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Paper 16
Date: September 20, 2024

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD.,
Petitioner,

v.

ADVANCED CODING TECHNOLOGIES, LLC,
Patent Owner.

IPR2024-00372 (Patent 10,218,995 B2)[1]
IPR2024-00374 (Patent 8,090,025 B2)

Before BART A. GERSTENBLITH, NATHAN A. ENGELS, and JASON M. REPKO, *Administrative Patent Judges*.

REPKO, *Administrative Patent Judge*.

TERMINATION
Due to Settlement After Institution of Trial
Granting Joint Motions to Terminate Proceeding
Granting In Part Joint Requests to Treat Settlement Agreement as Business Confidential Information
35 U.S.C. § 317; 37 C.F.R. § 42.74

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[1] This Order is being entered in IPR2024-00372 and IPR2024-00374 because it addresses issues common to both proceedings. The parties are not authorized to use this style heading in any subsequent papers.

APPLE 1085
Apple v. Advanced Coding Techn.
IPR2025-01158

I. DISCUSSION

Petitioner Samsung Electronics Co., Ltd. and Patent Owner Advanced Coding Technologies, LLC filed the following in each proceeding (1) a Joint Motion to Terminate Proceeding (Paper 14 ("Joint Motion" or "Mot."))[2] pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. § 42.74 based on a settlement agreement between the parties that involves, among other things, the challenged patents, (2) a true copy of the parties' written settlement agreement (Ex. 2003),[3] and (3) a Joint Request to Treat Agreement as Business Confidential Information (Paper 15 ("Joint Request")). The Joint Motion indicates that the parties have settled all the disputes in this proceeding and that the parties jointly move to terminate each proceeding. Mot. 1. Collectively, the Joint Motions also state that Exhibits 2003 and 2006 are true and correct copies of a confidential written settlement agreement between the parties, and the Joint Motions state that there are no other agreements between the parties made in connection with, or in contemplation of, termination of these proceedings. *Id.* (citing Ex. 2003).

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

[2] The parties filed similar papers and exhibits in both cases. *Compare* IPR2024-00372, Papers 14, 15, *with* IPR2024-00374, Papers 16, 17. For brevity, we refer to the papers in IPR2024-00372 unless otherwise noted.
[3] The settlement agreement was filed as Exhibit 2006 in IPR2024-00374.

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)[4] ("The Board expects that a proceeding will terminate after the filing of a settlement agreement, 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, termination of these proceedings is appropriate, and the Joint Motions are granted.

Additionally, we are persuaded that the parties' settlement agreements contain business confidential information that warrants keeping the settlement agreements separate from the files of the above-referenced patents. Accordingly, we grant this part of the Joint Requests to treat Exhibits 2003 and 2006 as business confidential information, in IPR2024-00372 and IPR2024-00374, respectively. *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).

The parties also request "that the Board inform [them] if anyone seeks production of [Exhibits 2003 and 2006] and afford the parties an opportunity to address whether such request is supported by good cause." Joint Request 2. But the statute does not provide for any such notification or opportunity to respond. *See* 35 U.S.C. § 317(b). Nor does the regulation. *See* 37 C.F.R.

[4] *Available at* https://www.uspto.gov/TrialPracticeGuideConsolidated.

§ 42.74(c). Also, we see no persuasive reason or special circumstance here that would justify issuing an order that imposes these additional requirements. Thus, we deny that part of the Joint Requests.

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

II. ORDER

Accordingly, it is

ORDERED that the Joint Motions to Terminate Proceeding (IPR2024-00372, Paper 14; IPR2024-00374, Paper 16) are *granted*;

FURTHER ORDERED that the Joint Requests to Treat Agreement as Business Confidential Information (IPR2024-00372, Paper 15; IPR2024-00374, Paper 17) are *granted in part* as described above;

FURTHER ORDERED that the settlement agreement (IPR2024-00372, Ex. 2003; IPR2024-00374, Ex. 2006) be treated as business confidential information, kept separate from the file of the 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 this proceeding is terminated.

IPR2024-00372 (Patent 10,218,995 B2)
IPR2024-00374 (Patent 8,090,025 B2)

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