

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ALIGN TECHNOLOGY, INC.,
Petitioner,

v.

3SHAPE A/S,
Patent Owner.

IPR2021-01309 and IPR2021-01310¹
Patent 10,383,711 B2

Before FRANCES L. IPPOLITO, JAMES J. MAYBERRY, and
JASON M. REPKO, *Administrative Patent Judges*.

REPKO, *Administrative Patent Judge*.

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

¹ This Order addresses issues that are the same in each of the identified proceedings.

I. INTRODUCTION

With the Board’s authorization, Petitioner and Patent Owner filed Motions that request termination in IPR2021-01309 and IPR2021-01310. Paper 13 (“Motion”).² Along with the Motion, the parties filed a copy of a Settlement Agreement (Ex. 1027, “Settlement Agreement”), and a Joint Request that the Settlement Agreement be treated as business confidential information and kept separate from the file of U.S. Patent No. 10,383,711 B2 (“the ’711 patent”). Paper 14 (“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.

According to the Motion, the Settlement Agreement resolves their disputes involving the patent at issue in the above-captioned proceedings. Motion 1. 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 proceedings. *Id.* The Settlement Agreement states that it “constitute[s] the entire agreement between the Parties.” Settlement Agreement 22.

² The papers and exhibits filed in the above-captioned proceedings are substantively the same. *See* IPR2021-01309, Paper 13; IPR2021-01310, Paper 15. We cite to the record in IPR2021-01309, unless otherwise indicated.

The Board has 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 the termination of the proceedings is appropriate. Under these circumstances, we determine that good cause exists to terminate the proceedings with respect to the parties.

In the Joint Request, the parties request that the Settlement Agreement be treated as business confidential information and kept separate from the file of the '711 patent. Joint Request 1. After reviewing the Settlement Agreement, we find that it contains confidential business information about the settlement terms. Thus, good cause exists to treat the Settlement Agreement as business confidential information pursuant to 37 C.F.R. § 42.74(c), and we grant this part of the parties' request.

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." Joint Request 1. 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

It is

ORDERED that the Motions are *granted*;

FURTHER ORDERED that IPR2021-01309 and IPR2021-01310 are

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terminated with respect to Petitioner and Patent Owner; and

FURTHER ORDERED that the Joint Requests to treat the Settlement Agreement as business confidential information (IPR2021-01309, Paper 14; IPR2021-01310, Paper 16) are *granted-in-part* and *denied-in-part*, and the Settlement Agreement (IPR2021-01309, Ex. 1027; IPR2021-01310, Ex. 1027) shall be kept separate from the file of U.S. Patent No. 10,383,711 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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For PETITIONER:

Michael T. Rosato
Matthew A. Argenti
Tasha M. Thomas
Yahn Lin Chu
WILSON SONSINI GOODRICH & ROSATI
mrosato@wsgr.com
margenti@wsgr.com
tthomas@wsgr.com
ychu@wsgr.com

For PATENT OWNER:

Todd R. Walters
Roger H. Lee
Andrew R. Cheslock
BUCHANAN INGERSOLL & ROONEY PC
todd.walters@bipc.com
roger.lee@bipc.com
andrew.cheslock@bipc.com