

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HP INC., MICROSOFT CORPORATION, DELL INC.,
DELL PRODUCTS LP, LENOVO (UNITED STATES) INC., and
MOTOROLA MOBILITY LLC.,
Petitioner,

v.

NEODRON LTD.,
Patent Owner.

IPR2020-00459
Patent 8,946,574 B2

Before MIRIAM L. QUINN, PATRICK M. BOUCHER, and
SCOTT B. HOWARD, *Administrative Patent Judges*.

HOWARD, *Administrative Patent Judge*.

TERMINATION

Due to Settlement After Institution of Trial and
Granting Joint Request to Treat Settlement Agreement as
Business Confidential Information
35 U.S.C. § 317; 37 C.F.R. § 42.74

I. INTRODUCTION

HP Inc., Microsoft Corporation, Dell Inc., Dell Products LP, Lenovo (United States) Inc., and Motorola Mobility LLC., (collectively, “Petitioner”) and Neodron Ltd. (“Patent Owner”), (collectively “the Parties”), request that the above-identified *inter partes* review proceeding be terminated pursuant to a settlement. With our authorization, the Parties filed a Joint Motion to Terminate the above-identified proceeding (“Joint Motion”). Paper 24.

The Parties also filed Settlement and License Agreements (Ex. 2011; Ex. 2012; Ex. 2013; Ex. 2014; Ex. 2015, collectively “Settlement Agreements”) and a Joint Request to Keep Separate (Paper 25, “Joint Request”).

II. DISCUSSION

Under 35 U.S.C. § 317(a), “[a]n *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.” It is also provided in 35 U.S.C. § 317(a) that if no petitioner remains in the *inter partes* review, the Office may terminate the review.

In the Joint Motion, the Parties represent that they have reached an agreement to jointly seek termination of this *inter partes* review proceeding, that the filed copies of the Settlement Agreements are true copies, and there are no other collateral agreements. Joint Motion 1–3. Further, the Settlement Agreements indicate they are complete agreements. Ex. 2011, 9–10; Ex. 2012, 7; Ex. 2013, 7; Ex. 2014, 9–10; Ex. 2015, 7. The Parties also represent that their Settlement Agreements resolve all currently pending

Patent Office and District Court proceedings between the Parties involving U.S. Patent No. 8,946,574 B2 (“the ’574 patent”). Joint Motion 1–3.

We instituted a trial on the above-identified proceeding on September 14, 2020. Paper 17. We have not yet decided the merits of the proceeding, and a final written decision has not been entered. Notwithstanding that the proceeding has moved beyond the preliminary stage, the Parties have adequately shown that the termination of the proceeding is appropriate. Under these circumstances, we determine that good cause exists to terminate the proceeding with respect to the Parties.

The Parties also requested that the Settlement Agreements be treated as business confidential information and be kept separate from the file of the ’574 patent. Joint Request 1–2. After reviewing the Settlement Agreements between the Parties, we find that the Settlement Agreements contain confidential business information regarding the terms of settlement. We determine that good cause exists to treat the Settlement Agreements as business confidential information pursuant to 35 U.S.C. § 317(b) and 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 is *granted*, and IPR2020-00459 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 Request is *granted*, and the Settlement Agreements shall be kept separate from the file of the ’574

IPR2020-00459
Patent 8,946,574 B2

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).

IPR2020-00459
Patent 8,946,574 B2

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