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Paper 39
Entered: July 21, 2020

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS AMERICA, INC.,
Petitioner,

v.

UNILOC 2017 LLC,
Patent Owner.

IPR2017-01797 (Patent 8,724,622 B2);
IPR2017-01798 (Patent 8,724,622 B2);
IPR2017-01799 (Patent 8,199,747 B2);
IPR2017-01800 (Patent 8,243,723 B2);
IPR2017-01801 (Patent 8,995,433 B2);
IPR2017-01802 (Patent 7,535,890 B2)

Per Curiam.

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

IPR2017-01797 (Patent 8,724,622 B2);
IPR2017-01798 (Patent 8,724,622 B2);
IPR2017-01799 (Patent 8,199,747 B2);
IPR2017-01800 (Patent 8,243,723 B2);
IPR2017-01801 (Patent 8,995,433 B2);
IPR2017-01802 (Patent 7,535,890 B2)

I. INTRODUCTION

With the Board's authorization, Petitioner and Patent Owner ("Parties") filed Joint Motions to Terminate these proceedings due to settlement. IPR2017-01797, Paper 37; IPR2017-01798, Paper 37; IPR2017-01799, Paper 45; IPR2017-01800, Paper 40; IPR2017-01801, Paper 37; IPR2017-01802, Paper 36. In support of these motions, the Parties filed a copy of a confidential settlement agreement (IPR2017-01797, Ex. 2007; IPR2017-01798, Ex. 2007; IPR2017-01799, Ex. 2010; IPR2017-01800, Ex. 2012; IPR2017-01801, Ex. 2006; IPR2017-01802, Ex. 2007 ("Settlement Agreement")), as well as joint requests to file the settlement agreement as business confidential information pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) (IPR2017-01797, Paper 38; IPR2017-01798, Paper 38; IPR2017-01799, Paper 46; IPR2017-01800, Paper 41; IPR2017-01801, Paper 38; IPR2017-01802, Paper 37). For simplicity, we refer below only to the filings in IPR2017-01797, which are representative of the filings in all of the proceedings.

II. DISCUSSION

Under 35 U.S.C. § 317(a), "[a]n 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." Section 35 U.S.C. § 317(a) also provides that if no petitioner remains in the *inter partes* review, the Office may terminate the review. Section 317(b) requires that any agreement between the parties, including collateral

agreements, made in connection with the termination of an *inter partes* review "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."

The Parties represent that they have reached an agreement to seek termination of these *inter partes* review proceedings jointly. *E.g.*, IPR2017-01797 Joint Motion 2. "There are no other agreements, oral or written, between the parties made in connection with, or in contemplation of, the termination of this proceeding," and the filed copy of the Settlement Agreement is a true and correct copy. *E.g.*, *id.* at 3–5. The Parties further represent that the Settlement Agreement resolves all currently pending Patent Office and District Court proceedings between the Parties involving the patents at issue. *E.g.*, *id.* at 4.

We instituted trials on the above-identified proceedings. Although we decided the merits of the proceedings and entered final written decisions, the Federal Circuit vacated those final written decisions. *Uniloc 2017 LLC v. Samsung Elecs. Am., Inc.*, Nos. 19-2165, -2166, -2167, -2168, -2169 (Fed. Cir. Feb. 27, 2020) (order granting motion to vacate and remand). Notwithstanding that the proceedings have moved beyond the preliminary stages, the Parties have shown adequately that the termination of the proceedings is appropriate. Under these circumstances, we determine that good cause exists to terminate the proceedings. We further determine that the Settlement Agreement complies with the requirements for written agreements regarding termination set forth in 35 U.S.C. § 317(b).

IPR2017-01797 (Patent 8,724,622 B2);
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The Parties also filed Joint Requests that the Settlement Agreement be treated as business confidential information and be kept separate from the file of the respective patents involved in this *inter partes* proceeding. *E.g.*, IPR2017-01797 Joint Request. After reviewing the Settlement Agreement between Petitioner and Patent Owner, we find that the Settlement Agreement contains confidential business information regarding the terms of settlement. We determine that good cause exists to treat the Settlement Agreement between Petitioner and Patent Owner as business confidential information pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

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

III. ORDER

Accordingly, for the reasons discussed above, it is

ORDERED that, for each proceeding, the Joint Motion to Terminate is *granted*, and IPR2017-01797, IPR2017-01798, IPR2017-01799, IPR2017-01800, IPR2017-01801, and IPR2017-01802 are *terminated* pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. § 42.72; and

FURTHER ORDERED that, for each proceeding, the Joint Request to Treat the Settlement Agreement as Business Confidential Information is *granted*, and the Settlement Agreement shall be kept separate from the files of U.S. Patent Nos. 8,724,622 B2; 8,199,747 B2; 8,243,723 B2; 8,995,433 B2; and 7,535,890 B2, and made available only to Federal Government agencies on written request, or to any person on a showing of good cause, pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

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