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Paper 15
Date: July 5, 2024

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TRANSCORE, LP,
Petitioner,

v.

HAND HELD PRODUCTS, INC.,
Patent Owner.

IPR2024-00391 (Patent 8,141,784 B2)
IPR2024-00443 (Patent 8,919,654 B2)
IPR2024-00982 (Patent 10,452,968 B2)[1]

Before SCOTT A. DANIELS, CHRISTOPHER M. KAISER, and LISA L. TSANG *Administrative Patent Judges*.

TSANG, *Administrative Patent Judge*.

TERMINATION
Due to Settlement Prior to Institution of Trial
35 U.S.C. § 317; 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 Terminate *Inter Partes* Review of the above captioned proceedings. Paper 14 ("Joint Motions").[2] In support of the Joint Motions, the Parties filed copies of a License and Settlement Agreement (Ex. 2001 ("Settlement Agreement")), as well as Joint Requests to Treat Agreement as Business Confidential and Kept Separate Under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) (Paper 15 ("Joint Requests")).

II. DISCUSSION

In the Joint Motions, the Parties represent that they have reached an agreement to jointly seek termination of the above captioned *inter partes* review proceedings, and that the filed copies of the Settlement Agreement are true and correct copies. Joint Motions 1. Additionally, the parties represent that "[t]here are no collateral agreements, such as other agreements, oral or written, between the parties made in connection with, or in contemplation of, the termination of the proceeding." *Id.* at 1–2. The Parties further represent that their Settlement Agreement settles all disputes between the Parties involving the above captioned patents at issue. *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, the Parties' representations, and the settlement between the

[2] IPR2024-00391, IPR2024-00443, and IPR2024-00982 include similar papers and exhibits. Unless otherwise noted, all citations are to papers and exhibits in IPR2024-00391 as representative. This Decision applies equally to all captioned proceedings.

Parties, we agree with the Parties and determine that good cause exists to terminate the proceedings with respect to the Parties. *See* Joint Motions 2–3.

The Parties also filed Joint Requests that the Settlement Agreement be treated as business confidential information and be kept separate from the file of the patents involved in these *inter partes* proceedings. Joint Requests 2. 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 37 C.F.R. § 42.74(c).

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

Accordingly, for the reasons discussed above, it is:

III. ORDER

ORDERED that the Joint Motions to Terminate *Inter Partes* Review are *granted*, the petitions in IPR2024-00391, IPR2024-00443, and IPR2024-00982 are dismissed, and IPR2024-00391, IPR2024-00443, and IPR2024-00982 are *terminated*;

FURTHER ORDERED that the Joint Requests to Treat Agreement as Business Confidential and Kept Separate Under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) are *granted*, and the Settlement Agreement shall be kept separate from the files of Patent Nos. 8,141,784 B2, 8,919,654 B2, and 10,452,968 B2 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).

IPR2024-00391 (Patent 8,141,784 B2)
IPR2024-00443 (Patent 8,919,654 B2)
IPR2024-00982 (Patent 10,452,968 B2)

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