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Paper 16
Date: December 22, 2022

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

TELEFONAKTIEBOLAGET LM ERICSSON,
Patent Owner.

IPR2022-00457
Patent 9,509,440 B2

Before SALLY C. MEDLEY, GEORGIANNA W. BRADEN, and NATHAN A. ENGELS, *Administrative Patent Judges*.

MEDLEY, *Administrative Patent Judge*.

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

I. INTRODUCTION

Apple Inc. ("Petitioner") filed a Petition requesting an *inter partes* review of claims 1–9, 11–19, 21, 23, 25, and 27 of U.S. Patent No. 9,509,440 B2 (Ex. 1001, "the '440 patent"). Paper 1 ("Pet."). Telefonaktiebolaget LM Ericsson ("Patent Owner") filed a Preliminary Response. Paper 6 ("Prelim. Resp.").

On September 21, 2022, the Board instituted an *inter partes* review of claims 1–9, 11–19, 21, 23, 25, and 27 in the '440 patent. Paper 7.

On December 21, 2022, after receiving Board authorization, Petitioner and Patent Owner filed a Joint Motion to Terminate Proceeding under 35 U.S.C. § 317(a) and 37 C.F.R. § 42.74 along with a settlement agreement. Paper 14; Ex. 1017. The parties also filed 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). Paper 15.

II. DISCUSSION

The parties represent that they "have reached a settlement as to all the disputes in this proceeding and as to the '440 patent." Paper 14, 2. The parties represent that a "true copy of the settlement agreement" is filed as Exhibit 1017. *Id.* The parties also represent that "[n]o other such agreements, written or oral, exist between or among" the parties. *Id.*

The parties assert that termination "would save significant further expenditure of resources by" the parties. Paper 14, 2. The parties assert that termination "would also further the purpose of *inter partes* review proceedings, which seek to provide an efficient and less costly alternative forum for patent disputes." *Id.* at 2–3. Additionally, the parties contend that "maintaining the proceeding would discourage further settlements, as patent owners in similar situations would have a strong disincentive to settle if they

perceived that an *inter partes* review would continue regardless of a settlement." *Id.* at 3.

Patent Owner has not yet filed a Response. Based on the facts before us, we determine that it is appropriate to terminate this proceeding. We also determine that it is appropriate to treat the parties' settlement agreement (Exhibit 1017) as business confidential information under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

This Order does not constitute a final written decision under 35 U.S.C. § 318(a).

III. ORDER

Accordingly, it is

ORDERED that the parties' Joint Motion to Terminate Proceeding (Paper 14) is granted;

FURTHER ORDERED that this proceeding is terminated as to all parties; and

FURTHER ORDERED that the parties' Joint Request to Treat Settlement Agreement as Business Confidential Information (Paper 15) is granted, and the parties' settlement agreement (Exhibit 1017) shall be treated as business confidential information and be kept separate from the file of U.S. Patent No. 9,509,440 B2 and made available only under the provisions of 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

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