

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AMAZON.COM, INC. and AMAZON.COM SERVICES LLC,
Petitioner,

v.

NOKIA TECHNOLOGIES OY,
Patent Owner.

IPR2024-01176
Patent 8,175,148 B2

Before MICHAEL R. ZECHER, SCOTT B. HOWARD, and
JASON M. REPKO, *Administrative Patent Judges*.

REPKO, *Administrative Patent Judge*.

TERMINATION

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

I. DISCUSSION

With our authorization, Petitioner and Patent Owner filed (1) a Joint Motion to Terminate Proceeding (Paper 11 (“Mot.” or “Joint Motion”)), (2) a confidential written settlement agreement (Ex. 2003), (3) a patent agreement containing addendums that is referenced in the settlement agreement (Ex. 2004), and (4) a Joint Request to Treat Settlement Agreement and Patent Agreement as Business Confidential Information (Paper 12 (“Joint Request”)). According to the Joint Motion, the parties have settled the dispute in this proceeding, the parties have filed a true copy of their confidential written settlement agreement, and there are no other agreements between the parties made in connection with, or in contemplation of, termination of this proceeding other than those filed. Mot. 2–5. Thus, the parties jointly move to terminate this proceeding. *See id.*

Generally, the Board expects that a proceeding will terminate with respect to a petitioner after the filing of a settlement agreement. *See* 35 U.S.C. § 317(a) (“An 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.”); 37 C.F.R. § 42.72 (“The Board may terminate a trial without rendering a final written decision, where appropriate, including . . . pursuant to a joint request under 35 U.S.C. 317(a)”); *see also* Patent Trial and Appeal Board Consolidated Trial Practice Guide at 86 (Nov. 2019)¹ (“The 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.” (citing

¹ Available at <https://www.uspto.gov/TrialPracticeGuideConsolidated>.

35 U.S.C. §§ 317(a), 327)). Here, we have not yet decided the proceeding's merits, and we are persuaded that, under the circumstances, termination of this proceeding is appropriate. Thus, we grant the Joint Motion.

Also, we are persuaded that the settlement and patent agreements contain business confidential information that warrants keeping them separate from the patent file. Thus, we grant the part of the Joint Request asking that Exhibits 2003 and 2004 be treated as business confidential information. *See* 35 U.S.C. § 317(b) (“At the request of a party to the proceeding, the agreement or understanding shall be treated as business confidential information, shall be kept separate from the file of the involved patents, and shall be made available only to Federal Government agencies on written request, or to any person on a showing of good cause.”); *see also* 37 C.F.R. § 42.74(c) (same).

“Both parties also respectfully request that the Board inform [them] 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 4. But the statute does not provide for any such notification or opportunity to respond. *See* 35 U.S.C. § 317(b). Nor does the regulation. *See* 37 C.F.R. § 42.74(c). We see no persuasive reason or special circumstance here that would justify issuing an order that imposes this additional requirement. Thus, we deny that part of the Joint Request.

II. ORDER

It is

ORDERED that the Joint Motion to Terminate Proceeding (Paper 11) is *granted*;

FURTHER ORDERED that the Joint Request to Treat Settlement Agreement and Patent Agreement as Business Confidential Information (Paper 12) is *granted in part* as described above; and

FURTHER ORDERED that the settlement and patent agreements (Exs. 2003, 2004) be treated as business confidential information, kept separate from the file of the above-referenced patent, and made available only to Federal Government agencies on written request, or to any person on a showing of good cause, under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

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