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Paper 33
Date: June 5, 2025

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SONY CORPRATION,
Petitioner,

v.

OPTIMUM IMAGING TECHNOLOGIES, LLC,
Patent Owner.

IPR2024-00923 (Patent 10,873,685 B2)
IPR2024-00924 (Patent 7,612,805 B2)
IPR2024-00925 (Patent 8,451,339 B2)
IPR2024-01046 (Patent 10,877,266 B2)

Before MIRIAM L. QUINN, GARTH D. BAER, AND RUSSELL E. CASS, ADMINISTRATIVE PATENT JUDGES, *Administrative Patent Judges*.

QUINN, *Administrative Patent Judge*.

TERMINATION
Due to Settlement After Institution of Trial
35 U.S.C. § 317; C.F.R. § 42.74

I. INTRODUCTION

With the Board's authorization after an email from the parties announcing settlement, Patent Owner filed a Joint Motion to Terminate Proceeding in each of the above-identified proceedings.[1] In support of the Motion and for each proceeding, Patent Owner filed a "collateral" Patent License Agreement (Ex. 2055) and a Release Agreement (Ex. 2054) (collectively, "Settlement Agreement"), as well as a Joint Request that Settlement Agreement be Treated as Business Confidential and Kept Separate pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).[2]

II. DISCUSSION

In the Motion, the parties represent that they have reached a settlement agreement and jointly request termination of the above-identified *inter partes* review proceedings. Motion, 1. The parties further represent that their Settlement Agreement resolves all the disputes between the parties involving the above-identified patents-at-issue. *Id.*

The Board instituted trial in each of the above-identified proceedings.

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[1] In the 923 IPR, the Joint Motion is filed as Paper 31. The substantively identical motion was filed in the 924 IPR, as Paper 29, in the 925 IPR, as Paper 30, and in the 1046 IPR, as Paper 29. Hereinafter, for ease of reference, we refer to the filing as "Motion," and cite to Paper 31 filed in the 923 IPR.

[2] In the 923 IPR, the Joint Request is filed as Paper 32. The substantively identical motion was filed in the 924 IPR, as Paper 30, in the 925 IPR, as Paper 31, and in the 1046 IPR, as Paper 30. Hereinafter, for ease of reference, we refer to the filing as "Request," and cite to Paper 32 filed in the 923 IPR.

See, e.g., 923 IPR, Paper 11 and 925 IPR, Paper 10 (instituting trial on November 18, 2024); 924 IPR, Paper 10 (instituting trial on December 12, 2024); and 1046 IPR, Paper 11 (instituting trial on January 17, 2025). We have not yet decided the merits of any of these proceedings, and final written decisions have not been entered. Notwithstanding that these proceedings have moved beyond the preliminary stage, the parties have shown adequately that the termination of these proceedings is appropriate. Under these circumstances, we terminate these proceedings with respect to all parties.

The Parties also filed the Request for the Settlement Agreement to be treated as business confidential information and be kept separate from the file of the patents involved in these *inter partes* proceedings. Paper 13. After reviewing the Settlement Agreement, we find that there is confidential business information contained therein regarding the terms of settlement. We determine that the Settlement Agreement shall be treated as business confidential information pursuant to 37 C.F.R. § 42.74(c) and on the conditions specified in 35 U.S.C. § 317(b).

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:

ORDERED that for each captioned proceeding, the Motion is *granted*, and the proceeding is *terminated*; and

FURTHER ORDERED that for each captioned proceeding the Request is *granted*, and the Settlement Agreement shall be kept separate

from the files of the patent-at-issue 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).

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