

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

XILINX, INC.,
Petitioner,

v.

POLARIS INNOVATIONS LIMITED,
Patent Owner.

IPR2023-00513 (Patent 7,532,523 B2)
IPR2023-00516 (Patent 6,157,589)¹

Before JEAN R. HOMERE, BARBARA A. PARVIS, and
NORMAN H. BEAMER, *Administrative Patent Judges*.

PER CURIAM.

TERMINATION

Due to Settlement after Institution of Trial and
Granting Request to File Settlement Agreement
as Business Confidential Information
35 U.S.C. § 317; 37 C.F.R. §42.74

¹ This Order addresses issues that are the same in each of the above captioned proceedings. We exercise our discretion to issue one Order to cover all the proceedings. The parties, however, are not authorized to use this style heading in subsequent papers.

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I. INTRODUCTION

On February 8, 2024, with the Board’s authorization, Petitioner and Patent Owner (collectively, “the Parties”) filed a Joint Motion to Terminate Proceeding. Paper 18 (“Joint Motion”).² Along with the Joint Motion, the Parties filed a copy of a Highly Confidential Patent License, Tolling Stand-Still and Settlement Agreement. Ex. 1016 (“Settlement Agreement”). The Parties jointly request to file the Settlement Agreement as business confidential information and keep it separate from the file of U.S. Patent No. 7,532,523 B2 (“the ’523 patent”). Paper 20 (“Joint Request”).

I. 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.” 35 U.S.C. § 317(a) also provides that if no petitioner remains in the *inter partes* review, the Office may terminate the review.

In the Joint Motion, the Parties represent that the Settlement Agreement resolves their disputes involving the ’523 patent. Joint Motion 1. The Parties also represent that they have filed a true and correct copy of the Settlement Agreement (*id.*) and that “[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 this proceeding.” *Id.* The Parties further “represent that their entire agreement in connection

² For purposes of expediency, we cite to papers and an exhibit filed in IPR2023-00513, unless otherwise noted. The Parties filed similar papers and exhibit in IPR2023-00516.

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with the termination of this proceeding is embodied in the [Settlement] Agreement.” *Id.*

We instituted trial for IPR2023-00513 on September 14, 2023. *See* Paper 12. We have not yet decided the merits of the proceeding, and a final written decision has not been entered. Notwithstanding that the proceeding has moved beyond the preliminary stage, the Parties have shown adequately that termination of the proceeding is appropriate. Under these circumstances, we determine that good cause exists to terminate the proceeding with respect to the Parties.

The Parties jointly request that the Settlement Agreement be treated as business confidential information and kept separate from the file of the ’523 patent. Joint Request 1. We have reviewed the Settlement Agreement, which contains confidential business information regarding the settlement terms, and we determine that good cause exists to treat the Settlement Agreement as business confidential information pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) and keep it separate from the files of the ’523 patent and this proceeding. Accordingly, we grant this aspect of the Parties’ Joint Request.

The Parties also “that they be notified of [a] third party request and be given the opportunity to respond” if the “third party submits a written request to the Board for a copy of the settlement agreement along with a purported showing of good cause.” Joint Req. 2. However, neither the statute nor the regulation provides for any such notification, and the Parties have not provided any reason or special circumstance that would justify issuing an order that purports to impose an additional requirement. Accordingly, we deny that portion of the Parties’ Joint Request.

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II. ORDER

Accordingly, it is:

ORDERED that the Joint Motions to Terminate are *granted*, and IPR2023-00513 and IPR2023-00516 are *terminated* with respect to Petitioner and Patent Owner; and

FURTHER ORDERED that the Parties' joint requests to treat the Settlement Agreement as business confidential information are *granted*, and the Settlement Agreement shall be kept separate from the files of U.S. Patent Nos. 7,532,523 B2 and 6,157,589, and made available only to Federal Government agencies on written request, or to any person on a showing of good cause, pursuant to 37 C.F.R. § 42.74(c).

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