

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INTEL CORPORATION,
Petitioner,

v.

MASAHIRO IIDA,
Patent Owner.

IPR2023-00864
Patent 6,812,737 B2

Before JEAN R. HOMERE, DANIEL J. GALLIGAN, and
STEPHEN E. BELISLE, *Administrative Patent Judges*.

HOMERE, *Administrative Patent Judge*.

TERMINATION
Due to Settlement after Institution of Trial

35 U.S.C. § 317; 37 C.F.R. §42.74

I. INTRODUCTION

On February 8, 2024, with the Board’s authorization, Petitioner and Patent Owner (collectively, “the Parties”) filed a Joint Motion to terminate the above-captioned *inter partes* review proceeding. Paper 13 (“Joint Motion”). Along with the Joint Motion, the Parties filed a copy of a Confidential Settlement and Patent License Agreement. Ex. 1048 (“Settlement Agreement”). The Parties jointly request to file the Settlement Agreement as business confidential information and keep it separate from the file of U.S. Patent No. 6,812,737 B2 (“the ’737 patent”). Paper 14 (“Joint Request”). *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.”).

I. 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.”

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

In the Joint Motion, the Parties represent that the Settlement Agreement resolves their disputes involving the ’737 patent. Joint Motion 2. The Parties also represent that they have filed a true and correct copy of the Settlement Agreement (*id.* at 3) and that “[t]here are no collateral agreements or understandings made in connection with, or in contemplation of, the termination of this *inter partes* review.” *Id.* The Parties further

“represent that their entire agreement in connection with the termination of this proceeding is embodied in the [Settlement] Agreement.” *Id.*

We instituted trial for the above-identified *inter partes* review proceeding on November 22, 2023. *See* Paper 10. We have not yet decided the merits of the proceeding. The Parties have shown adequately that termination of the proceeding is appropriate. We therefore terminate the proceeding.

The Parties jointly request that the Settlement Agreement be treated as business confidential information and kept separate from the file of the ’737 patent. Joint Request 1. Pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c), we grant this aspect of the parties’ Joint Request.

The parties also “request that the Board inform them if anyone seeks production of the agreements and afford them an opportunity to address whether such request is supported by good cause.” Joint Req. 1. However, neither the statute nor the regulation provides for any such notification. Accordingly, we deny that portion of the parties’ Joint Request.

II. ORDER

Accordingly, it is:

ORDERED that the Joint Motion to terminate (Paper 13) is *granted*, and IPR2023-00864 is *terminated* with respect to Petitioner and Patent Owner; and

FURTHER ORDERED that the Parties’ joint request to treat the Settlement Agreement as business confidential information (Paper 14) is *granted*, and the Settlement Agreement (Ex. 1048) shall be kept separate from the file of U.S. Patent No. 6,812,737 B2, and made available only to

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Federal Government agencies on written request, or to any person on a showing of good cause, pursuant to 37 C.F.R. § 42.74(c).

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