

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD.,
SAMSUNG ELECTRONICS AMERICA, INC.,
AND SAMSUNG SEMICONDUCTOR, INC.,
Petitioner,

v.

TESSERA ADVANCED TECHNOLOGIES, INC.,
Patent Owner.

Cases IPR2018-00798 and IPR2018-00799
Patent 6,954,001 B2¹

Before BARBARA A. PARVIS, ROBERT J. WEINSCHENK, AND
SCOTT B. HOWARD, *Administrative Patent Judges*.

HOWARD, *Administrative Patent Judge*.

DECISION

Granting Joint Motions to Terminate Proceeding Due to
Settlement after Institution Decision and
Granting Joint Requests to File Settlement Agreement as
Business Confidential Information
35 U.S.C. § 317; 37 C.F.R. §§ 42.72, 42.74

¹ This Order addresses issues pertaining to the above-identified proceedings. We exercise our discretion to issue one Order to be filed in each case. The parties are not authorized to use this style heading for any subsequent papers.

Per our authorization provided on December 11, 2018, the parties filed a Joint Motion to Terminate Proceeding in each of the above-identified *inter partes* review proceedings due to settlement. Paper 12.² Pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b), the parties also filed copies of their written Settlement Agreement (Ex. 1021) and associated Consent Letter (Ex. 1022).

In the Joint Motion to Terminate, the parties represent that they “have settled their dispute, and respectfully submit that termination is proper here.” Paper 12, 1. The parties represent that they have “executed a Confidential Settlement Agreement to terminate this proceeding effective December 7, 2018” and that “[t]rue and correct copies of the Settlement Agreement and Consent Letter are submitted . . . as Confidential Exhibits 1021 and 1022.” *Id.* at 2–3. The parties further represent that, besides these *inter partes* review proceedings, “[U.S. Patent No. 6,954,001] was the subject of three separate matters” which have been either “terminated” or “the parties [have] stipulated to dismiss with prejudice.” *Id.* 1–2.

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 patent owner, unless the Office has decided the merits of the proceeding before the request for termination is filed.” Although a Decision to Institute was entered on October 1, 2018 (Paper 8), we have not entered a Final Written Decision on the merits.

Under these circumstances, we determine that good cause exists to terminate the proceedings with respect to the parties. Indeed, there are

² We cite to the record in IPR2018-00798. Similar documents were filed in IPR2018-00799.

strong public policy reasons to favor settlement between the parties to a proceeding. *Office Patent Trial Practice Guide*, 77 Fed. Reg. 48,756, 48,768 (Aug. 14, 2012). The trial is at an early stage. Patent Owner has not yet submitted its Patent Owner Response, the hearing is scheduled for July 1, 2019, and we have not yet entered a final written decision. *See id.* Accordingly, we determine that it is appropriate to terminate trial without entering a Final Written Decision. *See* 37 C.F.R. § 42.72.

The parties also filed a Joint Request to File Settlement Agreement and Consent Letter as Business Confidential Information in each of the above-identified proceedings. Paper 13. The parties requested that the Settlement Agreement (Ex. 1021) and Consent Letter (Ex. 1022) be filed as business confidential information, and that the Settlement Agreement and Consent Letter be kept separate from the file of the patent involved in the *inter partes* review and not be made available to any third party, except as provided for in 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c). Paper 13, 1; *see also* Paper 12, 2–3.

Our rules provide as follows:

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. The request must be filed with the settlement. If a timely request is filed, the settlement shall only be available: (1) To a Government agency on written request to the Board; or (2) To any other person upon written request to the Board to make the settlement agreement available, along with the fee specified in § 42.15(d) and on a showing of good cause.

37 C.F.R. § 42.74(c).

After reviewing the Settlement Agreement and Consent Letter between Petitioner and Patent Owner, we find that the Settlement Agreement

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and Consent Letter contain confidential business information regarding the terms of settlement. We determine that it is appropriate to treat the Settlement Agreement and Consent Letter 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

In consideration of the foregoing, it is hereby:

ORDERED that the Joint Motions to Terminate Proceeding, as to both Petitioner and Patent Owner, are GRANTED, and IPR2018-00798 and IPR2018-00799 are hereby terminated; and

FURTHER ORDERED that the parties' Joint Requests to File Settlement Agreement and Consent Letter as Business Confidential Information are GRANTED, and the Settlement Agreement (Ex. 1021) and associated Consent Letter (Ex. 1022) shall be kept separate from the file of Patent 6,954,001 B2 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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