

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

KIOXIA CORPORATION; KIOXIA AMERICA, INC.;
WESTERN DIGITAL TECHNOLOGIES, INC.; AND
DELL TECHNOLOGIES, INC.,
Petitioner,

v.

SONRAI MEMORY LIMITED,
Patent Owner.

IPR2021-01354
Patent 7,436,232 B2

Before GREGG I. ANDERSON, GARTH D. BAER, and
JOHN D. HAMANN, *Administrative Patent Judges*.

HAMANN, *Administrative Patent Judge*.

TERMINATION
Due to Settlement After Institution of Trial
35 U.S.C. § 317; 37 C.F.R. § 42.74

I. INTRODUCTION

a. Western Digital

On September 22, 2022, with authorization of the Board, Petitioner Western Digital Technologies, Inc. (“Western Digital”) and Patent Owner Sonrai Memory Limited (“Patent Owner”) filed a joint motion to terminate the *inter partes* review pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. §§ 42.72 and 42.74 with respect to Western Digital. Paper 20 (“Western Digital Joint Motion”). Western Digital and Patent Owner also filed a copy of a Release Agreement (“Western Digital Settlement Agreement”) governing their settlement. Ex. 2002. Western Digital and Patent Owner further request that the Western Digital Settlement Agreement be treated as business confidential information pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c). Paper 21 (“Western Digital Joint Request”).

b. Kioxia

Further, on September 28, 2022, with authorization of the Board, Petitioner Kioxia Corporation and Kioxia America, Inc. (collectively “Kioxia”) and Patent Owner filed a joint motion to terminate the *inter partes* review pursuant to 35 U.S.C. § 317 and 37 C.F.R. §§ 42.72 and 42.74 with respect to Kioxia. Paper 22 (“Kioxia Joint Motion”). Kioxia and Patent Owner also filed a copy of a Release Agreement (“Kioxia Settlement Agreement”) governing their settlement. Ex. 2003. Kioxia and Patent Owner further request that the Kioxia Settlement Agreement be treated as business confidential information pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c). Paper 23 (“Kioxia Joint Request”).

c. Dell

Also, on September 28, 2022, with authorization of the Board, Petitioner Dell Technologies, Inc. (“Dell”) and Patent Owner filed a joint motion to terminate the *inter partes* review pursuant to 35 U.S.C. § 317 and 37 C.F.R. §§ 42.72 and 42.74 with respect to Dell. Paper 24 (“Dell Joint Motion”). Dell and Patent Owner also filed a copy of a Release Agreement (“Dell Settlement Agreement”) governing their settlement. Ex. 2004.

II. DISCUSSION

a. Western Digital

In the Western Digital Joint Motion, Western Digital and Patent Owner represent that they have reached an agreement to jointly seek termination of the above-identified *inter partes* review proceeding, and that the filed copy of the Western Digital Settlement Agreement represents “a copy of the agreement entered between Patent Owner and Western Digital.” Paper 20, 3–4. Western Digital and Patent Owner further represent that the Western Digital Settlement Agreement resolves the disputes between Western Digital and Patent Owner concerning the above-identified patent. *Id.*

b. Kioxia

In the Kioxia Joint Motion, Kioxia and Patent Owner represent that they have reached an agreement to jointly seek termination of the above-identified *inter partes* review proceeding, and that the filed copy of the Kioxia Settlement Agreement represents a true copy of the Kioxia Settlement Agreement. Paper 22, 2. Kioxia and Patent Owner further represent that the Kioxia Settlement Agreement resolves all disputes

between Kioxia and Patent Owner concerning the above-identified patent.
Id.

c. Dell

In the Dell Joint Motion, Dell and Patent Owner represent that they have reached an agreement to jointly seek termination of the above-identified *inter partes* review proceeding, and that the filed copy of the Dell Settlement Agreement represents a true copy of the Dell Settlement Agreement. Paper 24, 2–4. Dell and Patent Owner further represent that the Dell Settlement Agreement resolves all disputes between Dell and Patent Owner concerning the above-identified patent. *Id.* at 2.

d. Analysis

We instituted a trial on the above-identified proceeding on February 11, 2022. Paper 10. Under the circumstances here, we determine that it is appropriate to terminate this proceeding as to Western Digital, Kioxia, and Dell, which are all the parties comprising the Petitioner in this proceeding, and thus terminates the proceeding. We also determine that it is appropriate to treat the Western Digital Settlement Agreement, Kioxia Settlement Agreement, and Dell Settlement Agreement¹ as business confidential information to be kept separate from the patent file and separate from the files of this proceeding. *See* 37 C.F.R. § 42.74(c).

In the Western Digital Joint Request, Western Digital and Patent Owner additionally request “that the Board order that in the event a person

¹ Because Patent Owner filed the Dell Settlement Agreement as confidential, we understand that the parties want it to be treated as business confidential information pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c), even though Dell and Patent Owner did not file a joint request to do so.

or entity makes a written request . . . for access to the [Western Digital Settlement Agreement], that any such written request be served upon the parties on the day the written request is provided to the Board.” Paper 21, 2. We have no such procedure to serve upon the parties a request for access to the agreements, and, further, our regulations do not require us to do so. Therefore, we decline to issue an order regarding requests to access any of the settlement agreements, including the Western Digital Settlement Agreement.

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 Western Digital Joint Motion to terminate the above-identified proceeding as to Western Digital is *granted*;

FURTHER ORDERED that the Kioxia Digital Joint Motion to terminate the above-identified proceeding as to Kioxia is *granted*;

FURTHER ORDERED that the Dell Joint Motion to terminate the above-identified proceeding as to Dell is *granted*;

FURTHER ORDERED that this proceeding is *terminated*; and

FURTHER ORDERED that the (i) Western Digital Settlement Agreement, (ii) Kioxia Settlement Agreement, and (iii) Dell Settlement Agreement are to be treated as business confidential information and kept separate from the patent file, 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).

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