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Paper 29
Entered: January 4, 2018

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ZTE (USA) INC., OLYMPUS CORPORATION, and
OLYMPUS AMERICA INC.,
Petitioner,

v.

PAPST LICENSING GMBH & CO. KG,
Patent Owner.

Case IPR2017-00415[1]
Patent 6,895,449 B2

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

BISK, *Administrative Patent Judge*.

DECISION
Granting Joint Motion to Terminate as to
Petitioner Olympus Corporation and Olympus America, Inc.
37 C.F.R. § 42.74

[1] IPR2017-01617 has been joined with this proceeding.

Petitioner, Olympus Corporation and Olympus America, Inc. (collectively "Olympus"), and Patent Owner, Papst Licensing GmbH & Co. KG ("Papst"), jointly move to terminate the instant *inter partes* review with respect to Olympus in light of the settlement between Olympus and Papst that resolves their dispute regarding U.S. Patent No. Patent 6,895,449 B2 ("the '449 patent"). Paper 27 ("Mot."). Olympus 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. 2011. Pursuant to 37 C.F.R. § 42.74(c), Olympus and Papst additionally filed a joint request to treat the Settlement Agreement as business confidential information kept separate from the file of the involved patent. Paper 28.

For the reasons set forth below, the Joint Motion to Terminate with respect to Olympus 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 Olympus. The proceeding, however, will not be terminated with respect to Papst, as another Petitioner, ZTE (USA) Inc., remains in the proceeding.

In consideration of the foregoing, it is hereby:

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

FURTHER ORDERED that this review is terminated with respect to Olympus only; but this review continues with Papst and the remaining Petitioner;

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 Olympus in the caption.

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