

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

QUALCOMM INCORPORATED and
ZYXEL COMMUNICATIONS CORPORATION¹
Petitioner,

v.

UNM RAINFOREST INNOVATIONS,
Patent Owner.

IPR2021-00375
Patent 8,265,096 B2

Before KRISTEN L. DROESCH, BARBARA A. PARVIS, and
CHARLES J. BOUDREAU, *Administrative Patent Judges*.

DROESCH, *Administrative Patent Judge*.

TERMINATION
Due to Settlement on Remand
35 U.S.C. § 317; 37 C.F.R. § 42.74

¹ Qualcomm Incorporated did not participate in the appeal of the Final Written Decision to the Court of Appeals for the Federal Circuit. *See* Paper 69, 1 n.1.

I. DISCUSSION

Qualcomm Incorporated (“Qualcomm”) filed the Petition in this proceeding, challenging claims 1–4 and 6–8 of U.S. Patent No. 8,265,096 B2. Paper 1. Subsequently, ZyXEL Communications Corporation (“ZyXEL”) filed a petition and motion for joinder in IPR2021-00734, and we joined ZyXEL as a petitioner in this proceeding. We entered a Final Written Decision in this proceeding on July 15, 2022, concluding that Qualcomm and ZyXEL established by a preponderance of the evidence that claims 1–4, 6, and 7 are unpatentable but had not established the unpatentability of claim 8. Paper 68. We also determined that UNM Rainforest Innovations (“Patent Owner” or “UNMRI”) met the statutory requirements for a motion to amend and that Qualcomm and ZyXEL had not established by a preponderance of the evidence that proposed substitute claims 44–47, 49, and 50 proposed in the motion to amend are unpatentable. *Id.*

ZyXEL filed an appeal of the Final Written Decision to the Court of Appeals of the Federal Circuit, and Patent Owner filed a cross-appeal. *See* Papers 69, 70. ZyXEL filed its Notice of Appeal without the involvement of Qualcomm. *See* Paper 69, 1 n.1. On July 22, 2024, the Court of Appeals for the Federal Circuit entered a Decision that affirmed our determination as to claims 1–4, 6, and 7; reversed our determination as to claim 8; and remanded for further evaluation with respect to proposed substitute claims 44–47, 49, and 50. *See* Paper 72.

On December 31, 2024, and January 17, 2025, with our authorization via emails dated December 6, 2024 and January 13, 2025, ZyXEL and Patent Owner jointly filed the following: (1) “Corrected Joint Motion to

Terminate *Inter Partes* Review Pursuant to 35 U.S.C. § 317 and 37 C.F.R. § 42.72” (Paper 75, “Mot.” or “Joint Motion”); (2) a true copy of the parties’ settlement agreement (Ex. 1041); and (3) “Joint Request to Maintain Confidentiality and to Keep Separate Pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.72(c)” (Paper 73, “Joint Request”).

In the Joint Motion, “Patent Owner UNM Rainforest Innovations . . . and sole remaining Petitioner ZyXEL Communications Corporation . . . ^[2] jointly request termination of this proceeding, IPR2021-00375, directed to U.S. Patent No. 8,265,096 B2 . . . , as a result of a Settlement Agreement that resolves all pending disputes between Petitioner and Patent Owner.” Mot. 1. Further, “the parties confirm that the submitted Settlement Agreement (Exhibit 1041) between Petitioner and Patent Owner is a true copy of any and all agreements made in connection with or in contemplation of the requested termination, including collateral agreements, and that there are no other collateral agreements, oral or written, in connection with the settlement.” *Id.* at 2.

The Board has not issued a decision on the remand in-part as to proposed substitute claims 44–47, 49, and 50. Thus, the Board has not finally decided the merits of the proceeding as to proposed substitute claims 44–47, 49, and 50. Under these particular circumstances, we determine that it is appropriate to terminate the proceeding without rendering a final written decision as to proposed substitute claims 44–47, 49, and 50. *See* 37 C.F.R. § 42.72.

In addition, we have reviewed the true copy of the parties’ settlement

² As observed by the Court of Appeals for the Federal Circuit, “Qualcomm appears to have settled with UNMRI.” Paper 72, 6.

agreement (Ex. 1041), and determine that good cause exists to treat this settlement agreement as business confidential information and keep it separate from the file of U.S. Patent 8,265,096 B2. *See* 35 U.S.C. § 317(b); 37 C.F.R. § 42.74(c).

II. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that the parties' Joint Request to file their settlement agreement as business confidential information and keep it separate from the file of U.S. Patent No. 8,265,096 B2 (Paper 73) is *granted*;

FURTHER ORDERED that Exhibit 1041 shall remain business confidential information, and shall be kept separate from the file of U.S. Patent No. 8,265,096 B2 and made available only to Federal Government agencies on written request or to any other person on a showing of good cause, pursuant to 37 C.F.R. § 42.74(c); and

FURTHER ORDERED that the parties' Corrected Joint Motion to Terminate (Paper 75) is *granted*; and this proceeding is terminated.

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(IPR2021-00375)

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