

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,
Petitioner,

v.

SMARTWATCH MOBILE CONCEPTS, LLC,
Patent Owner.

IPR2024-00852
Patent 10,362,480 B2

Before CHARLES J. BOUDREAU, SHEILA F. McSHANE, and
ELIZABETH J. REAGAN, *Administrative Patent Judges*.

REAGAN, *Administrative Patent Judge*.

DECISION
Settlement Prior to Institution of Trial
37 C.F.R. § 42.74

I. INTRODUCTION

On April 26, 2024, Google LLC (“Petitioner”) filed a Petition requesting *inter partes* review of claims 1–9 of U.S. Patent No. 10,362,480 B2 (“the ’480 patent”). Paper 2. SmartWatch Mobile Concepts, LLC (“Patent Owner”) filed its Mandatory Notice Pursuant to 37 C.F.R. § 42.8(a)(2) on July 16, 2024, identifying itself as the real party in interest for Patent Owner. Paper 4, 1 (“Mandatory Notice”).

On September 5, 2024, following email authorization by the Board, Petitioner and Patent Owner (collectively, “the parties”) filed a Joint Motion to Terminate Proceeding. Paper 6 (“Joint Motion to Terminate” or “Mot.”). The Joint Motion to Terminate was accompanied by a copy of an agreement (Ex. 1051) that the parties represent to be a true copy of a Settlement Agreement that resolves the disputes between them in this proceeding (Mot. 1), and a Joint Motion for Settlement Agreement to be Treated as Business Confidential Information and Kept Separate under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) (Paper 7) (“Joint Confidentiality Motion”), requesting that Exhibit 1051 be treated as business confidential information and kept separate, citing 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).¹

¹ In the Joint Confidentiality Motion, the parties request that “Exhibit 1051 be kept separate from the files of the involved patent *and* IPR2024-00852, and made available only to Federal Government agencies upon written request or to any other person upon written request and a showing of good cause.” Joint Confidentiality Motion 1 (emphasis added) (citing 35 U.S.C. § 317(b)). Because 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) provide only for agreements to be kept separate from the files of “an involved patent[],” we understand the parties’ request as a request to keep Exhibit 1051 separate from the file of the ’480 patent, instead of from the file of this proceeding. *See* 35 U.S.C. § 317(b); 37 C.F.R. § 42.74(c).

II. DISCUSSION

In the Joint Motion to Terminate, the parties “jointly request termination of this proceeding, IPR2024-00852, directed to U.S. Patent No. 10,362,480.” Mot. 1. The parties represent that they have “settled their dispute regarding U.S. Patent No. 10,362,480, including both this proceeding and Patent Owner’s assertion of U.S. Patent No. 10,362,480 in the related district court litigation, *SmartWatch MobileConcepts, LLC v. Google, LLC*, Case No. 3:24-cv-000937 (N.D. Cal.).” *Id.* The parties also represent that they “do not anticipate further litigation between them concerning U.S. Patent No. 10,362,480” and that “[t]here are no related proceedings currently before the Board.” *Id.* Further, the parties contend that “[g]ood cause exists to terminate this proceeding because the parties have settled their dispute regarding the U.S. Patent No. 10,362,480 and the proceeding is still at an early stage.” *Id.* The parties also state that “[Patent Owner]² has not yet provided its preliminary response” and contend that “[t]erminating the proceeding now would thus serve the interests of judicial economy as well as the mutual interest of the parties.” *Id.*

In addition, the parties represent that Exhibit 1051 is “[a] true and correct copy of the parties’ settlement agreement” and that “there are no other agreements, oral or written, between the parties made in connection with, or in contemplation of, the termination of the proceeding.” Mot. 1.

“There are strong public policy reasons to favor settlement between the parties to a proceeding,” and the Board generally expects that a case “will terminate after the filing of a settlement agreement, unless the Board

² In the Motion to Terminate, the parties refer to “[t]he Petitioner” here. We consider this to be a typographical error and have substituted “Patent Owner” in its place, according to our understanding. *See* Mot. 1.

has already decided the merits.” Patent Trial and Appeal Board Consolidated Trial Practice Guide 86 (Nov. 2019), *available at* <https://www.uspto.gov/sites/default/files/documents/tpgnov.pdf>. The present proceeding is in a preliminary stage. As noted by the parties, a Preliminary Response has not been filed. *See* Mot. 1. Further, the Board has not reached a decision whether to institute a trial. At this early stage, we therefore determine that termination is warranted for the reasons stated in the Joint Motion to Terminate.

We also determine that the parties have complied with the requirements of 37 C.F.R. § 42.74(c) to have their settlement agreement treated as business confidential information and kept separate from the file of the challenged patent. We therefore grant the joint request to treat the settlement agreement as business confidential and order that Exhibit 1051 be kept separate from the file of the ’480 patent.

III. ORDER

In consideration of the foregoing, it is hereby

ORDERED that the parties’ Joint Motion to Terminate Proceeding (Paper 6) is *granted*; the Petition (Paper 2) is *dismissed*; and this proceeding is terminated; and

FURTHER ORDERED that the parties’ Joint Motion for Settlement Agreement to be Treated as Business Confidential Information and Kept Separate under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) (Paper 7) is *granted*; and Exhibit 1051 is accordingly to be kept separate from the file of the ’480 patent, pursuant to 37 C.F.R. § 42.74(c).

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