

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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SAMSUNG DISPLAY CO., LTD.,  
Petitioner

v.

JOLED INC.,  
Patent Owner

Case No. IPR2021-00677

Patent No. 10,198,992

**JOINT MOTION TO TERMINATE PROCEEDING  
AND  
JOINT REQUEST TO TREAT SETTLEMENT AGREEMENT  
AS BUSINESS CONFIDENTIAL INFORMATION**

Pursuant to 35 U.S.C. § 317, 37 C.F.R. §§ 42.72 and 42.74, and the Board's authorization of April 30, 2021, Petitioner Samsung Display Co., Ltd. and Patent Owner JOLED Inc. jointly move to terminate the present *inter partes* review proceeding in light of the settlement of their dispute regarding U.S. Patent No. 10,198,992 ("the '992 patent"); and jointly request to treat as business confidential information the copy of the settlement agreement filed along with this paper (Confidential Exhibit 1029).

## **I. PROCEDURAL BACKGROUND**

This proceeding is in its preliminary phase, as the Board has yet to issue a decision on institution. The Petition was filed on March 23, 2021. Paper No. 1. Patent Owner's preliminary response is due on September 26, 2021. Paper No. 3.

On April 27, 2021, Petitioner and Patent Owner entered into a settlement agreement that resolves their dispute regarding the '992 patent. *See* Confidential Exhibit 1029. The parties contacted the Board the next day by email, to request authorization to file a joint motion to terminate and joint request to file the settlement agreement as business confidential information. The Board authorized these filings in a responsive email on April 30, 2021.

## II. JOINT MOTION TO TERMINATE THE PROCEEDING

Petitioner and Patent Owner jointly request that this *inter partes* review be terminated, in light of the settlement of their dispute regarding the '992 patent.

Under 37 C.F.R. § 42.72, “[t]he Board may terminate a trial without rendering a final written decision, where appropriate, including . . . pursuant to a joint request under 35 U.S.C. 317(a) or 327(a).” *See also* 37 C.F.R. § 42.74 (“[t]he parties may agree to settle any issue in a proceeding . . .”). Additionally, 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.” As the Board has explained:

There are strong public policy reasons to favor settlement between the parties to a proceeding. . . . The Board expects that a proceeding will terminate after the filing of a settlement agreement, unless the Board has already decided the merits of the proceeding. 35 U.S.C. §§ 317(a), 327.

Consolidated Trial Practice Guide (November 2019), page 86, § II.N.

Termination of the present *inter partes* review is appropriate because the moving parties have settled their dispute regarding the '992 patent and the Board has not yet decided the merits of the proceeding.

A true and complete copy of the settlement agreement is being filed along with this paper, consistent with the requirements of 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b). *See* Confidential Exhibit 1029. The parties certify that there are no other agreements or understandings between the parties, including any collateral agreements, made in connection with, or in contemplation of, the termination of this proceeding.<sup>1</sup>

Therefore, Petitioner and Patent Owner respectfully submit that this motion to terminate the proceeding should be granted.

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<sup>1</sup> Although the settlement agreement of Confidential Exhibit 1029 anticipates that the parties will subsequently enter into another agreement, no such other agreement has been entered into as of this date. Therefore, the Parties submit that they have complied with the requirements of 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b), given that Confidential Exhibit 1029 fully comprises the binding settlement agreement pursuant to which the parties are requesting termination.

### **III. JOINT REQUEST TO TREAT SETTLEMENT AGREEMENT AS BUSINESS CONFIDENTIAL INFORMATION**

Petitioner and Patent Owner further jointly request that the settlement agreement filed as Confidential Exhibit 1029 be treated as business confidential information and be kept separate from the publicly available files of the involved patent.

35 U.S.C. § 317(b) provides that:

At the request of a party to the proceeding, the agreement or understanding shall be treated as business confidential information, shall be kept separate from the file of the involved patents, and shall be made available only to Federal Government agencies on written request, or to any person on a showing of good cause.

Likewise, 37 C.F.R. § 42.74(c) provides that:

A party to a settlement may request that the settlement be treated as business confidential information and be kept separate from the files of an involved patent or application. The request must be filed with the settlement. If a timely request is filed, the settlement shall only be available:

- (1) To a Government agency on written request to the Board; or
- (2) To any other person upon written request to the Board to make the settlement agreement available, along with the fee specified in § 42.15(d) and on a showing of good cause.

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