

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,
Petitioner,

v.

SCRAMOGE TECHNOLOGY LTD.,
Patent Owner.

IPR2022-00284 (Patent 9,997,962 B2)
IPR2022-00385 (Patent 9,843,215 B2)¹

Before JAMESON LEE, KARL D. EASTHOM, BRIAN J. McNAMARA,
and AARON W. MOORE, *Administrative Patent Judges*.²

EASTHOM, *Administrative Patent Judge*.

TERMINATION

Due to Settlement After Institution of Trial
35 U.S.C. § 317; 37 C.F.R. § 42.74

¹ This Order addresses the same issue for the above-identified proceedings. The parties must obtain prior authorization to use this heading style.

² This is not an expanded panel. Judges Lee, Easthom, and Moore are the panel for IPR2022-00284. Judges Lee, Easthom, and McNamara are the panel for IPR2022-00385.

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I. INTRODUCTION

On September 1, 2022, with the Board’s authorization, Google LLC (“Petitioner”) and Scramoge Technology Ltd. (“Patent Owner”) (collectively, “the parties”) filed a Joint Motion to Terminate in each of the above-identified proceedings due to settlement of the parties’ disputes. Paper 17 (“Joint Motion”).³ With the Joint Motion, the parties filed, in each of the above-identified proceedings, a copy of their Settlement Agreement (Ex. 1030) that resolves the disputes between the parties related to the above-identified proceedings. Joint Motion 1. The parties also filed, in each of the above-identified proceedings, a Joint Request to Keep Separate 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 proceedings. Paper 18 (“Joint Request”), 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.” Prior to termination, the parties must file true copies of “[a]ny agreement or understanding between the patent owner and a petitioner, including any collateral agreements referred to in such agreement or understanding, made in connection with, or in contemplation of, the termination of an inter partes review.” 35 U.S.C. § 317(b).

³ References are to Papers and Exhibits in IPR2022-00284; however, reference to Papers 17 (or Joint Motion) and 18 (or Joint Request) include Papers 19 and 20 in IPR2022-00385, respectively. Reference to Exhibit 1030 (or Settlement Agreement) includes Exhibit 1035 in IPR2022-00385.

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In the Joint Motion, the parties represent that they have reached an agreement to seek termination of the above-identified *inter partes* review proceedings under 35 U.S.C. § 317(a) and 37 C.F.R. § 42.74. Joint Motion 1. The parties indicate that “a true copy of the Parties’ settlement agreement (including any other related agreement between the Parties) has been filed as Exhibit 1030.” *Id.* The parties also certify “[t]here are no other collateral agreements or understandings, oral or written, between the parties made in connection with, or in contemplation of, the termination of [these proceedings].” *Id.* at 3. The Joint Motion and Settlement Agreement collectively show that 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 these proceedings, 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)⁴; *see also* 35 U.S.C. § 317(a); 37 C.F.R. § 42.72. The Board has not decided the merits of these proceedings, and these proceedings involve no other parties. Accordingly, under the circumstances present here, it is appropriate to terminate the instant proceedings. *See* 35 U.S.C. § 317(a); 37 C.F.R. §§ 42.72(a, b), 42.74.

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 between the parties as business confidential information and to keep it separate from the files of the

⁴ Available at <https://www.uspto.gov/TrialPracticeGuideConsolidated>.

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patent in the above-identified proceedings pursuant to 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

For the reasons discussed above, it is

ORDERED that the Joint Motion is *granted* and these proceedings are terminated; and

FURTHER ORDERED that the Joint Request is *granted*, and that the Settlement Agreement shall be kept separate from the files of the above-listed patents, 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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