

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ERICSSON INC. AND
TELEFONAKTIEBOLAGET LM ERICSSON,
Petitioner,

v.

INTELLECTUAL VENTURES II LLC,
Patent Owner.

Case IPR2018-01185
Patent 9,320,018 B2

Before BRIAN J. McNAMARA, DAVID C. McKONE, and
MINN CHUNG, *Administrative Patent Judges*.

CHUNG, *Administrative Patent Judge*.

DECISION
Granting the Parties' Joint Motion to Terminate
37 C.F.R. §§ 42.71(a) and 42.74

I. DISCUSSION

With Board authorization, Ericsson Inc. and Telefonaktiebolaget LM Ericsson (collectively, “Petitioner”) and Intellectual Ventures I LLC (“Patent Owner”) filed a Joint Motion To Terminate this *inter partes* review on June 13, 2019. Paper 10 (“Mot.”). Along with the Joint Motion, the parties filed a copy of a document they describe as “a true copy” (*id.* at 3) of their written settlement agreement (Paper 11)¹ covering various matters, including those involving the patent at issue in this proceeding. The parties also filed a joint request to treat the settlement agreement as business confidential information under 37 C.F.R. § 42.74(c). Paper 12.

This proceeding is still in its preliminary stages. Petitioner filed a Petition (Paper 2, “Pet.”) requesting an *inter partes* review of claims 12–14, 16–18, 20–22, and 24–25 (the “challenged claims”) of U.S. Patent No. 9,320,018 B2 (Ex. 1001, “the ’018 patent”). Based on the information presented in the Petition, we denied institution of an *inter partes* review of the challenged claims of the ’018 patent. Paper 7 (“Decision”). Petitioner subsequently filed a Request for Rehearing (Paper 8, “Request”) seeking reconsideration of our Decision denying institution, and we have not entered a decision on Petitioner’s Request. Thus, because we denied institution and Petitioner’s Request for Rehearing is pending, this proceeding remains a preliminary proceeding under 37 C.F.R. § 42.2.

¹ The parties filed the true copy of their settlement agreement as a paper, rather than as a separate exhibit. The parties should have filed the true copy of their settlement agreement as a separate exhibit in accordance with 37 C.F.R. § 42.63(a) (“Evidence consists of affidavits, transcripts of depositions, documents, and things. All evidence must be filed in the form of an exhibit.”).

In the Joint Motion to Terminate, the parties represent that the settlement agreement resolves all disputes between the parties involving the '018 patent. Mot. 3. The parties also certify that there are no other agreements or understandings, oral or written, between the parties, including any collateral agreements, made in connection with, or in contemplation of, the termination of this proceeding. *Id.* at 4. Under these particular circumstances, we determine that it is appropriate to dismiss Petitioner's Request for Rehearing without rendering any further decisions, thereby terminating this proceeding. See 37 C.F.R. § 42.71(a). We also have reviewed the settlement agreement, and we determine that good cause exists to treat the settlement agreement as business confidential information under 37 C.F.R. § 42.74(c).

II. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that the parties' request to treat the settlement agreement (Paper 11) as business confidential information under 37 C.F.R. § 42.74(c) is *granted*;

FURTHER ORDERED that the settlement agreement (Paper 11) shall be treated as business confidential information, kept separate from the file of the '018 patent, 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 37 C.F.R. § 42.74(c); and

FURTHER ORDERED that the parties' Joint Motion to Terminate is *granted*, and Petitioner's Request for Rehearing is dismissed resulting in termination of this proceeding.

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PETITIONER:

Chad Walters
chad.walters@bakerbotts.com

Jeffery Becker
jeff.becker@bakerbotts.com

PATENT OWNER:

Byron Pickard
bpickard-ptab@sternekessler.com

Ross Hicks
rhicks-ptab@sternekessler.com

Steven Pappas
spappas-ptab@sternekessler.com

Russell Rigby
rrigby@intven.com

Tim Seeley
tims@intven.com