

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

COMMSCOPE TECHNOLOGIES LLC,¹
Petitioner,

v.

DALI WIRELESS, INC.,
Patent Owner.

IPR2022-01293
Patent 10,334,499 B2

Before KARL D. EASTHOM, BARBARA A. BENOIT, and
SHARON FENICK, *Administrative Patent Judges*.

FENICK, *Administrative Patent Judge*.

ORDER

Settlement as to CommScope Technologies LLC
35 U.S.C. § 317; 37 C.F.R. § 42.74

¹ The Board joined T-Mobile USA, Inc. as a party (Petitioner) to this proceeding. See Paper 26.

I. INTRODUCTION

With Board authorization, Petitioner CommScope Technologies LLC (“CommScope”) and Dali Wireless, Inc. (“Patent Owner”) filed a Joint Motion to Terminate Proceeding as to CommScope Petitioner. Paper 27 (“Joint Motion”). CommScope and Patent Owner also filed a copy of their Settlement Agreement (Exhibit 1073) and a Joint Request to Treat the Settlement Agreement as Business Confidential Information (Paper 28, “Joint Request”).

II. DISCUSSION

In the Joint Motion, CommScope and Patent Owner represent that they have reached an agreement to jointly seek termination of CommScope as Petitioner in this proceeding, they “have settled their entire dispute concerning the challenged patent,” and the filed copy of the Settlement Agreement is a “true copy.” Joint Motion 1; *see also* Joint Request 1 (“The Settlement Agreement fully resolves all disputes between CommScope and Dali relating to U.S. Patent No. 10,334,499 before the district court and the Patent Trial and Appeal Board.”). CommScope and Patent Owner certify that, “other than Exhibit 1073, they made no collateral agreements or understandings in connection with, or in contemplation of, the termination” of CommScope as Petitioner. Joint Motion 1.

We instituted trial in this proceeding on March 9, 2023. Paper 18. The trial is still in an early stage. An oral hearing has not yet been held, we have not yet decided the merits of the proceeding, and a final written decision has not been entered. CommScope and Patent Owner have shown adequately that termination of CommScope as Petitioner from this

proceeding is appropriate. Under these circumstances, we determine that good cause exists to terminate the proceeding only as to CommScope. Petitioner T-Mobile USA, Inc. remains in this proceeding and will act as the lead petitioner. *See* Paper 26.

CommScope and Patent Owner request that the Settlement Agreement be treated as business confidential information and be kept separate from the file of the involved patent. Joint Request 1–2. CommScope and Patent Owner further

request that the Board order that in the event a person or entity makes a written request, as stated in 37 C.F.R. § 42.74(c)(1)-(2), for access to the settlement agreement, that any such written request be served upon the parties on the day the written request is provided to the Board.

Id. at 2.

We grant-in-part the Joint Request. After reviewing the Settlement Agreement between CommScope 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 as business confidential information pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

However, we deny the portion of the Joint Request seeking an order from the Board that, in the event a person or entity makes a written request, as stated in 37 C.F.R. § 42.74(c)(1)-(2), for access to the Settlement Agreement, any such written request be served upon the parties on the day the written request is provided to the Board. Neither the statute nor the rule includes such a requirement.

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

III. ORDER

Accordingly, it is

ORDERED that the Joint Motion is *granted*, and this proceeding is *terminated* only with respect to CommScope;

FURTHER ORDERED that T-Mobile USA, Inc. remains as Petitioner in this proceeding and will act as the lead petitioner;

FURTHER ORDERED that the Joint Request is *granted-in-part* and *denied-in-part*, in the manner described above, and the Settlement Agreement shall be kept separate from the file of Patent 10,334,499 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); and

FURTHER ORDERED that the caption for this proceeding is as set forth in the attached Appendix, and the remaining parties shall use this caption for all further filings in this proceeding.

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Appendix: Sample Case Caption

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¹ The Board joined T-Mobile USA, Inc. as a party (Petitioner) to this proceeding. Original Petitioners CommScope Technologies LLC and Corning Optical Communications LLC have been terminated in this proceeding.