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Paper 9
Entered: August 23, 2017

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CANON INC., et al.,
Petitioner,

v.

PAPST LICENSING GMBH & CO. KG,
Patent Owner.

Case IPR2016-01211
Patent 8,504,746

Before JONI Y. CHANG, JENNIFER S. BISK, and MIRIAM L. QUINN, *Administrative Patent Judges.*

QUINN, *Administrative Patent Judge*.

DECISION
Granting Joint Motion to Terminate as to Petitioner Huawei Device Co., Ltd.
37 C.F.R. § 42.74

Joint Petitioner, Huawei Device Co., Ltd. ("Huawei"), and Patent Owner, Papst Licensing GmbH & Co. KG ("Papst"), jointly move to terminate the instant *inter partes* review with respect to Huawei in light of the settlement between Huawei and Papst that resolves their dispute regarding U.S. Patent No. 8,504,746 ("the '746 patent"). Paper 30 ("Mot."). Huawei and Papst 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. 2012. Pursuant to 37 C.F.R. § 42.74(c), the parties further 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 with respect to Huawei, 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.

Here, although the instant *inter partes* review has been instituted, we 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' contentions have merit, and that it is appropriate to terminate this proceeding with respect Huawei. The proceeding, however, will not be terminated with respect to Papst, as other Petitioners remain in the proceeding.

In consideration of the foregoing, it is hereby:

ORDERED that the Joint Motion to Terminate, with respect to Huawei, is *granted*;

FURTHER ORDERED that this review is terminated with respect to Huawei only; but this review continues to proceed with Papst and the remaining Petitioners;

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*; and

FURTHER ORDERED that any subsequent papers filed in this *inter partes* review should not include Huawei in the caption.

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