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Paper No. 17
Entered: November 7, 2023

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

MULLEN INDUSTRIES LLC,
Patent Owner.

IPR2022-01389 (Patent 11,190,633 B2)
IPR2023-00090 (Patent 11,122,418 B2)
IPR2023-00091 (Patent 9,204,283 B2)
IPR2023-00096 (Patent 11,096,039 B2)
IPR2023-00097 (Patent 8,374,575 B2)
IPR2023-00115 (Patent 11,234,117 B2)
IPR2023-00116 (Patent 11,234,117 B2)
IPR2023-00148 (Patent 11,246,024 B2)[1]

Before JEFFREY S. SMITH, BARBARA A. PARVIS, JAMES B. MAYBERRY, NATHAN A. ENGELS, and STEVEN M. AMUNDSON, *Administrative Patent Judges*.[2]

PER CURIAM.

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[1] This Order addresses issues that are the same in each of the identified proceedings. We exercise our discretion to issue one Order to be filed in each proceeding. The parties are not authorized to use this style heading in subsequent papers.

[2] This listing of Administrative Patent Judges does not reflect an expanded panel under SOP 1 § III.M. This order addresses multiple proceedings in which listed judges are paneled in various groups of three.

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

I. INTRODUCTION

With the Board's authorization, Petitioner and Patent Owner (collectively, "the Parties") filed a joint motion to terminate in each of the above-captioned proceedings. Paper 18 ("Joint Motion").[3] Along with the Joint Motion, the Parties filed a copy of a Settlement Agreement (Ex. 1019, "Settlement Agreement"), as well as a joint motion requesting that the Settlement Agreement be treated as business confidential information and kept separate from the files of the patents involved in the above-captioned proceedings. Paper 19 ("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." 35 U.S.C. § 317(a) also provides that if no petitioner remains in the *inter partes* review, the Office may terminate the review.

In the Joint Motion, the Parties represent that the Settlement Agreement resolves their disputes involving the patents at issue in the

[3] The relevant papers and exhibits filed in the above-captioned proceedings are substantively the same. We cite to the record in IPR2022-01389, unless otherwise indicated.

above-captioned proceedings. Joint Motion 2.[4] The Parties also "certify that there are no collateral agreements or understandings made in connection with, or in contemplation of, the termination of this proceeding, pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b)." *Id.* at 3.

We instituted trial for the above-identified *inter partes* review proceedings (*see* Paper 9), but we have not yet decided the merits of the proceedings, and final written decisions have not been entered. Notwithstanding that the proceedings have moved beyond the preliminary stage, the Parties have shown adequately that termination of the proceedings is appropriate. Under these circumstances, we determine that good cause exists to terminate the proceedings with respect to the Parties.

In the Joint Request, the Parties request that the Settlement Agreement be treated as business confidential information and kept separate from the files of the patents involved in the above-captioned proceedings. Joint Request 2.[5] After reviewing the Settlement Agreement, we find that it contains confidential business information regarding the terms of settlement. Thus, good cause exists to treat the Settlement Agreement as business confidential information pursuant to 37 C.F.R. § 42.74(c).

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

[4] The Joint Motion (Paper 18) does not include page numbers. We consider the title page as page 1 and then proceed from there in numerical order.

[5] The Joint Request (Paper 19) does not include page numbers. We consider the title page as page 1 and then proceed from there in numerical order.

III. ORDER

Accordingly, it is:

ORDERED that the Joint Motions to Terminate (IPR2022-01389, Paper 18; IPR2023-00090, Paper 17; IPR2023-00091, Paper 15; IPR2023-00096, Paper 15; IPR2023-00097, Paper 15; IPR2023-00115, Paper 15; IPR2023-00116, Paper 15; IPR2023-00148, Paper 14) are *granted*, and IPR2022-01389, IPR2023-00090, IPR2023-00091, IPR2023-00096, IPR2023-00097, IPR2023-00115, IPR2023-00116, and IPR2023-00148 are *terminated* with respect to Petitioner and Patent Owner; and

FURTHER ORDERED that the Joint Requests to treat the Settlement Agreement as business confidential information (IPR2022-01389, Paper 19; IPR2023-00090, Paper 18; IPR2023-00091, Paper 16; IPR2023-00096, Paper 16; IPR2023-00097, Paper 16; IPR2023-00115, Paper 16; IPR2023-00116, Paper 16; IPR2023-00148, Paper 15) are *granted*, and the Settlement Agreement (IPR2022-01389, Ex. 1019; IPR2023-00090, Ex. 1061; IPR2023-00091, Ex. 1063; IPR2023-00096, Ex. 1062; IPR2023-00097, Ex. 1061; IPR2023-00115, Ex. 1062; IPR2023-00116, Ex. 1062; IPR2023-00148, Ex. 1056) shall be kept separate from the files of U.S. Patent Nos. 11,190,633 B2, 11,122,418 B2, 9,204,283 B2, 11,096,039 B2, 8,374,575 B2, 11,234,117 B2, and 11,246,024 B2, and made available only to Federal Government agencies on written request, or to any person on a showing of good cause, pursuant to 37 C.F.R. § 42.74(c).

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