

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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VALENS SEMICONDUCTOR LTD.,  
Petitioner,

v.

VESPER TECHNOLOGY RESEARCH, LLC,  
Patent Owner.

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Case IPR2017-00865  
Patent 6,611,247 B1

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Before KEVIN F. TURNER, JASON J. CHUNG, and  
MELISSA A. HAAPALA, *Administrative Patent Judges*.

HAAPALA, *Administrative Patent Judge*.

DECISION

*Joint Motion to Terminate*

*35 U.S.C. § 317 and 37 C.F.R. §§ 42.72, 42.74*

Pursuant to our authorization, on May 10, 2017, the parties filed a joint Motion to Terminate Proceedings and Request to File Settlement Agreement as Business Confidential Information. Paper 6. Along with the motion, the parties filed a copy of a document they represent

is a true copy of the settlement agreement between the parties as Exhibit 2001. *Id.* at 2. The parties represent that there are no collateral agreements made in connection with the termination of this *inter partes* review. *Id.* The parties request the settlement agreement (Ex. 2001) be treated as business confidential information pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c). *Id.* at 3.

The parties may agree to settle any issue in a proceeding pursuant to a written agreement, a true copy of which shall be filed with the Board before termination of the trial. 37 C.F.R. § 42.74(a)–(b). Any 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 shall be in writing and a true copy of such agreement or understanding shall be filed in the Office before the termination of such review as between the parties. 35 U.S.C. § 317(b). Although the parties represent that they filed a “true copy” of the settlement agreement with the joint Motion to Terminate, the parties failed to include the associated exhibits (Exhibits A-E) referenced in the agreement. *See* Ex. 2001. Thus, the settlement agreement submitted by the parties is not a “true copy” of the entire agreement.

Because the parties did not comply with 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c), the joint Motion to Terminate this proceeding is denied. The settlement agreement (Ex. 2001) will be expunged. Accordingly, the request to treat the settlement agreement (Ex. 2001) as business confidential information is denied as moot.

However, under the circumstances identified by the parties, it may be appropriate to terminate the proceeding. Therefore, we authorize the parties

to file a revised joint motion to terminate this proceeding. As required by 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b), the motion must be accompanied by a true copy of the settlement agreement, including any associated exhibits, and must include a statement certifying that there are no other collateral agreements or understandings made in connection with, or in contemplation of, the termination of the *inter partes* review. The parties may request that the settlement agreement be treated as business confidential information and kept separate from the underlying patent file. *See* 35 U.S.C. § 317(b); 37 C.F.R. § 42.74(c). The request must be filed with the settlement. *Id.*

It is

ORDERED that the joint Motion to Terminate the captioned proceeding is *denied* without prejudice;

FURTHER ORDERED that Ex. 2001 is expunged;

FURTHER ORDERED that the joint request that the settlement agreement (Ex. 2001) be treated as business confidential information is *denied* as moot;

FURTHER ORDERED that the parties are authorized to file a revised joint motion to terminate this proceeding, which may include a request that the settlement agreement be treated as business confidential information; and

FURTHER ORDERED that the corrected joint motion must be accompanied by a true copy of the parties' settlement agreement, including any associated exhibits, as required by 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b).

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For PETITIONER:

Barry Schindler  
Lennie Bersh  
Vimal Kapadia  
GREENBERG TRAURIG LLP  
schindlerb@gtlaw.com  
bershl@gtlaw.com  
kapadiav@gtlaw.com

For PATENT OWNER:

Kenneth Weatherwax  
LOWENSTEIN & WEATHERWAX LLP  
weatherwax@lowensteinweatherwax.com