

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ALIGN TECHNOLOGY, INC.,
Petitioner,

v.

3SHAPE A/S,
Patent Owner.

IPR2022-00144 and IPR2022-00145¹
Patent RE48,221 E

Before SALLY C. MEDLEY, JAMES J. MAYBERRY, and
JASON M. REPKO, *Administrative Patent Judges*.

MEDLEY, *Administrative Patent Judge*.

DECISION

Settlement Prior to Institution of Trial and
Granting-In-Part and *Denying-In-Part* Joint Request to Treat Settlement
Agreement as Business Confidential Information
37 C.F.R. § 42.74

¹ This Order addresses issues that are the same in each of the identified proceedings. We exercise our discretion to issue one Order to be filed in each proceeding. The parties are not authorized to use this style heading in subsequent papers.

I. INTRODUCTION

With the Board’s authorization, Petitioner filed a Motion to Dismiss Petition in each of the above-captioned proceedings. Paper 9 (“Motion”).² Petitioner represents that Patent Owner does not oppose the Motion. Motion 1. Along with the Motion, Petitioner filed a copy of a Settlement Agreement between Petitioner and Patent Owner. Ex. 1049. The parties also filed a Joint Request that the Settlement Agreement be treated as business confidential information and kept separate from the file of U.S. Patent No. RE48,221 E (“the ’221 patent”). Paper 10 (“Joint Request”).

II. DISCUSSION

In the Motion, Petitioner represents that the Settlement Agreement resolves the parties’ disputes involving the ’221 patent and requests that the proceeding be terminated. Motion 1. Petitioner also represents that the Settlement Agreement is a true copy of the agreement or understanding made in connection with, or in contemplation of, the termination of the above-captioned proceedings. *Id.*

The proceedings are at an early stage, and we have not yet decided whether to institute a trial in the proceedings. In view of the early stage of the proceedings and the settlement between the parties, we determine that good cause exists to dismiss the petitions for *inter partes* review and terminate the proceedings.

In the Joint Request, the parties request that the Settlement Agreement be treated as business confidential information and kept separate from the

² The relevant papers and exhibits filed in the above-captioned proceedings are substantively the same. We cite to the record in IPR2022-00144, unless otherwise indicated.

file of the '221 patent. Joint Request 1. After reviewing the Settlement Agreement, we find that it contains confidential business information regarding the terms of settlement. Thus, good cause exists to treat the Settlement Agreement as business confidential information pursuant to 37 C.F.R. § 42.74(c), and we grant the parties' request in that regard.

In the Joint Request, the Parties also “jointly request that the Board order that in the event a person or entity makes a written request, as stated in 37 C.F.R. § 42.74(c)(1)-(2), for access to the settlement agreement, that any such written request be served upon the parties on the day the written request is provided to the Board.” *Id.* The parties have provided no basis for granting this request. Thus, we deny this part of the parties' request.

This Order does not constitute a final written decision pursuant to 35 U.S.C. § 318(a).

III. ORDER

Accordingly, it is:

ORDERED that the Motions to Dismiss Petitions are *granted*;

FURTHER ORDERED that the Joint Requests to treat the Settlement Agreement as business confidential information and be kept separate are *granted-in-part and denied-in-part*; and

FURTHER ORDERED that the proceedings are *terminated*.

IPR2022-00144 and IPR2022-00145
Patent RE48,221 E

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