

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD.,
Petitioner,

v.

HEADWATER RESEARCH LLC,
Patent Owner.

IPR2023-01360
Patent 9,609,544 B2

Before ROBERT J. WEINSCHENK, GARTH D. BAER, and
RUSSELL E. CASS, *Administrative Patent Judges*.

CASS, *Administrative Patent Judge*.

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

I. INTRODUCTION

With the Board’s authorization, Petitioner and Patent Owner (collectively referred to as “the Parties”) filed a Joint Motion to Terminate the above-identified proceeding due to settlement. Paper 15 (“Joint Motion”). In support of the Joint Motion, the Parties filed a Settlement Agreement (Ex. 1027 (“Settlement Agreement”)), as well as a Joint Request to Treat Exhibit 1027 as Business Confidential Information (Paper 16 (“Joint Request”)) pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74.

II. DISCUSSION

In the Joint Motion, the Parties represent that they “have reached a settlement that addresses this proceeding,” that they “have concurrently filed the Settlement Agreement as Exhibit 1027,” and that “there are no other agreements, oral or written, between the Parties made in connection with, or in contemplation of, the termination of the proceeding.” Joint Motion 3. The Parties further represent that their settlement resolves “all the disputes in this proceeding and as to the patent at issue,” and that they jointly stipulated to a dismissal with prejudice of Patent Owner’s claims in the related litigation. *Id* at 4.

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.

We instituted a trial on the above-identified proceeding on April 1, 2024. Paper 7. We have not yet decided the merits of the proceeding, and a

final written decision has not been entered. Notwithstanding that the proceeding has moved beyond the preliminary stage, the Parties have shown adequately that the termination of the proceeding is appropriate. Under these circumstances, we determine that good cause exists to terminate the proceeding with respect to the Parties.

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 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

In the Joint Request, the Parties indicate that the Settlement Agreement requires that its terms “are to be maintained as confidential by the Parties and, subject to certain exceptions, may not be disclosed to any third parties without the express written consent of the non-disclosing party.” Joint Request 1. We note that we have no procedure for obtaining express written consent of either party prior to disclosure, and our regulations do not require us to do so. We decline to issue an order regarding consent upon receiving Settlement Agreement access requests.

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 Motion to Terminate (Paper 15) is *granted*, and IPR2023-01360 is *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 Request to Treat Exhibit 1027 as Business Confidential Information (Paper 16) is *granted*, and the Settlement Agreement (Ex. 1027) shall be kept separate from the file of Patent 9,609,544, 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).

IPR2023-01360
Patent 9,609,544 B2

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