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Paper 16
Date: November 8, 2023

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TESLA, INC.,
Petitioner,

v.

AUTONOMOUS DEVICES, LLC,
Patent Owner.

IPR2023-01170 (Patent 10,102,449 B1)
IPR2023-01171 (Patent 11,113,585 B1)[1]

Before BARBARA A. PARVIS, ROBERT J. WEINSCHENK, and RUSSELL E. CASS *Administrative Patent Judges*.

PER CURIAM.

DECISION
Settlement Prior to Institution of Trial
Granting Joint Request to Treat Settlement Agreement as Business Confidential Information
37 C.F.R. § 42.74

[1] This Decision addresses issues that are the same in each of these proceedings. We issue one Decision to be entered in each proceeding. The parties are not permitted to use this style of caption.

I. INTRODUCTION

With the Board's authorization, Petitioner and Patent Owner (collectively "the Parties") filed Joint Motions to Dismiss and Terminate the above captioned proceedings. Paper 10 ("Joint Motions").[2] In support of the Joint Motions, the Parties filed copies of a Confidential Litigation Agreement (Ex. 1050 ("Litigation Agreement")), as well as Joint Requests that the Parties' Litigation Agreement be Treated as Business Confidential Information Under 37 C.F.R. § 42.74 (Paper 11 ("Joint Requests")).

II. DISCUSSION

In the Joint Motions, the Parties represent that they have reached an agreement to jointly seek dismissal and termination of the above captioned *inter partes* review proceedings, and that the filed copies of the Litigation Agreement are true and complete copies. Paper 10, 1–2. The Parties further represent that their Litigation Agreement resolves the disputes between the Parties involving the above captioned patents at issue. *Id.* at 2. Additionally, the Parties "certify that no collateral agreements or understandings exist in connection with, or in contemplation of, dismissal and termination of the Present IPR Proceeding[s] beyond the Litigation Agreement." *Id.*

These proceedings are at an early stage, and we have not yet decided whether to institute a trial in the proceedings. In view of the early stage of the proceedings and the settlement between the Parties, we determine that

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[2] IPR2023-01170 and IPR2023-01171 include similar papers and exhibits. Unless otherwise noted, all citations are to papers and exhibits in IPR2023-01170 as representative. This Decision applies equally to all captioned proceedings.

good cause exists to dismiss the petitions and terminate the proceedings with respect to the Parties.

The Parties also filed Joint Requests that the Litigation Agreement be treated as business confidential information and be kept separate from the file of the patents involved in these *inter partes* proceedings. Paper 11. After reviewing the Litigation Agreement between Petitioner and Patent Owner, we find that the Litigation Agreement contains confidential business information regarding the terms of settlement. We determine that good cause exists to treat the Litigation 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).

III. ORDER

ORDERED that the Joint Motions to Dismiss and Terminate are *granted*, the petitions in IPR2023-01170 and IPR2023-01171 are dismissed, and the IPR2023-01170 and IPR2023-01171 proceedings are *terminated*;

FURTHER ORDERED that the Joint Requests that the Parties' Litigation Agreement be Treated as Business Confidential Information Under 37 C.F.R. § 42.74(c) are *granted*, and the Litigation Agreement shall be kept separate from the files of Patent Nos. 10,102,449 B1 and 11,113,585 B1 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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