

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.

IPR2023-01048
Patent 10,546,685 B2

Before JAMESON LEE, MICHELLEN. WORMMEESTER, and
AARON W. MOORE, *Administrative Patent Judges*.

WORMMEESTER, *Administrative Patent Judge*.

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

I. INTRODUCTION

Petitioner filed a Petition (Paper 1) requesting *inter partes* review of U.S. Patent No. 10,546,685 B2 (Ex. 1001). Subsequently, the parties filed a joint motion to terminate this proceeding pursuant to a settlement agreement. Paper 6 (“Joint Motion to Terminate”). The parties also filed a copy of their settlement agreement made in connection with the termination of the proceeding. Ex. 1020. In a concurrently filed paper, the parties jointly request the settlement agreement to be treated as business confidential and to be kept separate from the file of the involved patent under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c). Paper 7 (“Joint Request to Keep Confidential and Separate”). We authorized the filing of the jointly-filed papers in an e-mail dated August 17, 2023. Ex. 3001.

II. DISCUSSION

The instant proceeding is in an early stage, and the Board has not determined whether to institute trial. The parties represent that Exhibit 1020 is “a true copy of the Parties’ settlement agreement,” which “resolves all underlying disputes between the parties, including this *inter partes* review proceeding IPR2023-01048 against U.S. Patent No. 10,546,685.” Paper 6, 3; Paper 7, 2. The parties further represent that “[t]he settlement agreement is in writing and constitutes the Parties’ entire understanding and agreement.” Paper 6, 3–4. In view of the foregoing, we determine that it is appropriate to dismiss the Petition and terminate the proceeding.

Further, after reviewing the parties’ settlement agreement, 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 as business confidential information and to keep it separate from the file of the patent in the above-identified proceeding pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

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

III. ORDER

Accordingly, it is:

ORDERED that the Joint Motion to Terminate (Paper 6) is *granted*, the Petition (Paper 1) is *dismissed*, and the proceeding is *terminated*; and

FURTHER ORDERED that the Joint Request to Keep Confidential and Separate (Paper 7) is *granted*, and that the settlement agreement (Ex. 1020) shall be treated as business confidential information, kept separate from the file of the above-identified patent, 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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FOR PETITIONER:

Lionel M. Lavenue
Kara A. Specht
Cory C. Bell
Safiya Aguilar
FINNEGAN, HENDERSON, FARABOW, GARRETT
& DUNNER, LLP
lionel.lavenue@finnegan.com
kara.specht@finnegan.com
cory.bell@finnegan.com
safiya.aguilar@finnegan.com

FOR PATENT OWNER:

Brett Cooper
BC LAW GROUP, P.C.
bcooper@bc-lawgroup.com

Robert A. Auchter
AUCHTER PLLC
robert@auchterlaw.com