

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HUAWEI TECHNOLOGIES CO. LTD.,
Petitioner,

v.

VERIZON PATENT AND LICENSING INC.,
Patent Owner.

IPR2021-00616 (Patent 8,121,111 B2)
IPR2021-00617 (Patent 8,983,288 B2)¹

Before MICHAEL R. ZECHER, TERRENCE W. McMILLIN, and SCOTT
RAEVSKY, *Administrative Patent Judges*.

Opinion for the Board by *Administrative Patent Judge* McMILLIN.

Opinion dissenting filed by *Administrative Patent Judge* ZECHER.

McMILLIN, *Administrative Patent Judge*.

ORDER
Granting Joint Motions to Dismiss
and Terminating the Proceedings
37 C.F.R. § 42.71(a)

¹ The parties are not authorized to use this form of caption and shall make separate filings in each case.

IPR2021-00616 (Patent 8,121,111 B2)
IPR2021-00617 (Patent 8,983,288 B2)

On August 20, 2021, as authorized by the Board (Ex. 3002), the parties filed a Joint Motion to Dismiss Petition for *Inter Partes* Review under 37 C.F.R. § 42.71(a) in both of the proceedings identified above. Paper 8 (“Motion” or “Mot.”).² In the Motion, the parties “jointly move under 37 C.F.R. § 42.71(a) to dismiss the petition for *inter partes* review filed March 26, 2021, without adverse judgment and without a decision on institution.” Mot. 1. The parties contend that, “[t]here is good cause for dismissal here because the *inter partes* review is in its pre-institution phase, and both parties are in agreement as to this outcome.” *Id.*

These proceedings are in their preliminary phase and a decision on institution of *inter partes* review has not yet been entered in either proceeding. And, we determine that good cause for dismissal and termination exists for the reasons stated by the parties in the Motion and because dismissal and termination under the present circumstances will facilitate the just, speedy, and inexpensive resolution of these proceedings. *See* 37 C.F.R. § 42.1(b).

² The Motion in IPR2021-00616 is referred to and cited in this Order. The Motion in IPR2021-00617 is substantively identical. The posture of, and the records in, these two proceedings are for all purposes material to the Motion the same.

IPR2021-00616 (Patent 8,121,111 B2)
IPR2021-00617 (Patent 8,983,288 B2)

ORDER

In consideration of the foregoing, it is hereby:

ORDERED that the Joint Motion[s] to Dismiss Petition for *Inter Partes* Review under 37 C.F.R. § 42.71(a) (Paper 8) filed in IPR2021-00616 and IPR2021-00617 are *granted*; and

FURTHER ORDERED that the Petition[s] (Paper 2) in IPR2021-00616 and IPR2021-00617 are *dismissed*, and both proceedings are *terminated*.

IPR2021-00616 (Patent 8,121,111 B2)
IPR2021-00617 (Patent 8,983,288 B2)

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ZECHER, *Administrative Patent Judge*, dissenting.

Because I would follow the long-standing practice of requiring the parties to file a written settlement agreement prior to dismissing the petitions, thereby resulting in termination of these proceedings, I respectfully dissent.

As the majority explains above, the parties filed a Joint Motion to Dismiss Petition for *Inter Partes* Review Under 37 C.F.R. § 42.71(a) in both proceedings. Paper 8 (“Motion” or “Mot.”).³ In the Motion, the parties rely on the majority holding in *Samsung Elecs. Co. v. Telefonaktiebolaget LM Ericsson*, IPR2021-00446, Paper 7 at 5 (PTAB Aug. 3, 2021) (Order—Dismissal Prior to Institution of Trial) (“*Samsung*”) to argue that “a settlement agreement is not required to be filed here because this motion to dismiss the petition is brought under, and seeks dismissal pursuant to, 37 C.F.R. § 42.71(a).” Mot. 2. The majority holding in the *Samsung* case,

³ Unless otherwise noted, all citations are to the papers filed in IPR2021-00616. Similar papers were filed in IPR2021-00617.

however, has not been designated precedential and, therefore, is not binding on this panel. Absent a precedential designation or a clear *written* directive from the person performing the functions and duties of the Under Secretary of Commerce for Intellectual Property and Director of the U.S. Patent and Trademark Office, I would not treat the *Samsung* case as binding authority.

Instead, I agree with the dissent in the *Samsung* case authored by my colleague, Judge Miriam L. Quinn, in which she explains how 37 C.F.R. § 42.74(b)—aptly titled “Agreements in writing”—applies to a preliminary proceeding, as well as the underlying policy considerations behind requiring the parties to file a written settlement agreement prior to dismissing a petition, thereby resulting in termination of the proceeding. *Samsung* at 6–12. I share Judge Quinn’s concern that deviating from the long-standing practice of requiring the parties to file a written settlement agreement prior to dismissing a petition would make terminating a preliminary proceeding by joint request of the parties dependent on how Board panels view the relevance of 37 C.F.R. §§ 42.71(a) and 42.74(b).

Accordingly, I respectfully dissent.