

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BMW OF NORTH AMERICA, LLC,
Petitioner,

v.

SCRAMOGE TECHNOLOGY LTD.,
Patent Owner.

IPR2023-00913
Patent 10,243,400 B2

Before KARL D. EASTHOM, KRISTINA M. KALAN, and
MICHELLE N. WORMMEESTER, *Administrative Patent Judges*.

KALAN, *Administrative Patent Judge*.

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

I. INTRODUCTION

With the Board’s authorization, Petitioner and Patent Owner (collectively, “the Parties”) filed a Joint Motion to Terminate the above-identified proceeding. Paper 6 (“Joint Motion”). In support of the Joint Motion, the Parties filed a copy of a Confidential Settlement and License Agreement (Ex. 1022 (“Settlement Agreement”)), as well as a Joint Request to Treat the Settlement Agreement as Business Confidential Information (Paper 7 (“Joint Request”)).

II. DISCUSSION

In the Joint Motion, the Parties represent that they have reached an agreement to jointly seek termination of the above-identified *inter partes* review proceeding, and that the filed copy of the Settlement Agreement is a true and complete copy. Paper 6. The Parties further represent that their Settlement Agreement resolves all currently pending Patent Office and District Court proceedings between the Parties involving the above-identified patent at issue. *Id.* at 2–3.

This proceeding is at an early stage, and we have not yet decided whether to institute a trial in the proceeding. In view of the early stage of the proceeding and the settlement between the Parties, we determine that good cause exists to dismiss the petition and terminate the proceeding with respect to the Parties.

The Parties also filed a Joint Request that the Settlement Agreement be treated as business confidential information and be kept separate from the file of the patent involved in this *inter partes* proceeding. Paper 7. After reviewing the Settlement Agreement between Petitioner 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 Petitioner 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).

Accordingly, for the reasons discussed above, it is:

ORDERED that the Joint Motion is *granted*, and the petition in IPR2023-00913 is *dismissed* and the proceeding is *terminated*;

FURTHER ORDERED that the Joint Request is *granted*, and the Settlement Agreement shall be kept separate from the files of Patent 10,243,400 B2 and made available only to 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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