

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MOTOROLA MOBILITY LLC,
Petitioner,

v.

LUMINTEC, LLC,
Patent Owner.

IPR2022-00430
Patent 8,724,983 B2

Before JAMES J. MAYBERRY, JOHN A. HUDALLA, and
SHARON FENICK, *Administrative Patent Judges*.

MAYBERRY, *Administrative Patent Judge*.

TERMINATION

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

I. INTRODUCTION

With the Board’s authorization, Petitioner, Motorola Mobility LLC , and Patent Owner, Lumintec, LLC, (collectively, “the Parties”), filed a Joint Motion to Terminate the above-captioned *inter partes* review proceeding. Paper 7 (“Joint Motion”). Included in the Joint Motion is a joint request that the Settlement Agreement be treated as business confidential information and kept separate from the file of U.S. Patent No. 8,724,983 B2 (“the ’983 patent”). Joint Motion 2, 3.

Along with the Joint Motion, the Parties filed a copy of a Confidential Settlement Agreement (Ex. 1020, “Settlement Agreement”), and a Joint Stipulation of Dismissal (Ex. 1021, “Joint Stipulation”) of the district court litigation between the Parties related to the ’983 patent.”

II. DISCUSSION

A. *Joint Motion to Terminate*

Under 35 U.S.C. § 317(a), “[a]n *inter partes* review instituted under this chapter shall be terminated with respect to any petitioner upon the joint request of the petitioner and the patent owner, unless the Office has decided the merits of the proceeding before the request for termination is filed.”

35 U.S.C. § 317(a) also provides that if no petitioner remains in the *inter partes* review, the Office may terminate the review.

In the Joint Motion, the Parties argue that “[g]ood cause exists to terminate this proceeding,” as the Parties “have resolved their disputes involving the ’983 patent.” Joint Motion 3; *see also* Joint Stipulation 1 (“Plaintiff Lumintec LLC hereby dismisses with prejudice all claims against Defendant Motorola Mobility LLC,” and “Defendant Motorola Mobility LLC hereby dismisses without prejudice all claims and defenses against

Plaintiff Lumintec LLC.”). The Parties indicate that Exhibit 1020 represents a true copy of the Settlement Agreement. Joint Motion 1. The Parties “certify that there is no other ‘agreement or understanding between the [Parties] . . . , including any collateral agreements referred to in such agreement or understanding, made in connection with, or in contemplation of, the termination of’ this proceeding.” *Id.* (quoting 35 U.S.C. § 317(a)).

We instituted trial for the above-identified *inter partes* review proceeding on June 30, 2022. *See* Paper 5. We have not yet decided the merits of the proceeding, and a final written decision has not been entered. Under these circumstances and in view of the Parties’ settlement, we determine that good cause exists to terminate the proceeding.

B. Joint Request to Treat Settlement Agreement as Business Confidential

In the Joint Motion, the Parties request that the Settlement Agreement be treated as business confidential information and kept separate from the file of the ’983 patent. Joint Motion 3. Consistent with 35 U.S.C. § 317(b), the Parties request that the Settlement Agreement “be made available only to Federal Government agencies on written request or to persons showing good cause.” *Id.*; *see* 35 U.S.C. § 317(b).

After reviewing the Settlement Agreement, we determine that good cause exists to treat the Settlement Agreement as business confidential information pursuant to 37 C.F.R. § 42.74(c), and we grant the Parties’ request in that regard.

III. ORDER

Accordingly, it is:

ORDERED that the Joint Motion to Terminate (Paper 7) is *granted*, and IPR2022-00430 is *terminated* with respect to Petitioner and Patent Owner; and

FURTHER ORDERED that the Parties' request to treat the Settlement Agreement as business confidential information (Paper 7) is *granted*, and the Settlement Agreement (Ex. 1020) shall be kept separate from the file of U.S. Patent No. 8,724,983 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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