

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

KIOXIA AMERICA, INC. and KIOXIA CORPORATION,
Petitioners,

v.

BiTMICRO LLC,
Patent Owner.

IPR2023-00742 (Patent 8,010,740 B2)
IPR2023-00743 (Patent 6,496,939 B2)

Before KEN B. BARRETT, TERRENCE W. McMILLIN, and
KEVIN C. TROCK, *Administrative Patent Judges*.

PER CURIAM.

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

I. BACKGROUND

On November 13, 2023, with Board authorization, Petitioners KIOXIA Corporation and KIOXIA America, Inc. and Patent Owner BiTMICRO, LLC filed a “Joint Motion to Terminate Pursuant to 35 U.S.C. § 317 and 37 C.F.R. § 42.74.” Paper 10 (“Motion” or “Mot.”).¹ Along with the Motion, Petitioners and Patent Owner filed Exhibit 2001, “a true and correct copy of the Settlement and License Agreement governing the resolution of the *inter partes* review.” Mot. 3. The Motion states that “[t]here are no other collateral agreements, oral or written, between the Parties made in connection with, or in contemplation of, the termination of this proceeding.” *Id.* Petitioners and Patent Owner jointly request termination and “submit that termination is appropriate because they have reached an agreement resolving the dispute involving the patent at issue in the above-captioned *inter partes* review.” *Id.* at 2.

Petitioners and Patent Owner also filed a Joint Request to treat their settlement agreement as business confidential information, and to maintain the filed copy of the Settlement Agreement (Ex. 2001) separate from the public file under 37 C.F.R. § 42.74(c). Paper 11.

II. DISCUSSION

We have not yet decided the merits of the proceedings, and a final written decision has not been entered. However, “[t]he Board expects that a proceeding will terminate after the filing of a settlement agreement, unless the Board has already decided the merits of the proceeding,” because of the

¹ The parties filed substantially identical documents in both IPR2023-00742 and IPR2023-00743. For convenience, we cite only to the record in IPR2023-00742. This order applies in both captioned proceedings.

“strong public policy reasons to favor settlement between the parties to a proceeding.” Consolidated Trial Practice Guide, November 2019, 86 (available at <https://www.uspto.gov/about-us/news-updates/consolidated-trial-practice-guide-november-2019>). Notwithstanding that the proceedings have moved beyond the preliminary stage, Petitioners and Patent Owner have shown adequately that termination of the proceedings is appropriate because of the resolution of their dispute. Under these circumstances, we determine that good cause exists to terminate the proceedings.

After reviewing the Settlement Agreement (Ex. 2001) between Petitioners and Patent Owner, we find that the Settlement Agreement contains confidential business information regarding the terms of settlement. We determine that good cause exists to treat the Settlement Agreement between Petitioners and Patent Owner 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).

III. ORDER

Accordingly, for the reasons discussed above, it is

ORDERED that the Joint Motion to Terminate (Paper 10) is *granted* in IPR2023-00742, and IPR2023-00742 is *terminated* pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. § 42.72; and

FURTHER ORDERED that the Joint Motion to Terminate (Paper 10) is *granted* in IPR2023-00743, and IPR2023-00743 is *terminated* pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. § 42.72; and

FURTHER ORDERED that, in both of the above-captioned proceedings, the Joint Request to File Settlement Agreement As Business

IPR2023-00742 (Patent 8,010,740 B2)

IPR2023-00743 (Patent 6,496,939 B2)

Confidential Information Pursuant to 35 U.S.C. § 317(b) and 37 C.F.R.

§ 42.74(c) (Paper 11) is *granted*, and the Settlement Agreement (Exhibit 2001) shall be designated as “Board Only” in the Board’s filing system, shall be made available only to Federal Government agencies on written request, or to any person on a showing of good cause, and shall be kept separate from the files of the involved patent and associated preliminary proceeding, pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

IPR2023-00742 (Patent 8,010,740 B2)

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