

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INNOLUX CORPORATION,
Petitioner,

v.

VISTA PEAK VENTURES, LLC,
Patent Owner.

Case IPR2019-00633
Patent 7,009,673 B2

Before DEBRA K. STEPHENS, JENNIFER MEYER CHAGNON, and
KAMRAN JIVANI, *Administrative Patent Judges*.

JIVANI, *Administrative Patent Judge*.

ORDER

Granting Joint Motion to Terminate Proceeding Due to
Settlement before Institution and
Granting Joint Request to File Settlement Agreement as
Business Confidential Information
35 U.S.C. § 317 and 37 C.F.R. §§ 42.71–42.74

I. INTRODUCTION

Petitioner and Patent Owner (collectively “the Parties”) have requested that the above-identified *inter partes* review proceeding be terminated pursuant to a settlement. On April 4, 2019, we authorized the Parties via email to file a joint motion to terminate the above-identified proceeding. On April 16, 2019, the Parties filed a Joint Motion to Terminate the above-identified proceeding (“Joint Motion”). Paper 6. The Parties filed a Settlement and License Agreement (Exhibit 1014, “Settlement Agreement”) and filed a Joint Request to File Settlement Agreement as Business Confidential Information pursuant to 37 C.F.R. § 42.74(c) (“Joint Request”). Paper 7.

II. DISCUSSION

In the Joint Motion, the Parties represent that they have reached an agreement to jointly seek termination of this *inter partes* review proceeding, that the filed copy of the Settlement Agreement is a true copy, and there are no other agreements of any kind. Joint Motion 1. Further, the Settlement Agreement indicates it is a complete agreement. Settlement Agreement 11–12. The Parties also represent that their settlement agreement resolves all currently pending Patent Office and District Court proceedings between the Parties involving U.S. Patent No. 7,009,673 B2 (“the ’673 patent”). Joint Motion 1–2.

This proceeding is at an early stage. We have not determined whether to institute trial in this proceeding. The Parties have shown adequately that the termination of the proceeding is appropriate. Under these circumstances, we determine that good cause exists to terminate the proceeding.

The Parties also requested that the Settlement Agreement be treated as business confidential information and be kept separate from the file of the '673 patent. Joint Request 1–2. After reviewing the 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).

III. ORDER

Accordingly, for the reasons discussed above, it is:

ORDERED that the Joint Motion to Terminate is *granted*, and IPR2019-00633 is *terminated* with respect to Petitioner and Patent Owner; and

FURTHER ORDERED that the Joint Request to File Settlement Agreement as Business Confidential Information is *granted*, and the Settlement Agreement shall be kept separate from the file of U.S. Patent No. 7,009,673 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).

IPR2019-00633
Patent 7,009,673 B2

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