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Paper 18
Entered: July 22, 2019

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

KOKUSAI ELECTRIC CORPORATION,
Petitioner,

v.

ASM IP HOLDING B.V.,
Patent Owner.

IPR2018-01357 (Patent 7,833,352 B2)
IPR2019-00099 (Patent 7,018,478 B2)[1]

Before MICHAEL P. TIERNEY, *Vice Chief Administrative Patent Judge,* DONNA M. PRAISS and CHRISTOPER L. CRUMBLEY, *Administrative Patent Judges*.

PRAISS, *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, the parties filed a Joint Motion to Terminate in each of these proceedings (collectively, "Joint Motions to Terminate") pursuant to 35 U.S.C. § 317(a). Paper 22.[2] With each motion to terminate, the parties filed a copy of a written settlement agreement (Ex. 2007)[3] along with a joint request (collectively, "Joint Requests") 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 21).[4] We authorized the filing of these papers in an e-mail dated July 10, 2019.

Generally, the Board expects that a proceeding will terminate after the filing of a settlement agreement. *See, e.g.*, Office Patent Trial Practice Guide, 77 Fed. Reg. 48756, 48768 (Aug. 14, 2012). We instituted trial in each of the above-identified proceedings (IPR2018-01357, Paper 11; IPR2019-00099, Paper 10). A decision on the merits has not been reached, yet, in these proceedings. The parties represent that Exhibit 2007 is a "true copy" of their settlement agreement. Paper 22, 2. They also represent that "[t]here are no other agreements, oral or written, between the parties made in connection with, or in contemplation of, the termination of this proceeding." *Id.* Based on the facts of these cases, we determine that it is appropriate to terminate these proceedings without rendering a final written decision. *See*

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[2] We cite herein to papers filed in IPR2018-01357. Petitioner filed a similar Joint Motion to Terminate in IPR2019-00099 (Paper 17).
[3] We cite herein to the copy of the written settlement agreement filed in IPR2018-01357. Petitioner also filed a copy of the written settlement agreement in IPR2019-00099 (Ex. 2002).
[4] Petitioner filed a similar Joint Request in IPR2019-00099 (Paper 16).

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."). Therefore, the Joint Motions to Terminate and the Joint Requests to treat the settlement agreement as business confidential information are *granted*.

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

ORDER

Accordingly, it is

ORDERED that the Joint Requests that the settlement agreements be treated as business confidential information and be kept separate from the files of the above-identified proceedings and from the files of the involved patents under the provisions of 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c), are *granted*;

FURTHER ORDERED that the Joint Motions to Terminate the above-identified proceedings are *granted*; 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.

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