

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SONY CORPORATION,
Petitioner,

v.

FUJIFILM CORPORATION,
Patent Owner.

Case IPR2018-00876 (Patent 6,462,905 B1)
Case IPR2018-00877 (Patent 6,462,905 B1)¹

Before SALLY C. MEDLEY, GREGG I. ANDERSON, and
SHEILA F. McSHANE, *Administrative Patent Judges*.

ANDERSON, *Administrative Patent Judge*.

DECISION
Granting Joint Motion to Terminate
37 C.F.R. § 42.72

¹ With respect to any further filings, the parties are not authorized to use this caption.

INTRODUCTION

Per our email dated July 24, 2019, we authorized the filing of a motion to terminate the above identified proceedings (“’876 IPR” and “’877 IPR”). ’876 and ’877 IPRs, Ex. 3002. The ’876 and ’877 IPRs challenge claims of U.S. Patent No. 6,462,905. On July 24, 2019, Sony Corporation (“Petitioner”) and FUJIFILM Corporation (“Patent Owner”) filed a Joint Motion to Terminate Proceeding Under 35 U.S.C § 317 and Joint Request to Keep Papers Separate as Business Confidential Information (“Joint Motion to Terminate and Keep Separate”) for each proceeding. ’876 IPR, Paper 38, ’877 IPR, Paper 34. Concurrently with the filing of the Joint Motion to Terminate and Keep Separate, the parties filed a true and correct copy of a settlement agreement. ’876 IPR and ’877 IPR, Ex. 2019.

DISCUSSION

The Joint Motion to Terminate and Keep Separate sets forth the parties’ agreement that they have settled their dispute with respect to the challenged patents and have reached agreement to seek termination of the ’876 and ’877 IPRs. ’876 IPR, Paper 38, 1, ’877 IPR, Paper 34, 1. The parties assert that there “are no collateral agreements or understandings made in connection with, or in contemplation of, the termination” of the proceedings. ’876 IPR, Paper 38, 1–2, ’877 IPR, Paper 34, 1–2. The parties request termination of the ’876 and ’877 IPRs. *Id.*

The parties provide reasons why termination is proper, including that we have not “decided the merits of the proceeding before the request for termination [wa]s filed.” *Id.* at 2 (citing 35 U.S.C. § 317(a)). We agree that “[t]here are strong public policy reasons to favor settlement between the parties to a proceeding,” and “[t]he Board expects that a proceeding will terminate after the filing of a settlement agreement, unless the Board has already decided

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the merits of the proceeding.” *Id.* (citing Patent Office Trial Practice Guidelines, Federal Register Vol. 77, No. 157, p. 48768. We are persuaded that, under these circumstances, it is appropriate to terminate all pending proceedings between the parties as identified above without rendering a final written decision. *See* 35 U.S.C. § 317(a); 37 C.F.R. § 42.72.

ORDER

Accordingly, it is:

ORDERED that the joint motion to terminate the proceedings is GRANTED, and the '876 IPR and '877 IPR proceedings are hereby TERMINATED as to all parties;

FURTHER ORDERED that the parties' joint request to treat the settlement agreement as business confidential information is GRANTED, and Exhibit 2019 in the '876 IPR and '877 IPR shall be: (i) treated as business confidential information; (ii) kept separate from the files of U.S. Patent No. 6,462,905; (iii) kept confidential from any third party; (iv) filed as “BOARD AND PARTIES ONLY” as accessible only to the Board and the parties to this proceeding; and (v) made available only to Federal Government agencies on written request, or to any person on a showing of good cause, under the provisions of 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c); and

FURTHER ORDERED that a copy of this Order will be filed in the '876 IPR and '877 IPR proceedings.

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