

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LITE-ON TECHNOLOGY CORPORATION,
Petitioner,

v.

DARFON ELECTRONICS CORPORATION,
Patent Owner.

Case IPR2018-01062
Patent 6,860,612 B2 & C1

Before ANDREI IANCU, *Director of the U.S. Patent and Trademark Office*, and
WILLIAM V. SAINDON and MICHAEL R. ZECHER, *Administrative Patent
Judges*.

ZECHER, *Administrative Patent Judge*.

DECISION
Granting the Parties' Joint Motion to Terminate
35 U.S.C. § 317(a) and 37 C.F.R. § 42.72

I. DISCUSSION

On April 18, 2019, the parties filed the following documents: (1) a Joint Motion to Terminate (Paper 27); (2) a true copy of the settlement agreement written in Mandarin (Ex. 1026, “true copy of the settlement agreement”); (3) a machine translation of the true copy of the settlement agreement (Ex. 1027, “machine translation”); and (4) a joint request to treat both the true copy of the settlement agreement and the machine translation as business confidential information under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) (Paper 28). Pursuant to our request, the parties agreed to file a “certified” translation of the true copy of the settlement agreement in accordance with 37 C.F.R. § 42.63(b) no later than thirty days after filing the Joint Motion to Terminate. Paper 27, 2.

This trial is still in its early stages. On November 15, 2018, we entered a decision instituting an *inter partes* review of claims 1, 5, 9–12, 14, 15, 17, 18, 21, and 22 of U.S. Patent No. 6,860,612 B1 (Ex. 1001 (originally issued patent)) and U.S. Patent No. 6,860,612 C1 (Ex. 1002 (*Ex Parte* Reexamination Certificate)) (collectively, the ‘612 patent). Paper 8. On February 22, 2019, Patent Owner, Darfon Electronics Corporation (“Darfon”) filed a Patent Owner Response (Paper 15), along with a Contingent Motion to Amend (Paper 16). To date, Petitioner, Lite-On Technology Corporation (“Lite-On”), has not filed a Reply to the Patent Owner Response nor has Lite-On filed an Opposition to the Contingent Motion to Amend. Because briefing is still open, we have not reached the merits of the proceeding.

In the Joint Motion to Terminate, the parties indicate that they have settled all their disputes regarding the ‘612 patent and they have agreed to terminate this trial. Paper 27, 4. The parties represent “that there are [no] . . . other proceedings before the Board [involving] the ‘612 patent.” *Id.* at 5. The parties also state that,

apart from the true copy of the settlement agreement filed as Exhibit 1026 and the machine translation filed as Exhibit 1027, “there are no other agreements or understandings, oral or written, between the parties, including any collateral agreements, made in connection with, or in contemplation of, the termination of the present proceeding.” *Id.* at 2. Under these particular circumstances, we determine that it is appropriate to terminate this trial without rendering any further decisions. *See* 37 C.F.R. § 42.72.

We also have reviewed the machine translation, and we determine that good cause exists to treat both the true copy of the settlement agreement and the machine translation as business confidential information under 37 C.F.R. § 317(b) and 37 C.F.R. § 42.74(c). The parties, however, are required to file a “certified” translation of the true copy of the settlement agreement in accordance with 37 C.F.R. § 42.63(b) no later than May 20, 2019.

II. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that the parties’ request to treat both the true copy of the settlement agreement (Ex. 1026) and the machine translation (Ex. 1027) as business confidential information under 37 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) is *granted*;

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

FURTHER ORDERED that the trial will be terminated upon entry of a “certified” translation of the true copy of the settlement agreement in accordance with 37 C.F.R. § 42.63(b). The “certified” translation of the true copy of the settlement agreement must be filed no later than May 20, 2019; and

IPR2018-01062

Patent 6,860,612 B2 & C1

FURTHER ORDERED that the “certified” translation of the true copy of the settlement agreement, when filed, shall be treated as business confidential information under 37 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

IPR2018-01062
Patent 6,860,612 B2 & C1

For PETITIONER:

Robert Pérez
Christopher Kao
PILLSBURY WINTHROP SHAW PITTMAN LLP
robert.perez@pillsburylaw.com
ckao@pillsburylaw.com

For PATENT OWNER:

Benjamin Weed
Jay Chiu
Erik Halverson
K&L GATES LLP
benjamin.weed.ptab@klgates.com
jay.chiu@klgates.com
erik.halverson@klgates.com