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Paper 29
Entered: September 6, 2024

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MANUFACTURING RESOURCES INTERNATIONAL, INC.,
Petitioner,

v.

SAMSUNG ELECTRONICS CO., LTD.,
Patent Owner.

IPR2023-01202 (Patent 8,223,311 B2)
IPR2023-01203 (Patent 8,842,253 B2)[1]

Before JAMESON LEE, THOMAS L. GIANNETTI, and
JOHN A. HUDALLA, *Administrative Patent Judges*.

HUDALLA, *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] This Decision applies to both of the captioned proceedings. These cases have not been consolidated or joined. We exercise our discretion to issue one Decision to be filed in each case. The parties are not authorized to use this heading style for any subsequent papers.

I. INTRODUCTION

With the Board's authorization, Petitioner and Patent Owner (collectively, "the Parties") filed in each of the above-identified proceedings a Joint Motion to Terminate the proceeding due to settlement ("Joint Motions"). Paper 26.[2] In support of the Joint Motions, the Parties filed a copy of a Settlement Agreement (Ex. 1015), as well as a Joint Motion to File the Settlement Agreement as Business Confidential Information pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) (Paper 27 ("Joint Requests")), in each of the above-identified proceedings.

II. 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." Section 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 Motions, the Parties represent that they have reached an agreement to jointly seek termination of *inter partes* review proceedings, and that the filed copies of the Settlement Agreement are true copies. Paper 26, 1–3. 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 patents. *Id.* at 1–2. The Parties additionally represent that there are no collateral agreements or

[2] For expediency, we cite to the papers filed in IPR2023-01202, unless otherwise indicated. Similar papers and exhibits were filed in IPR2023-01203.

understandings made in connection with, or in contemplation of, the termination of these proceedings. *Id.* at 2.

We instituted trial on each of the above-identified proceedings on February 7, 2024. Paper 10. We have neither decided the merits nor entered final written decisions in these proceedings. Notwithstanding that the proceedings have moved beyond the preliminary stage, the Parties have shown adequately that the termination of the proceedings is appropriate. Under these circumstances, we determine that good cause exists to terminate the proceedings with respect to the Parties.

For each of the above-identified proceedings, the Parties also filed a joint request to treat the Settlement Agreement as business confidential information and to keep the Settlement Agreement separate from the files of the patents at issue. Paper 27, 1. After reviewing the Settlement Agreement between Petitioner and Patent Owner, we find that it 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 confidential information 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, for the reasons discussed above, it is:

ORDERED that the Joint Motions to Terminate are *granted*, and IPR2023-01202 and IPR2023-01203 are *terminated* with respect to Petitioner and Patent Owner pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. § 42.72; and

FURTHER ORDERED that the Joint Motions to File the Settlement Agreement as Business Confidential Information are *granted*, and the Settlement Agreement shall be kept separate from the files of Patent 8,223,311 B2 and Patent 8,842,253 B2 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).

IPR2023-01202 (Patent 8,223,311 B2)
IPR2023-01203 (Patent 8,842,253 B2)

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