Trials@uspto.gov
Tel: 571.272.7822

Paper No. 26
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TOSHIBA CORPORATION, TOSHIBA MEMORY CORPORATION, and TOSHIBA AMERICA ELECTRONIC COMPONENTS, INC.,
Petitioner,

v.

MACRONIX INTERNATIONAL CO., LTD.,
Patent Owner.

Case IPR2017-01632
Patent 8,035,417 B1

Before KEN B. BARRETT, JENNIFER S. BISK, and JASON M. REPKO, *Administrative Patent Judges.*

REPKO, *Administrative Patent Judge*.

ORDER
Granting Joint Motion to Terminate
and
Granting Request to Treat Settlement Documents
as Confidential Business Information
37 C.F.R §§ 42.72, 42.74(c)

Macronix International Co., Ltd. ("Patent Owner") and Toshiba Corporation, Toshiba Memory Corporation, and Toshiba America Electronic Components, Inc. (collectively, "Petitioner"), jointly move to terminate this *inter partes* review in light of their settlement that resolves their dispute regarding U.S. Patent 8,035,417 B1. Paper 24 ("Mot."). The parties also filed a true copy of their written settlement agreement with the motion as required by 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b). Exs. 2003, 2004 ("Settlement Agreement"). Under 37 C.F.R. § 42.74(c), the parties also filed a joint request to treat the settlement agreement as business confidential information kept separate from the file of the involved patent. Paper 25. For the reasons below, the motions are *granted*.

The Board generally expects that a case "will terminate after the filing of a settlement agreement, unless the Board has already decided the merits." *Office Patent Trial Practice Guide*, 77 Fed. Reg. 48,756, 48,768 (Aug. 14, 2012). In this proceeding, we have not entered a final written decision. The parties submit that termination is appropriate because they have settled their dispute. Mot. 1. Under these circumstances, we determine that it is appropriate to terminate this proceeding.

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 it is appropriate to treat the Settlement Agreement between Petitioner and Patent Owner as business confidential information under 37 C.F.R. § 42.74(c).

ORDER

Accordingly, it is:

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

FURTHER ORDERED that the *inter partes* review is terminated as to all parties; and

FURTHER ORDERED that request that the Settlement Agreement (Exhibits 2003, 2004) be treated as business confidential information and be kept separate under 37 C.F.R. § 42.74(c) and 35 U.S.C. § 317(b) is *granted*.

PETITIONER:

Kevin C. Hamilton
Steven L. Park
Gerald T. Sekimura
DLA PIPER LLP (US)
kevin.hamilton@dlapiper.com
steven.park@dlapiper.com
gerald.sekimura@dlapiper.com

PATENT OWNER:

Christian A. Chu
Ayan Roy-Chowdhury
Kevin Su
Timothy W. Riffe
Ryan Chowdhury
Michael J. McKeon
FISH & RICHARDSON P.C.
chu@fr.com
roy-chowdhury@fr.com
su@fr.com
riffe@fr.com
rchowdhury@fr.com
mckeon@fr.com