

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NOKIA OF AMERICA CORP.,
Petitioner,

v.

TQ DELTA, LLC,
Patent Owner.

IPR2022-00471
Patent 8,462,835 B2

Before KARL D. EASTHOM, ROBERT J. WEINSCHENK, and
KARA L. SZPONDOWSKI, *Administrative Patent Judges*.

EASTHOM, *Administrative Patent Judge*.

TERMINATION

Due to Settlement After Institution of Trial
35 U.S.C. § 317; C.F.R. § 42.74

I. INTRODOCTION

With our authorization, the Parties, Nokia of America Corp. (“Nokia”), Petitioner, and TQ Delta, LLC, Patent Owner, filed a Joint Motion to Terminate the Proceeding. Paper 38. (“Motion” or “Mot.”). The Parties also filed true copies of a Patent License Agreement and a Mutual Standstill Agreement (collectively “Settlement Agreement”). The Parties also filed a Joint Request to File Settlement Agreement as Business Confidential, which requests the Board to treat the Settlement Agreement as business confidential information and to keep it separate from the publicly available files of the challenged patent, U.S. Patent No. 8,462,835. Paper 39 (“Request”), 1. For the reasons discussed below, we *grant* the Motion and Request.

II. ANALYSIS

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.” Prior to termination, parties must file true copies of “[a]ny agreement or understanding between the patent owner and a petitioner, including any collateral agreements referred to in such agreement or understanding, made in connection with, or in contemplation of, the termination of an inter partes review.” 35 U.S.C. § 317(b).

The Parties represent that they have reached an agreement to seek termination of this *inter partes* review proceeding under 35 U.S.C. § 317(a) and 37 C.F.R. § 42.74. Mot. 6–7. The Parties also represent that “a true and correct copy of the Patent License Agreement, as well as a collateral agreement, have been filed as Exhibits 1059 and 1060, respectively.” *Id.* at

7. The Parties also represent that “Exhibits 1059 and 1060 represent all agreements required to be filed with the Board pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b); [and] there are no other collateral agreements in connection with the settlement.” *Id.* at 7–8. The Motion and Settlement Agreement collectively show that the Parties represent that they filed all agreements between themselves, including all collateral agreements referred to, made in connection with, or in contemplation of, the termination of these proceedings, as 35 U.S.C. § 317(b) requires.

The Parties also request that the Settlement Agreement be treated as business confidential information and be kept separate from the file of U.S. Patent No. 8,462,835 B2. Request 1. After reviewing the Settlement Agreement, we find that it contains confidential business information regarding the terms of settlement. We determine that good cause exists to treat the Agreements as business confidential information pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

The Board has not decided the merits of this proceeding, and this proceeding involves no other parties. We note that in a concurrent proceeding, IPR2022-01443, CommScope, Inc. (“CommScope”) filed its second petition seeking *inter partes* review of the same patent challenged here, U.S. Patent No. 8,462,835.¹ *CommScope, Inc., v. TQ Delta, LLC*,

¹ Prior to filing its second petition, CommScope filed a first petition challenging the same patent in *CommScope, Inc. v. TQ Delta, LLC*, Paper 2, IPR2022-00352 (PTAB Dec. 31, 2021). The Board denied institution of CommScope’s first petition, holding it time-barred under 35 U.S.C. § 315(b) based on the Board’s finding that prior to filing its first petition, CommScope acquired a time-barred entity, 2Wire, Inc., and the acquisition rendered 2Wire, Inc. a real party-in-interest and privy. *See* IPR2022-00352, Paper 13 (denial of institution), 7–9, 12–16.

IPR2022-01443, Paper 3 (PTAB Sept. 3, 2022). CommScope's second petition is a copycat petition of the Petition involved here, which, in turn, is a "Copycat Petition" of CommScope's first (time-barred) petition. *See* Paper 2 (Petition), 1 ("Petitioner submits this Copycat Petition to preserve a later motion for joinder or to allow for timely consideration of the prior art presented herein if the CommScope [first petition] is denied for procedural reasons"); *supra* note 1. With its second petition, CommScope also filed a motion requesting joinder of IPR2022-01443 with the instant proceeding. We recognize that, if we terminate this proceeding, there will be no proceeding for CommScope to join, and its second petition, like its first petition, will be time-barred under 35 U.S.C. § 315(b). Nevertheless, "[t]here are strong public policy reasons to favor settlement between the parties to a proceeding," and "[t]he 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." Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,768 (Aug. 14, 2012).

Accordingly, under the circumstances present here, it is appropriate to terminate the instant proceedings. *See* 35 U.S.C. § 317(a); 37 C.F.R. §§ 42.72(a, b), 42.74. This Termination does not constitute a final written decision pursuant to 35 U.S.C. § 318(a).

III. ORDER

For the reasons discussed above, it is

ORDERED that the Motion is granted and this proceeding is terminated; and

FURTHER ORDERED that the Request is granted, and the Settlement Agreement shall be kept separate from the file of U.S. Patent No. 8,462,835 and made available only to Federal Government agencies on

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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).

For PETITIONER:

Christopher Douglas
Scott Stevens
Karlee Wroblewski
ALSTON & BIRD LLP
christopher.douglas@alston.com
scott.stevens@alston.com
karlee.wroblewski@alston.com

For PATENT OWNER:

Peter McAndrews
David Petty
McANDREWS, HELD & MALLOY LTD
pmcandrews@mcandrews-ip.com
dpetty@mcandrews-ip.com

Christian Hurt
THE DAVID FIRM PC
churt@bdavisfirm.com