Trials@uspto.gov
571-272-7822

Paper No. 9
Date Entered: May 20, 2019

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ASUSTEK COMPUTER INC. and
ASUS COMPUTER INTERNATIONAL,
Petitioner,

v.

MAXELL, LTD.,
Patent Owner.

Case IPR2019-00068
Patent 7,403,226 B2

Before MINN CHUNG, TERRENCE W. McMILLIN, and JOHN A. HUDALLA, *Administrative Patent Judges*.

CHUNG, *Administrative Patent Judge*.

DECISION
Granting the Parties' Joint Motion to Terminate
37 C.F.R. §§ 42.71(a) and 42.74

I. DISCUSSION

With Board authorization, the parties filed a Joint Motion To Terminate this *inter partes* review on April 11, 2019. Paper 7 ("Mot."). Along with the Joint Motion, the parties filed a copy of a document they describe as "a true and correct copy" (*id.* at 1) of their written settlement agreement (Ex. 1100) covering various matters, including those involving the patent at issue in this proceeding. The parties also filed a joint request to treat the settlement agreement as business confidential information under 37 C.F.R. § 42.74(c). Paper 8.

This proceeding is still in its preliminary stages. Petitioner filed a Petition requesting an *inter partes* review of claim 1 of U.S. Patent No. 7,403,226 B2 (Ex. 1001, "the '226 patent"). Paper 2. Patent Owner filed a Preliminary Response. Paper 6. We have not entered a decision on whether to institute an *inter partes* review.

In the Joint Motion to Terminate, the parties indicate that they have settled all their disputes regarding the '226 patent. Paper 7, 3. The parties represent that the settlement encompasses this proceeding and the co-pending district court case where Patent Owner asserted the '226 patent against Petitioner. *Id*. The parties also state that the settlement agreement filed as Exhibit 1100 "represents all agreements made in connection with, or in contemplation of, the termination of this proceeding." *Id.* at 4–5. Under these particular circumstances, we determine that it is appropriate to dismiss the Petition without rendering any further decisions, thereby terminating this proceeding. *See* 37 C.F.R. § 42.71(a). We also have reviewed the settlement agreement, and we determine that good cause exists to treat the settlement agreement as business confidential information under 37 C.F.R. § 42.74(c).

II. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that the parties' request to treat the settlement agreement (Exhibit 1100) as business confidential information under 37 C.F.R. § 42.74(c) is *granted*;

FURTHER ORDERED that the settlement agreement (Exhibit 1100) shall be treated as business confidential information, kept separate from the file of the '226 patent, and made available only to Federal Government agencies on written request to the Board, or to any person on a showing of good cause, under the provisions of 37 C.F.R. § 42.74(c); and

FURTHER ORDERED that the parties' Joint Motion to Terminate is *granted*, and the Petition is dismissed resulting in termination of this proceeding.

For PETITIONER:

Christopher Douglas
Thomas Davison
Derek Neilson
ALSTON & BIRD LLP
christopher.douglas@alston.com
tom.davison@alston.com
derek.neilson@alston.com

For PATENT OWNER:

Robert Pluta
Michael Word
Amanda Bonner
Luiz Miranda
Saqib Siddiqui
MAYER BROWN LLP
rpluta@mayerbrown.com
mword@mayerbrown.com
astreff@mayerbrown.com
lmiranda@mayerbrown.com
ssiddiqui@mayerbrown.com