

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

WESTERN DIGITAL TECHNOLOGIES, INC.,
Petitioner,

v.

SHAMROCK INNOVATIONS, INC.,
Patent Owner.

IPR2023-00842
Patent 9,535,454 B2

Before SHEILA F. McSHANE, GARTH D. BAER, and
IFTIKHAR AHMED, *Administrative Patent Judges*.

BAER, *Administrative Patent Judge*.

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

I. INTRODUCTION

With the Board’s authorization, Petitioner and Patent Owner (collectively referred to as “the Parties”) filed a Joint Motion to Terminate the above-identified proceeding due to settlement. Paper 27 (“Joint Motion”). In support of the Joint Motion, the Parties filed a Patent License Agreement (Exs. 2017, 2018, 2019 (“Agreement”)¹), as well as a Joint Request to File Resolution Documents as Business Confidential Information (Paper 28 (“Joint Request”)) pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74.

II. DISCUSSION

In the Joint Motion, the Parties represent that they “have reached an agreement to resolve this *inter partes* review (IPR) proceeding,” and that “[a] true copy of the document resolving the disputes related to the ’454 Patent is filed concurrently herewith.” Joint Motion 1, 3. The Parties further represent that as a result of their “resolution of the dispute, the Parties are filing a motion to dismiss the [related] Lawsuit.” *Id* at 2.

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 317(a) also provides that if no petitioner remains in the *inter partes* review, the Office may terminate the review.

We instituted a trial in the above-identified proceeding on October 19,

¹ The Parties filed three copies of the Agreement, executed by Western Digital Technologies, Inc., Shamrock Innovations, LLC, and Lenovo (United States), Inc., respectively. *See* Exs. 2017, 2018, 2019.

2023. Paper 9. We have not yet decided the merits of the proceeding, and a final written decision has not been entered. Notwithstanding that the proceeding has moved beyond the preliminary stage, the Parties have shown adequately that termination of the proceeding is appropriate. Under these circumstances, we determine that good cause exists to terminate the proceeding with respect to the Parties.

After reviewing the Agreement, we find that the Agreement contains confidential business information regarding the terms of settlement. We determine that good cause exists to treat the Agreement as business confidential information pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

In the Joint Request, the Parties indicate “[t]he Resolution Documents ha[ve] been filed for access by the ‘**Board Only**,’ and the parties jointly request that the Resolution Documents remain available for the ‘**Board Only**.’” Joint Request 1. To the extent the Parties intend the Joint Request to act as a motion to seal, we decline to treat it as such because the Parties have not proposed to enter a protective order. *See* 37 C.F.R. § 42.54(a). In any event, the procedure specified in 37 C.F.R. § 42.74(c) provides protection from disclosure beyond the Board for settlement agreements, such as the “Resolution Documents” (Exs. 2017, 2018, 2019 (“Agreement”)), except upon written request to the Board, by a Government agency, or by any other person with a fee and on a showing of good cause. 37 C.F.R. § 42.74(c).

The Parties further request “the Board order that in the event a person or entity makes a written request, as stated in 37 C.F.R. § 42.74(c)(1)-(2), for access to the Resolution Documents, that any such written request be served

upon the parties on the day the written request is provided to the Board.”
Joint Request 1–2. We have no such procedure to serve upon the Parties a request for access to the Agreement, and, further, our regulations do not require us to do so. Therefore, we decline to issue an order regarding access requests.

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 (Paper 27) is *granted*, and IPR2023-00842 is *terminated* pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. § 42.72; and

FURTHER ORDERED that the Joint Request (Paper 28) is *granted*, and the Agreement (Exs. 2017, 2018, 2019) shall be kept separate from the file of Patent 9,535,454 and made available only to Federal Government agencies on written request, or to any person on a showing of good cause, pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

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