

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

NL GIKEN INC.,
Patent Owner.

IPR2024-01277
Patent 9,948,968 B2

Before, MICHELLE N. WORMMEESTER, JOHN F. HORVATH, and
ANDREW L. NALVEN, *Administrative Patent Judges*.

WORMMEESTER, *Administrative Patent Judge*.

DECISION
Settlement Prior to Institution of Trial
37 C.F.R. § 42.74

I. INTRODUCTION

Petitioner filed a Petition (Paper 2) requesting *inter partes* review of U.S. Patent No. 9,948,968 B2 (Ex. 1001). Subsequently, the parties filed a joint motion to terminate this proceeding pursuant to a settlement agreement. Paper 6 (“Joint Motion to Terminate”). The parties also filed a copy of their Settlement Agreement (Ex. 1009) made in connection with the termination of the proceeding. In a concurrently filed paper, the parties jointly request the Settlement Agreement to be treated as business confidential and to be kept separate from the file of the involved patent under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c). Paper 7 (“Joint Request”). We authorized the filing of the jointly-filed papers in an e-mail dated October 28, 2024. Ex. 3001.

II. DISCUSSION

The instant proceeding is in an early stage, and the Board has not determined whether to institute trial. The parties represent that Exhibit 1009 is “a true copy of the Parties’ Settlement Agreement,” which “fully resolves all disputes relating to the ’968 Patent before the district court and the Patent Trial and Appeal Board.” Paper 6, 4; Paper 7, 2. The parties further represent that “[t]he Settlement Agreement is in writing and constitutes the Parties’ entire understanding and agreement.” Paper 6, 4–5. In view of the foregoing, we determine that it is appropriate to dismiss the Petition and terminate the proceeding.

Further, after reviewing the parties’ Settlement Agreement, 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 as business confidential information and to keep it 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).

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

III. ORDER

Accordingly, it is:

ORDERED that the Joint Motion to Terminate (Paper 6) is *granted*, the Petition (Paper 2) is *dismissed*, and the proceeding is *terminated*; and

FURTHER ORDERED that the Joint Request (Paper 7) is *granted*, and that the Settlement Agreement (Ex. 1009) shall be treated as business confidential information, kept separate from the file of the above-identified 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).

IPR2024-01277
Patent 9,948,968 B2

FOR PETITIONER:

Philip Woo
Daryl Bartow
Paul Belnap
Monte Squire
DUANE MORRIS LLP
pwwoo@duanemorris.com
dsbartow@duanemorris.com
phbelnap@duanemorris.com
mtsquire@duanemorris.com

FOR PATENT OWNER:

Scott McKeown
Gerald Hrycyszyn
Victor Cheung
WOLF GREENFIELD & SACKS, P.C.
smckeown-ptab@wolfgreenfield.com
ghrycyszyn-ptab@wolfgreenfield.com
vcheung-ptab@wolfgreenfield.com