

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

SONRAI MEMORY LIMITED,
Patent Owner.

IPR2023-00819
Patent 6,874,014 B2

Before GREGG I. ANERSON, STACEY G. WHITE, and
JOHN D. HAMANN, *Administrative Patent Judges*.

HAMANN, *Administrative Patent Judge*.

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

Petitioner (Apple Inc.) and Patent Owner (Sonrai Memory Ltd.) have indicated that they have reached an agreement to settle this *inter partes* review proceeding.

On December 18, 2023, pursuant to 37 C.F.R. § 42.74 and 35 U.S.C. § 317(a), the parties filed a joint motion to terminate this proceeding (“Joint Motion”) (Paper 10) and a joint request (“Joint Request”) (Paper 11) to treat a confidential Settlement Agreement (Ex. 2012) as business confidential information and to keep the Settlement Agreement separate from the files of U.S. Patent No. 6,874,014 B2.¹

The parties describe the filed copy of the confidential Settlement Agreement as “a true copy of their settlement agreement in connection with this matter.” Joint Motion 2. The parties represent that their Settlement Agreement “completely resolves all pending controversies between Apple and Sonrai concerning U.S. Patent No. 6,874,014.” *Id.* The parties further represent that “there are no other agreements or understandings, oral or written, between them, including any collateral agreements, made in connection with, or in contemplation of, the termination of this proceeding.” *Id.*

¹ Although the parties requested authorization to file the Joint Motion and Joint Request, they improperly filed these motions prior to the Board granting authorization as required by our rules. *See* 37 C.F.R. § 42.20(b); Joint Motion 2. Because termination of this proceeding based on settlement comports with our mandate to ensure “the just, speedy, and inexpensive resolution of every proceeding,” 37 C.F.R. § 42.1(b), we exercise our discretion under 37 C.F.R. § 42.5(b) to waive the preauthorization requirement. We remind counsel for the parties, however, that a continued failure to follow our Rules may implicate their ability to appear before the Board in future proceedings.

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.” Section 35 U.S.C. § 317(a) also provides that if no petitioner remains in the *inter partes* review, the Office may terminate the review. This proceeding is at an intermediate stage. We have not yet decided the merits of this proceeding, and a final written decision has not been entered in this proceeding. Furthermore, there are strong public policy reasons to favor settlement between the parties to a proceeding. Patent Trial and Appeal Board Consolidated Trial Practice Guide, 84 Fed. Reg. 64,280 (Nov. 21, 2019). Under these circumstances, and in view of the parties’ settlement and representations, we determine that good cause exists to terminate this proceeding. Accordingly, we *grant* the Joint Motion.

The parties also request “the settlement agreement between the parties filed concurrently herewith as Ex. 2012 . . . be treated as business confidential information and be kept separate from the file of the ’014 patent.” Joint Request 2. The parties further request that the Settlement Agreement “be made available only under the provisions of 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).” *Id.* We have reviewed the Settlement Agreement, which the parties contend contains confidential business information regarding the terms of settlement, and we determine that good cause exists to treat the Settlement Agreement as business confidential information and to keep them separate from the file of U.S. Patent No. 6,874,014 B2. Accordingly, we *grant* this aspect of the parties’ Joint Request.

The parties further request that the Board order that any requests for access to the agreement “be served upon the parties on the day the written request is provided to the Board and that the parties be given the opportunity to respond to the request.” *Id.* However, neither the statute nor the regulation provides for any such notification to the parties or opportunity to address whether a request is supported by good cause, and the parties have not provided any special circumstance that would justify issuing an order that purports to impose additional requirements. Accordingly, we *deny* this portion of the parties’ Joint Request.

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

ORDER

Accordingly, it is:

ORDERED that the Joint Motion to terminate IPR2023-00819 is *granted*, and that IPR2023-00819 is *terminated*;

FURTHER ORDERED that the Joint Request is *granted-in-part*, and the Settlement Agreement (Ex. 2012) shall be treated as business confidential information, shall be kept separate from the files of U.S. Patent No. 6,874,014 B2, and shall be made available only to Federal Government agencies on written request, or to any person on a showing of good cause on written request, pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c); and

FURTHER ORDERED that Exhibit 2012 shall remain designated as “Board” only in the Board’s P-TACTS system.

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