

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NXP USA, INC.,
Petitioner,

v.

MEDIATEK INC.,
Patent Owner.

IPR2022-00525 (Patent 9,538,531 B2)
IPR2022-00658 (Patent 10,211,948 B2)
IPR2022-00660 (Patent 9,265,056 B2)
IPR2022-00759 (Patent 8,464,037 B2)
IPR2022-00967 (Patent 6,823,451 B2)¹

Before, JOHN F. HORVATH, KEVIN C. TROCK, and
ARTHUR M. PESLAK *Administrative Patent Judges*.

PESLAK, *Administrative Patent Judge*.

DECISION

Granting Joint Motion to Terminate Proceeding Due to
Settlement before Institution and
Granting Joint Request to Treat Settlement Agreement as
Business Confidential Information
37 C.F.R. § 42.74

¹ This Order applies to all of the captioned proceedings. These cases have not been consolidated or joined. We exercise our discretion to issue one Order to be filed in each case. The parties are not authorized to use this style heading for any subsequent papers.

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I. INTRODUCTION

Petitioner and Patent Owner (collectively “the Parties”) have requested that the above-identified *inter partes* review proceedings be terminated pursuant to a settlement. On July 14, 2022, the Parties filed a Joint Motion to Terminate Inter Partes Review in each of the above-identified proceedings (“Joint Motion”). Paper 6.² The Parties previously sought authorization to file the Joint Motions and received that authorization via email on July 14, 2022. Joint Motion 1. The Parties also filed copies of a settlement agreement (Ex. 1028 “Settlement Agreement”) together with a Joint Request to File Settlement Agreement as Business Confidential Information (Paper 7, “Joint Request”) in each of the above-identified proceedings.

II. DISCUSSION

In the Joint Motions, the Parties represent that they have reached an agreement that settles all disputes between them regarding Patent 9,538,531, Patent 10,211,948, Patent 9,265,056, Patent 8,464,037, and Patent 6,823,451, that the filed copies of the Settlement Agreement are true copies, and that “[t]here are no collateral agreements or understandings made in connection with the termination of this IPR.” Joint Motion 1.

We have not yet instituted trial in any of the above-identified proceedings. Nor have we decided the merits of the proceedings, and final

² For expediency, we cite to the Papers filed in IPR2022-00525, unless otherwise indicated. Similar Papers and Exhibits were filed in IPR2022-00658, IPR2022-00660, IPR2022-00759, and IPR2022-00967.

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written decisions have not been entered in the proceedings. The Parties have shown adequately that termination of the proceedings is appropriate. Under these circumstances, we determine that good cause exists to terminate the proceedings with respect to the Parties.

The Parties also requested that the Settlement Agreement be treated as business confidential information and be kept separate from the files of Patent 9,538,531, Patent 10,211,948, Patent 9,265,056, Patent 8,464,037, and Patent 6,823,451. Joint Request 1. After reviewing the Settlement Agreement, we find it contains confidential business information regarding the terms of settlement. We determine that good cause exists to treat the Settlement Agreement between the Parties 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) in any of the above-identified proceedings.

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III. ORDER

Accordingly, for the reasons discussed above, it is:

ORDERED that the Joint Motions are *granted*, and IPR2022-00525, IPR2022-00658, IPR2022-00660, IPR2022-00759, and IPR2022-00967 are *terminated* with respect to Petitioner and Patent Owner; and

FURTHER ORDERED that the Joint Requests are *granted*, and the Settlement Agreement shall be kept separate from the files of Patent 9,538,531 B2, Patent 10,211,948 B2, Patent 9,265,056 B2, Patent 8,464,037 B2, and Patent 6,823,451 B2 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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