

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SENKO ADVANCED COMPONENTS, INC.,
Petitioner,

v.

US CONEC LTD.,
Patent Owner.

PGR2024-00037
Patent 11,906,794 B2

Before THOMAS L. GIANNETTI, JOHN A. HUDALLA, and
DANIEL KAZHDAN, *Administrative Patent Judges*.

KAZHDAN, *Administrative Patent Judge*.

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

I. BACKGROUND

Senko Advanced Components, Inc. (“Petitioner”) filed a Petition (Paper 1) requesting post grant review of claims 1–20 of U.S. Patent No. 11,906,794 B2 (Ex. 1001, the “’794 patent”). US Conec Ltd. (“Patent Owner”) has filed Mandatory Disclosures (Paper 4). Patent Owner has not filed a Preliminary Response.

With Board authorization, prior to receiving a decision on institution, Petitioner and Patent Owner filed a “Joint Motion to Withdraw the Petition” (Paper 6, “Joint Motion”). The Joint Motion seeks termination of this proceeding. *Id.* at 2.

The parties represent that they have settled their dispute regarding the ’794 patent in related litigation in the district court and proceedings in the International Trade Commission. *Id.* at 1–2. The parties maintain that there is good cause for granting the Joint Motion. *Id.* at 2–3.

Finally, in a separate motion, the parties jointly request that the Confidential Settlement Agreement (Ex. 1032, “Settlement Agreement”) be treated as confidential business information and kept separate from the public files, pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c). Paper 7.

II. DISCUSSION

Under 37 C.F.R. §§ 42.5 and 42.72, the Board may terminate a trial without rendering a final written decision, where appropriate, including pursuant to a joint request under 35 U.S.C. § 317(a).

The parties certify that they have complied fully with 37 C.F.R. § 42.74(b) by filing the written Settlement Agreement, reflected in Exhibit 1032, with the Board, and certify that there are no other collateral

agreements or understandings made in connection with, or in contemplation of, the termination sought. Joint Motion 1.

The parties represent that, pursuant to the Settlement Agreement, the parties have fully resolved their dispute regarding the '794 patent. Joint Motion 1–2. They further represent that based on the above, the parties do not anticipate any further litigation or proceedings between the parties involving the '794 patent. *Id.* at 2.

We find that for the reasons given by the parties, there is good cause to grant the Joint Motion to terminate this proceeding. This case is at an early stage. A Preliminary Response has not been filed. The Board has not reached a decision whether to institute a trial. “There are strong public policy reasons to favor settlement between the parties to a proceeding 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.” Consolidated Trial Practice Guide 86 (November 2019).¹

We also find that there is good cause for granting the joint request to file the Settlement Agreement as confidential. Paper 7.

III. ORDER

In consideration of the foregoing, it is hereby

ORDERED that the parties’ Joint Motion (Paper 6) is *granted* and this case is *terminated*; and

FURTHER ORDERED that the parties’ Joint Request to File Settlement Agreement as Business Confidential Information (Paper 7) is

¹ Available at <https://www.uspto.gov/TrialPracticeGuideConsolidated>.

granted, and Exhibit 1032 shall remain sealed and kept separate from the public files of the '794 patent, consistent with 37 C.F.R. § 42.74(b).

FOR PETITIONER:

Kurt James
John Schroeder
David Kim
Jonathan Pollmann
Steven Levitt
STINSON LLP
kurt.james@stinson.com
john.schroeder@stinson.com
david.kim@stinson.com
jonathan.pollmann@stinson.com
steven.levitt@stinson.com

FOR PATENT OWNER:

Jason Eisenberg
Kristina Kelly
Tyler Drye
STERNE, KESSLER, GOLDSTEIN & FOX PLLC
jasone-ptab@sternekessler.com
kckelly-ptab@sternekessler.com
tdrye-ptab@sternekessler.com