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Paper 23
Entered: July 26, 2023

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

RYAN HARDIN and ANDREW HILL,
Patent Owner.

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IPR2022-01333[1]
Patent 10,984,447 B2

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

PESLAK, *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*

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[1]IPR2022-01334 and IPR2022-01335 have been consolidated with this proceeding.

## I. INTRODUCTION

With the Board's authorization, Petitioner and Patent Owner (collectively referred to as "the Parties") filed a Joint Motion to Terminate Proceeding due to settlement ("Joint Motion"). Paper 21.[2] In support of the Joint Motion, the Parties filed Confidential Settlement and License Agreements (Exs. 1040, 1041 ("Settlement Agreements")). The Parties also filed a Joint Request to Treat the Settlement Agreement as Business Confidential Information pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) (Paper 22 ("Joint Request")).

## II. DISCUSSION

Under 35 U.S.C. § 317(a), "[a]n 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."

In the Joint Motion, the Parties represent that they have reached an agreement to jointly seek termination of this *inter partes* review proceeding, and that the filed copies of the Settlement Agreements are true and complete

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[2] In the Institution Decisions for IPR2022-01334 and IPR2022-01335, we consolidated each of those proceedings with IPR2022-01333 and indicated that "all further filings in the consolidated proceeding shall be made in IPR2022-01333." *See* Paper 13 at 25; Paper 13 at 25. We note that the Parties, however, also filed joint motions to terminate in IPR2022-01334 and IPR2022-01335 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 IPR2022-01334 and IPR2022-01335. The documents cited in this Decision are those that the Parties filed expressly in the consolidated proceeding of IPR2022-01333.

copies. Joint Motion 1–2. The Parties further represent that the Settlement Agreements resolve all proceedings currently pending before the Patent Office and related district court litigation involving U.S. Patent No. 10,984,447 B2 ("the '447 patent"). *Id.* at 1.

Although trial has been instituted in the consolidated proceeding, we have not yet decided the merits and a final written decision has not been entered. Notwithstanding that the consolidated proceeding has moved beyond the preliminary stage, the Parties have shown adequately that termination of the consolidated proceeding is appropriate. Under these circumstances, we determine that good cause exists to terminate the consolidated proceeding.

The Parties also filed a Joint Request that the Settlement Agreements be treated as business confidential information and be kept separate from the file of the '447 patent. Joint Request 1. After reviewing the Settlement Agreements between the parties, 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 pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

The Parties further 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 IPR2022-01333, which includes IPR2022-01334 and IPR2022-01335, 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 the Settlement Agreements shall be kept separate from the file of Patent No. 10,984,447 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 1040 and 1041 in IPR2022-01334 and Papers 15 and 16 and Exhibits 1040 and 1041 in IPR2022-01335

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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