

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD.,
Petitioner,

v.

DIGITALOPTICS CORPORATION MEMS,
Patent Owner.

Case IPR2018-01806
U.S. Patent No. 7,697,829 B1

Before: DANIEL N. FISHMAN, STACEY G. WHITE, and
JOHN. P. PINKERTON, *Administrative Patent Judges*.

PINKERTON, *Administrative Patent Judge*.

ORDER

Dismissing the Petition and Granting Request to Treat
Settlement Documents as Confidential Business Information

37 C.F.R. §§ 42.5(a), 42.71(a), 42.74

On December 21, 2018, Petitioner Samsung Electronics Co., Ltd. (“Petitioner”) and Patent Owner DigitalOptics Corporation MEMS (“Patent Owner”) (collectively, “the Parties”) filed a Joint Motion to Terminate Proceeding. Paper 6, (“Joint Motion to Terminate” or “Mot.”). Together with the Joint Motion to Terminate, the Parties filed (1) a copy of their written Confidential Settlement and License Agreement (Ex. 2001, “Agreement”) and (2) a copy of their Confidential Consent Letter (Ex. 2002, “Consent Letter”). The Parties also filed a Joint Request to Treat Settlement Agreement and Consent Letter as Business Confidential Under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c). Paper 7, (“Joint Request”).

In the Joint Motion to Terminate, the Parties indicate they have settled their dispute. Mot. 1. The Parties state that the district court proceeding involving U.S. Patent No. 7,697,829 B1 (“829 patent”) is being dismissed concurrently with prejudice. *Id.* The Parties also state they executed the Agreement to terminate this proceeding effective December 7, 2018. *Id.*

The Board generally expects that a case “will terminate after the filing of a settlement agreement, unless the Board has already decided the merits.” Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,768 (Aug. 14, 2012); *see also* 35 U.S.C. § 317(a) and 37 C.F.R. § 42.71(a). Here, the case is at a preliminary stage—one where the Patent Owner has yet to file its Patent Owner Preliminary Response.

In view of the early stage of the proceeding and the settlement between the parties, we determine that it is appropriate to dismiss the Petition. *See* 37 C.F.R. §§ 42.5(a) and 42.71(a). We also determine that it is appropriate to treat the

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Agreement (Ex. 2001) and Consent Letter (Ex. 2002) as business confidential information to be kept separate from the '829 patent file. *See* 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

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

ORDER

In view of the foregoing, it is:

ORDERED that the Parties' Joint Motion to Terminate (Paper 6) is granted and the Petition for *Inter Partes* Review of U.S. Patent No. 7,697,829 B1 is dismissed; and

FURTHER ORDERED that the Joint Request (Paper 7) to treat the Agreement and Consent Letter as business confidential information, and be kept separate from the '829 patent file, is granted.

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