

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HONEYWELL INTERNATIONAL, INC., SIERRA WIRELESS, INC.,
TCL COMMUNICATION TECHNOLOGY HOLDINGS LIMITED, TCT
MOBILE INTERNATIONAL LIMITED, TCT MOBILE, INC., TCT
MOBILE (US) INC., TCT MOBILE (US) HOLDINGS INC., and TELIT
CINTERON DEUTSCHLAND GMBH,
Petitioner,

v.

3G LICENSING S.A.,
Patent Owner.

IPR2024-00906
Patent 7,580,388 B2

Before JAMESON LEE, AARON W. MOORE, and
RUSSELL E. CASS, *Administrative Patent Judges*.

LEE, *Administrative Patent Judge*.

TERMINATION

Due to Settlement After Institution of Trial
35 U.S.C. § 317(a); 37 C.F.R. § 42.74

ORDER

Granting Request to Keep Settlement Agreement Confidential
35 U.S.C. § 317(b); 37 C.F.R. § 42.74(c)

I. INTRODUCTION

On April 8, 2025, petitioner constituents TCL Communication Technology Holdings Limited, TCT Mobile International Limited, TCT Mobile, Inc., TCT Mobile (US) Inc., and TCT Mobile (US) Holdings Inc. (collectively “TCL/TCT”) and Patent Owner together filed a Joint Motion to Terminate this proceeding as to TCL/TCT (Paper 84, “Joint Motion to Terminate TCL/TCT”) as well as a copy of their Settlement Agreement (Ex. 1017). Also on April 8, 2025, TCL/TCT and Patent Owner filed, under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c), a Joint Request to Treat Settlement Agreement as Business Confidential Information under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c), specifically identifying Exhibit 1017. Paper 85, 1 (“Joint Request”).

II. DISCUSSION

On December 6, 2022, we entered a Final Written Decision (Paper 74) determining that Petitioner proved unpatentable all challenged claims of Patent No. 7,580,388 B2, i.e., claims 1–4, 6, 8, 9, 12, 33–36, 38, 40, 41, 44, 56, 57, 62, and 63, and granting Patent Owner’s Revised Motion to Amend Claims (Paper 36) which proposed substitute claims 66–85.

On February 3, 2025, the Federal Circuit affirmed-in-part, vacated-in-part, and remanded. Paper 80. The mandate from the Federal Circuit issued on March 12, 2025. Paper 79.

On remand, we have not yet had a conference call with the parties to discuss a further course of action. A conference call is scheduled for April 10, 2025. We have reviewed the settlement agreement and find that it does include confidential information justifying the Joint Request. It is appropriate to terminate this proceeding now as to TCL/TCT, and to treat

Exhibit 1017 as business confidential information under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

III. ORDER

It is

ORDERED that the Joint Motion to Terminate TCL/TCT is *granted*, and this proceeding is hereby terminated as to TCL/TCT, i.e., TCL Communication Technology Holdings Limited, TCT Mobile International Limited, TCT Mobile, Inc., TCT Mobile (US) Inc., and TCT Mobile (US) Holdings Inc.;

FURTHER ORDERED that the Joint Request to treat Exhibit 1017 as business confidential information under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) is *granted*;

FURTHER ORDERED that the Settlement Agreement (Ex. 1017) shall be kept separate from the file of Patent 7,580,388 B1;

FURTHER ORDERED that the Settlement Agreement (Ex. 1017) shall, pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c), be made available only to Federal Government agencies on written request or to any other person upon written request and showing of good cause.

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For Petitioner:

Guy Yonay
Zeev Pearl
Kyle Auteri
Milo Eaden
Pearl Cohen Zedek Latzer Baratz LLP
gyonay@pearlcohen.com
zpearl@pearlcohen.com
kauteri@pearlcohen.com
meadan@pearlcohen.com

Erik J. Halverson
Brian Paul Bozzo
K & L GATES LLP
erik.halverson@klgates.com
brian.bozzo@klgates.com

Amanda Tessar
Daniel T. Keese
PERKINS COIE LLP
atessar-ptab@perkinscoie.com
dkeese@perkinscoie.com

Jeremy D. Peterson
Bradford A. Cangro
PV Law LLP
jeremy.peterson@pvuslaw.com
bradford.cangro@pvuslaw.com

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For Patent Owner:

Timothy Devlin
Neil Benchell
Andrew DeNarco
James M. Lennon
Jason M. Shapiro
Nadiia Loizides
Devlin Law Firm LLC
tdevlin@devlinlawfirm.com
nbenchell@devlinlawfirm.com
ademarco@devlinlawfirm.com
jlennon@devlinlawfirm.com
jshapiro@devlinlawfirm.com
nloizides@devlinlawfirm.com