

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TOYOTA MOTOR CORPORATION,
Petitioner,

v.

INFOGATION CORPORATION,
Patent Owner.

IPR2024-00754 (Patent 10,107,628 B2)
IPR2024-00756 (Patent 6,292,743 B1)¹

Before BART A. GERSTENBLITH, ERIC C. JESCHKE, and
RICHARD H. MARSCHALL, *Administrative Patent Judges*.

GERSTENBLITH, *Administrative Patent Judge*.

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

¹ Although these proceedings are not consolidated, the same issues are presented for our review and addressed in this Decision. Therefore, we exercise our discretion to issue one common decision in each proceeding. The parties are not authorized to use this combined caption.

I. DISCUSSION

Toyota Motor Corporation (“Petitioner”) and Infogation Corporation (“Patent Owner”) filed the following in each proceeding: (1) a Joint Motion to Dismiss *Inter Partes* Review Before Institution (IPR2024-00754, Paper 6; IPR2024-00756, Paper 6) based on a settlement agreement between those entities; (2) a true copy of their written settlement agreement (IPR2024-00754, Ex. 1027; IPR2024-00756, Ex. 1051); and (3) a Joint Request to Keep Separate (IPR2024-00754, Paper 7; IPR2024-00756, Paper 7). The parties indicate that they have settled all the disputes in each proceeding and jointly move to dismiss each proceeding. Motion 1.² The parties filed what they represent is a copy of their written settlement agreement and indicate that it resolves the disputes presented in each proceeding. *Id.*

Generally, the Board expects that a proceeding will terminate with respect to a petitioner after the filing of a settlement agreement. *See* 35 U.S.C. § 317(a) (“An 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.”); 37 C.F.R. § 42.72 (“The Board may terminate a trial without rendering a final written decision, where appropriate, including . . . pursuant to a joint request under 35 U.S.C. 317(a)”); *see also* Patent Trial and Appeal Board Consolidated Trial Practice Guide at 86 (Nov. 2019)³ (“The Board expects that a proceeding will terminate after the filing of a settlement agreement,

² Citations to “Motion” refer to both Motions as each contains the same substantive discussion.

³ *Available at* <https://www.uspto.gov/TrialPracticeGuideConsolidated>.

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unless the Board has already decided the merits of the proceeding.” (citing 35 U.S.C. §§ 317(a), 327)). Here, the merits of the proceedings have not yet been decided. Accordingly, we are persuaded that, under these circumstances, dismissal of these proceedings is appropriate.

Additionally, we grant the Joint Requests to treat Exhibit 1027 in IPR2024-00754 and Exhibit 1051 in IPR2024-00756 as business confidential information. *See* 35 U.S.C. § 317(b) (“At the request of a party to the proceeding, the agreement or understanding shall be 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.”); *see also* 37 C.F.R. § 42.74(c) (same).

This Decision is not a final written decision under 35 U.S.C. § 318(a).

II. ORDER

Accordingly, it is

ORDERED that each Joint Motion to Dismiss (IPR2024-00754, Paper 6; IPR2024-00756, Paper 6) is *granted*;

FURTHER ORDERED that each Joint Request to Keep Separate (IPR2024-00754, Paper 7; IPR2024-00756, Paper 7) is *granted*;

FURTHER ORDERED that each settlement agreement (IPR2024-00754, Ex. 1027; IPR2024-00756, Ex. 1051) be treated as business confidential information, kept separate from the file of the respective, above-referenced patent, 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); and

FURTHER ORDERED that these proceedings are *dismissed*.

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