Trials@uspto.gov
571-272-7822

Paper No. 10
Date Entered: April 22, 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.

Cases
IPR2019-00067 (Patent 9,451,229 B2)
IPR2019-00069 (Patent 9,544,517 B2)[1]

Before MICHAEL R. ZECHER, KEVIN C. TROCK, and JOHN A. HUDULLA, *Administrative Patent Judges*.

ZECHER, *Administrative Patent Judge*.

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

[1] This Decision addresses an issue that is identical in both cases. We, therefore, exercise our discretion to issue one Decision to be filed in each case.

I. DISCUSSION

The parties filed the following in each proceeding identified above: (1) a Joint Motion to Terminate (Case IPR2019-00067, Paper 10; Case IPR2019-00069, Paper 9); (2) a true copy of the parties' settlement agreement (Case IPR2019-00067, Ex. 1100; Case IPR2019-00069, Ex. 1100); and (3) a joint request to treat the settlement agreement as business confidential information under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) (Case IPR2019-00067, Paper 11; Case IPR2019-00069, Paper 8).

These proceedings are still in their preliminary stages. Petitioner, ASUSTek Computer, Inc. and ASUS Computer International ("ASUS"), filed a corrected Petition requesting an *inter partes* review of claims 1–12 of U.S. Patent No. 9,451,229 B2 ("the '229 patent"). Case IPR2019-00067, Paper 3. In addition to this Petition, ASUS filed another Petition 4 patent"). Case IPR2019-00069, Paper 2. In each proceeding, Patent Owner, Maxell Ltd. ("Maxell"), filed a Preliminary Response (Case IPR2019-00067, Paper 9; Case IPR2019-00069, Paper 7); however, we have not entered a decision whether to institute an *inter partes* review.

In the Joint Motions to Terminate, the parties indicate that they have settled all their disputes regarding the '229 patent and the '517 patent. Case IPR2019-00067, Paper 10, 4–5; Case IPR2019-00069, Paper 9, 3–4. The parties represent that the settlement encompasses these two proceedings and the co-pending district court case where Maxell asserted both the '229 patent and the '517 patent against ASUS. Case IPR2019-00067, Paper 10, 4–5; Case IPR2019-00069, Paper 9, 3–4. The parties also state that the settlement agreement filed as Exhibit 1100 in each proceeding "represents all agreements made in connection with, or in contemplation of, the termination of th[ese] proceeding[s]." Case IPR2019-00067,

Paper 10, 5–6; Case IPR2019-00069, Paper 9, 4–5. Under these particular circumstances, we determine that it is appropriate to dismiss both Petitions without rendering any further decisions, thereby terminating these proceedings. *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' requests to treat the settlement agreement filed in each proceeding (Case IPR2019-00067, Ex. 1100; Case IPR2019-00069, Ex. 1100) as business confidential information under 37 C.F.R. § 42.74(c) are *granted*; and

FURTHER ORDERED that the parties' Joint Motions to Terminate are *granted*, and both Petitions are dismissed resulting in termination of these proceedings.

For PETITIONER:

Christopher T.L. Douglas
Thomas W. Davison
Derek S. Neilson
Alston & Bird LLP
Christoper.Douglas@alston.com
Tom.Davison@alston.com
Derek.Neilson@alston.com

For PATENT OWNER:

Robert G. Pluta
Michael J. Word
Amanda S. Bonner
Luiz A. Miranda
Saqib J. Siddiqui
Mayer Brown LLP
rpluta@mayerbrown.com
mword@mayerbrown.com
astreff@mayerbrown.com
lmiranda@mayerbrown.com
ssiddiqui@mayerbrown.com