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Entered: March 7, 2022

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

II-VI, INC.,
Petitioner,

v.

ALEXANDER SOTO AND WALTER SOTO,
Patent Owner.

IPR2022-00085
Patent 10,763,958

Before PATRICK M. BOUCHER, KEVIN C. TROCK, and GARTH D. BAER, *Administrative Patent Judges*.

BAER, *Administrative Patent Judge*.

DECISION
Granting Motion to Terminate Proceeding Before Institution
37 C.F.R. § 42.74

With our authorization, the parties filed a Joint Motion to Terminate this proceeding "in light of Patent Owner's and Petitioner's settlement of their dispute regarding U.S. Patent No. 10,763,958." Paper 6, 3. With the Joint Motion, the parties filed a copy of what they describe to be "a true

copy of their written Settlement Agreement (Confidential Exhibit 1023) in connection with this matter as required by statute." *Id.*; *see* Ex. 1023. In their Joint Motion, the parties "certify that there are no other agreements or understandings, oral or written, between the parties, including any collateral agreements, made in connection with, or in contemplation of, the termination of the present proceeding with respect to Petitioner." Paper 6, 3. In a separately filed Joint Request to File Settlement Agreement as Business Confidential Information, the parties "jointly request to treat as business confidential information the true copy of the Settlement Agreement (Confidential Exhibit 1023) between the parties." Paper 7, 3.

"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." 35 U.S.C. § 317(a). The settlement agreement appears to be a true copy, and, after reviewing the agreement, we find that it contains confidential business information regarding the terms of settlement. *See* Ex. 1023. This proceeding is at an early stage, with no decision yet having been made whether to institute review of the subject patent. We accordingly determine that it is appropriate to terminate the proceeding and to treat the filed settlement agreement as business confidential information pursuant to 35 U.S.C. § 317(b).

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

It is

ORDERED that the Joint Motion to Terminate is *granted*;

FURTHER ORDERED that this proceeding is hereby *terminated* as to all parties;

FURTHER ORDERED that the Joint Request to File Settlement Agreement as Business Confidential Information is *granted*;

FURTHER ORDERED that the filed settlement agreement (Ex. 1023) be treated as business confidential information pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) and also remain designated as "Parties and Board Only" in the Board's E2E system.

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