

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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SAMSUNG ELECTRONICS CO., LTD.,  
SAMSUNG ELECTRONICS AMERICA, INC., HP INC.,  
LENOVO (UNITED STATES) INC., MOTOROLA MOBILITY LLC,  
DELL INC., and DELL PRODUCTS LP,  
Petitioner,

v.

NEODRON LTD.,  
Patent Owner.

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IPR2020-00267  
IPR2020-00653<sup>1</sup>  
Patent 8,432,173 B2

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Before MIRIAM L. QUINN, PATRICK M. BOUCHER, and  
CHRISTOPHER L. OGDEN, *Administrative Patent Judges*.

OGDEN, *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*

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<sup>1</sup> IPR2020-00635 has been joined with IPR2020-00267.

## I. INTRODUCTION

Petitioner and Patent Owner (collectively “the Parties”) have requested that the above-identified joined *inter partes* review proceeding be terminated pursuant to a settlement. On February 5, 2021, the Parties filed a Joint Motion to Terminate in the joined proceeding (“Joint Motion”). Paper 31. On February 1, 2021, we authorized the Parties, via email, to file a joint motion to terminate the joined proceeding. Joint Motion 1. The Parties also filed copies of Patent License Agreements and an Escrow Agreement (Ex. 2004; Ex. 2005; Ex. 2006; Ex. 2007, Ex. 2008; Ex. 2009; Ex. 2010; Paper 33,<sup>2</sup> collectively “Settlement Agreements”) and filed a Joint Request to Keep Separate (Paper 32, “Joint Request”) in IPR2020-00267.

## 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.” The Office may also terminate the *inter partes* review if no petitioner remains in the proceeding. *Id.*

In the Joint Motion, the Parties represent that they have reached an agreement to jointly seek termination of the joined *inter partes* review proceeding, that the filed copies of the Settlement Agreements are true copies, and there are no other collateral agreements between the parties

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<sup>2</sup> Petitioner filed Paper 33 as a paper instead of as an exhibit. Although evidences such as settlement agreements must be filed as exhibits, we determine this to be harmless error. *See* 37 C.F.R. § 42.63(a) (“Evidence consists of affidavits, transcripts of depositions, documents, and things. All evidence must be filed in the form of an exhibit.”).

made in connection with, or in contemplation of, the termination. Joint Motion 1–4. Further, the Settlement Agreements indicate they are complete agreements. Ex. 2004, 12; Ex. 2005, 9–10; Ex. 2006, 9–10; Ex. 2007, 7; Ex. 2008, 7; Ex. 2009, 12; Ex. 2010, 13. The Parties also represent that their Settlement Agreements resolve all currently pending Patent Office and District Court proceedings between the Parties involving Patent 8,432,173. Joint Motion 1–4.

We instituted a trial on the joined proceeding on September 15, 2020. Paper 20. We have not yet decided the merits of the joined proceeding, and a final written decision has not been entered. Notwithstanding that the joined proceeding has moved beyond the preliminary stage, the Parties have shown that the termination of the joined proceeding is appropriate. Under these circumstances, we determine that good cause exists to terminate the joined 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 Patent 8,432,173. Joint Request 1–2. After reviewing the Settlement Agreements between the Parties, we find that they 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

For the reasons discussed above, it is

ORDERED that the Joint Motion is *granted*, and the joined proceedings IPR2020-00267 and IPR2020-00653 are *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 Patent 8,432,173, 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).

IPR2020-00267, IPR2020-00653  
Patent 8,432,173 B2

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