

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TOKYO ELECTRON LIMITED,
Petitioner,

v.

DANIEL L. FLAMM,
Patent Owner.

Case IPR2017-01072
Patent RE40,264 E

Before CHRISTOPHER L. CRUMBLEY, JO-ANNE M. KOKOWSKI, and
KIMBERLY McGRAW, *Administrative Patent Judges*.

McGRAW, *Administrative Patent Judge*.

DECISION
Joint Motion to Terminate
37 C.F.R. §§ 42.72, 42.74

On May 25, 2018, Toyko Electron Limited (“Petitioner”) and Daniel L. Flamm (“Patent Owner”) filed a “Joint Motion to Terminate Proceeding in View of Settlement Pursuant to 35 U.S.C. §317(a), Joint Notice of Settlement Pursuant to 35 U.S.C. §317(b) and 37 C.F.R. § 42.74, and Joint Request to Keep Separate Pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).”¹ Paper 13 (“Motion” or “Mot.”). The parties state that they have entered into a “confidential settlement agreement (Confidential binding Memorandum of Understanding Daniel L. Flamm and Tokyo Electron Limited (the ‘MOU’))” that resolves their dispute over U.S. Patent No. RE40,264 (“the ’264 patent”). Mot. 1, 3. A copy of the MOU was submitted as required by 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74. Ex. 1022.

The parties request that the MOU be treated as business confidential information and be kept separate from the underlying files of the challenged patents, as provided in 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) (“A party to a settlement may request that the settlement be treated as business confidential information and be kept separate from the files of an involved patent or application.”). Mot. 3.

We declined to institute *inter partes* review of the challenged claims. Paper 7. Petitioner filed a Request for Rehearing (Paper 11), a decision on which has not yet issued. No other motions are pending. Based on the facts of this case, it is appropriate to terminate the proceedings with respect to

¹ Although the parties did not receive authorization to file this motion as required by 37 C.F.R. § 42.20(b), on the particular facts of this case, we waive that requirement pursuant to our authority under 37 C.F.R. § 42.5(b).

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both parties without rendering a decision on the motion for rehearing. *See* 35 U.S.C. § 317(a); 37 C.F.R §§ 42.72, 42.74. Therefore, the joint motion to terminate the proceeding is granted, and the Request for Rehearing is moot. This paper does not constitute a final written decision pursuant to 35 U.S.C. § 318(a).

Accordingly, it is

ORDERED that the joint motion to terminate the proceeding is GRANTED and the proceeding is terminated with respect to both the Petitioner and the Patent Owner;

FURTHER ORDERED that Petitioner's Request for Rehearing is moot; and

FURTHER ORDERED that the confidential settlement agreement shall be treated as business confidential information under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) and shall be kept separate from the file of the patent.

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