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Paper 53
Entered: May 23, 2017

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ZTE CORPORATION and ZTE (USA) INC.,
and
MICROSOFT CORPORATION,
Petitioner,

v.

IPR LICENSING, INC.,
Patent Owner.

Case IPR2014-00525[1]
Patent 8,380,244 B2

Before SALLY C. MEDLEY, MIRIAM L. QUINN, and BEVERLY M. BUNTING, *Administrative Patent Judges.*

BUNTING, *Administrative Patent Judge.*

DECISION
Joint Motion to Terminate
35 U.S.C. § 317 and 37 C.F.R. § 42.71

[1] Case IPR2015-00074 has been joined with this proceeding.

I. INTRODUCTION

On May 17, 2017, Microsoft and Patent Owner (collectively referred to as "the parties"), filed this joint motion to terminate Microsoft's participation in this proceeding[2] pursuant to a settlement agreement.[3] Paper 50. The parties also filed a true copy of their written settlement agreement, made in connection with the termination of Microsoft as a party from this proceeding, in accordance with 35 U.S.C. § 317(b) and 37 C.F.R. § 42.72. Ex. 2025. Additionally, the parties submitted a joint request to have their settlement agreement treated as confidential business information under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c). Paper 52.

The parties submit that termination as to Microsoft is appropriate because the parties have settled their dispute relating to U.S. Patent No. 8,380,244, and have reached agreement to terminate Microsoft's participation in this proceeding. Paper 50, 1. The parties represent that this settlement agreement ends all disputes between the parties related to this patent, including the pending district court lawsuit. *Id*. at 2.

The Parties are reminded that the Board is not a party to the settlement, and may identify independently any question of patentability.

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[2] IPR Licensing, Inc. ("Patent Owner") appealed our Final Written Decision ascertaining that claims 1–8, 14–16, 19–29, 36–38, and 41–44 of the 8,320,244 patent are obvious to the U.S. Court of Appeal for the Federal Circuit. Paper 49. On April 20, 2017, the Federal Circuit affirmed our determination with respect to claims 1–7, 14–16, 19–29, 36–38, and 41–44, but vacated the determination of unpatentability of claim 8 and remanded for further proceedings. *IPR Licensing, INC. v. ZTE Corporation,* Case Nos. 2016-1734, 2016-1443, 2017 WL 1406501 (Fed. Cir. April 20, 2017).

[3] Petitioners ZTE Corporation and ZTE (USA) Inc. are not parties to this settlement agreement, nor do they oppose termination as to Petitioner Microsoft. Paper 50, 1.

37 C.F.R. § 42.74(a). Generally, however, the Board expects that a proceeding will terminate with respect to a requesting petitioner after the filing of a settlement agreement. *See, e.g., Office Patent Trial Practice Guide*, 77 Fed. Reg. 48756, 48768 (Aug. 14, 2012).

Under the circumstances, based on the record before us, we determine that it is appropriate to terminate this proceeding with respect to Microsoft.

ORDER

In consideration of the foregoing, it is

ORDERED that the parties' joint request that the settlement agreement (Exhibit 2025) be treated as business confidential information under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c), to be kept separate from the patent file, is GRANTED;

FURTHER ORDERED that the joint motion to terminate the proceeding with respect to Microsoft is GRANTED;

FURTHER ORDERED that Microsoft, as a petitioner, and the joinder of Case IPR2015-00074 with this proceeding, shall no longer be listed on the caption page; and

FURTHER ORDERED that this proceeding is TERMINATED with respect to Microsoft, but not as to remaining petitioners ZTE Corporation and ZTE (USA) Inc.

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