

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS AMERICA, INC. and
CELLCO PARTNERSHIP D/B/A VERIZON WIRELESS,
Petitioner,

v.

BARKAN WIRELESS IP HOLDINGS, L.P.,
Patent Owner.

Case IPR2019-00234
Patent 9,392,638 B2

Before THU A. DANG, WILLIAM V. SAINDON, and
JOHN A. HUDALLA, *Administrative Patent Judges*.

DANG, *Administrative Patent Judge*.

DECISION

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

I. DISCUSSION

On July 7, 2019, the parties filed the following: (1) an Updated Joint Motion to Terminate (Paper 21); (2) a true copy of the parties' final settlement agreement signed by Patent Owner (Ex. 2021); (3) a true copy of the parties' final settlement agreement signed by Petitioner (Ex. 2022); and (4) a Joint Request to Treat Settlement Agreement as Business Confidential (Paper 22). The parties had previously filed a motion to terminate (Paper 15) based on a purported settlement agreement filed on May 31, 2019 (Ex. 2020, "original settlement agreement"). By our Order of June 28, 2019 (Paper 18), we dismissed without prejudice the parties' previous motion to terminate because the original settlement agreement contemplated further negotiations and the execution of a more detailed, final settlement agreement. Nevertheless, we granted leave to file the instant Updated Joint Motion to Terminate upon the completion of settlement negotiations. *Id.*

This proceeding is still in its preliminary stages. Petitioner filed a Petition requesting an *inter partes* review of claims 1–36 of U.S. Patent No. 9,392,638 (Ex. 1015, "the '638 patent"). Paper 1. Patent Owner filed a Preliminary Response. Paper 9. We have not entered a decision on whether to institute an *inter partes* review.

In the Updated Joint Motion to Terminate, the parties indicate that they have "resolved all their claims against each other" regarding the '638 patent. Paper 21, 1. The parties represent that the original settlement agreement (Ex. 2020) is "part of a mediation that finally resolves all claims against each other," whereby "Petitioner will no longer participate in the IPR" and "the parallel litigation has been dismissed." *Id.* at 1. The parties also state that the final settlement agreement is "an updated and more

detailed settlement agreement,” wherein “there would be no further agreement between them” and that “the original settlement agreement is binding and will not be replaced with another agreement.” *Id.* at 2 (citing Exs. 2021 and 2022).

Accordingly, the Parties “jointly certify that they have now filed all agreements or understandings, . . . between the parties that are made in connection with termination of this proceeding.” *Id.* Further, the Parties “jointly certify that no other written or oral agreements or understandings, including any collateral agreements, are made in connection with, or in contemplation of, the termination of these proceedings.” *Id.*

Under these particular circumstances, we determine that it is appropriate to terminate this proceeding without rendering any further decisions. *See* 37 C.F.R. § 42.71(a). We also have reviewed the original and final settlement agreements (Exs. 2020–2022), and we determine that good cause exists to treat these agreements as business confidential information under 37 C.F.R. § 42.74(c).

ORDER

In view of the foregoing, it is hereby:

ORDERED that the parties’ request to treat the original and final settlement agreements (Exhibit 2020–2022) as business confidential information under 37 C.F.R. § 42.74(c) is granted; and

FURTHER ORDERED that the parties’ Joint Motion to Terminate is granted, and the Petition is dismissed resulting in termination of this proceeding.

IPR2019-00234
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