

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD.,¹
Petitioner,

v.

VOIP-PAL.COM, INC.,
Patent Owner.

IPR2022-01231 (Patent 8,630,234 B2)
IPR2022-01232 (Patent 8,630,234 B2)
IPR2022-01234 (Patent 10,880,721 B2)
IPR2022-01235 (Patent 10,880,721 B2)²

Before MITCHELL G. WEATHERLY, TERRENCE W. McMILLIN, and
CHRISTOPHER L. OGDEN, *Administrative Patent Judges*.

PER CURIAM.

TERMINATION

Due to Settlement After Institution of Trial
35 U.S.C. § 317; 37 C.F.R. § 42.74

¹ Samsung Electronics Co., Ltd. was joined as Petitioner on March 16, 2023, pursuant to motions for joinder filed in IPR2022-01390, IPR2022-01391, IPR2022-01392, and IPR2022-01393.

² The parties may not use a combined-case caption, unless given permission to do so.

IPR2022-01231 (Patent 8,630,234 B2)
IPR2022-01232 (Patent 8,630,234 B2)
IPR2022-01234 (Patent 10,880,721 B2)
IPR2022-01235 (Patent 10,880,721 B2)

On June 26, 2023, with Board authorization, the parties filed in each of these proceedings a Joint Motion to Terminate Proceeding. Paper 23³ (“Mot.”). The parties assert they “have resolved their dispute and jointly request to terminate IPR2022-01231 and IPR2022-01390,”⁴ and request that the Board terminate the above-captioned *inter partes* reviews and IPR2022-01390, IPR2022-01391, IPR2022-01392, and IPR2022-01393. Mot. 1. Along with the Motion, the parties filed the “the pertinent document resolving the dispute[s] between the Parties.” *Id.* The parties represent that “[t]here are no other agreements, oral or written, between the parties made in connection with, or in contemplation of, the termination of the[se] proceeding[s].” *Id.* at 1–2.

In addition, the parties filed a Joint Request to treat their agreement as business confidential information, and to maintain the filed copies of the agreements separate from the public file under 37 C.F.R. § 42.74(c). Paper 24.

I. DISCUSSION

On January 31, 2023 we instituted *inter partes* review of claims of U.S. Patent No. 8,630,234 B2 (Ex. 1001) and U.S. Patent No. 10,880,721 B2. Paper 10; IPR2022-01232, Paper 14; IPR2022-01234, Paper 12;

³ We refer to papers and exhibits in IPR2022-01231. Similar documents were filed in IPR2022-01232, IPR2022-01234, and IPR2022-01235. This Termination applies equally to all captioned proceedings and to IPR2022-01390, IPR2022-01391, IPR2022-01392, and IPR2022-01393.

⁴ Similar statements are made in IPR2022-01232, IPR2022-01234, and IPR2022-01235, with regard to IPR2022-01391, IPR2022-01392, and IPR2022-01393, respectively.

IPR2022-01231 (Patent 8,630,234 B2)
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IPR2022-01235, Paper 12. We have not yet decided the merits of the proceedings, and a final written decision has not been entered in any of the proceedings. Notwithstanding that the proceedings have moved beyond the preliminary stage, the parties have shown adequately that the termination of the proceedings is appropriate because of the resolution of their disputes. Under these circumstances, we determine that good cause exists to terminate the proceedings.

After reviewing the Settlement Agreement between the parties, we find that the Settlement Agreement (Ex. 1023) contains confidential business information regarding the terms of settlement. We determine that good cause exists to treat the Settlement Agreement between the parties as business confidential information pursuant to 37 C.F.R. § 42.74(c).

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

II. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that, in each of IPR2022-01231, IPR2022-01232, IPR2022-01234, and IPR2022-01235, the Joint Motion to Terminate Proceeding is *granted*;

FURTHER ORDERED that, in each of IPR2022-01231, IPR2022-01232, IPR2022-01234, IPR2022-01235, IPR2022-01390, IPR2022-01391, IPR2022-01392, and IPR2022-01393 the proceeding is *terminated*;

FURTHER ORDERED that a copy of this Order shall be filed in IPR2022-01231, IPR2022-01232, IPR2022-01234, IPR2022-01235, IPR2022-01390, IPR2022-01391, IPR2022-01392, and IPR2022-01393; and

IPR2022-01231 (Patent 8,630,234 B2)
IPR2022-01232 (Patent 8,630,234 B2)
IPR2022-01234 (Patent 10,880,721 B2)
IPR2022-01235 (Patent 10,880,721 B2)

FURTHER ORDERED that, in each of in each of these proceedings, the Joint Request to File Resolution Document as Business Confidential Information (Ex. 1023 in all four proceedings) is *granted*, and the Settlement Agreement shall remain designated as “Board Only” in Board’s filing system, shall made available only to Federal Government agencies on written request, or to any person on a showing of good cause, and shall be kept separate from the files of the involved patents and associated preliminary proceedings, pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

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