

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ams AG, AMS-TAOS USA INC.,
SAMSUNG ELECTRONICS AMERICA, INC., and
SAMSUNG ELECTRONICS CO. LTD.,
Petitioner,

v.

511 INNOVATIONS, INC.,
Patent Owner.

Case IPR2016-01810, Patent 6,307,629 B1
Case IPR2016-01818, Patent 7,113,283 B2
Case IPR2016-01819, Patent 6,915,955 B2

Before KARL D. EASTHOM, DAVID C. MCKONE, KERRY BEGLEY,
and JOHN A. HUDALLA, *Administrative Patent Judges*.¹

PER CURIAM.

JUDGMENT

Termination of the Proceeding
35 U.S.C. § 317; 37 C.F.R. §§ 42.72, 42.74

¹ This is not a decision by an expanded panel of the Board. Judges Easthom, McKone, and Hudalla are paneled on IPR2016-01810 and IPR2016-01819. Judges Easthom, Begley, and Hudalla are paneled on IPR2016-01818.

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On April 25, 2017, the parties filed, in each of the instant proceedings, a joint motion to terminate the proceeding pursuant to 35 U.S.C. § 317 and 37 C.F.R. §§ 42.72 and 42.74. Paper 19. The parties submit that termination is appropriate because they have settled and “fully resolve[d]” their dispute regarding the patent-at-issue in each proceeding. *Id.* at 2–3, 6.

Along with the motion, the parties filed in the record of each proceeding what they represent to be a “true and complete” copy of their settlement agreement, pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b). *Id.* at 2; *see* IPR2016-01810, Ex. 2003; IPR2016-01818, Ex. 2002; IPR2016-01819, Ex. 2002. In addition, the parties filed a joint request to have the settlement agreement treated as business confidential information under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c). Paper 20. For the reasons given below, we grant the joint motion to terminate and the joint request to treat the settlement agreement as business confidential information in each of the instant proceedings.

Under 35 U.S.C. § 317(a), an instituted *inter partes* review “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). Since institution of each of the instant *inter partes* review proceedings, Patent Owner has not filed a Response, Petitioner has not filed a Reply, and no oral hearing has been held. As a result, the Board has not yet decided the merits of any of the proceedings. Moreover, we determine that terminating each proceeding promotes efficiency and minimizes unnecessary costs. Upon consideration of the facts before us, we determine

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that it is appropriate to terminate each proceeding and enter judgment without rendering a final written decision. *See* 35 U.S.C. § 317(a); 37 C.F.R. § 42.72.

In addition, 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b) require that “[a]ny agreement or understanding” between the parties “made in connection with, or in contemplation of, the termination of” an *inter partes* review proceeding “shall be in writing and a true copy” “shall be filed” with the Board “before the termination” of the proceeding. 35 U.S.C. § 315(b); 37 C.F.R. § 42.74(b). The agreement or understanding filed with the Board must include “any collateral agreements referred to in such agreement or understanding.” 35 U.S.C. § 315(b). We denied without prejudice an earlier-filed joint motion to terminate each of the instant proceedings based on a failure to comply with these requirements, because the version of the settlement agreement previously filed with the Board was incomplete, with portions of Exhibits G and H omitted. Paper 18. The version of the agreement filed with the present motion to terminate in each proceeding, however, appears to include the entirety of these exhibits. *See* IPR2016-01810, Ex. 2003; IPR2016-01818, Ex. 2002; IPR2016-01819, Ex. 2002. Based on our review of the filed settlement agreement and the parties’ certification that there are no other agreements or understandings between them, we determine that the parties have complied with the requirements of 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b). *See* Paper 19, 2.

Turning to the joint request to file the settlement agreement as business confidential information, we determine that the parties have complied with the requirements of 37 C.F.R. § 42.74(c) to have their

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settlement agreement treated as business confidential information that is kept separate from the files of the patent-at-issue in each proceeding.

Accordingly, the agreement shall be made available only to a Government agency on written request to the Board or to any other person upon a showing of good cause and compliance with the other requirements of 37 C.F.R. § 42.74(c)(2).

ORDER

For the foregoing reasons, it is:

ORDERED that the Joint Motion to Terminate (Paper 19), in each of the above-captioned proceedings, is *granted*;

FURTHER ORDERED that the Joint Request to File Settlement Agreement as Business Confidential Information and to Maintain Said Agreement Separate from the Public File (Paper 20), in each of the above-captioned proceedings, is *granted*;

FURTHER ORDERED that the record copies of parties' settlement agreement (IPR2016-01810, Ex. 2003; IPR2016-01818, Ex. 2002; IPR2016-01819, Ex. 2002) shall continue to be designated as "Board Only" in the Patent Trial and Appeal Board End to End (PTAB E2E) system;

FURTHER ORDERED that the parties' settlement agreement shall be made available only to a Government agency on written request to the Board or to any other person upon a showing of good cause and compliance with the other requirements of 37 C.F.R. § 42.74(c)(2); and

FURTHER ORDERED that each of IPR2016-01810, IPR2016-01818, and IPR2016-01819 is terminated pursuant to 35 U.S.C. § 317.

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