

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FORMFACTOR, INC.
Petitioner,

v.

FEINMETALL, GmbH
Patent Owner.

IPR2019-00080
IPR2019-00081
IPR2019-00082
Patent 7,850,460 B2

Before GEORGIANNA W. BRADEN, STACEY G. WHITE, AND
SHELDON M. MCGEE, *Administrative Patent Judges*.

WHITE, *Administrative Patent Judge*.

TERMINATION
Due to Settlement After Institution of Trial
35 U.S.C. § 317; 37 C.F.R. § 42.74

FormFactor, Inc. (“Petitioner”) filed three petitions requesting *inter partes* review of claims 1–33 of U.S. Patent No. 7,850,460 B2 (“the ’460 patent,” Ex. 1001) pursuant to 35 U.S.C. §§ 311–319, in Cases IPR2019-00080, IPR2019-00081, and IPR2019-00082. Feinmetall, GmbH (“Patent Owner”) filed a Preliminary Response in each of these cases. On April 15, 2019, we instituted *inter partes* review pursuant to each of the petitions filed in these matters on claims 1–33 of the ’460 patent.

On April 14, 2020, the parties filed a Joint Motion to Terminate in these proceedings pursuant to 37 C.F.R. § 42.74. Paper 41¹. With the motion to terminate, the parties filed a copy of a written settlement agreement (Ex. 1045) along with a joint request (“Joint Request”) to file the settlement agreement as business confidential information and to keep the settlement agreement separate from the patent files, under 35 U.S.C. § 317 and 37 C.F.R. § 42.74 (Paper 42). We authorized the filing of these papers² in an email to the parties dated April 13, 2020.

The parties represent that Exhibit 1045 is a “true and correct copy” of their settlement agreement. Paper 41, 2. They also represent that “[t]here are no collateral agreements or understandings made in connection with, or

¹ The same papers were filed in each of the three proceedings. For ease of reference, we will refer to the papers filed in IPR2019-00080.

² We note, however, that the papers were received late. Due to the impending statutory deadline for the Final Written Decisions in these matters, we ordered the parties to file their papers by no later than noon eastern time on April 14, 2020. The papers were received after that time. We will excuse the lateness (less than an hour), but we note that time is of the essence with such an impending deadline and other panels may choose not to excuse tardiness.

in contemplation of, the termination of this proceeding.” *Id.* The parties state that “[i]f the Office has already decided the merits, Petitioner requests publication of the Office’s decision in connection with the withdrawal of the petition and termination. Patent Owner requests there be no publication of the decision in connection with the withdrawal of the petition and termination.” *Id.*

Generally, the Board expects that a proceeding will terminate after the filing of a settlement agreement. See Consolidated Trial Practice Guide (“Consolidated Practice Guide”) 86 (Nov. 21, 2019), <https://www.uspto.gov/sites/default/files/documents/tpgnov.pdf>. We decline to exercise our authority to proceed to final written decision despite the parties’ settlement. See 37 C.F.R. § 42.74(a) (Stating that in the event of a settlement between the parties we “may independently determine any question of jurisdiction, patentability, or other Office practice.”). Thus, we exercise our discretion in this manner to terminate without entering a final written decision. See *id.* § 42.72. Accordingly, the Joint Motion to Terminate is *granted* and the Joint Request to treat the settlement agreement as business confidential information is *granted*.

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

ORDER

In consideration of the foregoing, it is hereby:

ORDERED that Joint Request that the settlement agreement be treated as business confidential information and be kept separate from the

IPR2019-00080, IPR2019-00081, IPR2019-00082
Patent 7,850,460 B2

files of the involved patent under the provisions of 35 U.S.C. § 317(b) and
37 C.F.R. § 42.74(c), is granted;

FURTHER ORDERED that the Joint Motion to Terminate this
proceeding is granted; and

FURTHER ORDERED that this proceeding is terminated with respect
to both Petitioner and Patent Owner pursuant to 35 U.S.C. § 317(a) and 37
C.F.R. § 42.72.

PETITIONER:

David L. McCombs
David O'Dell
Kelly Gehrke Lyle
Jamie H. McDole
HAYNES AND BOONE, LLP
David.mccombs.ipr@haynesboone.com
David.odell.ipr@haynesboone.com
Kelly.lyle.ipr@haynesboone.com
jamie.mcdole@haynesboone.com

PATENT OWNER:

Robert M. Masters
Timothy P. Cremen
SHEPPARD, MULLIN, RICHTER & HAMPTON LLP
rmasters@sheppardmullin.com
tcremen@sheppardmullin.com