Trials@uspto.gov
571-272-7822

Paper 17
Date: December 31, 2024

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MEDIATEK INC.,
Petitioner,

v.

MOSAID TECHNOLOGIES, INC.,
Patent Owner.

IPR2024-00598 (Patent 7,051,306 B2)[1]
IPR2024-00599 (Patent 7,224,563 B2)
IPR2024-00600 (Patent 8,854,077 B2)
IPR2024-00719 (Patent 7,945,885 B2)

Before KEN B. BARRETT, JOHN F. HORVATH, and ELIZABETH M. ROESEL, *Administrative Patent Judges*.

HORVATH, *Administrative Patent Judge*.

TERMINATION
Due to Settlement After Institution of Trial
and
ORDER
Granting-in-part Request to File Settlement Agreement
as Business Confidential Information

35 U.S.C. § 317; 37 C.F.R. §42.74

[1] This Decision addresses issues common to the above-listed proceedings. The combined caption is for administrative convenience only and does not indicate that the above-listed proceedings have been joined.

I. INTRODUCTION

With Board authorization, Petitioner and Patent Owner (collectively, "the Parties") filed Joint Motions to Terminate the above-captioned *inter partes* review proceedings together with copies of their Confidential Settlement Agreement. Paper 17 ("Joint Motion"); Ex. 2007 ("Settlement Agreement").[2] The Parties also filed Joint Motions to Treat the Settlement Agreement as Business Confidential Information. Paper 18 ("Joint Request").

II. DISCUSSION

In the Joint Motions, the Parties represent that they have filed "a substantially identical Joint Motion in each of the cases" identified above, have "resolved their disputes concerning the patents-at-issue in the proceedings," and "now move to terminate the IPR[s]." Joint Motion 1. The Parties also represent that they have filed true and correct copies of their Settlement Agreement and that "there are no collateral agreements or understandings made in connection with or in contemplation of, the termination of these *inter partes* reviews." *Id.* at 4.

Although *inter partes* review has been instituted in each of these proceedings, all of the proceedings are at an early stage. Patent Owner has not filed a response in any proceeding, and the Board has not decided the

[2] We refer to the papers and exhibit filed in IPR2024-00600. The Parties filed similar papers and exhibits in IPR2024-00598 (Papers 17, 18; Ex. 2006), IPR2024-00599 (Papers 18, 19; Ex. 2011), and IPR2024-00719 (Papers 15, 16, Ex. 2006).

merits of any proceeding. In view of the early stage of the proceedings and the settlement between the Parties, we determine that good cause exists to terminate the proceedings.

The Parties' request to treat the Settlement Agreement filed in each proceeding as business confidential information also requests that the Settlement Agreement be "kept separate from the files of the involved patent[] and *inter partes* review proceeding, and only made available to Federal Government agencies upon written request and a finding of good cause after notice to the parties to the agreement and an opportunity for those parties to respond to the request." Joint Request 1.

We have reviewed the Settlement Agreement, find it contains confidential business information, and determine good cause exists to treat the Settlement Agreement as business confidential information. Per statute, an agreement treated as business confidential information "shall be kept separate from the file of the involved patents, and shall be made available only to Federal Government agencies on written request, or to any person on a showing of good cause." 35 U.S.C. § 317(b). Similarly, per regulation, a settlement agreement treated as business confidential information may be made available to "a Government agency on written request" or to "any other person upon written request . . . on a showing of good cause." 37 C.F.R. § 42.74(c).

Accordingly, we grant the Parties' request to treat the Settlement Agreement as business confidential information and to keep the Settlement Agreement separate from the files of the involved patents. However, we deny the Parties' requests to keep the Settlement Agreement separate from

the files of the involved *inter partes* review proceedings and to limit the Settlement Agreement's availability to only "Federal Government agencies upon written request and a finding of good cause after notice to the parties . . . and an opportunity for th[e] parties to respond." *See* Joint Request 1. As explained above, the governing statute and regulation: (1) do not require a requesting Federal Government agency to show good cause; (2) allow the Settlement Agreement to be provided to other parties upon a showing of good cause; and (3) do not require the Parties to be notified of any request or provided with an opportunity to respond to a request.

III. ORDER

For the reasons explained above, it is:

ORDERED that the Joint Motions to terminate IPR2024-00598, IPR2024-00599, IPR2024-00600, and IPR2024-00719 are *granted*, and each of these *inter partes* reviews is *terminated* with respect to both Petitioner and Patent Owner;

FURTHER ORDERED that the Parties' joint request to treat the Settlement Agreement filed in each of IPR2024-00598, IPR2024-00599, IPR2024-00600, and IPR2024-00719 as business confidential information is *granted*;

FURTHER ORDERED that the Parties' joint request to keep the Settlement Agreement filed in each of IPR2024-00598, IPR2024-00599, IPR2024-00600, and IPR2024-00719 separate from the files of the patents involved in each proceeding is *granted*;

FURTHER ORDERED that the Parties' joint request to keep the Settlement Agreement filed in each of IPR2024-00598, IPR2024-00599,

IPR2024-00600, and IPR2024-00719 separate from the files of each of these *inter partes* reviews is *denied*;

FURTHER ORDERED that the Parties' joint request to make the Settlement Agreement filed in each of IPR2024-00598, IPR2024-00599, IPR2024-00600, and IPR2024-00719 available only to Federal Government agencies upon written request and a finding of good cause and after notice to the Parties and an opportunity for the Parties to respond is *denied*; and

FURTHER ORDERED that the Settlement Agreement filed in each of IPR2024-00598, IPR2024-00599, IPR2024-00600, and IPR2024-00719 shall, pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c), be made available to Federal Government agencies upon written request or to any other person upon written request and a showing of good cause.

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For PETITIONER:

Timothy Riffe
Joseph Colaianni
Linhong Zhang
Jared Hartzman
Tim Rawson
FISH & RICHARDSON PC
riffe@fr.com
colaianni@fr.com
lwzhang@fr.com
hartzman@fr.com
rawson@fr.com

For PATENT OWNER:

David W. Higer
Jamie H. McDole
David A. Neal
WINSTEAD PC
dhiger@winstead.com
jmcdole@winstead.com
dneal@winstead.com

Kenneth J. Weatherwax
Flavio M. Rose
LOWENSTEIN & WEATHERWAX LLP
weatherwax@lowensteinweatherwax.com
rose@lowensteinweatherwax.com