

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SPRINT SPECTRUM L.P., SPRINTCOM, INC.,
T-MOBILE USA, INC., and T-MOBILE US, INC.,
Petitioner,

v.

INTELLECTUAL VENTURES II LLC,
Patent Owner.

Case IPR2018-01770
Patent 8,953,641 B2

Before JAMESON LEE, AMBER L. HAGY,
and JASON W. MELVIN, *Administrative Patent Judges*.

LEE, *Administrative Patent Judge*.

ORDER

Granting Joint Motion to Terminate
Granting Joint Request to Keep Agreement Confidential and Separate
35 U.S.C. § 317; 37 C.F.R. §§ 42.72, 42.74

I. INTRODUCTION

Petitioner and Patent Owner (collectively referred to as “the Parties”) have requested that the above-identified *inter partes* review proceeding be terminated pursuant to a settlement. On June 25, 2019, we authorized the Parties to file a joint motion to terminate this proceeding. On June 25, 2019, the Parties filed a Joint Motion to Terminate this proceeding (“Joint Motion”). Paper 22. Along with the Joint Motion, the Parties filed copies of two Patent License Agreements (“Settlement Agreements” (Ex. 1019 and Ex. 1020)). The Parties also filed a Joint Request that the Settlement Agreements be Treated as Business Confidential Information and be Kept Separate pursuant to 37 C.F.R. § 42.74(c) (“Joint Request”). Paper 23.

II. DISCUSSION

In the Joint Motion, the Parties represent that they have reached an agreement to jointly seek termination of this *inter partes* review proceeding, that the filed Settlement Agreements constitute a true and accurate copy of their written agreements, and that there are no other written or oral agreements. Paper 22, 1, 3–4.

We have not yet decided the merits of this proceeding, and a final written decision has not been entered. Notwithstanding that the proceeding has moved beyond the preliminary stage, the Parties have shown adequately that termination of this proceeding is appropriate.

Section 317 of Title 35, United States Code, provides that an *inter partes* review “shall be terminated with respect to any petitioner upon the joint request of the petitioner and the patent owner” and further that “[i]f no petitioner remains in the inter partes review, the Office *may* terminate the review or proceed to a final written decision.” 35 U.S.C. § 317(a) (emphasis

added). Under these circumstances, we determine that this proceeding should be terminated with respect to both Petitioner and Patent Owner. Notably, Patent Owner has not yet filed its Patent Owner Response. We also have reviewed the Joint Request and find the circumstances appropriate for granting the Joint Request under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

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

III. ORDER

Accordingly, for the reasons discussed above, it is:

ORDERED that the Joint Motion to Terminate is *granted*, and IPR2018-01770 is *terminated*; and

FURTHER ORDERED that the Parties' Joint Request that the Settlement Agreements (Exhibits 1019 and 1020) be treated as business confidential information and be kept separate is *granted*, and the Settlement Agreements shall be kept separate from the file of Patent 8,953,641 B2 and be 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).

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