

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

DELL INC.,
Petitioner

v.

3G LICENSING S.A.,
Patent Owner.

IPR2020-01157 (Patent 7,274,933 B2)
IPR2020-01158 (Patent 7,460,868 B2)
IPR2020-01159 (Patent 7,596,375 B2)
IPR2020-01160 (Patent 8,275,374 B2)
IPR2020-01161 (Patent 8,472,955 B2)
IPR2020-01162 (Patent 8,948,756 B2)¹

Before TERRENCE W. MCMILLIN, AMANDA F. WIEKER,
MONICA S. ULLAGADDI, and RUSSELL E. CASS,
Administrative Patent Judges.

WIEKER, *Administrative Patent Judge.*

TERMINATION

Due to Settlement After Institution of Trial

35 U.S.C. § 317(a),(b); 37 C.F.R. §§ 42.72, 42.74

¹ This Order addresses issues that are the same in the above-captioned proceedings. The parties are not authorized to use a multi-case caption. Moreover, this is not an expanded panel. Each of the four listed judges are part of three-judge panels assigned to the listed proceedings.

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I. INTRODUCTION

On December 10, 2021, Dell Inc. and Patent Owner 3G Licensing S.A. (hereinafter “Joint Movants”) filed, in each of the above-identified proceedings, a Joint Motion to Terminate Proceedings. *See, e.g.*, IPR2020-01157, Paper 47 (“Motion”).² The Joint Movants also filed, on December 10, 2021, a true copy of a settlement agreement (Ex. 1034, “Settlement Agreement”) and a Joint Request to Treat Exhibit 1034 as Business Confidential Information. *See, e.g.*, IPR2020-01157, Paper 48 (“Request”).

II. DISCUSSION

The Motion states: “Dell and 3G have reached a Settlement and License Agreement (‘Agreement’) to resolve the Parties’ disputes at issue in this proceeding.” Mot. 1. The Motion also states: “Pursuant to 37 C.F.R. § 42.74(b), the Parties’ Agreement is in writing, and a true and correct copy is being filed as Exhibit 1034.” *Id.* The Motion further states: “No other such agreements, written or oral, exist between or among the Parties relating to this proceeding.” *Id.* at 2. Accordingly, the Motion states that “the Parties respectfully request that the Board terminate this *inter partes* review.” *Id.* at 3.

² For purposes of expediency, we cite to papers and exhibits filed in IPR2020-01157, unless otherwise noted. The Parties filed similar papers and exhibits in each of the above-identified proceedings.

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Generally, 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. PTAB Consolidated Trial Practice Guide, 86 (November 2019).³ Here, although the Board has instituted *inter partes* review of the challenged patents, the Board has not decided the merits of these proceedings. Under these circumstances, we grant the Motion to terminate in each proceeding.

Additionally, the Request states that “[t]he Parties consider the Settlement and License Agreement to contain highly sensitive business confidential information that would substantially harm their business interests if publicly disclosed,” and that “[t]he Settlement and License Agreement has been filed for access ‘Available only to board.’” Request 2. Therefore, the Joint Movants:

request that the Settlement and License Agreement (Confidential Exhibit 1034) (i) be treated as business confidential information, (ii) be maintained separate from the publicly available file of the involved patent, and (iii) shall be made available only to Federal Government agencies on written request, or to persons showing good cause on written request, with any such written request being served on the parties on the day it is provided to the Board, pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

Id.

We *grant-in-part* the Request. The Settlement Agreement in each proceeding shall be kept separate from the files of the applicable challenged

³ Available at <https://www.uspto.gov/TrialPracticeGuideConsolidated>.

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patent (i.e., U.S. Patent No. 7,274,933 B2, U.S. Patent No. 7,460,868 B2, U.S. Patent No. 7,596,375 B2, U.S. Patent No. 8,275,374 B2, U.S. Patent No. 8,472,955 B2, and U.S. Patent No. 8,948,756 B2), and will be made available only under the provisions of 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c). However, we *deny* the portion of the Request seeking an order from the Board that, in the event a person or entity makes a written request as stated in 37 C.F.R. § 42.74(c)(1)–(2) for access to the Settlement Agreement, any such written request be served upon the parties on the day the written request is provided to the Board. Neither the statute nor the rule includes such a requirement.

III. ORDER

In view of the foregoing, it is:

ORDERED that the Joint Motion to Terminate Proceedings in each of the above-identified proceedings is *granted*, and that Dell Inc. and 3G Licensing S.A. are herein terminated from these proceedings;

FURTHER ORDERED that the Joint Request to Treat Exhibit 1034 as Business Confidential Information in each of the above-identified proceedings is *granted-in-part and denied-in-part*, in the manner noted above; and

FURTHER ORDERED that the Settlement Agreement in each proceeding shall be kept separate from the files of U.S. Patent No. 7,274,933 B2, U.S. Patent No. 7,460,868 B2, U.S. Patent No. 7,596,375 B2, U.S. Patent No. 8,275,374 B2, U.S. Patent No. 8,472,955 B2, and U.S.

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IPR2020-01162 (Patent 8,948,756 B2)

Patent No. 8,948,756 B2, and will be made available only under the provisions of 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

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