

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HTC CORPORATION AND HTC AMERICA, INC.,
Petitioner,

v.

MOTIVA PATENTS, LLC,
Patent Owner.

IPR2019-01665
Patent 8,159,354 B2

Before LYNNE E. PETTIGREW, MONICA S. ULLAGADDI, and
IFTIKHAR AHMED, *Administrative Patent Judges*.

PETTIGREW, *Administrative Patent Judge*.

TERMINATION
Due to Settlement After Institution of Trial
35 U.S.C. § 317; 37 C.F.R. § 42.74

Petitioner (HTC Corporation and HTC America, Inc.) and Patent Owner (Motiva Patents, LLC) have requested that this proceeding be terminated in light of a settlement between the parties. The Board authorized the parties to file a joint motion to terminate the proceeding on April 29, 2020.

On May 4, 2020, and pursuant to 37 C.F.R. § 42.74 and 35 U.S.C. § 317(a), the parties filed a Joint Motion to Terminate this proceeding (Paper 11 (“Joint Motion”)) and a Joint Request that the settlement agreement be treated as business confidential information and be kept separate from the patent file (Paper 12 (“Joint Request”)), along with a copy of the written settlement agreement (Ex. 1028 (“Settlement Agreement”)).

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.” Section 317(a) also provides 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 resolving their dispute and that Exhibit 1028 is a true and complete copy of their Settlement Agreement. Paper 11, 2–3.¹ The parties further represent that their Settlement Agreement resolves all currently

¹ The Joint Motion does not have numbered pages. We count the pages of the Joint Motion starting from the first (title) page.

pending Patent Office and District Court proceedings between the parties involving U.S. Patent No. 8,159,354. *Id.* at 3–5.

We instituted trial in this proceeding on April 3, 2020. Paper 9. Patent Owner has not filed a Patent Owner Response, we have not yet decided the merits of this proceeding, and a final written decision has not been entered in this proceeding. Under these circumstances, we determine it is appropriate to terminate this proceeding with respect to both parties. Further, after reviewing the Settlement Agreement between Petitioner and Patent Owner, we determine it is appropriate to treat the Settlement Agreement as business confidential information and keep it separate from the file of the patent pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

Therefore, the Joint Motion to Terminate and the Joint Request 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, for the reasons discussed above, it is:

ORDERED that the Joint Motion to Terminate (Paper 11) is *granted*, and this proceeding is *terminated* with respect to both 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 (Paper 12) to Treat the Settlement Agreement (Exhibit 1028) as Business Confidential Information is *granted*, and the Settlement Agreement shall be kept separate from the

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files of the above-identified proceeding and from the file of U.S. Patent No. 8,159,354, under the provisions of 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

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