

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ERICSSON INC., NOKIA OF AMERICA CORP.,
AT&T SERVICES, INC., CELLCO PARTNERSHIP d/b/a VERIZON
WIRELESS, GOOGLE LLC,
and T-MOBILE USA, INC.,
Petitioner,

v.

PEGASUS WIRELESS INNOVATION LLC,
Patent Owner.

IPR2025-00083
Patent 10,638,463 B2

Before KRISTEN L. DROESCH, JASON M. REPKO, and
STEPHEN E. BELISLE, *Administrative Patent Judges*.

DROESCH, *Administrative Patent Judge*.

ORDER

Denying Without Prejudice

Joint Motion to Terminate as to AT&T, Verizon, and T-Mobile

Joint Requests to Treat Confidential and Separate

35 U.S.C. § 317; 37 C.F.R. § 42.74

DISCUSSION

On October 27, 2025, with our authorization via an email dated October 15, 2025, AT&T Services, Inc., (“AT&T”) Cellco Partnership d/b/a Verizon Wireless (“Verizon”), T-Mobile USA, Inc. (“T-Mobile”), and KT Corporation (“KT”) and Exclusive Licensee Pegasus Wireless Innovation LLC (“Pegasus” or “Patent Owner”) jointly filed the following: (1) a “Joint Motion to Partially Terminate Proceeding as to AT&T, Verizon, and T-Mobile, Pursuant to 35 U.S.C. § 317 and 37 C.F.R. §§ 42.72, 42.74” (Paper 33, “Mot.” or “Joint Motion”); (2) true copies of three Binding Term Sheets (Exs. 1045, 1046, 1047); and (3a) “Joint Request to Treat AT&T-KT-Pegasus Binding Term Sheet as Business Confidential Information” (Paper 34); (3b) “Joint Request to Treat Verizon-KT-Pegasus Binding Term Sheet as Business Confidential Information” (Paper 35); and (3c) “Joint Request to Treat T-Mobile-KT-Pegasus Binding Term Sheet as Business Confidential Information” (Paper 36) (collectively “Joint Requests”).

Despite the parties’ joint certification “that there are presently no other agreements or understandings, oral or written, between them, including any collateral agreements, made in connection with, or in contemplation of, the termination of KT and Pegasus¹ from this proceeding as set forth in 35 U.S.C. § 317(b),” the three Binding Term Sheets filed by the parties (Exs. 1045, 1046, 1047) do not appear to include all collateral agreements referred to, made in connection with, or in contemplation of, the termination of this proceeding between the parties. More specifically, the Motion states, “as indicated in each of the term sheets, the parties continue to negotiate a

¹ The identification here of KT and Pegasus appears to be an error. The parties should correct the identification of the parties in any renewed motion.

‘Long Form Agreement (Ex. 1045 at 7; 1046 at 7; and 1047 at 7).’ Mot. 2. The parties further indicate that “no Long Form Agreement has been executed” and “[t]he parties will submit any long form agreement, if executed, within 5 business days of execution.” The parties have not yet filed any long form agreements. It is unclear whether any long form agreements have been executed by the parties, or if negotiations remain ongoing.

Under 35 U.S.C. § 317(b), “[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 under this section shall be in writing, and a true copy of such agreement or understanding *shall be filed in the Office before the termination* of the inter partes review as between the parties. 35 U.S.C. § 317(b) (emphasis added).

Because the parties have not yet filed any long form agreements, as referenced in each of the Binding Term Sheets, we deny without prejudice the parties’ Joint Motion. *See DTN, LLC v. Farms Technology, LLC*, IPR2018-01412, Paper 21 (PTAB June 14, 2019) (precedential) (explaining that parties must file any collateral agreements referenced in a settlement agreement before the Board can terminate the proceeding via settlement under 35 U.S.C. § 317). We also deny without prejudice the parties’ Joint Requests to keep each Binding Term Sheet confidential, and will expunge these Binding Term Sheets (Exs. 1045, 1046, 1047) from the record at this juncture.

Also, according to the Joint Requests, “[t]he parties also respectfully request that the Board inform us if anyone seeks production of the

agreement and afford the parties an opportunity to address whether such request is supported by good cause.” Joint Request 8. Neither 35 U.S.C. § 317(b) nor 37 C.F.R. § 42.74(c) provide for this notice to the parties.

We authorize the parties to file a renewed motion to terminate, together with renewed joint requests to treat the Binding Term Sheets and any forthcoming settlement agreements between the parties as business confidential.

II. ORDER

Accordingly, it is:

ORDERED that the Joint Motion is denied without prejudice;

FURTHER ORDERED that the Joint Requests are denied without prejudice; and

FURTHER ORDERED that Exhibits 1045, 1046, and 1047 are expunged.

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