

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SONY INTERACTIVE ENTERTAINMENT LLC,
Petitioner,

v.

TECHNO VIEW IP, INC.,
Exclusive Licensee of the Patent Owner.¹

Case IPR2018-00534
Patent 9,503,742 B2

Before KEVIN F. TURNER, WILLIAM V. SAINDON, and
NORMAN H. BEAMER, *Administrative Patent Judges*.

SAINDON, *Administrative Patent Judge*.

ORDER

Granting Joint Motion to Terminate Proceeding Due to
Settlement after Institution and
Granting Joint Request to Treat Settlement Agreement as
Business Confidential Information
37 C.F.R. §§ 42.72, 42.74

¹ TD Vision Corporation S.A. de C.V is the Patent Owner. Paper 4.

I. INTRODUCTION

On November 6, 2018, Petitioner and Patent Owner’s Exclusive Licensee (collectively referred to as “the Parties”) filed a Joint Motion to Terminate the above-identified *inter partes* review proceeding (“Joint Motion”). Paper 11. The Parties represent that the Board authorized filing the Joint Motion in an email dated November 5, 2018. *Id.* at 2. Along with the Joint Motion, the Parties filed a copy of a Confidential Agreement (“Settlement Agreement”) (Ex. 1032), as well as a Joint Request 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) (“Joint Request”). Paper 11, 2.

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.”

In the Joint Motion, the Parties represent that they “have now resolved their dispute with regards to the ‘742 Patent and have reached agreement to terminate this proceeding.” Paper 11, 3. The Parties further represent that the filed Settlement Agreement is “a true and accurate copy of the agreement between the parties that resolves the present proceeding.” *Id.*

We instituted a trial in the above-identified proceeding on August 21, 2018. Paper 9. We have not yet decided the merits of the proceeding, and a final written decision has not been entered. Notwithstanding that the proceeding has moved beyond the preliminary stage, the Parties have adequately shown that termination of the proceeding is appropriate. Under

these circumstances, we shall terminate the proceeding with respect to the Parties.

Under 35 U.S.C. § 317(b), “[a]t the request of a party to the proceeding, the agreement or understanding shall be treated as business confidential information, shall be kept separate from the file of the involved patents, and shall be made available only to Federal Government agencies on written request, or to any person on a showing of good cause.”

In the Joint Request, the Parties request that the Settlement Agreement be treated as business confidential information and be kept separate from the file of the patent involved in the above-identified proceeding. Paper 11, 2. After reviewing the Settlement Agreement, we find that the Settlement Agreement contains business confidential information regarding the terms of settlement, and thus the Settlement Agreement shall be available only as provided in 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 the Joint Motion to terminate is *granted*, and IPR2018-00534 is *terminated* due to settlement after institution decision with respect to the Parties pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. § 42.72; and

FURTHER ORDERED that the Joint Request to treat the Settlement Agreement as business confidential information is *granted*, and the Settlement Agreement shall be kept separate from the file of Patent

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9,503,742, and shall be 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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