

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ASM IP HOLDING B.V.,
Petitioner,

v.

KOKUSAI ELECTRIC CORPORATION,
Patent Owner.

Case IPR2019-00371
Patent 9,318,316 B2

Before KRISTINA M. KALAN, MICHELLE N. WORMMEESTER, and
SHELDON M. McGEE, *Administrative Patent Judges*.

KALAN, *Administrative Patent Judge*.

TERMINATION
Dismissing the Proceeding
37 C.F.R. § 42.5(a), 37 C.F.R. § 42.71(a)

On July 12, 2019, the parties filed a joint motion to terminate the proceeding in the above-referenced case under 35 U.S.C. § 317 and 37 C.F.R. § 42.74. Paper 13. The parties also filed a copy of a settlement agreement (Ex. 1037), along with a 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 14). 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). This case is in the preliminary proceeding stage, which begins with the filing of a petition and ends with a written decision as to whether trial will be instituted. *See* 37 C.F.R. § 42.2. At this juncture, the Board has not determined whether to institute trial. The parties represent that Exhibit 1037 is a “true copy” of their settlement agreement. Paper 13, 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 this case, we determine that it is appropriate to dismiss this case without rendering a decision as to whether a trial will be instituted. Therefore, the joint motion to terminate the above-referenced case is GRANTED.

ORDER

Accordingly, it is:

ORDERED that the parties' request that the settlement agreement be treated as business confidential information, and be kept separate from the patent file, is GRANTED;

FURTHER ORDERED that the joint motion to terminate the above-referenced case is GRANTED;

FURTHER ORDERED that the Petition for *inter partes* review in IPR2019-00371 is DISMISSED.

IPR2019-00371
Patent 9,318,316 B2

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