

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

PROMETHEAN LTD. and PROMETHEAN INC.,
Petitioner,

v.

FLATFROG LABORATORIES AB,
Patent Owner.

IPR2022-00065
Patent 10,775,935 B2

Before DEBRA K. STEPHENS, GARTH D. BAER, and
NABEEL U. KHAN, *Administrative Patent Judges*.

BAER, *Administrative Patent Judge*.

DECISION

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

I. INTRODUCTION

With the Board's authorization, Petitioner and Patent Owner (collectively, "the Parties") filed a Joint Motion requesting termination of the above-captioned proceeding due to settlement. Paper 11 ("Joint Motion"). Along with the Joint Motion, the Parties filed a copy of a written, confidential "SETTLEMENT, RELEASE AND LICENSE AGREEMENT." Ex. 1024 ("Settlement Agreement"). The Parties also filed a Joint Request that the Settlement Agreement be treated as business confidential information and kept separate from the file of U.S. Patent No. 10,775,935 B2 ("the '935 patent"). Paper 10 ("Joint Request").

II. DISCUSSION

In the Joint Motion, the Parties represent that the Settlement Agreement resolves the Parties' disputes involving the '935 patent. Joint Motion 2. The Parties also represent that the Settlement Agreement is a true copy of the agreement or understanding made in connection with, or in contemplation of, the termination of the proceeding. *Id.* The Settlement Agreement states that it "constitutes the entire agreement between the Parties with respect to settlement of the Action and supersedes all prior written or oral agreements and understandings between the Parties with respect to such subject matters." Settlement Agreement 18.

There are strong public policy reasons to favor settlement between the parties to a proceeding. Office Patent Trial Practice Guide, 84 Fed. Reg. 64,280 (Nov. 21, 2019). The proceeding is at an early stage, and we have not yet decided whether to institute a trial in the proceeding. In view of the early stage of the proceeding and the settlement between the Parties, we

determine that good cause exists to dismiss the petition for *inter partes* review and terminate the proceeding with respect to the Parties.

In the Joint Request, the Parties request that the Settlement Agreement be treated as business confidential information and kept separate from the file of the '935 patent. Joint Request 2.¹ After reviewing the Settlement Agreement, we find that it contains confidential business information regarding the terms of settlement. Thus, we determine the Settlement Agreement shall be treated as business confidential information pursuant to 37 C.F.R. § 42.74(c) and shall be kept separate from the files of the patents and associated proceeding.

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 requesting termination of the proceeding is *granted*;

FURTHER ORDERED that IPR2022-00065 is *terminated* with respect to Petitioner and Patent Owner; and

FURTHER ORDERED that the Joint Request to treat the Settlement Agreement as business confidential information is *granted*, and the Settlement Agreement shall be kept separate from the file of U.S. Patent No. 10,775,935 B2, and shall be made available only to Federal Government

¹ The Joint Request does not include page numbers. For reference herein, we consider the caption page as page 1 and the subsequent pages proceed in numerical order.

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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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