

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

T-MOBILE USA, INC.,
Petitioner,

v.

SHARPE INNOVATIONS, INC.,
Patent Owner.

Cases

IPR2018-00222 (Patent 8,337,239 B2)

IPR2018-00225 (Patent 8,573,986 B2)

Before DANIEL J. GALLIGAN, KEVIN C. TROCK, and
STACY B. MARGOLIES, *Administrative Patent Judges*.

GALLIGAN, *Administrative Patent Judge*.

ORDER

Termination of Trial

35 U.S.C. § 317, 37 C.F.R. §§ 42.72 and 42.74

I. DISCUSSION

On September 10, 2018, with Board authorization, the parties filed in each of IPR2018-00222 and IPR2018-00225 a Joint Motion to Terminate¹ along with what they indicate is a true copy of their settlement agreement.² In the Joint Motions to Terminate, the parties represent that they have settled their disputes regarding the patents at issue in these proceedings, and they state that “[t]here are no collateral agreements or understandings between the parties in connection with the termination of this review.” Paper 9, 1–2. In each of these proceedings, the parties also request to have their settlement agreement treated as business confidential information and kept separate from the file of the respective patent pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c). *Id.* at 2.

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.” Further, under 35 U.S.C. § 317(b),

[a]ny agreement or understanding between the patent owner and a petitioner, including any collateral agreements referred to in such agreement or understanding, made in connection with, or in contemplation of, the termination of an inter partes review under this section shall be in writing and a true copy of such agreement or understanding shall be filed in the Office before the termination.

We instituted trial in the -00222 proceeding on May 23, 2018 and the -00225 proceeding on May 31, 2018. A hearing is currently scheduled for

¹ Paper 9 in each proceeding.

² Exhibit 1015 in each proceeding.

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January 30, 2019, and the Board has not yet entered a final written decision. Based on the circumstances of these proceedings, we determine that it is appropriate to terminate without rendering final written decisions under 35 U.S.C. § 318(a). *See* 35 U.S.C. § 317; 37 C.F.R. §§ 42.72, 42.74.

Accordingly, the Joint Motions to Terminate the above-identified proceedings and the parties' requests to treat the settlement agreement as business confidential information are granted. As requested by the parties, the settlement agreement will be treated as business confidential information and will be kept separate from the patent file. 35 U.S.C. § 317(b); 37 C.F.R. § 42.74(c). This paper does not constitute a final written decision pursuant to 35 U.S.C. § 318(a).

II. ORDER

Therefore, it is

ORDERED that the parties' requests that their settlement agreement (Ex. 1015) be treated as business confidential information under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) are GRANTED; and

FURTHER ORDERED that the parties' Joint Motions to Terminate these proceeding are GRANTED, and these proceedings are hereby terminated.

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