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Paper 14
Entered: March 15, 2021

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ABILITY OPTO-ELECTRONICS TECHNOLOGY CO., LTD,
Petitioner,

v.

LARGAN PRECISION CO., LTD.,
Patent Owner.

IPR2020-01339, Patent 8,988,796 B2[1]
IPR2020-01345, Patent 8,395,691 B2

Before MINN CHUNG, NORMAN H. BEAMER, and JOHN D. HAMANN, *Administrative Patent Judges*.

HAMANN, *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

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[1] We exercise our discretion to issue one Order to be filed in each case. The parties are not authorized to use this style heading for any subsequent papers.

On March 8, 2021, the parties filed, with our authorization, in each of the proceedings (i) a Joint Motion to Terminate Pursuant to 35 U.S.C. § 317 and 37 C.F.R. §§ 42.5, 42.71(a), and 42.74 (Paper 12,[2] "Joint Motion to Terminate"); (ii) written settlement materials (Ex. 1050); and (iii) a Joint Request to File Settlement Materials as Business Confidential Information and to Maintain Said Materials Separate From the Public File Pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) (Paper 13, "Joint Request").

The parties indicate that they have settled their dispute concerning U.S. Patent Nos. 8,988,796 B2 and 8,395,691 B2 ("the '796 and '691 patents"), and that the parties have agreed to terminate these proceedings. Joint Motion to Terminate 1–2. The parties state in each Joint Motion to Terminate that they "certify that they are concurrently filing a true and complete copy of their confidential written settlement materials (Confidential Exhibit 1050) in connection with this matter as required by statute." *Id.* at 1.

Generally, the Board expects that a proceeding will terminate after the filing of a settlement agreement. *See* 35 U.S.C. § 317(a) ("An 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."); 37 C.F.R. § 42.72 ("The Board may terminate a trial without rendering a final written decision, where appropriate, including . . . pursuant to a joint request under 35 U.S.C. 317(a) . . . ."); *see also* Patent

[2] The parties filed substantially identical papers pertaining to this termination in both IPR2020-01339 and IPR2020-01345. We cite to the papers in IPR2020-01339.

Trial and Appeal Board Consolidated Trial Practice Guide (Nov. 2019) at 86, available at https://www.uspto.gov/sites/default/files/documents/tpgnov.pdf ("The Board expects that a proceeding will terminate after the filing of a settlement agreement, unless the Board has already decided the merits of the proceeding." (citing 35 U.S.C. §§ 317(a), 327)).

We instituted a trial in each of these proceedings on February 22, 2021. We have not yet decided the merits of the proceedings, and final written decisions have not been entered. Notwithstanding that the proceedings have moved beyond the preliminary stage, the parties have shown adequately that terminating the proceedings is appropriate. Accordingly, we are persuaded that, under these circumstances, it is appropriate to terminate these proceedings as to all parties.

Additionally, we grant the parties' Joint Request in each proceeding to treat their settlement materials as business confidential information and to keep the materials separate from the files of the '796 and '691 patents. Joint Request 1–2; *see* 35 U.S.C. § 317(b) ("At the request of a party to the proceeding, the agreement or understanding shall be treated as business confidential information, shall be kept separate from the file of the involved patents, and shall be made available only to Federal Government agencies on written request, or to any person on a showing of good cause."); *see also* 37 C.F.R. § 42.74(c) (same).

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

Accordingly, it is

ORDERED that the parties' Joint Motion to Terminate is *granted* in each of these proceedings;

FURTHER ORDERED that the parties' Joint Request is *granted* in each of these proceedings;

FURTHER ORDERED that the written settlement materials (Exhibit 1050) be treated as business confidential information, kept separate from the files of the '796 and '691 patents, 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 these proceedings are terminated.

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