

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

T-MOBILE USA, INC. AND RPX CORPORATION,
Petitioners,

v.

VERTICAL CONNECTION TECHNOLOGIES LLC,
Patent Owner.

Case IPR2018-01387 (Patent 7,245,917 B2)
Case IPR2018-01388 (Patent 7,245,917 B2)

Before WILLIAM M. FINK, *Vice Chief Administrative Patent Judge*,
MICHAEL W. KIM and NORMAN H. BEAMER, *Administrative Patent Judges*.

BEAMER, *Administrative Patent Judge*.

ORDER

Granting Joint Motions to Terminate Proceedings as to T-Mobile USA, Inc.
Due to Settlement after Institution and
Granting Joint Requests to Treat Settlement Agreement as
Business Confidential Information
35 U.S.C. § 317; 37 C.F.R. §§ 42.72, 42.74

On April 11, 2019, T-Mobile USA, Inc. (“T-Mobile”) and Vertical Connection Technologies LLC (“Patent Owner”) filed, with Board authorization, a Joint Motion to terminate the proceeding as to T-Mobile in each of the above-identified *inter partes* review proceedings in accordance with 35 U.S.C. § 317(a) and 37 C.F.R. § 42.72. Paper 17 (“Joint Motion” or “Joint Mot.”).¹ T-Mobile and Patent Owner also filed copies of their settlement agreement covering, *inter alia*, Patent No. 7,245,917 B2, at issue in the above-identified *inter partes* reviews. Ex. 1032, 1–11 (“Settlement Agreement”). T-Mobile and Patent Owner represent that RPX Corporation does not oppose termination of the above-identified *inter partes* reviews as to T-Mobile. Joint Mot. 1.

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 the patent owner, unless the Office has decided the merits of the proceeding before the request for termination is filed.”

We instituted trials in the above-identified proceedings on January 23, 2019. Paper 14. We have not yet decided the merits of the above-identified proceedings, and final written decisions have not been entered. T-Mobile and Patent Owner represent that they have settled their disputes with respect to Patent No. 7,245,917 B2. Joint Mot. 1. T-Mobile and Patent Owner further represent the underlying District Court litigation in the Eastern District of New York (case number 2:17-cv-04992) was dismissed with prejudice. Joint Mot. 3. Notwithstanding that the above-identified

¹ For expediency, we refer to papers and exhibits filed in IPR2018-01387. Similar papers and exhibits were filed in IPR2018-01388.

proceedings have moved beyond the preliminary stage, we determine that T-Mobile and Patent Owner have adequately shown that termination of the proceedings, as to T-Mobile, is appropriate, especially in view of the fact that the proceedings overall will continue with RPX Corporation remaining as Petitioner.

T-Mobile and Patent Owner also filed a Joint Request in each of the above-identified proceedings to treat the Settlement Agreement as business confidential information. Paper 17, 4 (“Joint Request”). The Parties request that the Settlement Agreement be kept separate from the files of the above-identified proceedings, and only be made available to Federal Government agencies on written request, or to any person showing good cause. *Id.*

“A party to a settlement may request that the settlement be treated as business confidential information and be kept separate from the files of an involved patent or application. The request must be filed with the settlement. If a timely request is filed, the settlement shall only be available: (1) To a Government agency on written request to the Board; or (2) To any other person upon written request to the Board to make the settlement agreement available, along with the fee specified in § 42.15(d) and on a showing of good cause.” 37 C.F.R. § 42.74(c). After reviewing the Settlement Agreement between T-Mobile and Patent Owner, we find that the Settlement Agreement contains confidential business information regarding the terms of settlement. We determine that it is appropriate to treat the Settlement Agreement as business confidential information pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

Case IPR2018-01387 (Patent 7,245,917 B2)

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This Order does not constitute a final written decision pursuant to 35 U.S.C. § 318(a), and the above-identified proceedings shall continue with respect to RPX Corporation and Patent Owner.

It is

ORDERED that the Joint Motions to terminate the proceedings as to T-Mobile in IPR2018-01387 and IPR2018-01388 are *granted*;

FURTHER ORDERED that the Joint Requests in IPR2018-01387 and IPR2018-01388 to treat the Settlement Agreement 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 proceedings in IPR2018-01387 and IPR2018-01388 are terminated with respect to T-Mobile pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. § 42.72.

Case IPR2018-01387 (Patent 7,245,917 B2)

Case IPR2018-01388 (Patent 7,245,917 B2)

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