

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

BELL NORTHERN RESEARCH, LLC,
Patent Owner

IPR2021-01591
Patents 7,957,450 B2

Before JAMESON LEE, BRYAN F. MOORE, and JASON M. REPKO,
Administrative Patent Judges.

REPKO, *Administrative Patent Judge.*

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

INTRODUCTION

With our emailed authorization, the parties filed a “Joint Motion to Dismiss Pursuant to 35 U.S.C. § 317 and 37 C.F.R. §§ 42.72 and 42.7[4].” Paper 7 (“Joint Motion to Terminate”). With our emailed authorization, the parties also filed a “Joint Motion to Keep [Settlement Agreement (Exhibit 2001)] Confidential and Separate under 35 U.S.C. § 317(B) and 37 C.F.R. § 42.74(C).” Paper 6 (“Joint Motion to Keep Separate”).

The Joint Motion to Terminate explains that the parties “have entered into a written confidential settlement agreement that fully resolves this matter.” Paper 7, 1. The Joint Motion to Terminate further states that “[t]he parties agree that neither Patent Owner nor Petitioner will be prejudiced by termination of this proceeding.” *Id.* The parties have filed a copy of their settlement agreement as Exhibit 2001. *Id.* The Joint Motion to Terminate states: “The undersigned represents that Exhibit 2001 represents a true and accurate copy of the agreement between the parties (‘Confidential Settlement Agreement’) that resolves the present proceeding.” *Id.*

JOINT MOTION TO TERMINATE

Generally, the Board expects that a proceeding will terminate after the filing of a settlement agreement, unless the Board has already decided the merits of the proceeding. Patent Trial and Appeal Board, Consolidated Trial Practice Guide 86 (Nov. 2019).¹ This proceeding is at an early stage. Patent Owner has not yet filed a Preliminary Response, and we have not issued a decision on whether to institute an *inter partes* review. Under these

¹ Available at <https://www.uspto.gov/TrialPracticeGuideConsolidated>.

circumstances, we grant the Joint Motion to Terminate as to both Petitioner and Patent Owner.

JOINT MOTION TO KEEP SEPARATE

The parties filed a Joint Motion to Keep Separate to treat the parties' Settlement Agreement as business confidential information and have it kept apart from the file of Patent 7,957,450 B2 "*pursuant to 35 U.S.C. § 317(b) (and) 37 C.F.R. § 42.74(c).*" Paper 6 (emphasis added). We grant the request. We note that the Joint Motion to Keep Separate also states, in part,

Petitioner and Patent Owner, jointly request that the settlement agreement(s) and collateral agreement(s) (if any) resolving the disputes between Petitioner and Patent Owner (Exhibit 2001) submitted in this case concurrently herewith be treated as business confidential information and kept separate from the files of the involved patent *and inter partes review proceeding*, and only made available to Federal Government agencies upon written request, or to any other person upon written request and a finding of good cause *after notice to the parties to the agreement and an opportunity for those parties to respond to the request.*

Id. at 2 (emphasis added). The rule, however, does not require notice to the parties or allow for an opportunity for the parties to respond to the request. 37 C.F.R. § 42.74(c). Nor does the rule require that the Settlement Agreement be kept separate from the files of the *inter partes* review proceeding. Instead, the rule states,

A party to a settlement may request that the settlement be treated as business confidential information and *be kept separate from the files of an involved patent or application.* The request must be filed with the settlement. If a timely request is filed, the settlement shall only be available:

(1) To a Government agency on written request to the Board; or

(2) To any other person *upon written request to the Board* to make the settlement agreement available, along with the fee specified in § 42.15(d) and on a showing of good cause.

Id. (emphasis added). Thus, by granting the request “pursuant to” 37 C.F.R. 42.74(c), the files may be made available without notice to the parties to the agreement and without an opportunity for those parties to respond to the request, and the agreement need not be kept separate from the files of the *inter partes* review proceeding. *See* Paper 6. Also, we understand “written request” in the Joint Motion to Keep Separate to mean “written request *to the Board*,” as stated in the rule. *See id.*

ORDER

It is

ORDERED that the Joint Motion to Dismiss (Paper 7) is *granted* both as to Petitioner and to Patent Owner;

FURTHER ORDERED that the Joint Motion to Keep Separate (Paper 6) is *granted*, as explained above, under the terms of 37 C.F.R. § 42.74(c);

FURTHER ORDERED that the Settlement Agreement (Ex. 2001) shall be treated as business confidential information, shall be kept separate from the file of Patent 7,957,450 B2, and shall be made available only in accordance with the provisions of 37 C.F.R. § 42.74(c); and

FURTHER ORDERED that this proceeding is *terminated* both as to Petitioner and to Patent Owner, and the Petition is *dismissed*.

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For PETITIONER:

W. Karl Renner
Jeremy J. Monaldo
Timothy W. Riffe
Jennifer Huang
FISH & RICHARDSON P.C.
axf-ptab@fr.com
jjm@fr.com
riffe@fr.com
jhuang@fr.com

For PATENT OWNER:

Daniel S. Young
Chad E. King
ADSERO IP LLC
dyoung@adseroip.com
chad@adseroip.com