

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HISENSE INTERNATIONAL CO. LTD. and
HISENSE INTERNATIONAL (HONG KONG) AMERICA
INVESTMENTS CO. LTD.,
Petitioner,

v.

VISTA PEAK VENTURES, LLC,
Patent Owner.

IPR2023-00651 (Patent 6,513,943 B2)
IPR2023-00725 (Patent 6,594,143 B2)

Before DONNA M. PRAISS, LARRY J. HUME, and
GEORGIANNA W. BRADEN, *Administrative Patent Judges*.

PER CURIAM

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

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IPR2023-00725 (Patent 6,594,143 B2)

On June 16, 2023, with prior Board authorization provided via email sent June 13, 2023, the parties filed joint motions to terminate proceedings IPR2023-00651 (Patent 6,513,943 B2, “the ’943 Patent”) (Paper 6, “Joint Motion”) and IPR2023-00725 (Patent 6,594,143 B2, “the ’143 Patent”) (Paper 6, “Joint Motion”), along with a copy of what they indicate is their written settlement agreement (Ex. 1013 in IPR2023-00651; Ex. 1010 in IPR2023-00725) made in connection with the termination of these proceedings. Pursuant to 37 C.F.R. § 42.74(c), the parties also concurrently filed a Joint Request to Keep Separate (“Joint Request”) pertaining to their settlement agreement (“Settlement Agreement”). Paper 7.¹

The Joint Request to treat the Settlement Agreement as business confidential information includes a request that the Settlement Agreement be kept separate from the patent file. *Id.*; *see also* 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.”). After reviewing the parties’ settlement agreement, we find that the settlement agreement contains confidential business information regarding the terms of settlement. We determine good cause exists to treat the settlement agreement as business confidential information

¹ Citations are to the record in IPR2023-00725. Similar corresponding documents are in the record for IPR2023-00651. We note a typographical error in the caption for Paper 7 (JOINT REQUEST THAT SETTLEMENT AGREEMENT BE TREATED AS BUSINESS CONFIDENTIAL INFORMATION AND BE KEPT SEPARATE PURSUANT TO 35 U.S.C. § 317(b) AND 37 C.F.R. § 42.74(c)) in IPR2023-00651 which incorrectly references Patent 7,593,070 instead of Patent 6,513,943, which is the subject of IPR2023-00651. Patent 7,593,070 was the subject of IPR2022-01425, now terminated.

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and to keep it separate from the files of the patents in the above-identified proceedings pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

The parties state the subject IPR petitions are related to lawsuits filed in the Eastern District of Texas asserting the '943 Patent (*Vista Peak Ventures, LLC v. Hisense International Co. Ltd. et al.*, Case No. 2:21-cv-00263) (Paper 4 at 2; Paper 6 at 2, n.1), and the '143 Patent (*Vista Peak Ventures, LLC v. Xianyang Caihong Optoelectronics Technology Co., Ltd. et al.*, Case No. 2:21-cv-00260). Paper 4 at 2; Paper 6 at 2, n.1. “Pursuant to the terms of the Settlement Agreement, the parties filed Stipulations of Dismissal in the aforementioned cases, and the parties’ disputes have been dismissed by the court.” Paper 6 at 2.

The parties indicate good cause exists to terminate the above-identified IPR Proceedings. *Id.* at 2–3. According to counsel, the parties have settled their disputes, and have reached agreement to terminate these IPR proceedings. *See id.* at 1–2. In addition to being unopposed, the parties state that the proceedings are at an early stage, no Patent Owner Responses have been filed, and now there is no pending district court litigation. *Id.*

We agree that these proceedings are at an early stage. The Patent Owner, Vista Peak Ventures, LLC, has not filed a Patent Owner’s Response in either proceeding, and the Board has not issued a decision on whether to institute trial in either proceeding.² The parties represent that Exhibit 1010 (IPR2023-00751) and Exhibit 1013 (IPR2023-00651) are “true and correct cop[ies]” of their settlement agreement, and that their settlement agreement “will resolve the parties’ dispute regarding the challenged patent[.]” *Id.* at 2.

² We note a termination order due to settlement after institution of trial was entered on June 29, 2023 in related proceeding IPR2022-01425.

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The parties further represent that “[t]here are no other agreements, oral or written, between the parties made in connection with, or in contemplation of, the termination of this proceeding.” *Id.* at 2.

Based on the facts of this case, it is appropriate to dismiss the Petitions and terminate the proceedings, as doing so will preserve both the Board’s and the parties’ resources while also epitomizing the Patent Office’s policy of “secur[ing] the just, speedy, and inexpensive resolution”; and this is a just and fair resolution.

Accordingly, the Joint Motions to terminate the above-identified proceedings and the Joint Requests to treat the Settlement Agreement as business confidential information (Paper 7 in both proceedings) are granted. As requested by the parties, the Settlement Agreement will be treated as business confidential information, and kept separate from the patent files. 37 C.F.R. § 42.74(c). This paper does not constitute a final written decision pursuant to 35 U.S.C. § 318(a).

Therefore, it is

ORDERED that the joint motions to terminate the above-captioned proceedings are granted;

FURTHER ORDERED that the proceedings in IPR2023-00651 and IPR2023-00725 are terminated pursuant to 37 C.F.R. §§ 42.5, 42.72, 42.74(c); and

FURTHER ORDERED that the parties’ joint requests to keep separate Exhibit 1010 in IPR2023-00725 and Exhibit 1013 in IPR2023-00651 are GRANTED, and the specified exhibit in each proceeding shall be: (i) treated as business confidential information; (ii) be kept separate from the files of each involved patent captioned above; (iii) kept confidential from

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any third party; (iv) filed as “BOARD ONLY” as accessible only to the Board and no other party to this proceeding; and (v) made available only to Federal Government agencies on written request, or to any person on a showing of good cause, under the provisions of 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

FOR PETITIONER:

Ya-Chiao Chang
Louis Campbell
WINSTON & STRAWN LLP
ychang@winston.com
llcampbell@winston.com

FOR PATENT OWNER:

Tarek Fahmi
Jonathan Tsao
ASCENDA LAW GROUP, PC
tarek.fahmi@ascendalaw.com
jonathan.tsao@ascendalaw.com