

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AMPEREX TECHNOLOGY LTD.,
Petitioner,

v.

LG CHEM, LTD. and TORAY INDUSTRIES, INC.,
Patent Owner.

Case IPR2018-00783
Patent 7,638,241 B2

Before GRACE KARAFFA OBERMANN, CHRISTOPHER M. KAISER,
and CHRISTOPHER C. KENNEDY, *Administrative Patent Judges*.

KENNEDY, *Administrative Patent Judge*.

JUDGMENT

Termination of the Proceeding Due to Settlement
35 U.S.C. § 317 and 37 C.F.R. §§ 42.72, 42.74

I. INTRODUCTION

On September 19, 2018, we instituted *inter partes* review in this proceeding. Paper 8. On January 3, 2019, with our authorization, the parties filed (1) a Joint Motion to Terminate Under 35 U.S.C. § 317 and 37 C.F.R. §§ 42.72 and 42.74 (Paper 13), (2) a copy of the executed written settlement agreement that provides the basis for the Motion to Terminate (Ex. 1027 (sealed)), and (3) a Joint Request to Keep Agreement Confidential and Separate under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) (Paper 14).

For the reasons below, we *grant* the Motion to Terminate and the Request to Keep Agreement Confidential and Separate.

II. DISCUSSION

Under 35 U.S.C. § 317(a), an instituted *inter partes* review “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 this proceeding, we instituted *inter partes* review, but Patent Owner has not yet filed a Patent Owner Response, and we have not yet decided the merits. We must terminate with respect to Petitioner.

Section 317(a) also provides that, “[i]f no petitioner remains in the *inter partes* review, the Office may terminate the review or proceed to a final written decision under section 318(a).” The Board, therefore, has discretion to terminate these proceedings with respect to Patent Owner.

In the Motion to Terminate, the parties state that they have settled their dispute and have reached a written agreement that resolves the dispute in this proceeding as well as the disputes in other matters between the parties relating to the patent involved in this proceeding. Paper 13 at 2–4. In

support of the Motion to Terminate, the parties submitted a true copy of their written settlement agreement. *See* Ex. 1027. The parties state that there are no other collateral agreements between the parties made in connection with, or in contemplation of, the termination of this proceeding. Paper 13 at 4; *see also* 35 U.S.C. § 317(b).

Upon consideration of the Motion to Terminate, and in view of the early stage of the proceeding, we determine that it is appropriate to terminate this proceeding as to Petitioner and Patent Owner without rendering a final written decision. *See* 35 U.S.C. § 317(a); 37 C.F.R. § 42.72 (“The Board may terminate a trial without rendering a final written decision, where appropriate, including where the trial is consolidated with another proceeding or pursuant to a joint request under 35 U.S.C. 317(a)”).

The parties also request that the settlement agreement be treated as business confidential information and that it be kept separate from the file of the involved patent in accordance with 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c). Paper 14 at 2–3. We find that the settlement agreement contains confidential business information regarding the terms of settlement and that good cause exists to treat the settlement agreement as business confidential information pursuant to 35 U.S.C. § 317(b).

It is hereby:

ORDERED that the Joint Motion to Terminate (Paper 13) is *granted*;

FURTHER ORDERED that the Joint Request to Keep Agreement Confidential and Separate (Paper 14) is *granted*; and

FURTHER ORDERED that this *inter partes* review is hereby *terminated*.

IPR2018-00783
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