

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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LG CHEM LTD. and LG ELECTRONICS, INC.,  
Petitioner,

v.

SK INNOVATION CO., LTD.,  
Patent Owner.

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IPR2020-00657  
Patent 9,698,398 B2

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Before JO-ANNE M. KOKOSKI, JON B. TORNQUIST, and  
MICHELLE N. ANKENBRAND, *Administrative Patent Judges*.

KOKOSKI, *Administrative Patent Judge*.

TERMINATION  
Due to Settlement After Institution of Trial  
*37 C.F.R. § 42.74*

On May 26, 2021, with the Board’s authorization, LG Chem Ltd., LG Electronics, Inc., and LG Energy Solution, Ltd. (collectively, “Petitioner”) and SK Innovation Co., Ltd. (“Patent Owner”) filed a Joint Motion to Terminate the above-identified proceeding due to settlement. Paper 40 (“Joint Motion”). The parties also filed a confidential Settlement Agreement (Ex. 1043), along with a Joint Request to Treat the Settlement Agreement as business confidential pursuant to 37 C.F.R. § 42.74(c) (Paper 41 (“Joint Request”)).

In the Joint Motion, the parties represent that they have settled their dispute, and that the Settlement Agreement resolves all currently pending proceedings between the parties involving Patent 9,698,398 B2. Joint Motion 1–2. The parties confirm that the “settlement agreement is in writing, and a true and correct copy is being filed concurrently herewith as Exhibits 1043,” and “that there are no collateral agreements or understandings made in connection with, or in contemplation of, the termination of the present *inter partes* review.” *Id.* at 1. Accordingly, the parties jointly request termination of this proceeding. *Id.* at 2.

The Board generally expects that a case “will terminate after the filing of a settlement agreement, unless the Board has already decided the merits.” *Consolidated Trial Practice Guide*, 86 (Nov. 2019) (“Consolidated TPG”)<sup>1</sup>; *see* 35 U.S.C. §317(a); 37 C.F.R. § 42.72. Here, the Board instituted *inter partes* review of the challenged patent on September 30, 2020 (Paper 9), but has not decided the merits of this proceeding. Under these circumstances,

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<sup>1</sup> Available at <https://www.uspto.gov/TrialPracticeGuideConsolidated>.

we determine that it is appropriate to terminate this proceeding without rendering a final written decision.

The parties also request that the Settlement Agreement be treated as business confidential information and be kept separate from the files of the patent involved in this *inter partes* proceeding. Joint Request 2. Upon review of the Joint Request, we determine that good cause exists to treat the Settlement Agreement as business confidential information pursuant to 37 C.F.R. § 42.74(c). Therefore, we grant the Joint Request.

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

Accordingly, it is:

ORDERED that the Joint Motion to Terminate is *granted*, and the above-identified proceeding is *terminated* with respect to both Petitioner and Patent Owner; and

FURTHER ORDERED that the Joint Request to Treat the Settlement Agreement as Business Confidential is *granted*, and the Settlement Agreement shall be kept separate from the file of Patent 9,698,398 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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Patent 9,698,398 B2

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