Trials@uspto.gov
571-272-7822

Paper 23
Entered: July 17, 2019

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ASM IP HOLDING B.V.,
Petitioner,

v.

HITACHI KOKUSAI ELECTRIC INC.,
Patent Owner.

IPR2018-01479 (Patent 6,514,869 B2)
IPR2018-01523 (Patent 7,622,007 B2)[1]

Before JON B. TORNQUIST, WESLEY B. DERRICK, and AMBER L. HAGY, *Administrative Patent Judges.*

TORNQUIST, *Administrative Patent Judge*.

ORDER
Termination of the Proceedings
35 U.S.C. § 317(a)

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[1] This Order addresses issues that are the same in the above-identified proceedings. We exercise our discretion to issue one Order to be entered in each proceeding. The Parties are not authorized to use this joint heading and filing style in their papers.

On July 12, 2019, with Board authorization, the parties filed a Joint Motion to Terminate in each of these proceedings. IPR2018-01479, Paper 21; IPR2018-01523, Paper 22. With each motion to terminate, the parties filed a copy of a written settlement agreement (Exhibit 1037 in both proceedings) along with a joint request that the settlement agreement be treated as business confidential information and kept separate from the files of the identified patents. IPR2018-01479, Paper 20; IPR2018-01523, Paper 21.

Generally, the Board expects that a proceeding will terminate after the filing of a settlement agreement. *See* 35 U.S.C. § 317(a) ("An 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."); Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,768 (Aug. 14, 2012). Based on the facts of these cases, we determine that it is appropriate to terminate these proceedings without rendering a final written decision. We also determine that it is appropriate to treat the settlement agreements as business confidential information to be kept separate from the files of U.S. Patent Nos. 6,514,869 B2 and 7,622,007 B2. *See* 35 U.S.C. § 317(b).

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

In consideration of the foregoing, it is hereby:

ORDERED that the Joint Motions to Terminate are *granted*;

FURTHER ORDERED that the settlement agreement between the parties (Ex. 1037) shall be treated as business confidential information and

kept separate from the files of U.S. Patent Nos. 6,514,869 B2 and 7,622,007 B2; and

FURTHER ORDERED that the above-identified proceedings are *terminated* with respect to both Petitioner and Patent Owner pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. § 42.72.

For PETITIONER:

Kerry Taylor
Adeel Akhtar
KNOBBE, MARTENS, OLSON & BEAR, LLP
2kst@knobbe.com
2asa@knobbe.com

For PATENT OWNER:

Dion Bregman
Michael Lyons
Jason Gettleman
dion.bregman@morganlewis.com
michael.lyons@morganlewis.com
jason.gettleman@morganlewis.com