

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

VIZIO, INC.,
Petitioner,

v.

MAXELL, LTD.,
Patent Owner.

IPR2022-01348¹
Patent 8,170,394 B2

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

McMILLIN, *Administrative Patent Judge*.

TERMINATION
Due to Settlement After Institution of Trial
35 U.S.C. § 317; 37 C.F.R. § 42.74

¹ Vizio, Inc., which filed a petition in IPR2023-00316, has been joined as party to this proceeding

I. BACKGROUND

On September 8, 2023, with Board authorization, Petitioner Vizio, Inc. 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 33 (“Mot.”). Along with the Motion, Petitioner and Patent Owner filed the “written confidential agreement that fully resolves this matter,” Exhibit 2001. Mot. 2. The Motion states that “Exhibit 2001 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 2001 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 copy of the agreement separate from the public file under 37 C.F.R. § 42.74(c). Paper 34.

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 termination of the proceedings is appropriate because of the resolution of their dispute. Under these circumstances, we determine that good cause exists to terminate the proceedings.

After reviewing the Settlement Agreement between Petitioner and Patent Owner, we find that the Settlement Agreement (Ex. 2001) 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).

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

III. ORDER

Accordingly, for the reasons discussed above, it is:

ORDERED that the Joint Motion to Terminate (Paper 33) is *granted*, and IPR2022-01348 is *terminated* with respect to Petitioner and Patent Owner pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. § 42.72; and

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) (Paper 34) is *granted*, and the Settlement Agreement (Exhibit 2001) 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) .

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