

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

II-VI INCORPORATED,
Petitioner,

v.

SAINT-GOBAIN CERAMICS & PLASTICS, INC.,
Patent Owner.

IPR2019-01535
Patent 9,963,800 B2

Before GRACE KARAFFA OBERMANN, JEFFREY W. ABRAHAM, and
ELIZABETH M. ROESEL, *Administrative Patent Judges*.

ABRAHAM, *Administrative Patent Judge*.

TERMINATION

Due to Settlement After Institution of Trial and
Granting Joint Request to Treat Settlement Agreement as
Business Confidential Information
35 U.S.C. § 317; 37 C.F.R. § 42.74

I. INTRODUCTION

On June 11, 2020, Petitioner and Patent Owner (collectively “the Parties”) filed a Joint Motion to Terminate the above-identified proceeding (“Joint Motion”). Paper 9. The Parties also filed an Intellectual Property License and Settlement Agreement (Exhibit 1028, “Settlement Agreement”) and requested that the Settlement Agreement be treated as business confidential information and be kept separate. Joint Motion 1, 3. We authorized the filing of these papers in an email sent on June 3, 2020. *See* Joint Motion 2.

II. DISCUSSION

Under 35 U.S.C. § 317(a), “[a]n *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.” It is also provided in 35 U.S.C. § 317(a) that if no petitioner remains in the *inter partes* review, the Office may terminate the review.

In the Joint Motion, the Parties represent that they have reached an agreement to jointly seek termination of this *inter partes* review proceeding, that the filed copy of the Settlement Agreement is a true copy, and there are no other written or oral agreements. Joint Motion 1–3. The Parties also represent that their settlement agreement resolves all currently pending Patent Office and District Court proceedings between the Parties involving US Patent No. 9,963,800 B2. *Id.* at 1, 3.

We instituted a trial on the above-identified proceeding on March 9, 2020. Paper 6. Given the parties’ joint request, we must terminate the proceeding with respect to Petitioner unless we have decided the merits of

the proceeding. *See* 35 U.S.C. § 317(a). We have not yet decided the merits of the proceeding, and a final written decision has not been entered.

Notwithstanding that the proceeding has moved beyond the preliminary stage, the Parties have shown adequately that the termination of the proceeding is appropriate. Under these circumstances, we determine that the proceeding should be terminated with respect to the Parties.

The Parties also requested that the Settlement Agreement be treated as business confidential information and be kept separate from the file of US Patent No. 9,963,800 B2. Joint Request 1, 3. After reviewing the Settlement Agreement between the Parties, we find that the Settlement Agreement contains confidential business information regarding the terms of settlement. We determine that good cause exists to treat the Settlement Agreement between the Parties as business confidential information pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

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

III. ORDER

Accordingly, for the reasons discussed above, it is:

ORDERED that the Joint Motion to Terminate is *granted*, and IPR2019-01535 is *terminated* with respect to Petitioner and Patent Owner, pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. § 42.72; and

FURTHER ORDERED that the Joint Request to File Settlement Agreement as Business Confidential Information is *granted*, and the Settlement Agreement shall be kept separate from the file of US Patent No. 9,963,800 B2, and made available only to Federal Government agencies on written request, or to any person on a showing of good cause, pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

IPR2019-01535
Patent 9,963,800 B2

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