

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HUAWEI DEVICE CO., LTD.,
Petitioner,

v.

MAXELL, LTD.,
Patent Owner.

Case IPR2018-00209
Patent 7,509,139 B2

Before MELISSA A. HAAPALA, *Acting Vice Chief Administrative Patent Judge*, and MINN CHUNG and AMBER L. HAGY, *Administrative Patent Judges*.

HAGY, *Administrative Patent Judge*.

ORDER

Termination of Trial Due to Settlement Agreement
35 U.S.C. § 317 and 37 C.F.R. § 42.72

I. INTRODUCTION

By way of a Petition accorded a filing date of November 20, 2017 (*see* Paper 3, mailed November 30, 2017), Huawei Device Co., Ltd. (“Huawei” or “Petitioner”) requested an *inter partes* review of claims 1 and 7–14 of U.S. Patent No. 7,509,139 B2 (Ex. 1001, “the ’139 patent”). Paper 1 (“Pet.”). Maxell, Ltd. (“Patent Owner”) filed a Preliminary Response (Paper 6, “Prelim. Resp.”). We issued a decision instituting review on May 23, 2018. Paper 10.

Pursuant to Board authorization, Patent Owner and Petitioner filed a Joint Motion To Terminate the Proceedings on April 2, 2019. Paper 29. Along with the motion, the parties filed a copy of a document they describe as “a true and complete copy of their written settlement agreement” (Ex. 1029), and certify that there are no other agreements between the parties made in connection with, or in contemplation of, the termination of the present proceeding. Paper 29, 1. The parties also filed a joint request to treat the settlement agreement as business confidential information. Paper 30. *See* 37 C.F.R. § 42.74(c) (a party to a settlement may request that the settlement agreement be treated as business confidential and be kept separate from the patent file).

II. DISCUSSION

The Parties state the following in the Joint Motion to Terminate: “Huawei and Patent Owner have settled their dispute regarding the ’139 patent and have agreed to terminate the proceeding” and “the Settlement Agreement completely resolves the controversy between Patent Owner and Huawei relating to the ’139 patent.” Paper 29, 2–3. The parties also represent that “there are no other proceedings involving the ’139 patent

pending before the office.” *Id.* at 2. With regard to the co-pending district court proceeding (*Maxell, Ltd. v. Huawei Device USA Inc., et al.*, Case No. 5:16-cv-00178-RWS (E.D. Tex.)), the parties represent that “[o]n February 18, 2019, the Patent Owner filed a notice of settlement in the district court.” *Id.* at 2–3.

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.”

Although a Decision to Institute was entered on May 23, 2018 (Paper 10), we have not held an oral hearing (which was scheduled to be held on February 21, 2019, but was canceled at the request of the parties in light of impending settlement (Paper 28, 2–3)), and we have not entered a Final Written Decision on the merits.

According to the parties’ settlement agreement, termination of the proceedings would be part of resolution by the parties of all pending related matters. When, as here, we have not entered a Final Written Decision on the merits, we generally expect that trial 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). As the parties have filed their written settlement agreement as to this proceeding (which they represent to be a true and complete copy as required by 35 U.S.C. 317(b)), we determine that it is appropriate to terminate trial without entering a Final Written Decision as to the patentability of claims 1 and 7–14 of the ’139 patent.

After reviewing the parties’ settlement agreement, we find the settlement agreement contains business confidential information regarding

the terms of the settlement and good cause exists to treat the settlement agreement as business confidential information pursuant to 37 C.F.R. § 42.74(c).

III. ORDER

It is

ORDERED that the Joint Motion to Terminate trial is GRANTED, and this trial is hereby terminated;

FURTHER ORDERED that the joint request to treat the parties' settlement agreement as business confidential information is GRANTED, and the settlement agreement (Exhibit 1029) shall be treated as business confidential information, kept separate from the file of U.S. Patent 9,319,471 B2, and made available only to Federal Government agencies on written request to the Board, or to any person on a showing of good cause, under the provisions of 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

Case IPR2018-00209

Patent 7,509,139 B2

PETITIONER:

David A. Garr

Gregory Discher

Anupam Sharma

Peter Chen

COVINGTON & BURLING LLP

dgarr@cov.com

gdischer@cov.com

asharma@cov.com

pchen@cov.com

PATENT OWNER:

Robert G. Pluta

Saqib J. Siddiqui

Bryan C. Nese

Amanda S. Bonner

MAYER BROWN LLP

rpluta@mayerbrown.com

ssiddiqui@mayerbrown.com

bnese@mayerbrown.com

asbonner@mayerbrown.com