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Paper 19
Date: February 27, 2024

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

META PLATFORMS, INC.,
Petitioner,

v.

IMMERSION CORPORATION,
Patent Owner.

IPR2023-00942 (Patent 8,469,806 B2)
IPR2023-00943 (Patent 8,896,524 B2)
IPR2023-00944 (Patent 10,269,222 B2)
IPR2023-00945 (Patent 10,664,143 B2)
IPR2023-00946 (Patent 9,727,217 B2)
IPR2023-00947 (Patent 10,248,298 B2)[1]

Before MICHAEL R. ZECHER, PATRICK R. SCANLON, CHRISTOPHER L. OGDEN, and IFTIKHAR AHMED, *Administrative Patent Judges*.

SCANLON, *Administrative Patent Judge*.

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

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[1] We exercise our discretion to issue a single Order to be entered in each case using a joint caption. The joint caption is for administrative convenience only and does not indicate joined cases or an expanded panel under SOP 1 § III.M. This order addresses multiple proceedings that collectively involve more than three Administrative Patent Judges. The parties are not authorized to use this caption. For convenience, we use the Paper and Exhibit numbers from IPR2023-00942.

On February 23, 2024, with the Board's authorization, Meta Platforms, Inc. ("Petitioner") and Immersion Corporation ("Patent Owner") filed joint motions to terminate the above-captioned proceedings pursuant to 35 U.S.C. § 317(a). Paper 10 ("Mot."). Each motion was accompanied by a true, unredacted copy of a settlement and license agreement (Ex. 1012, "the Agreement"), and a joint request to treat the Agreement as business confidential information and to be kept separate from the patent file, pursuant to 35 U.S.C. § 317(b) (Paper 11).

The parties represent in their joint motions that they have resolved all disputes between them regarding the patents challenged in these *inter partes* review proceedings, as well as the related district court proceeding. Mot. 1. The parties also represent that they have filed a true copy of the Agreement and that "there are no other collateral agreements or understandings, oral or written, between the Parties made in connection with, or in contemplation of, the termination of this proceeding." *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 patent owner, unless the Office has decided the merits of the proceeding before the request for termination is filed." As indicated in the Joint Motions, the parties are requesting termination prior to the Board deciding the merits of the proceedings "as Patent Owner has not yet filed its response to the petition" in each proceeding. Mot. 2.

Under the circumstances presented here, we determine that termination of the proceedings is appropriate. *See* Consolidated Trial Practice Guide (November 2019)[2] at 86 ("The 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."). Accordingly, we grant the parties' joint motions to terminate.

We also determine that the parties have complied with the requirements of 37 C.F.R. § 42.74(c) to have the Agreement treated as business confidential information and kept separate from the patent files of the challenged patents. Thus, we grant the joint requests to treat the Agreement as business confidential.

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

Accordingly, it is:

ORDERED that the joint motions to terminate are *granted*;

FURTHER ORDERED that each of these proceedings (IPR2023-00942, IPR2023-00943, IPR2023-00944, IPR2023-00945, IPR2023-00946, and IPR2023-00947) is *terminated*; and

FURTHER ORDERED that the joint requests to treat the Agreement as business confidential information are *granted*, and the Agreement shall be kept separate from the files of U.S. Patent Nos. 8,469,806, 8,896,524, 9,727,217, 10,269,222, 10,248,298, and 10,664,143, and be made available

[2] *Available at* https://www.uspto.gov/TrialPracticeGuideConsolidated.

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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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