED that the Joint Motion to Terminate is *granted*;

FURTHER ORDERED that the instant *inter partes* review is terminated as to all parties including ZTE and Papst; and

FURTHER ORDERED that the Joint Request to File Settlement Agreement as Business Confidential Information and to keep such settlement agreement separate from the patent file, and to make it available only to Federal Government agencies on written request, or to any person on a showing of good cause, pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c), is *granted*.

² *Papst Licensing GmbH & Co. KG v. Apple Inc.*, No. 6:15-cv-1095-RWS (E.D. Tex) and the consolidated case *Papst Licensing GmbH & Co. KG v. ZTE Corporation and ZTE (USA), Inc.*, No. 6:15-cv- 1100-RWS (E.D. Tex.).

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