

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

IQE PLC,
Petitioner,

v.

CORNELL RESEARCH FOUNDATION INC.,
Patent Owner.

IPR2024-00609
Patent 7,250,360 B2

Before KIMBERLY MCGRAW and JULIA HEANEY,
Administrative Patent Judges.

McGRAW, *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 Proceeding (Paper 14, “Joint Motion”) due to settlement. The Parties also filed a copy of a confidential settlement agreement (Ex. 2028, “Settlement Agreement”) as well as a Joint Request to Treat Settlement Agreement as Business Confidential Information Pursuant to 35 U.S.C. § 317(b) (Paper 15, “Joint Request”).

In the Joint Motion, the Parties represent that they have “reached a Confidential Settlement Agreement” to resolve their disputes, including their disputes regarding U.S. Patent 7,250,360 B2 (“the ‘360 patent”), which is the patent challenged in this proceeding and is also at issue in the following district court cases and PTAB proceeding: *Akoustis Techs., Inc. v. Qorvo, Inc.*, 2:23-mc-8 (E.D. Tex.) and *IQE KC, LLC v. Akoustis Techs., Inc.*, No. 2:24-mc-8 (E.D. Tex.) (“the District Court Litigation”); *Qorvo, Inc. v. Cornell Research Foundation Inc.*, IPR2024-00758 (PTAB) (“the Additional PTAB Litigation”).

The Parties state that in “the Settlement Agreement, the Cornell entities, the Akoustis entities, Qorvo, and IQE KC, LLC have agreed to dismiss the District Court Litigation and the Additional PTAB Litigation.” Joint Motion, 1. The Parties state that, apart from the present IPR proceeding, the Additional PTAB Litigation, and the District Court Litigation, there are no other litigations or proceedings involving the ’360 patent between the Parties, and no litigations or proceedings involving the ’360 patent between the Parties are contemplated in the foreseeable future. *Id.* at 1–2.

The Parties also represent that Exhibit 2028 is a true and correct copy of the Parties' Settlement Agreement. *Id.* at 2. The Parties further state that there are no collateral agreements or understandings made in connection with, or in contemplation of, the termination of the proceedings beyond the Settlement Agreement. *Id.*

The Parties also request that the Settlement Agreement be treated as business confidential information, be maintained separate from the publicly available file of the involved patent, and be made available only to Federal Government agencies on written request, or to persons showing good cause on written request, pursuant to 35 U.C. § 317(b) and 37 C.F.R. § 42.74(c). Joint Request, 1–2. The Parties also request that the Board inform the Parties if anyone seeks production of the agreement and afford the Parties an opportunity to address whether such request is supported by good cause. *Id.* at 2.

II. ANALYSIS

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 patent owner, unless the Office has decided the merits of the proceeding before the request for termination is filed.” In this case, the Board has instituted review, but has not yet issued a final written decision deciding the merits of the proceeding. Under the circumstances presented here, we are persuaded it is appropriate to terminate this proceeding as to both Petitioner and Patent Owner.

We have also reviewed the Settlement Agreement (Ex. 2028), which contains confidential business information regarding the terms of the settlement, and we determine that it is appropriate to treat the Settlement

Agreement as business confidential information and to keep that document separate from the file of the patent in the above-identified proceeding pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

We deny the Parties' request that they be informed by the Board if anyone seeks production of the agreement and be afforded an opportunity to address whether such request is supported by good cause. The Board does not have a procedure to serve upon parties a request for access to the Settlement Agreement, and our regulations do not require us to do so. *See Samsung Electronics Co. v. Hardin*, IPR2022-01333, Paper 23 at 2–3 (PTAB July 26, 2023) (denying parties' request for notification and opportunity to respond); *Seimens Gamesa Renewable Energy Inc. v. General Electric Co.*, IPR2022-01279, Paper 19 at 3 (PTAB Apr. 10, 2023) (denying parties' request for notification and opportunity to respond); *OnePlus Technology (Shenzhen) Co. v. Bell Northern Research, LLC*, IPR2022-00048, Paper 10 at 4 (PTAB Jan. 28, 2022) (denying parties' request for notification and opportunity to respond); *Dell Inc. v. 3G Licensing S.A.*, IPR2020-01157, IPR2020-01158, –01159, –01160, –01161, –01162, Paper 49 at 4 (Dec. 14, 2021) (denying parties' request for notification); *VMware Inc. and Dell Technologies Inc. v. Proven Networks, LLC.*, IPR2021-00194, Paper 10 at 3 (Aug. 10, 2021) (denying request for notification and opportunity to respond). Therefore, we decline to issue an order regarding requests to access the Settlement Agreement.

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

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ORDERED that the Joint Motion to terminate the proceeding is granted, and IPR2024-00609 is *terminated*; and

FURTHER ORDERED that the Settlement Agreement (Exhibit 2028) be maintained as confidential business information and kept separate from the files of U.S. Patent No. 7,250,360 B2 and made available only in accordance with the provisions of 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

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