Trials@uspto.gov
571-272-7822

Paper 9
Date: October 5, 2021

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HISENSE COMPANY, LTD. and HISENSE USA CORPORATION,
Petitioner,

v.

AEGIS 11 S.A.,
Patent Owner.

IPR2021-00829 (Patent 9,350,434 B2)
IPR2021-00876 (Patent 9,584,200 B2)
IPR2021-00903 (Patent 9,848,443 B2)[1]

Before KEN B. BARRETT, JEFFREY S. SMITH, and
BART A. GERSTENBLITH, *Administrative Patent Judges*.

GERSTENBLITH, *Administrative Patent Judge*.

DECISION
Settlement Prior to Institution of Trial
37 C.F.R. § 42.74

[1] We exercise our discretion to issue one combined Decision to be filed in each case.

I. DISCUSSION

With our prior authorization, the parties filed a Joint Motion to Terminate Pursuant to 35 U.S.C. § 317 and 37 C.F.R. §§ 42.72 & 42.74,[2] a copy of their written Settlement Agreement,[3] and a Joint Motion to Keep Confidential and Separate Under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c)[4] in each proceeding.

The parties indicate that they have settled their underlying dispute and have agreed to terminate these proceedings. Mot. 2. The parties filed what they represent is a true and accurate copy of their written Settlement Agreement and indicate that it resolves each of the present proceedings. *Id.* The parties further indicate that they filed a joint stipulation of dismissal in related district court litigation. *Id.* at 3.

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

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[2] IPR2021-00829, Paper 8; IPR2021-00876, Paper 8; IPR2021-00903, Paper 8. The substance, with minor exceptions, and pagination of each motion to terminate is identical. Therefore, our citations to the motions to terminate apply to the motion filed in each proceeding.

[3] IPR2021-00829, Ex. 1020; IPR2021-00876, Ex. 1028; IPR2021-00903, Ex. 1016.

[4] IPR2021-00829, Paper 7; IPR2021-00876, Paper 7; IPR2021-00903, Paper 7.

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 Trial and Appeal Board Consolidated Trial Practice Guide at 86 (Nov. 2019) ("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)). Here, a trial has not yet been instituted and the merits of the proceedings not yet decided. Accordingly, we are persuaded that, under these circumstances, termination of these proceedings is appropriate.

Additionally, we grant the parties' Joint Motion to Keep Confidential and Separate. *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).

II. ORDER

Accordingly, it is

ORDERED that the parties' Joint Motion to Terminate Pursuant to 35 U.S.C. § 317 and 37 C.F.R. §§ 42.72 & 42.74 (IPR2021-00829, Paper 8; IPR2021-00876, Paper 8; IPR2021-00903, Paper 8) is *granted*;

FURTHER ORDERED that the parties' Joint Motion to Keep Confidential and Separate Under 35 U.S.C. § 317(b) and 37 C.F.R.

§ 42.74(c) (IPR2021-00829, Paper 7; IPR2021-00876, Paper 7; IPR2021-00903, Paper 7) is *granted*;

FURTHER ORDERED that the Settlement Agreement (IPR2021-00829, Ex. 1020; IPR2021-00876, Ex. 1028; IPR2021-00903, Ex. 1016) be treated as business confidential information, kept separate from the file of the above-referenced 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 this proceeding is terminated.

IPR2021-00829 (Patent 9,350,434 B2)
IPR2021-00876 (Patent 9,584,200 B2)
IPR2021-00903 (Patent 9,848,443 B2)

For PETITIONER:

Christopher J. Higgins
Jeffrey Johnson
ORRICK, HERRINGTON & SUTCLIFFE LLP
0CHPTABDocket@orrick.com
3J6PTABDocket@orrick.com

For PATENT OWNER:

Timothy Devlin
Leonard Monfredo
DEVLIN LAW FIRM LLC
TD-PTAB@devlinlawfirm.com
lmonfredo@devlinlawfirm.com