

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

UNIVERSAL SECURE REGISTRY, LLC,
Patent Owner.

IPR2020-01220 (Patent 9,947,000 B2)
IPR2020-01221 (Patent 9,947,000 B2)
IPR2020-01222 (Patent 9,928,495 B2)
IPR2020-01223 (Patent 9,928,495 B2)
IPR2020-01224 (Patent 10,163,103 B2)
IPR2020-01225 (Patent 10,163,103 B2)

Before PATRICK R. SCANLON, GEORGIANNA W. BRADEN, and
JASON W. MELVIN, *Administrative Patent Judges*.

MELVIN, *Administrative Patent Judge*.

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

IPR2020-01220 (Patent 9,947,000 B2)
IPR2020-01221 (Patent 9,947,000 B2)
IPR2020-01222 (Patent 9,928,495 B2)
IPR2020-01223 (Patent 9,928,495 B2)
IPR2020-01224 (Patent 10,163,103 B2)
IPR2020-01225 (Patent 10,163,103 B2)

I. INTRODUCTION

With the Board's authorization, Petitioner and Patent Owner (collectively "the Parties") filed a Joint Motion to Terminate in each of the above-referenced proceedings due to settlement. Paper 8 ("Joint Motion").¹ In support of each Joint Motion, the Parties filed a copy of a Release and Covenant Agreement (Ex. 1016 ("Settlement Agreement")), as well as a Joint Motion to File Agreement as Business Confidential Information pursuant to 37 C.F.R. § 42.74(c) (Paper 9 ("Joint Request")).

II. DISCUSSION

In the Joint Motions, the Parties represent that they have reached an agreement to terminate the proceedings. Joint Motion 1. The Parties further represent that the Settlement Agreement is a true copy, and "that there are no other collateral agreements or understandings, oral or written, between the parties made in connection with, or in contemplation of, the termination of" the proceedings. *Id.* at 1–2.

The above-referenced proceedings are each at an early stage, and we have not yet decided whether to institute trials. In view of the early stage of the proceedings and the settlement between the Parties, we determine that good cause exists to dismiss the petitions and terminate the proceedings with respect to the Parties.

¹ For expediency, we refer to papers and exhibits filed in IPR2020-01220. Similar papers and exhibits were filed in each of the above-referenced proceedings.

IPR2020-01220 (Patent 9,947,000 B2)
IPR2020-01221 (Patent 9,947,000 B2)
IPR2020-01222 (Patent 9,928,495 B2)
IPR2020-01223 (Patent 9,928,495 B2)
IPR2020-01224 (Patent 10,163,103 B2)
IPR2020-01225 (Patent 10,163,103 B2)

In the Joint Requests, the Parties request that the Settlement Agreement be treated as business confidential information and be kept separate from the files of the patents involved in these proceedings. Joint Request 1. After reviewing the Settlement Agreement between Petitioner and Patent Owner, 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 between Petitioner and Patent Owner as business confidential information pursuant to 37 C.F.R. § 42.74(c).

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

III. ORDER

Accordingly, for the reasons discussed above, it is:

ORDERED that the Joint Motions to Terminate are *granted*, and the petitions in IPR2020-01220, IPR2020-01221, IPR2020-01222, IPR2020-01223, IPR2020-01224, and IPR2020-01225 are dismissed and these proceedings are *terminated*; and

FURTHER ORDERED that the Joint Requests are *granted*, and the Settlement Agreement shall be kept separate from the files of Patents 9,947,000 B2, 9,928,495 B2, and 10,163,103 B2 and be made available only to Federal Government agencies on written request, or to any person on a showing of good cause, pursuant to 37 C.F.R. § 42.74(c).

IPR2020-01220 (Patent 9,947,000 B2)
IPR2020-01221 (Patent 9,947,000 B2)
IPR2020-01222 (Patent 9,928,495 B2)
IPR2020-01223 (Patent 9,928,495 B2)
IPR2020-01224 (Patent 10,163,103 B2)
IPR2020-01225 (Patent 10,163,103 B2)

FOR PETITIONER:

Monica Grewal
Benjamin Fernandez
Scott Bertulli
WILMER CUTLER PICKERING HALE AND DORR LLP
monica.grewal@wilmerhale.com
ben.fernandez@wilmerhale.com
scott.bertulli@wilmerhale.com

FOR PATENT OWNER:

Christopher A. Mathews
Tigran Guledjian
James M. Glass
Nima Hefazi
Razmig Messerian
QUINN EMANUEL URQUHART & SULLIVAN LLP
chrismathews@quinnemanuel.com
tigranguledjian@quinnemanuel.com
jimglass@quinnemanuel.com
nimahefazi@quinnemanuel.com
razmessengerian@quinnemanuel.com