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Paper 10
Entered: February 18, 2021

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD.,
SAMSUNG ELECTRONICS AMERICA, INC.,
DELL INC., DELL PRODUCTS LP,
LENOVO (UNITED STATES) INC.; and HP INC.,
Petitioners,

v.

NEODRON LTD.,
Patent Owner.

IPR2020-00515[1]
Patent 9,024,790 B2

Before MIRIAM L. QUINN, PATRICK M. BOUCHER, and SCOTT B. HOWARD, *Administrative Patent Judges*.

HOWARD, *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

[1] Dell Inc., Dell Products LP, Lenovo (United States) Inc., and HP Inc. were joined as a party to this proceeding via a Motion for Joinder in IPR2020-00731.

I. INTRODUCTION

Samsung Electronics Co., Ltd., Samsung Electronics America, Inc., Dell Inc., Dell Products LP, Lenovo (United States) Inc., and HP Inc. (collectively, "Petitioner") and Neodron Ltd. ("Patent Owner"), (collectively "the Parties") request that the above-identified joined *inter partes* review proceeding be terminated pursuant to a settlement. With our authorization, the Parties filed a Joint Motion to Terminate in the joined proceeding ("Joint Motion"). Paper 33.

The Parties also filed copies of Patent License Agreements, a Settlement Agreement, Settlement and License Agreements, an Escrow Agreement, and an Exhibit A to the Escrow Agreement (Ex. 2005; Ex. 2006; Ex. 2007; Ex. 2008; Ex. 2009; Ex. 2010; Paper 35,[2] collectively "Settlement Agreements") and filed a Joint Request to Keep Separate (Paper 34, "Joint Request") in the joined proceeding.

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.

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[2] Exhibit A to the Escrow Agreement was filed as a paper instead of as an exhibit. We determine this to be a harmless error. The parties are reminded that evidences such as the Settlement Agreements must be filed as exhibits. *See* 37 C.F.R. § 42.63(a) ("Evidence consists of affidavits, transcripts of depositions, documents, and things. All evidence must be filed in the form of an exhibit.").

In the Joint Motion, the Parties represent that they have reached an agreement to jointly seek termination of the joined *inter partes* review proceeding, that the filed copies of the Settlement Agreements are true copies, and there are no other collateral agreements between the parties made in connection with, or in contemplation of, the termination. Joint Motion 1–3. Further, the Settlement Agreements indicate they are complete agreements. Ex. 2005, 12; Ex. 2006, 7; Ex. 2007, 9–10; Ex. 2008, 9–10; Ex 2009, 12; Ex. 2010, 13. The Parties also represent that their Settlement Agreements resolve all currently pending Patent Office and District Court proceedings between the Parties involving U.S. Patent No. 9,024,790 (the '790 patent"). Joint Motion 1–3.

We instituted a trial on the joined proceeding on July 31, 2020. Paper 13. We have not yet decided the merits of the joined proceeding, and a final written decision has not been entered. Notwithstanding that the joined proceeding has moved beyond the preliminary stage, the Parties have shown adequately that the termination of the joined proceeding is appropriate. Under these circumstances, we determine that good cause exists to terminate the joined proceeding with respect to the Parties.

The Parties also requested that the Settlement Agreements be treated as business confidential information and be kept separate from the file of the '790 patent. Joint Request 1–2. After reviewing the Settlement Agreements between the Parties, we find that the Settlement Agreements contain confidential business information regarding the terms of settlement. We determine that good cause exists to treat the Settlement Agreements 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 is *granted*, and the joined proceedings IPR2020-00515 and IPR2020-00731 are *terminated* with respect to Petitioner and Patent Owner, pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. § 42.72;

FURTHER ORDERED that the Joint Request is *granted*, and the Settlement Agreements shall be kept separate from the file of Patent 9,024,790, 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); and

FURTHER ORDERED that a copy of this TERMINATION shall be entered into the record of IPR2020-00731.

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