

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD. and SAMSUNG ELECTRONICS
AMERICA, INC.
Petitioner

v.

VISUAL EFFECT INNOVATIONS, LLC
Patent Owner

Case IPR2018-01733 (Patent 9,699,444 B2)
Case IPR2018-01734 (Patent 9,716,874 B2)

Before CHRISTOPHER L. CRUMBLEY, MINN CHUNG, and
JASON M. REPKO, *Administrative Patent Judges*.

REPKO, *Administrative Patent Judge*.

SETTLEMENT
Before Institution of Trial
35 U.S.C. § 316(a)(4); 37 C.F.R. § 42.74

Case IPR2018-01733 (Patent 9,699,444 B2)

Case IPR2018-01734 (Patent 9,716,874 B2)

Petitioner, Samsung Electronics Co., Ltd. and Samsung Electronics America, Inc., and Patent Owner, Visual Effect Innovations, LLC, jointly request to terminate¹ IPR2018-01733 challenging U.S. Patent No. 9,699,444 B2 and IPR2018-01734 challenging U.S. Patent No. 9,716,874 B2. IPR2018-01733, Paper 6; IPR2018-01734, Paper 5 (“Motion”). Along with the joint motions, the parties filed a settlement agreement covering the challenged patents. IPR2018-01733, Ex. 2001; IPR2018-01734, Ex. 2001(“Settlement Agreements”). The parties have filed joint requests to have the Settlement Agreements treated as business confidential information under 37 C.F.R. § 42.74(c). IPR2018-01733, Paper 8; IPR2018-01734, Paper 7.

The Board generally expects that a case “will terminate after the filing of a settlement agreement, unless the Board has already decided the merits.” *Office Patent Trial Practice Guide*, 77 Fed. Reg. 48,756, 48,768 (Aug. 14, 2012). In this case, we have not issued a decision on institution. The parties have settled their dispute. Motion 3. Under the circumstances, it is appropriate to dismiss the petitions. *See* 37 C.F.R. § 42.71(a).

We have reviewed the Settlement Agreements between Petitioner and Patent Owner. Because the Settlement Agreements contain business confidential information about the settlement terms, it is appropriate to treat

¹ Although the motion refers to 35 U.S.C. § 317(a) (Motion 2), that section provides, in relevant part, “[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.” 35 U.S.C. § 317(a) (emphasis added). Because we have not issued a decision on institution in either case, we treat the requests as seeking dismissal of the petitions.

Case IPR2018-01733 (Patent 9,699,444 B2)

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the Settlement Agreements as business confidential information under 37 C.F.R. § 42.74(c).

ORDER

Accordingly, it is:

ORDERED that the Motion is *granted*;

FURTHER ORDERED that the petitions in IPR2018-01733 and IPR2018-01734 are *dismissed*; and

FURTHER ORDERED that the request that the Settlement Agreements be treated as business confidential information and be kept separate from the patent files under 37 C.F.R. § 42.74(c) is *granted*.

Case IPR2018-01733 (Patent 9,699,444 B2)

Case IPR2018-01734 (Patent 9,716,874 B2)

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