

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

VIZIO, INC.,
Petitioner,

v.

MAXELL, LTD.,
Patent Owner.

IPR2022-01458
Patent 9,578,369 B2

Before JOHN A. HUDALLA, KARA L. SZPONDOWSKI,
and JASON W. MELVIN, *Administrative Patent Judges*.

SZPONDOWSKI, *Administrative Patent Judge*.

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

I. INTRODUCTION

On September 7, 2023, with the Board’s authorization, Petitioner and Patent Owner (collectively referred to as “the Parties”) filed a Joint Motion to Terminate *Inter Partes* Review (“Joint Motion”) (Paper 14), as well as a Joint Motion to Keep Confidential and Separate (“Joint Request”) (Paper 15). In support of the Joint Request, the Parties filed a copy of a Patent License Agreement (“Agreement”) (Ex. 1029).

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 entered into a written confidential agreement that fully resolves the matter,” “have now settled their dispute and have reached agreement to terminate the Petition,” and that “neither Patent Owner nor Petitioner will be prejudiced by termination of this proceeding.” Joint Motion 2. The Parties further represent that the Agreement is “the entire agreement or understanding between the Parties made in connection with, or in contemplation of, the termination of this proceeding,” and that it “is a true and accurate copy of the agreement between the Parties that resolves the present proceeding.” *Id.*

We instituted a trial in this proceeding on April 11, 2023. Paper 8. Even though this proceeding has moved beyond the preliminary stage, we have not yet decided the merits, and the Parties have adequately shown that termination of the proceeding is appropriate. *See* Joint Motion 2–3. Under

these circumstances, we determine that good cause exists to terminate this proceeding. *See* 37 C.F.R. 42.72.

In the Joint Request, the Parties request to file the Agreement “as business confidential, and to have it be kept separate from the file of the involved patent. Joint Request 1. After review, we find that the Agreement contains business confidential information regarding the terms of settlement. We determine that good cause exists to treat the Agreement as business confidential information to be kept separate from the patent file 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).

III. ORDER

Accordingly, for the reasons discussed above, it is:

ORDERED that the Joint Motion is *granted*, and IPR2022-01458 is *terminated* with respect to Petitioner and Patent Owner pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. § 42.72; and

FURTHER ORDERED that the Joint Request is *granted*, and the Agreement shall be kept separate from the files of Patent 9,578,369 B2, and be 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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