

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

NEODRON LTD.,
Patent Owner.

IPR2020-01287
Patent 9,411,472 B2

Before MIRIAM L. QUINN, PATRICK M. BOUCHER, and
CHRISTOPHER L. OGDEN, *Administrative Patent Judges*.

QUINN, *Administrative Patent Judge*.

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

With our authorization, the parties filed a Joint Motion to Terminate this proceeding (Paper 6) and a Joint Request to Keep Separate (Paper 7). With these filings the parties also filed what they describe as “a true copy of the settlement agreement (Patent License Agreement) that resolves the disputes in the above-captioned inter partes review relating to the Patent-in-Suit.” Paper 6, 1; *see* Ex. 2001; *see also* Paper 7, 1 (representing that “[t]he settlement agreement[] resolve[s] the disputes in the above-captioned *inter partes* review relating to U.S. Patent No. 9,411,472.”). The parties also represent that “[t]here are no other collateral agreements between the parties made in connection with, or in contemplation of, the termination sought.” Paper 6, 1.

In the Joint Motion to Terminate, the parties ask the Board to “terminate the *inter partes* review of the Patent-in-Suit, Case IPR2020-01287, in its entirety.” Paper 6, 1. Under 37 C.F.R. § 42.71(a), the Board may “dismiss any petition,” thus terminating a preliminary proceeding. In addition, when the parties seek to terminate a proceeding by submitting a settlement agreement, “[a]ny agreement or understanding between the parties made in connection with, or in contemplation of, the termination of a proceeding shall be in writing and a true copy shall be filed with the Board.” 37 C.F.R. § 42.74(b).

This case is still in the preliminary proceeding stage, and the Board has not yet decided whether to institute trial. Under these circumstances, we determine that it is appropriate to dismiss the Petition and terminate this case without rendering a decision on institution. We also determine that the filed Exhibit 2001 appears to be a true copy of the agreement between the parties

in connection with settlement of this proceeding. Therefore, we grant the Joint Motion to Terminate.

In the Joint Request to Keep Separate, “[t]he parties jointly request that the Board treat the settlement agreements as business confidential information and keep them separate from the files of this proceeding and the files of the Patent-in-Suit.” Paper 7, 1. We find that the submitted settlement agreements contain confidential business information regarding the terms of the settlement. Ex. 2001. Accordingly, we agree that the settlement agreement should be treated as business confidential information and kept separate from the files of the involved patent, and we grant the Joint Request to Keep Separate.

It is

ORDERED that the Joint Motion to Terminate is *granted*;

FURTHER ORDERED that the Petition is dismissed;

FURTHER ORDERED that this proceeding is terminated as to all parties;

FURTHER ORDERED that the Joint Request to Keep Separate is *granted*; and

FURTHER ORDERED that the filed settlement agreement (Ex. 2001) be treated as business confidential information pursuant to 37 C.F.R. § 42.74(c) and also remain designated as “Parties and Board Only” in the Board’s E2E system.

IPR2020-0
Patent 9,411,472 B2

For PETITIONER:

Adam P. Seitz (Lead Counsel)
Paul R. Hart
Callie A. Pendergrass
ERISE IP, P.A.
adam.seitz@eriseip.com
paul.hart@eriseip.com
callie.pendergrass@eriseip.com

For PATENT OWNER:

Kent Shum (Lead Counsel)
Neil A. Rubin
Reza Mirzaie
Philip X. Wang
RUSS AUGUST & KABAT
kshum@raklaw.com
nrubin@raklaw.com
rmirzaie@raklaw.com
pwang@raklaw.com