Trials@uspto.gov
571-272-7822

Paper 8
Entered: February 7, 2023

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

AMERICAN HONDA MOTOR CO., INC.,
Petitioner,

v.

INTELLECTUAL VENTURES II LLC,
Patent Owner.

---

IPR2023-00077
Patent 8,811,356 B2

---

Before JAMES P. CALVE, SCOTT A. DANIELS, and FREDERICK C. LANEY, *Administrative Patent Judges.*

CALVE, *Administrative Patent Judge*.

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

With our authorization, the parties filed a Joint Motion to Terminate Proceeding. Paper 6. The parties assert that they "have reached an agreement to resolve this *inter partes* review (IPR) proceeding." *Id.* at 1. The parties represent that, as a result of the parties' resolution of their dispute, they also are filing a motion to dismiss the co-pending lawsuit related to U.S. Patent No. 8,811,356 B2 ("the '356 Patent"), which is the patent at issue in this proceeding. *Id.* at 3. The parties also represent that "[a] true copy of the document resolving the disputes related to the '356 Patent is filed concurrently herewith," which was filed as Exhibit 2001. *Id.* at 4. We have reviewed that document, and it indicates that the agreement is the entire agreement between the parties.

In a separate paper, the parties also jointly request that the Board "treat the document resolving the proceeding (the 'Resolution Document,' Exhibit 2001) . . . as business confidential information" and "that the confidential Resolution Document be kept separate from the file of the subject patent in the captioned proceeding and be made available only to Federal Government agencies on written request or to persons showing good cause." Paper 7, 1.

The Board has not yet entered a decision on institution of a trial, and we determine that good cause exists to dismiss the Petition (Paper 2) and to terminate the preliminary proceeding. *See* 37 C.F.R. § 42.74. After reviewing the parties' confidential Resolution Document, we find that the Resolution Document contains confidential business information regarding the terms of settlement, and we determine that good cause exists to treat the Resolution Document as business confidential information.

It is

ORDERED that the Joint Motion to Terminate Proceeding is *granted*;

FURTHER ORDERED that the Petition (Paper 2) is *dismissed* and the preliminary proceeding is *terminated*; and

FURTHER ORDERED that the filed Resolution Document (Ex. 2001) be treated as business confidential information pursuant to 37 C.F.R. § 42.74(c) and also remain designated as available only to "Parties and Board" in the Board's E2E system.

FOR PETITIONER:

Reza Dokhanchy
Adam R. Alper
Akshay S. Deoras
Michael W. De Vries
KIRKLAND & ELLIS LLP
reza.dokhanchy@kirkland.com
adam.alper@kirkland.com
akshay.deoras@kirkland.com
michael.devries@kirkland.com

FOR PATENT OWNER:

Daniel H. Golub
Michael F. Snyder
Jeffrey G. Glabicki
Robert D. Leonard
Dawn C. Kerner
Ryan W. O'Donnell
VOLPE KOENIG
DGolub@vklaw.com
Msnyder@vklaw.com
JGlabicki@vklaw.com
RLeonard@vklaw.com
DKerner@vklaw.com
RODonnell@vklaw.com

Russell J. Rigby
INTELLECTUAL VENTURES
RRigby@intven.com