

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NIKON CORPORATION,
Petitioner,

v.

ASML NETHERLANDS B.V.
CARL ZEISS AG,
Patent Owner.

Case IPR2018-00687, Patent 6,731,335 B1;
Case IPR2018-00688, Patent 6,463,163 B1

Before JEFFREY S. SMITH, DAVID C. MCKONE, and
KEVIN W. CHERRY, *Administrative Patent Judges*.

MCKONE, *Administrative Patent Judge*.

DECISION
Motion to Terminate
37 C.F.R. § 42.74

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IPR2018-00688, Patent 6,463,163 B1

On February 22, 2019, Petitioner Nikon Corporation and Patent Owner ASML Netherlands B.V. and Carl Zeiss AG, filed a Joint Motion to Terminate Proceeding in each of the above-captioned proceedings (Paper 23¹) and a Joint Request that Settlement Agreement and Memorandum of Understanding Filed as Exhibit 1011 Be Treated as Business Confidential Information and Kept Separate From the Files (Paper 24). The parties represent that they have reached a Settlement Agreement, which is in writing and a true copy of which has been filed in conjunction with the above motions as required under 37 C.F.R. § 42.74(b). Paper 23, 1; Ex. 1011. The parties state that they also have agreed to dismiss the related District Court litigation and other pending proceedings between them. Paper 23, 1.

“An 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). We have not yet decided the merits of these proceedings. Accordingly, pursuant to Section 317(a), we grant the Motions to Terminate as to Petitioner. “If 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).” *Id.* Because the parties have settled this proceeding and the other matters between them, and because we have not yet decided the merits of these proceedings, we also grant the Motions to Terminate as to Patent

¹ Unless otherwise specified, we refer to the paper and exhibit numbering in IPR2018-00687. Similar filings were made in both of the above-captioned cases.

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Owner. We determine that terminating each proceeding promotes efficiency and minimizes unnecessary costs. Upon consideration of the facts before us, we determine 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). The parties certify that no other agreements exist between the parties concerning these cases or the patents at issue. Paper 23, 1. 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).

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 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

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showing of good cause and compliance with the other requirements of 37 C.F.R. § 42.74(c)(2).

ORDER

It is

ORDERED that the Joint Motion to Terminate Proceeding (IPR2018-00687, Paper 23; IPR2018-00688, Paper 24), in each of the above-captioned proceedings, is granted;

FURTHER ORDERED that the Joint Request that Settlement Agreement and Memorandum of Understanding Filed as IPR2018-00687, Exhibit 1011, and IPR2018-00687, Exhibit 1018, be Treated as Business Confidential Information and Kept Separate From the Files (IPR2018-00687, Paper 24; IPR2018-00688, Paper 25), in each of the above-captioned proceedings, is granted;

FURTHER ORDERED that the record copies of the parties' settlement agreement (IPR2018-00687, Ex. 1011; IPR2018-00688, Ex. 1018) 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 IPR2018-00687 and IPR2018-00688 is terminated pursuant to 35 U.S.C. § 317.

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