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Paper 17
Entered: July 26, 2023

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

RYAN HARDIN and ANDREW HILL,
Patent Owner.

IPR2022-01331[1]
Patent 9,779,418 B2

Before BART A. GERSTENBLITH, MICHELLE N. WORMMEESTER, and ARTHUR M. PESLAK, *Administrative Patent Judges*.

WORMMEESTER, *Administrative Patent Judge*.

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

[1] IPR2022-01330 and IPR2022-01332 have been consolidated with this proceeding.

I. INTRODUCTION

Petitioner and Patent Owner (collectively, "the Parties") filed a Joint Motion to Terminate Proceeding ("Joint Motion") due to settlement. Paper 22 ("Joint Motion").[2] In support of the Joint Motion, the Parties filed two Confidential Settlement and License Agreements (collectively, "the Settlement Agreements"). Ex. 1036; Ex. 1037. The Parties also filed a Joint Request to Treat Settlement Agreement as Business Confidential Information ("Joint Request") pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c). Paper 23 ("Joint Request"). The Joint Request applies to both Settlement Agreements. *Id.* at 1. We authorized the filing of these papers and exhibits in an e-mail dated June 1, 2023.

II. DISCUSSION

In the Joint Motion, the Parties represent that they have reached an agreement to jointly seek termination of this *inter partes* review proceeding, which involves U.S. Patent No. 9,779,418 B2 ("the '418 patent"). Joint Motion 1. The Parties further represent that they "have settled their dispute

[2] References are to papers and exhibits in IPR2022-01331. In the institution decisions for IPR2022-01330 and IPR2022-01332, we consolidated each of those proceedings with IPR2022-01331 and indicated that "all further filings in the consolidated proceeding shall be made in IPR2022-01331." *See* IPR2022-01330, Paper 13 at 26; IPR2022-01332, Paper 13 at 27. We note that the Parties, however, also filed joint motions to terminate in IPR2022-01330 and IPR2022-01331 along with other papers and exhibits similar to those referred to in this Decision. Each of those joint motions is substantially the same as the Joint Motion filed here. In accordance with our order consolidating the three related proceedings, we issue this Decision in this consolidated proceeding and, to keep the record clear, we expunge the similar papers and exhibits filed by the Parties in IPR2022-01330 and IPR2022-01332.

regarding the '418 patent, including both this proceeding and Patent Owners' assertion of the '418 patent in the related district court litigation." *Id.* The parties also indicate that Exhibits 1036 and 1037 together are "[a] true and correct copy of the parties' settlement agreements." *Id.* at 2. In addition, the Parties certify that there are "no collateral agreements or understandings made in connection with, or in contemplation of, the termination of the proceedings beyond the settlement agreements in Exhibits 1036 and 1037." *See id.*

Although we instituted trial on February 7, 2023, the consolidated proceeding is at an early stage, and we have not yet decided the merits of the proceeding. In view of the early stage of the consolidated proceeding, and the settlement between the Parties, we determine that good cause exists to terminate the consolidated proceeding.

Further, we find that the Settlement Agreements contain confidential business information regarding the terms of settlement. We determine that good cause exists to treat the Settlement Agreements between the Parties as business confidential information and to keep them separate from the files of the patent in the consolidated proceeding pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

The Parties request "that they be notified if and when the Board receives and/or considers a request for access to the settlement agreement, and be offered an opportunity to respond to any such request." Joint Request 2 (citing *Arista Networks, Inc. v. Castlemorton Wireless LLC*, IPR2020-00986, Paper 7 at 4 (PTAB Oct. 28, 2020)). The Board does not have a procedure to serve upon the Parties a request for access to the Settlement Agreements, and our regulations do not require us to do so. We

note that *Arista* involved a settlement agreement between the patent owner and only one of three petitioners involved in the case. *Arista*, Paper 7 at 2. The agreement precluded the non-settling petitioners from accessing the settlement agreement. *Id.* The special circumstances that led to the decision in *Arista* are not presented here, and the Parties do not argue otherwise. *See* Joint Request 2. Therefore, we deny the Parties' request for notification.

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

III. ORDER

Accordingly, for the reasons discussed above, it is:

ORDERED that the Joint Motion to Terminate is *granted*, and the consolidated proceeding of IPR2022-01331, which includes IPR2022-01330 and IPR2022-01332, is *terminated* pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. § 42.72;

FURTHER ORDERED that the Joint Request is *granted*, and that the Settlement Agreements shall be kept separate from the file of U.S. Patent No. 9,779,418 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);

FURTHER ORDERED that the Parties' request for notification if the Board receives a request for access to the Settlement Agreements is *denied*; and

FURTHER ORDERED that, to clarify the record in this consolidated proceeding and the record in each proceeding that was consolidated with this proceeding, Papers 15 and 16 and Exhibits 1036 and 1037 in IPR2022-01330, as well as Papers 15 and 16 and Exhibits 1036 and 1037 in IPR2022-

01332, will be expunged from the records in those proceedings, and this Decision will also be entered in the record for each of those proceedings.

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