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Paper No. 41
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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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3SHAPE A/S and 3SHAPE INC.,
Petitioner,

v.

ALIGN TECHNOLOGY, INC.,
Patent Owner.

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IPR2020-01622 (Patent 9,675,430 B2)
IPR2020-01642 and IPR2020-01643 (Patent 10,507,088 B2)
IPR2020-01644 and IPR2020-01645 (Patent 10,507,089 B2)[1]

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Before BRIAN J. McNAMARA, NEIL T. POWELL, and
ELIZABETH M. ROESEL, *Administrative Patent Judges*.

PER CURIAM.

TERMINATION
Due to Settlement After Institution of Trial and
*Granting-in-Part* and *Denying-in-Part* 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] This Order addresses issues that are the same in each of the identified proceedings. We exercise our discretion to issue one Order to be filed in each proceeding. The parties are not authorized to use this style heading in subsequent papers.

## I. INTRODUCTION

With the Board's authorization, Petitioner and Patent Owner (collectively, "the Parties") filed a Joint Motion to Terminate in each of the above-captioned proceedings. Paper 38 ("Joint Motion").[2] Along with the Joint Motion, the Parties filed a copy of a Settlement, Release and Patent License Agreement (Ex. 2019, "Settlement Agreement"), as well as a Joint Request that the Settlement Agreement be treated as business confidential information and be kept separate from the files of the patents involved in the above-captioned proceedings. Paper 39 ("Joint Request").

## 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." 35 U.S.C. § 317(a) also provides that if no petitioner remains in the *inter partes* review, the Office may terminate the review or proceed to a final written decision.

In the Joint Motion, the Parties represent that the Settlement Agreement resolves their disputes involving the patents at issue in the above-captioned proceedings. Joint Motion 1. The Parties "certify that there are no other agreements, oral or written, between the parties made in connection with, or in contemplation of, the termination of this inter partes

[2] The relevant papers and exhibits filed in the above-captioned proceedings are substantively the same. We cite to the record in IPR2020-01622, unless otherwise indicated.

review proceeding." *Id.* The Parties also represent that they have filed a true copy of the Settlement Agreement made in connection with, or in contemplation of, the termination of the above-captioned proceedings. *Id.* The Settlement Agreement states that it "constitute[s] the entire agreement between the Parties." Settlement Agreement 22.

We instituted trial for each of the above-captioned proceedings (*see* Paper 8), but we have not yet decided the merits of the proceedings, and final written decisions have not yet been entered. Under these circumstances and in view of the Parties' settlement, we determine that good cause exists to terminate the proceedings.

In the Joint Request, the Parties request that the Settlement Agreement be treated as business confidential information and be kept separate from the files of the patents involved in the above-captioned proceedings. Joint Request 1. After reviewing the Settlement Agreement, we determine that good cause exists to treat the Settlement Agreement as business confidential information pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c), and we grant the Parties' request in that regard.

In the Joint Request, the Parties also "jointly request that the Board order that in the event a person or entity makes a written request, as stated in 37 C.F.R. § 42.74(c)(1)-(2), for access to the settlement agreement, that any such written request be served upon the parties on the day the written request is provided to the Board." *Id.* The Parties have provided no basis for granting this request. Thus, we deny this part of the Parties' request.

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

## III. ORDER

Accordingly, it is:

ORDERED that the Joint Motions to Terminate (IPR2020-01622, Paper 38; IPR2020-01642, Paper 39; IPR2020-01643, Paper 39; IPR2020-01644, Paper 38; IPR2020-01645, Paper 38) are *granted*, and IPR2020-01622, IPR2020-01642, IPR2020-01643, IPR2020-01644, and IPR2020-01645 are *terminated* with respect to Petitioner and Patent Owner; and

FURTHER ORDERED that the Joint Requests to treat the Settlement Agreement as business confidential information (IPR2020-01622, Paper 39; IPR2020-01642, Paper 40; IPR2020-01643, Paper 40; IPR2020-01644, Paper 39; IPR2020-01645, Paper 39) are *granted-in-part* and *denied-in-part*, and the Settlement Agreement (IPR2020-01622, Ex. 2019; IPR2020-01642, Ex. 2019; IPR2020-01643, Ex. 2019; IPR2020-01644, Ex. 2019; IPR2020-01645, Ex. 2019) shall be kept separate from the files of U.S. Patent Nos. 9,675,430 B2, 10,507,088 B2, and 10,507,089 B2, and made available only to Federal Government agencies on written request, or to any person on a showing of good cause, pursuant to 37 C.F.R. § 42.74(c).

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