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Paper 10
Date: May 17, 2023

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

DELL TECHNOLOGIES INC. AND DELL INC.,
Petitioner,

v.

GREENTHREAD LLC,
Patent Owner.

IPR2023-00506 (Patent No. 10,510,842 B2)
IPR2023-00507 (Patent No. 10,734,481 B2)
IPR2023-00509 (Patent No. 11,121,222 B2)
IPR2023-00510 (Patent No. 11,316,014 B2)[1]

Before CHRISTOPHER L. CRUMBLEY, CHRISTOPHER M. KAISER, and KRISTI L. R. SAWERT, *Administrative Patent Judges*.

Per Curiam.

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

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[1] This Order addresses issues that are the same in the above-captioned proceedings. The parties are not authorized to use a multi-case caption.

I. INTRODUCTION

On May 2, 2023, after email authorization by the Board, Petitioner and Patent Owner (collectively "the Parties") filed a Joint Motion to Terminate *Inter Partes* Review in the above-identified proceeding. Paper 9 ("Joint Motion").[2] In support of the Joint Motion, the Parties filed copies of Confidential Settlement-Related Agreements (Exs. 2001, 2002 ("Settlement Agreements")), as well as a Joint Request to Keep Separate Pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) (Paper 10 ("Joint Request")).

II. DISCUSSION

In the Joint Motion, "[t]he Parties jointly request that the Board terminate this *inter partes* review of the Patent-in-Suit, Case No. IPR2023-00506, in its entirety." Paper 9, 2. The Parties represent that the filed Settlement Agreements are true copies and "together form the complete agreement resolving the disputes in the *inter partes* review between the Parties" and that "[t]here are no other collateral agreements between the Parties made in connection with, or in contemplation of, the termination sought." *Id.* at 1. The Parties further represent that a "joint motion to dismiss the lawsuit between" the Parties "involving the Patent-in-Suit was filed on April 24, 2023." *Id.* at 2.

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 patent involved in this *inter partes* proceeding and the files of this

[2] For purposes of expediency, we cite to papers and exhibits filed in IPR2023-00506, unless otherwise noted. The Parties filed similar papers and exhibits in each of the above-identified proceedings.

proceeding. Paper 10, 1. As the filing party for confidential Exhibit 2001, Patent Owner represents that it "is not permitted to share certain portions . . . with any party other than the Board and its staff." Paper 9, 1. Patent Owner further represents that "Exhibit 2001, to which Dell is not a party, is to be filed such that it is available to the Board and Patent Owner only" and that "the Parties are in agreement with this procedure." *Id.*

This proceeding is in its preliminary phase. Petitioner filed its Petition on January 27, 2022, and Patent Owner has not filed a Preliminary Response. Paper 9, 2. Accordingly, we have not yet entered a decision on institution. In view of the early stage of the proceeding and the settlement between the Parties, we determine that good cause exists to terminate the proceeding with respect to the Parties.

After reviewing each of the Settlement Agreements, 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 as business confidential information pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) and kept separate from the files of the challenged patent. On the other hand, as to the Parties' request that the Board keep the Settlement Agreements "separate from the files of this proceeding," Paper 10, 1, our regulations do not require us to do so. Therefore, we decline to issue an order to keep the Settlement Agreements separate from the file of this *inter partes* proceeding.

The Parties further request that "the Board inform them if anyone seeks production of the agreements and afford them an opportunity to address whether such request is supported by good cause." Paper 10, 1. We

have no such procedure to serve upon the Parties a request for access to the Settlement Agreements, and, further, our regulations do not require us to do so. Therefore, we decline to issue an order regarding any request for access to the Settlement Agreements.

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

Accordingly, for the reasons discussed above, it is:

III. ORDER

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

FURTHER ORDERED that the Joint Request to Keep Separate Pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) is *granted-in-part* and *denied-in-part*,

FURTHER ORDERED that Exhibits 2001 and 2002 shall remain business confidential information, and

FURTHER ORDERED that the Petition is *dismissed*.

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