

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

PANASONIC CORPORATION,
Petitioner,

v.

NEODRON LTD.,
Patent Owner.

IPR2021-01115
Patent 8,946,574 B2

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

HOWARD, *Administrative Patent Judge*.

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

I. INTRODUCTION

With the Board's prior authorization, Panasonic Corporation and Neodron Ltd. (collectively "the Parties") filed a Joint Motion By Petitioner and Patent Owner to Terminate the above-captioned preliminary proceeding. Paper 6 ("Joint Motion"). In support of the Joint Motion, the Parties filed a copy of a written, confidential "SETTLEMENT AND LICENSE AGREEMENT." Ex. 1020 ("Settlement Agreement"). The Parties also filed a Joint Request to File Settlement Agreement as Confidential Business Information. Paper 7 ("Joint Request").

II. DISCUSSION

In the Joint Motion, the Parties state that they "have entered into a confidential Settlement and License Agreement . . . , which . . . requires both parties to terminate all disputes, including (i) *Inter Partes* Review Proceeding No. IPR2021-01115, and (ii) *Neodron Ltd. v. Panasonic Corporation, et al.*, in the Eastern District of Texas, Civil Action No. 2:20-cv-00241-JRP-RSP." Joint Motion 2. The parties further state that "the confidential Agreement between the parties has been made in writing, . . . a true and correct copy is being filed with the Patent Office with this Motion," and "[t]here are no other collateral agreements between the parties made in connection with, or in contemplation of, the termination sought." *Id.* at 2–3.

There are strong public policy reasons to favor settlement between the parties to a proceeding. *Office Patent Trial Practice Guide*, 84 Fed. Reg. 64,280 (Nov. 21, 2019). Here, the Parties assert that

termination of this *inter partes* review is appropriate because (i) the proceeding is at a sufficiently early stage; (ii) the parties have settled their disputes; (iii) the parties have agreed to dismiss, and already have dismissed the related litigation; and

(iv) the parties to this *inter partes* review agree that it should be terminated.

Joint Motion 3. For at least these reasons, we determine that good cause exists and that it is appropriate to dismiss the petition and terminate the preliminary proceeding as to the Parties, without rendering a decision on institution or a final written decision. *See* 37 C.F.R. § 42.74.

In the Joint Request, the Parties jointly request that the Settlement Agreement “is treated as confidential business information, kept separate from the files of the involved patent, and made available only to Federal Government agencies on written request, or to any person on a showing of good cause.” Joint Request 2.

After reviewing the Settlement Agreement between the Parties, we find that the Settlement Agreement contains confidential business information regarding the terms of settlement. Thus, we determine that good cause exists to treat the Settlement Agreement (Ex. 1020) between the Parties as business confidential information under 37 C.F.R. § 42.74(c), to keep it separate from the files of the involved patent and associated preliminary proceeding, and to limit its availability as requested by the Parties.

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 Motion to Terminate is *granted*;

FURTHER ORDERED that the preliminary proceeding in IPR2021-01115 is *terminated* and its petition is *dismissed*; and

FURTHER ORDERED that the Joint Request to File Settlement Agreement as Confidential Business Information is *granted*, and the Settlement Agreement shall remain designated as “Parties and Board Only” in Board’s filing system, shall made available only to Federal Government agencies on written request, or to any person on a showing of good cause, and shall be kept separate from the files of the involved patents and associated preliminary proceedings, pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

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