

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INTEL CORPORATION,
Petitioner,

v.

PACT XPP SCHWEIZ AG,
Patent Owner.

IPR2020-00533
Patent 8,301,872 B2

Before KEN B. BARRETT, CHARLES J. BOUDREAU, and
CHRISTOPHER L. OGDEN, *Administrative Patent Judges*.

BOUDREAU, *Administrative Patent Judge*.

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

On August 24, 2020, we instituted an *inter partes* review of claims 2, 4, 6, 10, 12, and 14–16 of U.S. Patent No. 8,301,872 B2 (“the ’872 patent”). Paper 11. On January 8, 2021, with our authorization, Petitioner Intel Corporation and Patent Owner PACT XPP Schweiz AG (collectively, “the Parties”) filed a Joint Motion to Terminate Proceeding Pursuant to 35 U.S.C. § 317 and 37 CFR §§ 42.72, 42.74. Paper 29 (“Mot.” or “Motion”). The Motion was accompanied by a copy of a Dismissal Agreement and Release (Ex. 2023) that the Parties represent to be the settlement agreement between them (Mot. 1, 6), and a Joint Request to Treat Settlement Agreement as Business Confidential Information (Paper 30), requesting that the Dismissal Agreement and Release be treated a business confidential information and be kept separate from the file of the ’872 patent, pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

The Parties represent in the Motion that they agreed, among other things, to dismiss with prejudice the ’872 patent from the ongoing pending litigation between the Parties, *PACT XPP Schweiz AG v. Intel Corp.*, Civil Action No. 19-1006 (D. Del. May 30, 2019), and that the district court dismissed all claims and counterclaims related to the ’872 patent from that litigation on January 4, 2021.¹ Mot. 1–2. The Parties also identify three prior district court cases between the Parties involving the ’872 patent that, the Parties represent, were terminated prior to the filing of this Proceeding. *Id.* at 2 (citing *PACT XPP Schweiz AG v. Intel Corp.*, Civil Action No. 19-267 (D. Del. Feb. 7, 2019); *PACT XPP Schweiz AG v. Intel Corp.*, Civil

¹ The Parties state that the present Motion “does not apply to any other pending IPRs between the parties” (Mot. 1), and we do not understand any claims or counterclaims related to the patents involved in those other IPRs to have been dismissed from the ongoing district court litigation.

Action No. 19-273 (W.D. Tex. April 23, 2019); and *Intel Corp. v. PACT XPP Schweiz AG*, Civil Action No. 19-2241 (N.D. Cal. April 25, 2019)).

The Board generally expects that a case “will terminate after the filing of a settlement agreement, unless the Board has already decided the merits.” Patent Trial and Appeal Board Consolidated Trial Practice Guide 86 (Nov. 2019), *available at* <https://www.uspto.gov/sites/default/files/documents/tpgnov.pdf>; *see* 37 C.F.R. § 42.72. Under the circumstances presented here, we determine that it is appropriate to terminate this Proceeding with respect to both Petitioner and Patent Owner. Accordingly, we grant the Parties’ Motion.

We also determine that the Parties have complied with the requirements of 37 C.F.R. § 42.74(c) to have their settlement agreement treated as business confidential information and kept separate from the patent files of the challenged patents. Thus, we grant the Parties’ Joint Request to Treat Settlement Agreement as Business Confidential Information.

Accordingly, it is

ORDERED that the Joint Motion to Terminate Proceeding Pursuant to 35 U.S.C. § 317 and 37 CFR §§ 42.72, 42.74 is granted;

FURTHER ORDERED that this proceeding is accordingly terminated as to all parties;

FURTHER ORDERED that the Joint Request to Treat Settlement Agreement as Business Confidential Information is granted; and

FURTHER ORDERED that Exhibit 2023 is accordingly to be kept separate from the file of the involved U.S. Patent No. 8,301,872 B2 under the provisions of 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

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Patent 8,301,872 B2

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