

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC and MOTOROLA MOBILITY LLC,
Petitioner,

v.

PRINCEPS SECUNDUS LLC,
Patent Owner.

IPR2020-01135
Patent 6,703,963 B2

Before JUSTIN T. ARBES, STACEY G. WHITE, and NABEEL U. KHAN,
Administrative Patent Judges.

WHITE, *Administrative Patent Judge.*

DECISION
Settlement Prior to Institution of Trial
37 C.F.R. § 42.74

With the Board’s authorization, Google LLC and Motorola Mobility LLC (collectively “Petitioner”) and Princeps Secundus LLC (“Patent Owner”) (collectively “the Parties”) filed a Joint Motion to Terminate Proceeding Pursuant to 37 C.F.R. § 42.74. Paper 12 (“Motion” or “Mot.”).

In support of the Motion, Petitioner Google LLC and Patent Owner filed a copy of a Settlement Agreement. Paper 13 (“Settlement Agreement”).¹ In the Motion, Petitioner Google LLC and Patent Owner represent that they have reached an agreement to jointly seek termination of the above-identified proceeding, and that the filed copy of the Settlement Agreement is a true and complete copy of the only agreement between Petitioner Google LLC and Patent Owner made in connection with, or in contemplation of, the termination of the proceeding under 37 C.F.R. § 42.74(b). Mot. 1. Petitioner Google LLC and Patent Owner further represent that their Settlement Agreement resolves their disputes regarding the above-identified patent, including in the above-identified proceeding and all related district court litigation. *Id.* at 1–2. Further, Petitioner Motorola Mobility LLC and Patent Owner represent that there is no settlement agreement between Petitioner Motorola Mobility LLC and Patent Owner made in connection with, or in contemplation of, the termination of the proceeding under 37 C.F.R. § 42.74(b). *Id.* at 1.

Based on the record before us, we dismiss the Petition in this proceeding. The instant proceeding is in the preliminary stage. Patent Owner did not file a preliminary response, and we have not yet considered

¹ The Parties are reminded that settlement agreements must be filed as exhibits, so they may be referenced individually by exhibit number. See 37 C.F.R. § 42.63. We treat the Parties’ filing of the Settlement Agreement as a paper rather than an exhibit as harmless error.

the merits of the Petition. In view of the early stage of the proceeding, the settlement between Petitioner Google LLC and Patent Owner and filing of the only agreement between the parties required to be filed under 35 U.S.C. § 42.74(b), and in view of the requested termination of the above-identified proceeding by the Parties as represented in the Motion, we determine that dismissing the Petition pursuant to the parties' joint request will lead to a "just, speedy, and inexpensive resolution" in this proceeding. 37 C.F.R. § 42.1(b). Under these circumstances, we determine that it is proper to dismiss the Petition and to terminate the proceeding. 37 C.F.R. § 42.5(a); 37 C.F.R. § 42.71(a).

The Parties also filed a Joint Request to File Settlement Agreement as Business Confidential Information and Keep the Agreement Separate from the File of the Involved Patent. Paper 14 ("Joint Request"). In the Joint Request, the Parties represent that the filed copy of the Settlement Agreement between Petitioner Google LLC and Patent Owner is a true and complete copy. Joint Request 1. After reviewing the Settlement Agreement, we find that the Settlement Agreement contains confidential business information regarding the terms of settlement. We determine that good cause exists 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).

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

Accordingly, for the reasons discussed above, it is:

ORDERED that the Motion is *granted*, the Petition in IPR2020-01135 is *dismissed*, and the proceeding is *terminated*; and

FURTHER ORDERED that the Joint Request is *granted*, and the Settlement Agreement between Petitioner Google LLC and Patent Owner

IPR2020-01135
Patent 6,703,963 B2

shall be kept separate from the files of U.S. Patent No. 6,703,963 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).

PETITIONER:

Theodoros Konstantakopoulos
Kevin McNish
DESMARAIS LLP
tkonstantakopoulos@desmaraisllp.com
kkm-ptab@desmaraisllp.com

PATENT OWNER:

Patrick R. Delaney
Timothy Devlin
DEVLIN LAW FIRM LLC
pdelaney@devlinlawfirm.com
TD-PTAB@devlinlawfirm.com