

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HEWLETT PACKARD ENTERPRISE COMPANY,
Petitioner,

v.

INTELLECTUAL VENTURES II LLC,
Patent Owner.

IPR2022-00906
Patent 7,822,841 B2

Before KEN B. BARRETT, NABEEL U. KHAN, and
STEPHEN E. BELISLE, *Administrative Patent Judges*.

BARRETT, *Administrative Patent Judge*.

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

On November 28, 2022, we instituted an *inter partes* review of claims 1–5, 7, and 8 of U.S. Patent No. 7,822,841 B2 (“the ’841 patent”). Paper 15. On January 26, 2023, with our authorization, the parties filed a “Joint Motion to Terminate.” Paper 17¹ (“Mot.” or “Motion”). The parties represent in the Motion that they have settled their disputes as to the ’841 patent. Mot. 1. The Motion was accompanied by a document (Ex. 1017) that the parties represent to be a true and correct copy of the written settlement agreement in connection with this proceeding. *Id.* at 1. Based on the parties’ representations, we understand that are no other agreements or understandings between Petitioner and Patent Owner made in connection with, or in contemplation of, the termination of this proceeding.

The parties also filed, with our authorization, a “Joint Request to Maintain Confidentiality and to Keep Separate Pursuant To 35 U.S.C. § 327(b) and 37 C.F.R. § 42.74” (“Joint Request Keep Separate,” Paper 18), requesting that the settlement agreement be treated a business confidential information and be kept separate from the file of the ’841 patent, pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

The parties represent in the Motion that “Patent Owner agreed to dismiss the [related district court] litigation with prejudice and to terminate related proceedings.” Mot. 1.

¹ The Motion and accompanying Request to Keep Separate (Papers 17 and 18) are signed by Petitioner’s counsel but are not signed by counsel for Patent Owner. In light of the joint nature of the papers, we treat them as if they are signed by Patent Owner’s Lead Counsel.

The Board generally expects that a case “will terminate after the filing of a settlement agreement, unless the Board has already decided the merits.” Patent Trial and Appeal Board Consolidated Trial Practice Guide 86 (Nov. 2019), *available at* <https://www.uspto.gov/sites/default/files/documents/tpgnov.pdf>; *see* 37 C.F.R. § 42.72. We have not decided yet the merits of this proceeding, and a final written decision has not been entered. Under the circumstances presented here, we determine that it is appropriate to terminate this proceeding with respect to both Petitioner and Patent Owner. Accordingly, we grant the parties’ motion to terminate the proceeding.

We also determine that the parties have complied with the requirements of 37 C.F.R. § 42.74(c) to have their settlement agreement treated as business confidential information and kept separate from the patent files of the challenged patent. Thus, we grant the parties’ joint request to treat the settlement agreement as business confidential information.

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

Accordingly, it is

ORDERED that the Joint Motion to Terminate this *inter partes* review is *granted*;

FURTHER ORDERED that this proceeding is *terminated*;

FURTHER ORDERED that the Joint Request Keep Separate is *granted*; and

FURTHER ORDERED that the parties’ settlement agreement, Exhibit 1017, is to be kept separate from the file of the involved U.S. Patent No.

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7,822,841 B2 under the provisions of 35 U.S.C. § 317(b) and 37 C.F.R.
§ 42.74(c).

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