

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

VIZIO, INC.,
Petitioner,

v.

BROADCOM CORPORATION,
Patent Owner.

Case IPR2018-00013 (Patent 8,284,844 B2)
Case IPR2018-00786 (Patent 7,590,059 B2)

Before JEAN R. HOMERE, THOMAS L. GIANNETTI,
RAMA G. ELLURU, PATRICK M. BOUCHER, and
NORMAN H. BEAMER, *Administrative Patent Judges*.¹

PER CURIAM.

DECISION

Granting Joint Motion to Terminate Proceeding Due to
Settlement after Institution and
Granting Joint Request to Treat Settlement Agreement as
Business Confidential Information
35 U.S.C. § 317; 37 C.F.R. §§ 42.72, 42.73, 42.74

¹ This is not a decision by an expanded panel of the Board.

I. DISCUSSION

On November 19, 2018, after receiving our authorization via an email communication, Petitioner and Patent Owner (collectively referred to as “the Parties”) filed Joint Motions to Terminate the above-identified proceedings (collectively “Joint Motions”) pursuant to a written settlement agreement. Paper 26.² Along with the Joint Motions, the Parties filed respective Joint Requests to File Settlement Agreement as Business Confidential Information Under 35 U.S.C. § 317 and 37 C.F.R. § 42.74 (collectively “Joint Requests”) to have the agreement treated as business confidential information. Paper 27.³ The parties also filed what they represent as true copies of a Confidential Settlement Agreement (“Settlement Agreement”). Ex. 1024.⁴

In the Joint Motions, the Parties represent that they have reached an agreement to jointly seek termination of the above-identified *inter partes* review proceedings. Paper 26, 1. The Parties further represent that their Settlement Agreement resolves all currently pending Patent Office, District Court, and International Trade Commission proceedings between the Parties involving the above-identified patents at issue. Paper 26, 2.

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 the patent owner, unless the Office has decided the merits of the proceeding before the request for termination is filed.” It is also provided in 35 U.S.C. § 317(a) that if no petitioner remains in the *inter*

² We cite to the paper filed in IPR2018-00013. A similar paper was filed in IPR2018-00786. Paper 9.

³ The Parties filed a similar Joint Request in IPR2018-00786. Paper 10.

⁴ The Parties also filed a copy of the Settlement Agreement in IPR2018-00786. Ex. 1030.

partes review, the Office may terminate the review. Further, under 35 U.S.C. § 317(b),

[a]ny 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 under this section shall be in writing and a true copy of such agreement or understanding shall be filed in the Office before the termination.

We instituted a trial on IPR2018-00013 on April 6, 2018 (Paper 16) and we also instituted a trial on IPR2018-00786 on September 7, 2018 (Paper 7). We have not yet decided the merits of the above-identified proceedings, and a final written decision has not been entered for either proceeding. Notwithstanding that the above-identified proceedings have moved beyond the preliminary stage, the Parties have shown adequately that the termination of the above-identified proceedings is appropriate. Under these circumstances, we determine that good cause exists to terminate the above-identified proceedings with respect to the Parties. *See* 35 U.S.C. § 317; 37 C.F.R. §§ 42.72, 42.74

The Parties also filed Joint Requests that the Settlement Agreement be treated as business confidential information and be kept separate from the file of the respective patents involved in the above identified *inter partes* proceedings.⁵ Paper 27, 1; *see also* Paper 26, 3–4. After reviewing the

⁵ Although the Joint Requests actually request the Settlement Agreement be kept separate from files of the *inter partes proceedings*, rather than the patents (*see* Paper 27; 1; *see also* Paper 10, 1 of IPR2018-00786), we treat these requests as requests for the Settlement Agreement to be kept separate from files of the respective patents involved in the *inter partes* proceedings, consistent with 35 U.S.C. § 317(b).

IPR2018-00013 (Patent 8,284,844 B2)
IPR2018-00786 (Patent 7,590,059 B2)

Settlement Agreement between Petitioner and Patent Owner, we find that the Settlement Agreement contains confidential business information regarding the terms of settlement. We determine that good cause exists to treat the Settlement Agreement between Petitioner and Patent Owner as business confidential information pursuant to 37 C.F.R. § 42.74(c).

This Order does not constitute a final written decision pursuant to 35 U.S.C. § 318(a).

II. ORDER

Accordingly, for the reasons discussed above, it is:

ORDERED that the Joint Motions to Terminate are *granted*, and IPR2018-00013 and IPR2018-00786 are *terminated*;

FURTHER ORDERED that the Joint Requests to File the Settlement Agreement as Business Confidential Information are *granted*, and the Settlement Agreement shall be kept separate from the files of Patent 8,284,844 and Patent 7,590,059 and made available only to Federal Government agencies on written request, or to any person on a showing of good cause, pursuant to 37 C.F.R. § 42.74(c).

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