

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

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

Case IPR2019-00632
Patent 8,014,284 B2

Before MEREDITH C. PETRAVICK and WILLIAM V. SAINDON,
Administrative Patent Judges.

SAINDON, *Administrative Patent Judge.*

ORDER

Granting Joint Motion to Terminate Proceeding
Due to Settlement before Institution and
Granting Joint Request to Treat Settlement Agreements as
Business Confidential Information
37 C.F.R. § 42.74

On May 31, 2019, with our authorization, the Parties filed a Joint Motion to Terminate Under 35 U.S.C. § 317(a) and 37 C.F.R. § 42.72 (Paper 10)¹ and included a copy of a signed agreement relating to settlement (Ex. 2034). On July 7, 2019, the Parties filed an Updated Joint Motion to Terminate Under 35 U.S.C. § 317(a) and 37 C.F.R. § 42.72 (Paper 15) and included countersigned copies of an additional agreement relating to settlement and termination of these proceedings (Exs. 2035, 2036). The Parties also filed joint requests to treat the agreements as Business Confidential Information pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. § 42.74(c). Papers 11, 16.

ANALYSIS

The Parties jointly certify that they “executed a binding settlement agreement as part of a mediation that finally resolves all claims against each other” and that Petitioner has agreed to terminate its IPR petition (Paper 10, 1), and the Updated Joint Motion includes the Parties’ certification that the agreements filed constitute all agreements or understandings made in connection with termination of this proceeding (Paper 15, 2). In the Updated Joint Motion, 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” and “that no other written or oral agreements or understandings, including any collateral agreements, are

¹ The Board has not decided whether to institute review in this proceeding. 35 U.S.C. § 317(a) applies to “[a]n inter partes review instituted under this chapter.” Similarly, 37 C.F.R. § 42.72 pertains to termination of “a trial.” We deem the Parties’ citation of 35 U.S.C. § 317(a) and 37 C.F.R. § 42.72 in the Joint Motions and Joint Requests as harmless error.

made in connection with, or in contemplation of, the termination of these proceedings.” Paper 15, 2–3.

This proceeding is at an early stage, and we have not yet decided whether to institute a trial in the proceeding. In view of the early stage of the proceeding and the settlement between the Parties, we determine that good cause exists to dismiss the petition and terminate the proceeding with respect to the Parties.

The Parties also filed a Joint Request that the Settlement Agreement be treated as business confidential information and be kept separate from the file of the patent involved in this *inter partes* proceeding. Papers 11, 16. After reviewing the Settlement Agreements between Petitioner and Patent Owner, we find that the Settlement Agreements contain confidential business information regarding the terms of settlement. We determine that good cause exists to treat the Settlement Agreements between Petitioner and Patent Owner as business confidential information pursuant to 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).

ORDER

In view of the foregoing, it is hereby:

ORDERED that the Parties’ joint requests for termination are *granted*, and the petition in IPR2019-00632 is dismissed and the proceeding is *terminated*;

FURTHER ORDERED that the Joint Request to Treat the Settlement Agreements as Business Confidential Information is granted, and the Settlement Agreements (Exhibits 2034, 2035, 2036) shall be kept separate

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from the files of Patent 8,014,284 B2 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).

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