

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HUAWEI DEVICE CO., LTD.,
Petitioner,

v.

MAXELL, LTD.,
Patent Owner.

Case IPR2018-00233
Patent 6,754,440 B2

Before MINN CHUNG, TERRENCE W. McMILLIN, and
JOHN A. HUDALLA, *Administrative Patent Judges*.

CHUNG, Administrative Patent Judge.

TERMINATION
Settlement After Institution of Trial
35 U.S.C. § 317 and 37 C.F.R. § 42.74

Upon Board authorization, Huawei Device Co., Ltd. (“Huawei” or “Petitioner”) and Maxell, Ltd. (“Maxell” or “Patent Owner”) filed a Joint Motion To Terminate this *inter partes* review on April 2, 2019. Paper 36 (“Mot.”). Along with the Joint Motion, the parties filed a copy of a document they describe as “a true and complete copy” (*id.* at 1) of their written settlement agreement (Ex. 1027) covering various matters, including those involving the patent at issue in this proceeding. The parties certify that there are no other agreements or understandings, oral or written, between the parties, including any collateral agreements, made in connection with, or in contemplation of, the termination of this proceeding. Mot. 1. The parties also filed a joint request to treat the settlement agreement as business confidential information under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c). Paper 37.

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 patent owner, unless the Office has decided the merits of the proceeding before the request for termination is filed.” In this proceeding, we have not yet reached a decision on the merits with respect to the patentability of any involved claim. Accordingly, we must terminate the review with respect to Huawei, as Petitioner.

Furthermore, “[i]f no petitioner remains in the *inter partes* review, the Office may terminate the review or proceed to a final written decision under section 318(a).” 35 U.S.C. § 317(a). We, therefore, have discretion to terminate this review with respect to Maxell.

Although a Decision on Institution instituting trial was entered on May 24, 2018 (Paper 9), we have not held an oral hearing (which was

scheduled to be held on February 21, 2019, but was canceled at the request of the parties in light of impending settlement (Paper 35, 2–3)), and we have not entered a Final Written Decision on the merits in this proceeding. In their Joint Motion, the parties represent that the settlement agreement completely resolves the underlying disputes between the parties involving U.S. Patent No. 6,754,440 B2 (Ex. 1001, “the ’440 patent”) at issue in this proceeding. Mot. 2. When, as here, we have not entered a Final Written Decision on the merits, we generally will terminate the trial after a settlement agreement is filed. *See* Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,768 (Aug. 14, 2012). Under the particular circumstances of this case, we determine that it is appropriate to terminate this *inter partes* review as to both Huawei and Maxell without rendering a Final Written Decision. *See* 35 U.S.C. § 317(a); 37 C.F.R. § 42.72.

After reviewing the parties’ settlement agreement, we find the settlement agreement contains business confidential information regarding the terms of the settlement and good cause exists to treat the settlement agreement as business confidential information under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

Accordingly, it is

ORDERED that the parties’ joint request (Paper 37) to treat the parties’ settlement agreement as business confidential information is *granted*;

FURTHER ORDERED that the settlement agreement (Exhibit 1027) shall be treated as business confidential information, kept separate from the file of the ’440 patent, and made available only to Federal Government

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agencies on written request to the Board, or to any person on a showing of good cause, under the provisions of 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c);

FURTHER ORDERED that the Joint Motion to Terminate this *inter partes* review (Paper 36) is *granted*; and

FURTHER ORDERED that this *inter partes* review is hereby *terminated*.

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