

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BORGWARNER ITHACA LLC,
Petitioner,

v.

SCHAEFFLER GROUP USA INC.,
Patent Owner.

IPR2022-00321
Patent 7,389,756 B2

Before NEIL T. POWELL, JAMES J. MAYBERRY, and
JASON W. MELVIN, *Administrative Patent Judges*.

POWELL, *Administrative Patent Judge*.

DECISION
Settlement Prior to Institution of Trial
37 C.F.R. § 42.74

I. INTRODUCTION

On April 7, 2022, pursuant to our e-mail authorization, Petitioner and Patent Owner (collectively, “the Parties”) filed a Joint Motion to Dismiss the Petition for *Inter Partes* Review in the above-identified proceeding. Paper 6 (“Joint Motion”). In support of the Joint Motion, the Parties filed a copy of a Settlement Agreement settling the parties’ dispute in the above-identified proceeding. Ex. 1020. Along with the Joint Motion, the Parties filed a Joint Request to Treat Settlement Agreement as Business Confidential Information, pursuant to 35 U.S.C § 317(b) and § 37 C.F.R. § 42.74(c). Paper 7 (“Joint Request”).

II. DISCUSSION

In the Joint Motion, the Parties represent that they have resolved their disputes regarding Patent 7,389,756 B2 in both this *inter partes* review proceeding and the related district court litigation, that the filed copy of the Settlement Agreement is a true and correct copy, and that there are no other agreements or understandings between the parties made in connection with, or in contemplation of, the termination of this proceeding. Paper 6, 1–2; *see* Ex. 1021.

This proceeding is at an early stage, and we have not yet decided whether to institute a trial in the proceeding. In view of the early stage of the proceeding and the settlement between the Parties, we determine that good cause exists to dismiss the petition and terminate the proceeding with respect to the Parties.

The Parties also jointly requested that we treat the Settlement Agreement as business confidential information, and that it be kept separate from the file of the involved patent. Paper 7, 1. After reviewing the Settlement Agreement between Petitioner and Patent Owner, we find that the

Settlement Agreement contains confidential business 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 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

In consideration of the foregoing, it is hereby:

ORDERED that the Joint Motion to Dismiss the petition in the above-identified proceeding is *granted* and the proceeding is *terminated*;

FURTHER ORDERED that the Joint Request to Treat Settlement Agreement as Business Confidential Information is *granted*, and the Settlement Agreement shall be kept separate from the files of Patent 7,389,756 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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