Trials@uspto.gov
571-272-7822

Paper: 18
Entered: July 20, 2018

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TAIWAN SEMICONDUCTOR MANUFACTURING COMPANY, LTD.,
Petitioner,

v.

DR. URI COHEN,
Patent Owner.

Case IRP2018-00468
Case IRP2018-00720
Case IRP2018-00721
Patent 7,199,052 B2[1]

Before THU A. DANG, KEN B. BARRETT, and
ROBERT J. WEINSCHENK, *Administrative Patent Judges*.

BARRETT, *Administrative Patent Judge*.

ORDER
Dismissing Petitions Pursuant to Settlement
37 C.F.R. §§ 42.71(a), 42.74

[1] This Order will be entered in each case. The parties are not authorized to use this caption style.

The parties filed, in each of the captioned cases, a Joint Motion to Terminate *Inter Partes* Review. IPR2018-00468, Paper 16; IPR2018-00720, Paper 7; IRP2018-00721, Paper 7. The parties also filed a copy of a written settlement agreement and associated collateral agreements and a joint request to have the settlement agreement, including the collateral agreements, treated as confidential business information under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c). IPR2018-00468, Paper 17 and Exhibits 1028–1030; IPR2018-00720, Paper 8 and Exhibits 1029–1031; IRP2018-00721, Paper 8 and Exhibits 1039–1041.

Patent Owner has filed a Preliminary Response in these cases, but the Board has not yet issued institution decisions. The parties represent that their settlement agreement resolves all underlying disputes with respect to the challenged patent. IPR2018-00468, Paper 16, 1–2; IPR2018-00720, Paper 14, 1–2; IRP2018-00721, Paper 7, 1–2. Under these circumstances, we determine that it is appropriate to dismiss the Petitions. *See* 37 C.F.R. §§ 42.5(a), 42.71(a). After reviewing the parties' settlement agreement, we find that the settlement agreement contains confidential business information regarding the terms of settlement and good cause exists to treat the settlement agreement, including the collateral agreements, as business confidential information pursuant to 35 U.S.C. § 317(b).

The parties also "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 and/or its associated collateral agreements, that any such written request be served upon the parties on the day the written request is provided to the Board."

IPR2018-00468, Paper 17, 1–2; IPR2018-00720, Paper 8, 1; IRP2018-00721, Paper 8, 1. We decline to impose upon non-parties an obligation beyond any required by law or regulation.

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

Accordingly, it is

ORDERED that the Petitions are *dismissed*;

FURTHER ORDERED that the parties' settlement agreement, including the associated collateral agreements, (Exhibits 1028, 1029, and 1030 in IPR2018-00468; Exhibits 1029, 1030, and 1031 in IPR2018-00720; and Exhibits1039, 1040, and 1041 in IRP2018-00721) shall be treated as business confidential information and kept separate from the files of U.S. Patent No. 7,199,052, and remain designated as "Board and Parties Only."

For PETITIONER:

Lori Gordon
lgordon@kslaw.com

Rudy Y. Kim
rudykim@mofo.com

For PATENT OWNER:

Matthew Compton
mcompton@pfalawfirm.com