

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MOTOROLA MOBILITY LLC,
VIZIO, INC.,
Petitioners,

v.

MAXELL, LTD.,
Patent Owner.

IPR2022-01348*
Patent 8,170,394 B2

Before, TERRENCE W. McMILLIN, KEVIN C. TROCK, and JASON W. MELVIN, *Administrative Patent Judges*.

McMILLIN, *Administrative Patent Judge*.

ORDER

Settlement as to Motorola Mobility LLC
Conduct of the Proceeding
35 U.S.C. § 317; 37 C.F.R. §§ 42.5, 42.74

* Vizio, Inc., which filed a petition in IPR2023-00316, has been joined as a party to this proceeding.

I. BACKGROUND

On June 23, 2023, with Board authorization,¹ Petitioner Motorola Mobility LLC and Patent Owner Maxell, Ltd. filed a “Joint Motion to Terminate *Inter Partes* Review of U.S. Patent No. 8,170,394 Under 37 C.F.R. § 42.72.” Paper 22 (“Mot.”). Along with the Motion, Petitioner and Patent Owner filed the “written confidential license agreement that fully resolves this matter,” Exhibit 1021. Mot. 2. The Motion states that “Exhibit 1021 represents the entire agreement or understanding between the Parties made in connection with, or in contemplation of, the termination of this proceeding, and further, that Exhibit 1021 is a true and accurate copy of the agreement between the Parties that resolves the present proceeding.” *Id.* Petitioner and Patent Owner assert they have “fully resolve[d] this matter” and “jointly request termination.” *Id.* at 1–2.

Petitioner and Patent Owner also filed a Joint Motion to treat their agreement as business confidential information, and to maintain the filed copies of the agreements separate from the public file under 37 C.F.R. § 42.74(c). Paper 23.

In addition, on July 6, 2023, Vizio, Inc. was joined as a petitioner in this matter pursuant to a petition and motion for joinder filed in IPR2023-00316.² Paper 24.

¹ In the email granting authorization, the Board stayed this proceeding and vacated Due Date 1 of the Scheduling Order (Paper 8). Ex. 3001.

² In the Motion, “Patent Owner recognize[d] that the Board, in the event the VIZIO petition is instituted, may wish to join that petition to IPR2022-01348 rather than terminate this proceeding.” Mot. 4.

II. DISCUSSION

We have not yet decided the merits of the proceedings, and a final written decision has not been entered. Notwithstanding that the proceedings have moved beyond the preliminary stage, Petitioner and Patent Owner have shown adequately that the termination of the proceedings as to Motorola Mobility LLC is appropriate because of the resolution of their dispute. Under these circumstances, we determine that good cause exists to terminate the proceedings with respect to Motorola Mobility LLC.

After reviewing the Settlement Agreement between Petitioner and Patent Owner, we find that the Settlement Agreement (Ex. 1021) contains confidential business information regarding the terms of settlement. We determine that good cause exists to treat the Settlement Agreement between Petitioner and Patent Owner as business confidential information pursuant to 37 C.F.R. § 42.74(c).

In view of the joinder of Vizio, Inc. as a petitioner in this proceeding, we determine that it is appropriate that this proceeding shall continue. And, it is appropriate that the stay be lifted, Due Date 1 be reset, and the Scheduling Order be modified.

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

III. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that the Joint Motion to Terminate (Paper 22) is *granted* as to Motorola Mobility LLC;

FURTHER ORDERED that the proceeding is *terminated* with respect to Motorola Mobility LLC.;

FURTHER ORDERED that Vizio, Inc. will remain as Petitioner in this proceeding, and the above-captioned case will continue to proceed;

FURTHER ORDERED that the Joint Motion to Keep Confidential and Separate Under 35 U.S.C. § 317(B) and 37 C.F.R. § 42.74(C) is *granted*, and the License Agreement (Exhibit 1021) shall remain designated as “Board Only” in Board’s filing system, shall 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 patents and associated preliminary proceedings, pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c);

FURTHER ORDERED that the stay of this proceeding is lifted and this matter shall proceed;

FURTHER ORDERED that the Scheduling Order (Paper 8) is modified in the following respects only: (1) Due Date 1 is reset to August 8, 2023; (2) Due Date 2 is reset to September 7, 2023; and (3) Due Date 3 is reset to October 6, 2023; but the Scheduling Order (Paper 8) shall otherwise continue in full force and effect; and

FURTHER ORDERED that the caption of this cases is modified to eliminate the reference to “MOTOROLA MOBILITY LLC.” and to substitute “VIZIO, INC.” as set forth in the attached Exhibit. The remaining parties are directed to use this caption in all further filings.

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EXHIBIT : Sample Case Caption

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