

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG DISPLAY CO., LTD. and APPLE INC.,
Petitioner,

v.

SOLAS OLED LTD.,
Patent Owner.

IPR2020-00320¹
Patent 7,446,338 B2

APPLE INC.,
Petitioner,

v.

SOLAS OLED LTD.,
Patent Owner.

IPR2020-01275
Patent 7,446,338 B2

Before SALLY C. MEDLEY, JESSICA C. KAISER, and JULIA HEANEY,
Administrative Patent Judges.

KAISER, *Administrative Patent Judge.*

¹ Apple Inc., which filed a petition in IPR2020-01275, has been joined as a petitioner in IPR2020-00320.

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ORDER
Settlement as to Apple Inc.
Termination Due to Settlement After Institution of Trial
35 U.S.C. § 317; 37 C.F.R. § 42.74

I. INTRODUCTION

Samsung Display Co., Ltd. (“Samsung”) filed a Petition seeking institution of an *inter partes* review of claims 1–3 and 5–13 of U.S. Patent No. 7,446,338 B2 (Ex. 1001, “the ’338 patent”). Paper 1.² After reviewing the Petition (Paper 1) and Patent Owner’s preliminary response (Paper 6), we instituted an *inter partes* review. Paper 9.

After institution, Apple Inc. (“Apple”), filed a petition and a joinder motion in IPR2020-01275, requesting that Apple be joined as a petitioner in IPR2020-00320. *Apple Inc. v. Solas OLED, Ltd.*, IPR2020-01275, Paper 1 (petition), Paper 3 (joinder motion). After considering the parties’ papers, we instituted trial in IPR2020-01275, granted Apple’s joinder motion, and added Apple as a petitioner to IPR2020-00320. *Apple Inc. v. Solas OLED, Ltd.*, IPR2020-01275, Paper 7 (Institution Decision). In addition, we entered a copy of that decision in IPR2020-00320. Paper 24.

On March 2, 2021, pursuant to our authorization, Petitioner Apple and Patent Owner Solas OLED, Ltd. (“Solas”) filed a Joint Motion to Terminate as to Petitioner Apple. Paper 29 (“Motion” or “Mot.”). Apple and Solas also filed a copy of a settlement agreement (Ex. 2009), along with an authorized joint request to treat the settlement agreement as business

² Unless otherwise indicated, all Paper numbers referenced herein refer to IPR2020-00320.

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confidential information and to keep it separate under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) (Paper 30).

In the Motion, Apple and Solas state that they have settled their dispute with respect to IPR2020-00320 and IPR2020-01275, and that the related district court litigation styled *Solas OLED Ltd. v. Apple Inc.*, 6:19-cv-00537-ADA (W.D. Tex.) has been dismissed. Mot. 2.

They also submit that Confidential Exhibit 2009 is a true copy of the settlement agreement and there are no collateral agreements made in connection with, or in contemplation of, the termination of the *inter partes* review. *Id.* at 1.

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.” Any agreement or understanding “made in connection with, or in contemplation of, the termination of an *inter partes* review” must be in writing, and a true copy of any such documents must be filed in the Office before termination. *Id.* § 317(b); *accord* 37 C.F.R. § 42.74(b).

Because the moving parties (Apple and Solas) represent that they have complied with the applicable requirements, we terminate the *inter partes* review with respect to Petitioner Apple. *See* 35 U.S.C. § 317(a); 37 C.F.R. § 42.74. We also grant the parties’ request to treat the settlement agreement (Exhibit 2009) as business confidential information. *See* 35 U.S.C. § 317(b); 37 C.F.R. § 42.74(c).

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Samsung, the original Petitioner in IPR2020-00320, is not a party to the settlement agreement and did not join the Motion. Accordingly, IPR2020-00320 remains pending as to Petitioner Samsung Display Co., Ltd.

ORDER

Accordingly, it is:

ORDERED that the Joint Motion to Terminate with respect to Apple only is granted in IPR2020-00320;

FURTHER ORDERED that the case caption for future submissions in IPR2020-00320 shall not list Apple as a petitioner;

FURTHER ORDERED that the settlement agreement (Exhibit 2009) be treated as business confidential information and be kept separate from the files of the involved U.S. Patent No. 7,446,338 B2;

FURTHER ORDERED this paper does not constitute a final written decision pursuant to 35 U.S.C. § 318(a); and

FURTHER ORDERED that IPR2020-01275 be terminated under 37 C.F.R. § 42.72.

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