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Paper 12
Date: December 5, 2022

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AMERICAN HONDA MOTOR CO., INC.,
Petitioner,

v.

MICROPAIRING TECHNOLOGIES, LLC,
Patent Owner.

IPR2022-01079 (Patent 7,178,049 B2)
IPR2022-01080 (Patent 7,793,136 B2)
IPR2022-01081 (Patent 8,006,117 B1)
IPR2022-01082 (Patent 8,020,028 B1)[1]

Before MICHAEL R. ZECHER, MIRIAM L. QUINN, GREGG I. ANDERSON, JOHN R. KENNY, JULIET MITCHELL DIRBA, and IFTIKHAR AHMED, *Administrative Patent Judges.*[2]

PER CURIAM.

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

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[1] We exercise our discretion to issue one Order to be entered in each proceeding. The parties are not authorized to use a multiple-case caption.
[2] This listing of Administrative Patent Judges does not reflect an expanded panel under SOP 1 § III.M. This order addresses multiple proceedings that collectively involve more than three Administrative Patent Judges.

I. INTRODUCTION

With the Board's authorization, Petitioner American Honda Motor Co., Inc. and Patent Owner MicroPairing Technologies, LLC (collectively, "the parties") filed (1) a Joint Motion to Terminate Pursuant to 35 U.S.C. § 317 (Paper 13, "Joint Motion") based on a settlement agreement between them, (2) a copy of their written settlement agreement (Ex. 1036), and (3) a Joint Request to Keep Separate Pursuant to 35 U.S.C. § 317 and 37 C.F.R. § 42.74 (Paper 14, "Joint Request").[3]

II. DISCUSSION

In the Joint Motion, the parties represent that they have resolved their underlying dispute and have reached agreement to terminate these proceedings. Joint Motion 2. The parties filed what they represent is a true copy of their written settlement agreement. *Id.* at 4. The parties certify that there are no collateral agreements or understandings made in connection with, or in contemplation of, the termination of these proceedings. *Id.* The parties contend that termination of these proceedings is appropriate because we have not made a decision on institution in these proceedings and no other party's rights will be prejudiced by the termination of these proceedings. *Id.* at 3–4. The parties indicate that they are moving to dismiss the related district court litigation as well. *Id.* at 4.

[3] Our citations to Papers and Exhibits are to those filed in IPR2022-01079. Similar Papers and Exhibits have been filed in each of the other identified proceedings.

Generally, the Board expects that a proceeding will terminate with respect to a petitioner after the filing of a settlement agreement. *See* 35 U.S.C. § 317(a) ("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."); 37 C.F.R. § 42.72 ("The Board may terminate a trial without rendering a final written decision, where appropriate, including . . . pursuant to a joint request under 35 U.S.C. 317(a) . . . ."); *see also* Patent Trial and Appeal Board Consolidated Trial Practice Guide at 86 (Nov. 2019)[4] ("The Board expects that a proceeding will terminate after the filing of a settlement agreement, unless the Board has already decided the merits of the proceeding." (citing 35 U.S.C. §§ 317(a), 327)). Here, these proceedings are in the preliminary stage and trials have not yet been instituted. Accordingly, we are persuaded that, under these circumstances, termination of these proceedings is appropriate.

The parties also request that the settlement agreement be treated as business confidential information and kept separate from the file of the involved patent. Joint Request 2. After reviewing the settlement agreement, we find that the settlement agreement contains confidential business information regarding the terms of settlement. Accordingly, we grant the Joint Request to treat the settlement agreement as business confidential information. *See* 35 U.S.C. § 317(b) ("At the request of a party to the

[4] *Available at* https://www.uspto.gov/TrialPracticeGuideConsolidated.

proceeding, the agreement or understanding shall be treated as business confidential information, shall be kept separate from the file of the involved patents, and shall be made available only to Federal Government agencies on written request, or to any person on a showing of good cause."); *see also* 37 C.F.R. § 42.74(c) (same).

This Decision 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 13 in IPR2022-01079, IPR2022-01080, IPR2022-01082; and Paper 10 in IPR2022-01081) is *granted*;

FURTHER ORDERED that the Joint Request to Keep Separate Pursuant to 35 U.S.C. § 317 and 37 C.F.R. § 42.74 (Paper 14 in IPR2022-01079, IPR2022-01080, IPR2022-01082; and Paper 11 in IPR2022-01081) is *granted*;

FURTHER ORDERED that the settlement agreement (Ex. 1036 in IPR2022-01079, IPR2022-01080, IPR2022-01081, and IPR2022-01082) be treated as business confidential information, kept separate from the file of the above-referenced patent, 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); and

FURTHER ORDERED that these proceedings are terminated.

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IPR2022-01081 (Patent 8,006,117 B1)
IPR2022-01082 (Patent 8,020,028 B1)

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