

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

STMICROELECTRONICS, INC.,
Petitioner,

v.

NEODRON LTD.,
Patent Owner.

IPR2021-01160 (Patent 8,749,251 B2)
IPR2021-01161 (Patent 8,749,251 B2)¹

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
35 U.S.C. § 317(a),(b); 37 C.F.R. §§ 42.72, 42.74

¹ This Order addresses issues that are the same in each of the above-identified proceedings. We exercise our discretion to issue one order for all of the above-identified proceedings. The proceedings have not been consolidated, and the parties are not authorized to use this caption format.

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I. INTRODUCTION

With the Board’s prior authorization, Petitioner STMicroelectronics, Inc. and Patent Owner Neodron Ltd. (collectively “the Parties”) filed, in each of the above-identified proceedings, a Joint Motion to Terminate *Inter Partes* Review. See Paper 10 (“Motion”); Ex. 2001.² The Parties also filed a true copy of a release agreement (Ex. 2002, “Settlement Agreement”) and a Joint Request to Keep Separate. See Paper 9 (“Request”).

II. DISCUSSION

The Motion states: “Patent Owner Neodron Ltd. and Petitioner STMicroelectronics, Inc. have reached a settlement.” Motion 1. The Motion further states: “a true copy of the settlement agreement that resolves the disputes in the above-captioned *inter partes* review relating to the Patent-in-Suit is filed herewith as an exhibit,” and “[t]here are no other collateral agreements between the parties made in connection with, or in contemplation of, the termination sought.” *Id.* at 1–2. The Motion further states that “[t]he parties jointly request that the Board terminate this *inter partes* review of the Patent-in-Suit, in its entirety.” *Id.* at 2; see also *id.* at 1 (“the parties jointly request termination of the *inter partes* review of U.S. Patent No. 8,749,251 (‘Patent-in-Suit’).”).

Generally, 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. PTAB Consolidated Trial Practice Guide, 86

² For purposes of expediency, we cite to papers and exhibits filed in IPR2021-01160, unless otherwise noted. The Parties filed similar papers and exhibits in each of the above-identified proceedings.

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(November 2019).³ Here, although the Board has instituted *inter partes* review of the challenged patents, the Board has not decided the merits of these proceedings. Under these circumstances, we grant the Motion to terminate in each proceeding. *See* Motion 2 (“Because all parties request termination and the Board has not yet decided the merits of the proceeding, the Board should terminate the proceeding.”).

The Parties also “jointly request that the Board treat the settlement agreement as business confidential information and keep it separate from the files of this proceeding and the files of the Patent-in-Suit.” Request 2. The Parties further “request that the settlement agreement ‘be made available only to Federal Government agencies on written request, or to any person on a showing of good cause’ in accordance with 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74.” *Id.*

After reviewing the Settlement Agreement between the Parties, we find that the Settlement Agreement contains confidential business information regarding the terms of settlement. Thus, we determine that good cause exists to treat the Settlement Agreement (Ex. 2002) between the Parties as business confidential information under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c), to keep it separate from the files of the involved patent and associated preliminary proceeding, and to limit its availability as requested by the Parties.

III. ORDER

In view of the foregoing, it is:

³ Available at <https://www.uspto.gov/TrialPracticeGuideConsolidated>.

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ORDERED that the Joint Motion to Terminate *Inter Partes* Review in each of the above-identified proceedings is *granted*, and IPR2021-01160 and IPR2021-01161 are *terminated* with respect to Petitioner and Patent Owner, pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. § 42.72;

FURTHER ORDERED that the Joint Request to Keep Separate in each of the above-identified proceedings is *granted*; and

FURTHER ORDERED that the Settlement Agreement in each proceeding shall be kept separate from the files of U.S. Patent No. 8,749,251 B2, and will be made available only under the provisions of 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

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