

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD., AND
SAMSUNG ELECTRONICS AMERICA, INC.,
Petitioner,

v.

SOLAS OLED LTD.,
Patent Owner.

IPR2021-00591
Patent 7,868,880 B2

Before SALLY C. MEDLEY, JO-ANNE M. KOKOSKI, and
JULIA HEANEY, *Administrative Patent Judges*.

HEANEY, *Administrative Patent Judge*.

TERMINATION
Due to Settlement After Institution of Trial
Granting Joint Request to Keep Separate
35 U.S.C. § 317; 37 C.F.R. § 42.74

I. INTRODUCTION

On August 12, 2022, with Board authorization, the parties filed a Joint Motion to Terminate (Paper 22, “Joint Motion”). With the Joint Motion, the parties filed a Patent License Agreement and Release Agreement (Exhibit 1015) and their Escrow Agreement (Exhibit 1016) (collectively “Settlement Agreement”) that resolves the disputes between the parties related to the above-identified proceeding. Joint Motion 1. The parties also filed a Joint Request to Keep Separate (Paper 23, “Joint Request”) that requests the Board to treat the Settlement Agreement as business confidential information and to keep it separate from the publicly available files in the above-identified proceeding. Paper 23, 1.

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 the above-identified proceeding, the filed copy of the Settlement Agreement is a true copy, and “[t]here are no other collateral agreements between the parties made in connection with, or in contemplation of, the termination sought.” Joint Motion 1. Further, the parties represent that they filed all agreements between themselves, including all collateral agreements referred to, made in connection with, or in contemplation of, the termination of this proceeding, as 35 U.S.C.

§ 317(b) requires.

The Board generally expects that a case “will terminate after the filing of a settlement agreement, unless the Board has already decided the merits.” *Consolidated Trial Practice Guide*, 86 (Nov. 2019); *see also* 35 U.S.C. § 317(a); 37 C.F.R. §§ 42.72, 42.74. The Board has not decided the merits of this proceeding, and this proceeding involves no other parties. Accordingly, under these circumstances, we determine that good cause exists to terminate this proceeding. *Id.*

Further, we find that the Settlement Agreement contains confidential business information regarding the terms of settlement. We determine that good cause exists to treat the Settlement Agreement as business confidential information and keep it separate from the file of Patent 7,868,880 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 IPR2021-00591 is *terminated*; and

FURTHER ORDERED that the Joint Request is *granted*, and the Settlement Agreement shall be kept separate from the file of Patent 7,868,880, 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).

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