

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HUAWEI TECHNOLOGIES CO., LTD.,
Petitioner,

v.

MAXELL, LTD.,
Patent Owner.

Case IPR2019-00464
Patent 7,995,897 B2

Before MINN CHUNG, TERRENCE W. McMILLIN, and
JOHN A. HUDALLA, *Administrative Patent Judges*.

CHUNG, *Administrative Patent Judge*.

TERMINATION
Settlement Before Institution of Trial
37 C.F.R. §§ 42.71(a) and 42.74

With Board authorization (Paper 6), Huawei Technologies Co., Ltd. (“Petitioner”) and Maxell, Ltd. (“Patent Owner”) filed a Joint Motion To Terminate on April 10, 2019. Paper 7 (“Mot.”). Along with the Joint Motion, the parties filed a copy of a document they describe as “a true and complete copy” (*id.* at 1) of their written settlement agreement (Ex. 1013) covering various matters, including those involving the patent at issue in this proceeding. The parties also filed a joint request to treat the settlement agreement as business confidential information under 37 C.F.R. § 42.74(c). Paper 8.

This proceeding is still in its preliminary stages. Petitioner filed a Petition requesting an *inter partes* review of claims 10–12 of U.S. Patent No. 7,995,897 B2 (Ex. 1001, “the ’897 patent”). Paper 2. Patent Owner has not filed a Preliminary Response.

In their Joint Motion, the parties represent that the settlement agreement completely resolves the underlying disputes between the parties involving the ’897 patent at issue in this proceeding. Mot. 3. The parties indicate that the settlement encompasses this proceeding and the co-pending district court case where Patent Owner asserted the ’897 patent against Petitioner. *Id.* The parties certify that there are no other agreements or understandings, oral or written, between the parties, including any collateral agreements, made in connection with, or in contemplation of, the termination of this proceeding. *Id.* at 1–2.

Under the particular circumstances of this case, we determine that it is appropriate to dismiss the Petition without rendering any further decisions, thereby terminating this proceeding. *See* 37 C.F.R. § 42.71(a). We also have reviewed the settlement agreement, and we determine that the

settlement agreement contains business confidential information regarding the terms of the settlement and that good cause exists to treat the settlement agreement as business confidential information under 37 C.F.R. § 42.74(c).

Accordingly, it is

ORDERED that the parties' joint request (Paper 8) to treat the parties' settlement agreement as business confidential information is *granted*;

FURTHER ORDERED that the settlement agreement (Exhibit 1013) shall be treated as business confidential information, kept separate from the file of the '897 patent, and made available only to Federal Government agencies on written request to the Board, or to any person on a showing of good cause, under the provisions 37 C.F.R. § 42.74(c);

FURTHER ORDERED that the Joint Motion to Terminate (Paper 7) is *granted*; and

FURTHER ORDERED that the Petition is *dismissed*, resulting in termination of this proceeding.

IPR2019-00464
Patent 7,995,897 B2

PETITIONER:

Michael Hawkins
Patrick Bisenius
Stuart Nelson
Kim Leung
Nicholas Stephens
Fish & Richardson P.C.
hawkins@fr.com
bisenius@fr.com
snelson@fr.com
leung@fr.com
nstephens@fr.com

PATENT OWNER:

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