

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

QUALCOMM, INC.,
Petitioner,

v.

FUTURE LINK SYSTEMS, LLC,
Patent Owner.

IPR2021-01396
Patent 7,917,680 B2

Before KARL D. EASTHOM, KEVIN C. TROCK, and
JOHN A. HUDALLA, *Administrative Patent Judges*.

TROCK, *Administrative Patent Judge*.

TERMINATION

Due to Settlement After Institution of Trial and
Granting Joint Request to Treat the Release Agreement
as Business Confidential Information
35 U.S.C. § 317; 37 C.F.R. § 42.74

I. INTRODUCTION

On June 13, 2022, pursuant to our authorization, Petitioner and Patent Owner (collectively, “the Parties”) filed a Joint Motion to Terminate this proceeding due to settlement. Paper 9 (“Joint Motion”). The Parties also filed a first copy of a Release Agreement (Ex. 1012 (“Release Agreement”)) comprising eight pages purportedly governing their settlement along with a joint request (Paper 10 (“Joint Request”)) that the Release Agreement be treated as business confidential information and kept separate from the publicly available file of the proceeding. The first copy of the Release Agreement appeared to be incomplete, however, as page 8¹ of the document titled “Schedule 1 Patents” refers to an “Exhibit B” that was not part of the filing. On June 17, 2022, the Board sent an email (Ex. 3001) to counsel of record advising them of the incomplete document and requesting the Parties file a complete copy of their settlement agreement, including all exhibits and schedules, pursuant to 37 C.F.R. § 42.74. The Parties filed a second copy of the Release Agreement (also numbered Ex. 1012) comprising sixteen pages, including pages 9 through 16 listing a number of patent documents that are apparently subject to the Release Agreement. *See* Ex. 1012. These additional pages had been omitted from the first copy of the Release Agreement.

¹ The Release Agreement does not include page numbers. *See* Ex. 1012. For convenience, we refer to the pages of the Release Agreement as if numbered consecutively beginning with the page captioned “RELEASE TERMS” as page 1.

II. DISCUSSION

In the Joint Motion, the Parties represent that the Release Agreement resolves their disputes involving the patent at issue in the above-captioned proceeding. Joint Motion 1. The Parties also represent that they have filed a true and accurate copy of the of the agreement between the parties that resolves this proceeding, and that there are no other agreements, oral or written, between the parties made in connection with, or in contemplation of, the termination of this proceeding. *Id.* at 1–2.

We instituted trial for this proceeding (*see* Paper 7), but we have not yet decided the merits of this proceeding, and a final written decision has not been entered. Notwithstanding that this proceeding has moved beyond the preliminary stage, the Parties have shown adequately that the termination of this proceeding is appropriate.

We also have reviewed the second copy of the Release Agreement at Exhibit 1012, and it appears to be the complete agreement between the parties as required by 35 U.S.C. § 317(b). Under these circumstances, we determine that good cause exists to terminate this proceeding with respect to the Parties.

In the Joint Request, the Parties request that the Release Agreement be treated as business confidential information and kept separate from the file of the patent involved in this proceeding. Joint Request 1. After reviewing the Release Agreement, we find that it contains confidential business information regarding the terms of settlement. Thus, good cause exists to treat both copies of the Release Agreement at Exhibit 1012 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, it is

ORDERED that the Joint Motion to Terminate (Paper 9) is *granted*, and IPR2021-01396 is *terminated*; and

FURTHER ORDERED that the Joint Request (Paper 10) is *granted*, and both copies of the Release Agreement (Ex. 1012) shall be kept separate from the file of U.S. Patent No. 7,917,680 B2, and 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).

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