Trials@uspto.gov
571-272-7822

Paper No. 24
October 9, 2019

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

KATHREIN USA, INC.,
T-MOBILE US, INC,
Petitioner,

v.

FRACTUS S.A.,
Patent Owner.

Case IPR2019-00947
Patent 7,250,918 B2

Before JAMESON LEE, KARL D. EASTHOM, and JOHN R. KENNY, *Administrative Patent Judges.*

KENNY, *Administrative Patent Judge.*

DECISION
Granting Joint Motion to Terminate and
Granting in Part Request to Keep the Kathrein Agreement Separate
37 C.F.R. §§ 42.71(a), 42.74

DISCUSSION

On October 2, 1019, with Board authorization, the parties filed a joint motion to terminate the proceeding (Paper 22, "Motion to Terminate"), a request to keep the settlement agreement between Kathrein USA, Inc. ("Kathrein") and Patent Owner (Ex. 2025, "Kathrein Agreement") separate from the file of the patent challenged in this *inter partes* review (Patent 7,250,918; "challenged patent") (Paper 23, "Request to Keep the Kathrein Agreement Separate"), and copies of the Kathrein agreement and the settlement agreement between T-Mobile US, Inc. ("T-Mobile") and Patent Owner (Ex. 2026, "T-Mobile Agreement").

Kathrein and Patent Owner represent that they have agreed to settle, Exhibit 2025 is a copy of their settlement agreement, and "there are no collateral agreements or understandings made in connection with, or in contemplation of, the termination of the *inter partes* review." Motion to Terminate, 5. Further, Kathrein and Patent Owner request that the Kathrein Agreement be treated as business confidential information and be kept separate from the file of the challenged patent pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c). Request to Keep the Kathrein Agreement Separate, 2.

T-Mobile and Patent Owner represent that they have agreed to settle, Exhibit 2026 constitutes their settlement agreement, and "there are no additional collateral agreements or understandings made in connection with, or in contemplation of, the termination of the *inter partes* review." Termination Motion 4. Exhibit 2026 (the T-Mobile Agreement) constitutes two documents: a litigation stipulation amongst, *inter alia*, Patent Owner

and T-Mobile, dated September 24, 2019; and a Covenant Not to Sue, dated September 23, 2019. Motion to Terminate, 4; Ex. 2026. T-Mobile and Patent Owner do not request that the T-Mobile Agreement be treated as business confidential information or be kept separate from the file of the challenged patent pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c). Motion to Terminate, 1.

Generally, the Board expects that a proceeding will terminate after the filing of a settlement agreement. *See* 35 U.S.C. § 317(a) ("An 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."); 37 C.F.R. § 42.72 ("The Board may terminate a trial without rendering a final written decision, where appropriate, including . . . pursuant to a joint request under 35 U.S.C. 317(a) . . . ."); *see also* Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,768 (Aug. 14, 2012) ("The Board expects that a proceeding will terminate after the filing of a settlement agreement, unless the Board has already decided the merits of the proceeding.").

This proceeding is at an early stage. We have not issued a decision on whether to institute an *inter partes* review. Under these circumstances, we grant the Motion to Terminate (Paper 22).

We also grant in part the Request to Keep the Kathrein Agreement Separate (Paper 23). *See* 35 U.S.C. § 317(b) ("At the request of a party to the proceeding, the agreement or understanding shall be treated as business confidential information, shall be kept separate from the file of the involved patents, and shall be made available only to Federal Government agencies

on written request, or to any person on a showing of good cause."); 37 C.F.R. § 42.74(c). We deny the portion of the parties' request that seeks to have the Kathrein Agreement "kept separate from the file of the present proceeding." Paper 23, 2. The parties cite no basis for that relief, and the parties filed the Kathrein Agreement as an exhibit in this proceeding.

ORDER

It is:

ORDERED that the Motion to Terminate (Paper 22) is *granted*;

FURTHER ORDERED that the Request to Keep the Kathrein Agreement Separate (Paper 23) is *granted in part*;

FURTHER ORDERED that the Kathrein Agreement (Ex. 2025) shall be treated as business confidential information, shall be kept separate from the file of the above-referenced patent, and shall be made available only in accordance with the provisions of 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c); and

FURTHER ORDERED that this proceeding is *terminated* both as to Petitioner and Patent Owner.

FOR PETITIONER:

Scott Burow
Matthew Becker
Binal Patel
John Curry
Jordan Bodner
Shambhavi Patel
BANNER AND WITCOFF, LTD.
sburow@bannerwitcoff.com
mbecker@bannerwitcoff.com
bpatel@bannerwitcoff.com
jcurry@bannerwitcoff.com
jbodner@bannerwitcoff.com
spatel@bannerwitcoff.com

Brian Oaks
David Tobin
BAKER BOTTS L.L.P.
brian.oaks@bakerbotts.com
david.tobin@bakerbotts.com

FOR PATENT OWNER:

Jason Shapiro
Patrick Finnan
Mark DeBoy
EDELL, SHAPIRO, AND FINNAN LLC
js@usiplaw.com
pjf@usiplaw.com
mjd@usiplaw.com