

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NOKIA OF AMERICA CORPORATION, ERICSSON INC.,
Petitioner,

v.

GODO KAISHA IP BRIDGE 1,
Patent Owner.

IPR2022-00446
Patent 7,372,909 B2

Before DAVID C. McKONE, SHEILA F. McSHANE, and
AMBER L. HAGY, *Administrative Patent Judges*.

HAGY, *Administrative Patent Judge*.

TERMINATION

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

I. INTRODUCTION

Petitioner and Patent Owner (collectively “the Parties”) have requested that the above-identified *inter partes* review proceeding be terminated pursuant to a settlement. On March 8, 2023, the Parties filed a Joint Motion to Terminate Proceeding (“Joint Motion”) in the above-identified proceeding. Paper 20. The Parties previously sought authorization to file the Joint Motion and received that authorization on March 7, 2023. Joint Motion 2. The Parties also filed copies of a Patent License and Transfer of Patents Agreement (Ex. 1017) and a Settlement and License Agreement (Ex. 1018) (collectively, the “Settlement Agreements”). Additionally, the Parties filed a Joint Motion to File Agreement as Business Confidential Information (Paper 19) for a Patent License and Transfer of Patents Agreement (Ex. 1017) and a Joint Motion to File Agreement as Business Confidential Information (Paper 21) for a Settlement and License Agreement (Ex. 1018).

II. DISCUSSION

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

In the Joint Motion, the Parties represent that they have reached an agreement to resolve all of their present disputes regarding Patent 7,372,909, that the filed copies of the Settlement Agreements are “true and correct” copies, and that “[t]here are no other agreements, oral or written, between

the Parties made in connection with, or in contemplation of, the termination of this proceeding.” Joint Motion 2–4.

We instituted trial in the above-identified proceeding. Paper 8. We have not yet decided the merits of the proceeding, and a final written decision has not been entered. Notwithstanding that the proceeding has moved beyond the preliminary stage, the Parties have shown adequately that termination of the proceeding is appropriate. Under these circumstances, we determine that good cause exists to terminate the proceeding with respect to the Parties.

The Parties also requested that the Settlement Agreements be treated as business confidential information and be kept separate from the file of Patent 7,372,909. Paper 19, 3; Paper 21, 3. After reviewing the Settlement Agreements, we find that the Settlement Agreements contain confidential business information regarding the terms of settlement. We determine that good cause exists to treat the Settlement Agreements as business confidential information pursuant to 35 U.S.C. § 317(b) and 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, for the reasons discussed above, it is:

ORDERED that the Joint Motion to Terminate Proceeding (Paper 20) is *granted* and IPR2022-00446 is *terminated* with respect to Petitioner and Patent Owner, pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. § 42.72; and

FURTHER ORDERED that the Joint Motions to File Agreement as Business Confidential Information (Papers 19, 21) are *granted*, and the

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Settlement Agreements (Exhibits 1017, 1018) shall be kept separate from the file of Patent 7,372,909 and made available only to Federal Government agencies on written request, or to any person on a showing of good cause, pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

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