

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO. LTD.,
Petitioner,

v.

HEADWATER RESEARCH LLC,
Patent Owner.

IPR2024-01337
Patent 8,588,110 B2

Before HYUN J. JUNG, SCOTT B. HOWARD, and
STEPHEN E. BELISLE, *Administrative Patent Judges*.

JUNG, *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 the above-identified proceeding due to settlement. Paper 17 (“Joint Motion” or “Mot.”). In support of the Joint Motion, the Parties filed a confidential Patent License Agreement (Ex. 2010, “License Agreement”),¹ as well as a Joint Request to Treat Settlement Agreement as Business Confidential Information referencing Exhibit 1052 (Paper 18) and a Joint Request to Keep Separate Pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) referencing Exhibit 2010 (Paper 19).

II. DISCUSSION

In the Joint Motion, the Parties represent that they have reached an agreement to jointly seek termination of the above-identified *inter partes* review proceeding. *See generally* Mot. The Parties represent that Exhibit 2010 is “a complete copy of all agreements between Petitioner and Patent Owner which resolve the disputes between the parties with respect to U.S. Patent No. 8,588,110 (‘Patent-in-Suit’) and this *inter partes* review challenging the Patent-in-Suit.” Paper 19, 1.

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 the patent owner, unless the Office has decided

¹ The Parties filed “[a]n inadvertently partial version” of the License Agreement as Exhibit 1052. *See* Paper 19, 1. With the Board’s authorization, the Parties filed the complete version of the License Agreement as Exhibit 2010. *Id.* The Joint Motion refers to Exhibit 1052 (*see generally* Mot.), but we understand the Parties now rely on Exhibit 2010 as supporting the Joint Motion. *See* Paper 19, 1.

the merits of the proceeding before the request for termination is filed.” Section 35 U.S.C. § 317(a) also provides that if no petitioner remains in the *inter partes* review, the Office may terminate the review.

We instituted a trial in the above-identified proceeding on March 13, 2025. Paper 9. We have not yet decided the merits of the proceeding, and a final written decision has not been entered. Notwithstanding that the proceeding has moved beyond the preliminary stage, the Parties have shown adequately that the termination of the proceeding is appropriate. Under these circumstances, we determine that good cause exists to terminate the proceeding with respect to the Parties.

After reviewing the License Agreement (Ex. 2010) and the partial version of the License Agreement (Ex. 1052), we find that the agreements contain confidential business information regarding the terms of settlement. We determine that good cause exists to treat the agreements as business confidential information pursuant to 37 C.F.R. § 42.74(c).

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

III. ORDER

In view of the above, it is

ORDERED that the Joint Motion to Terminate (Paper 17) is *granted*, the Petition is dismissed, and the above proceeding is *terminated*;

FURTHER ORDERED that the Joint Request to Treat Settlement Agreement as Business Confidential Information (Paper 18) and the Joint Request to Keep Separate Pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) (Paper 19) are *granted*; and

FURTHER ORDERED that the partial Patent License Agreement

(Ex. 1052) and the complete Patent License Agreement (Ex. 2010) shall remain designated as “Parties and Board” and “Filing Party and Board,” respectively, in the Board’s filing system, shall be made available only to Federal Government agencies on written request, or to any person on a showing of good cause, and shall be kept separate from the files of the involved patent and associated preliminary proceeding, pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

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