

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 IPR2019-00392 (Patent 6,744,018 B2)
Case IPR2019-00393 (Patent RE43,023 E)¹

Before BENJAMIN D. M. WOOD, HYUN J. JUNG, and
RICHARD J. SMITH, *Administrative Patent Judges*.

SMITH, *Administrative Patent Judge*.

TERMINATION
Dismissing the Proceeding
37 C.F.R §§ 42.5(a), 42.71(a), 42.74

¹ We exercise our discretion to issue one order to be entered in both cases.

With our prior authorization, on July 12, 2019, the parties filed a joint motion to terminate the proceeding in both of the above-referenced cases under 35 U.S.C. § 317 and 37 C.F.R. § 42.74. Paper 13.² 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), in both of the above-referenced cases.

In each motion, the parties indicate that “Petitioner and Patent Owner reached an agreement resolving the dispute in this and all other inter partes reviews between Petitioner and Patent Owner, as well as the related district court litigations between Petitioner and Patent Owner.” Paper 13, 1. The parties 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.* at 2.

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). Both of these cases are 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. Based on the facts of both cases, we determine that it is appropriate to dismiss both cases without rendering a decision as to whether a trial will be instituted. Therefore, the joint motions to terminate the above-referenced cases are GRANTED.

² Paper numbers and the exhibit number referred to herein are the same in both IPR2019-00392 and IPR2019-00393.

IPR2019-00392 (Patent 6,744,018 B2)

IPR2019-00393 (Patent RE43,023 E)

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 files, is GRANTED;

FURTHER ORDERED that the joint motions to terminate the above-referenced cases are GRANTED; and

FURTHER ORDERED that the Petitions for *inter partes* review in IPR2019-00392 and IPR2019-00393 are DISMISSED.

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