

Trials@uspto.gov
571.272.7822

Paper No. 8, IPR2018-00346
Paper No. 8, IPR2018-00351
Paper No. 8, IPR2018-00352
Paper No. 8, IPR2018-00358
Paper No. 8, IPR2018-00360
Entered: April 23, 2018

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HTC CORPORATION and HTC AMERICA, INC.,
Petitioner,

v.

IPA TECHNOLOGIES, INC.,
Patent Owner.

Cases¹

IPR2018-00346 (Patent 6,523,061 B1)
IPR2018-00351 (Patent 6,757,718 B1)
IPR2018-00352 (Patent 6,742,021 B1)
IPR2018-00358 (Patent 6,742,021 B1)
IPR2018-00360 (Patent 6,742,021 B1)

Before DEBRA K. STEPHENS, THOMAS L. GIANNETTI, and
BART A. GERSTENBLITH, *Administrative Patent Judges*.

GERSTENBLITH, *Administrative Patent Judge*.

DECISION

Termination and Settlement

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

¹ This Decision addresses issues that apply to each case. We, therefore, exercise our discretion to issue one Decision to be filed in each case.

IPR2018-00346 (Patent 6,523,061 B1)
IPR2018-00351 (Patent 6,757,718 B1)
IPR2018-00352 (Patent 6,742,021 B1)
IPR2018-00358 (Patent 6,742,021 B1)
IPR2018-00360 (Patent 6,742,021 B1)

I. DISCUSSION

In an e-mail dated April 16, 2018, we authorized the parties to file joint motions to terminate the instant proceedings with true copies of their agreement(s) in contemplation of termination and joint motions to treat the filed copies of their agreement(s) as business confidential information under 37 C.F.R. § 42.74(c). The following day, the parties filed a Joint Motion to Terminate Pursuant to 35 U.S.C. § 317 (Paper 6), a copy of a written Settlement Agreement (Ex. 1035), and a Joint Request to Keep Separate Pursuant to 35 U.S.C. § 317 and 37 C.F.R. § 42.74 (Paper 7) in each proceeding.²

The parties indicate that they have settled their underlying dispute and have agreed to terminate these proceedings. Paper 6, 1. The parties filed what they represent is a true and correct copy of their written Settlement Agreement as Exhibit 1035, and indicate that there are no other collateral agreements referred to the Settlement Agreement, made in connection with, or in contemplation of, the termination of these proceedings. *Id.* at 5. The parties further indicate that they are moving to dismiss a related district court case between the parties involving the challenged patent. *Id.* at 3.

Generally, the Board expects that a proceeding will terminate after the filing of a settlement agreement. *See* 35 U.S.C. § 317(a) (“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,

² In each proceeding, the Joint Motion is Paper 6, the Joint Request to Keep Separate is Paper 7, and the Settlement Agreement is Exhibit 1035.

IPR2018-00346 (Patent 6,523,061 B1)
IPR2018-00351 (Patent 6,757,718 B1)
IPR2018-00352 (Patent 6,742,021 B1)
IPR2018-00358 (Patent 6,742,021 B1)
IPR2018-00360 (Patent 6,742,021 B1)

unless the Office has decided the merits of the proceeding before the request for termination is filed.”); 37 C.F.R. § 42.72 (“The Board may terminate a trial without rendering a final written decision, where appropriate, including . . . pursuant to a joint request under 35 U.S.C. 317(a)”); *see also* Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,768 (Aug. 14, 2012) (“The Board expects that a proceeding will terminate after the filing of a settlement agreement, unless the Board has already decided the merits of the proceeding.”). Here, a trial has not yet been instituted and the merits of the proceedings not yet decided. Accordingly, we are persuaded that, under these circumstances, termination of these proceedings is appropriate.

Additionally, we grant the parties’ Joint Request to Keep Separate. *See* 35 U.S.C. § 317(b) (“At the request of a party to the proceeding, the agreement or understanding shall be treated as business confidential information, shall be kept separate from the file of the involved patents, and shall be made available only to Federal Government agencies on written request, or to any person on a showing of good cause.”); *see also* 37 C.F.R. § 42.74(c) (same).

This Decision does not constitute a final written decision pursuant to 35 U.S.C. § 318(a).

IPR2018-00346 (Patent 6,523,061 B1)
IPR2018-00351 (Patent 6,757,718 B1)
IPR2018-00352 (Patent 6,742,021 B1)
IPR2018-00358 (Patent 6,742,021 B1)
IPR2018-00360 (Patent 6,742,021 B1)

II. ORDER

Accordingly, it is

ORDERED that the parties' Joint Motion to Terminate Pursuant to 35 U.S.C. § 317 (Paper 6) is *granted*;

FURTHER ORDERED that the parties' Joint Request to Keep Separate Pursuant to 35 U.S.C. § 317 and 37 C.F.R. § 42.74 (Paper 7) is *granted*;

FURTHER ORDERED that the Settlement Agreement (Exhibit 1035) be treated as business confidential information, kept separate from the file of the above-referenced patents, and made 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); and

FURTHER ORDERED that each of these proceedings is terminated.

IPR2018-00346 (Patent 6,523,061 B1)
IPR2018-00351 (Patent 6,757,718 B1)
IPR2018-00352 (Patent 6,742,021 B1)
IPR2018-00358 (Patent 6,742,021 B1)
IPR2018-00360 (Patent 6,742,021 B1)

For PETITIONER:

Eliot D. Williams
H. Hopkins Guy
Ali Dhanani
BAKER BOTTS L.L.P.
eliot.williams@bakerbotts.com
hop.guy@bakerbotts.com
ali.dhanani@bakerbotts.com

For PATENT OWNER:

Steven W. Hartsell
Alexander E. Gasser
Sarah E. Spires
SKIERMONT DERBY LLP
IPA_SDTeam@skiermontderby.com