

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HYUNDAI MOTOR AMERICA,
Petitioner,

v.

STRATOSAUDIO, INC.,
Patent Owner.

IPR2021-01371
Patent 8,200,203 B1

Before JUSTIN T. ARBES, HYUN J. JUNG, and KEVIN C. TROCK,
Administrative Patent Judges.

TROCK, *Administrative Patent Judge.*

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

I. INTRODUCTION

With the Board’s authorization, Petitioner and Patent Owner (collectively referred to as “the Parties”) filed a Joint Motion to Terminate *Inter Partes* Review. Paper 16 (“Joint Motion”). In support of the Joint Motion, the Parties filed a copy of a Covenant Not to Sue and Release Agreement (Ex. 1027 (“Settlement Agreement”)), as well as a Joint Request to Keep Separate Pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) (Paper 17 (“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.

In the Joint Motion, the Parties represent that “[t]he lawsuit between StratosAudio and HMA [Petitioner Hyundai Motor America] is in the process of being partially dismissed as to the claims of the ’203 Patent, and StratosAudio and HMA do not contemplate any litigation or proceeding involving the Patent-in-Suit in the foreseeable future.” Joint Motion 2. The Parties further represent that the filed copy of the Settlement Agreement is a true copy and that “[t]here are no other collateral agreements between the parties made in connection with, or in contemplation of, the termination sought.” *Id.* at 1.

We instituted a trial in this proceeding on February 17, 2022, concerning claims 43, 47, 48, 51–53, 61, and 62 of U.S. Patent No. 8,200,203 B1 (“the ’203 Patent”). Paper 7. We have not yet decided the merits of the proceeding, and a final written decision has not been entered. Notwithstanding that the proceeding has moved beyond the preliminary stage, the Parties have adequately shown that termination of the proceeding is appropriate. Under these circumstances, we determine that good cause exists to terminate this proceeding with respect to the Parties.

In the Joint Request, the Parties request that the Settlement Agreement be treated as business confidential information and be kept separate from the file of the ’203 Patent involved in this proceeding. Joint Request 1. After reviewing the Settlement Agreement between Petitioner and Patent Owner, we find that the Settlement Agreement contains business confidential information regarding the terms of settlement. We determine that good cause exists to treat the Settlement Agreement between Petitioner and Patent Owner as business confidential information pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

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

III. ORDER

Accordingly, for the reasons discussed above, it is

ORDERED that the Joint Motion is *granted*, and IPR2021-01371 is *terminated* with respect to Petitioner and Patent Owner pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. § 42.72; and

FURTHER ORDERED that the Joint Request is *granted*, and the Settlement Agreement shall be kept separate from the file of U.S. Patent No. 8,200,203 B1, and be 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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