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Paper 28
Date: October 1, 2024

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

APEX BEAM TECHNOLOGIES LLC,
Patent Owner.

IPR2023-00599 (Patent 10,912,081 B2)
IPR2023-00601, -00602 (Patent 10,568,113 B2)
IPR2023-00603 (Patent 10,944,527 B2)[1]

Before JOHN D. HAMANN, SEAN P. O'HANLON, and
SCOTT RAEVSKY, *Administrative Patent Judges*.

RAEVSKY, *Administrative Patent Judge*.

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

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[1] We exercise our discretion to issue a single order in these cases. The parties are not authorized to use this caption format.

I. INTRODUCTION

On September 11, 2024, with Board authorization, Petitioner and Patent Owner filed a joint motion to terminate the above-styled proceedings. Paper 25 ("Mot.").[2] Along with the motions, the parties filed a copy of a Confidential Settlement Agreement (Ex. 2007), as well as joint requests to treat the Confidential Settlement Agreement as business confidential information (Paper 26). *See* 37 C.F.R. § 42.74(c) ("A party to a settlement may request that the settlement be treated as business confidential information and be kept separate from the files of an involved patent or application.").

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." It is also provided in 35 U.S.C. § 317(a) that if no petitioner remains, the Office may terminate the *inter partes* review.

In these proceedings, the Board issued decisions to institute *inter partes* review. Paper 9. However, the Board has not yet entered any final written decisions. In the joint motions, the parties state that they have settled their dispute and have reached an agreement to request termination of these

[2] For convenience, this Order cites solely to the papers and exhibit in the IPR2023-00599 proceeding. Similar papers and exhibits have been filed in the other styled cases.

inter partes reviews. Paper 25, 1–3. Accordingly, in the circumstances present here, we determine that it is appropriate to terminate the proceedings. 37 C.F.R. § 42.71(a). This Order does not constitute a final written decision pursuant to 35 U.S.C. § 318(a).

The parties also ask that the Confidential Settlement Agreement be treated as business confidential information and be kept separate from the file of the challenged patents. Paper 26, 1–2. We determine that it is appropriate to treat the Confidential Settlement Agreement as business confidential information, and to keep that document separate from the files of the challenged patents, pursuant to 37 C.F.R. § 42.74(c).

The parties further "request that the Board inform [them] if anyone seeks production of [the Confidential Settlement Agreement] and afford the parties an opportunity to address whether such request is supported by good cause." *Id.* at 2. The statutory and regulatory provisions governing access to such settlement agreements stand on their own and do not provide for such notice, and, therefore, we deny the parties' request here.

III. ORDER

Accordingly, it is:

ORDERED that Joint Motion to Terminate in each styled case is *granted*;

FURTHER ORDERED that the Joint Requests to treat the Confidential Settlement Agreement as business confidential information is *granted*;

FURTHER ORDERED that the joint requests to inform the parties if anyone seeks production of the Confidential Settlement Agreement and

afford the parties an opportunity to address whether such request is supported by good cause is *denied*;

FURTHER ORDERED that the Confidential Settlement Agreement (Ex. 2007 in IPR2023–00599 and IPR2023-00603, and Ex. 2008 in IPR2023–00601 and IPR2023-00602) shall remain designated as "Parties and Board Only" in the Board's electronic filing system, be kept separate from the files of the involved patents, and be made available only under the provisions of 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c); and

FURTHER ORDERED that IPR2023-00599, IPR2023-00601, IPR2023-00602, and IPR2023-00603 are *terminated*.

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