

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD. and
SAMSUNG ELECTRONICS AMERICA, INC.,
Petitioner,

v.

SONRAI MEMORY LIMITED,
Patent Owner.

IPR2022-00306
Patent 7,325,733 B2

Before GARTH D. BAER, AMBER L. HAGY, and MICHAEL T. CYGAN,
Administrative Patent Judges.

HAGY, *Administrative Patent Judge.*

TERMINATION

Due to Settlement After Institution of Trial and
Granting Joint Request to Treat Patent License Agreement
and Escrow Agreement as Business Confidential Information
35 U.S.C. § 317; 37 C.F.R. § 42.74

I. INTRODUCTION

With the Board's authorization, Petitioner and Patent Owner (collectively, "the Parties") filed a Joint Motion to Terminate the above-captioned *inter partes* review proceeding. Paper 14 ("Joint Motion"). Along with the Joint Motion, the Parties filed copies of a Patent License Agreement (Ex. 1021) and an Escrow Agreement (Ex. 1022; Ex. 1023; Ex. 2001), as well as a Joint Request (Paper 16 ("Joint Request")) that the Patent License Agreement and Escrow Agreement be treated as business confidential information and kept separate from the file of U.S. Patent No. 7,325,733 B2 ("the '733 patent").

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 the Patent License Agreement resolves their entire dispute involving the '733 patent. Joint Motion 2. The Parties also represent that they have filed true copies of the Patent License Agreement and related Escrow Agreement made in connection with, or in contemplation of, the termination of the above-captioned proceeding. *Id.* The Patent License Agreement states that it, "together with the Escrow Agreement, embodies the entire understanding of and agreement between the Parties with respect to the Patents and merges

and supersedes all prior agreements, understandings, negotiations, and discussions between the Parties.” Ex. 1021, 13.

We instituted trial for the above-identified *inter partes* review proceeding on July 26, 2022. *See* Paper 8. 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 shown adequately that termination of the proceeding is appropriate. Under these circumstances, we determine that good cause exists to terminate the proceeding with respect to the Parties.

In the Joint Request, the Parties request that the Patent License Agreement and Escrow Agreement be treated as business confidential information and kept separate from the file of the ’733 patent. Joint Request 2. After reviewing the Patent License Agreement and Escrow Agreement, we find that the documents contain confidential business information regarding the terms of settlement. Thus, good cause exists to treat the Patent License Agreement and Escrow Agreement as business confidential information pursuant to 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, it is:

ORDERED that the Joint Motion to Terminate (Paper 14) is *granted*, and IPR2022-00306 is *terminated* with respect to Petitioner and Patent Owner; and

FURTHER ORDERED that the Joint Request (Paper 16) to treat the Patent License Agreement (Ex. 1021) and Escrow Agreement (Ex. 1022;

Ex. 1023; Ex. 2001) as business confidential information is *granted*, and the Patent License Agreement and Escrow Agreement shall be kept separate from the file of U.S. Patent No. 7,325,733 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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