

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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HEWLETT PACKARD ENTERPRISE CO.,  
Petitioner,

v.

INTELLECTUAL VENTURES II LLC,  
Patent Owner.

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IPR2022-00096  
Patent RE44,818 E

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Before DAVID C. MCKONE, JOHN A. HUDALLA, and  
JOHN D. HAMANN, *Administrative Patent Judges*.

HUDALLA, *Administrative Patent Judge*.

TERMINATION

Due to Settlement After Institution of Trial and  
*Granting* Joint Request to Treat Settlement Agreement as  
Business Confidential Information  
*35 U.S.C. § 317; 37 C.F.R. § 42.74*

## I. INTRODUCTION

Petitioner and Patent Owner (collectively “the Parties”) have requested termination of the above-identified *inter partes* review proceeding based on a settlement. On January 25, 2023, the Parties filed a Joint Motion to Terminate Proceeding (“Joint Motion”) in the above-identified proceeding. Paper 26. The Parties previously sought authorization to file the Joint Motion and received that authorization on January 23, 2023. Joint Motion 1. The Parties also filed a copy of a settlement agreement (Ex. 1033, “Settlement Agreement”) and a Joint Motion to File Agreement as Business Confidential Information (Paper 27, “Joint Request”) in the proceeding.

## II. DISCUSSION

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.” Section 317(a) also states that if no petitioner remains in the *inter partes* review, the Office may terminate the review.

In the Joint Motion, the Parties represent that they have reached an agreement to resolve all of their present disputes regarding Patent RE44,818, that the filed copy of the Settlement Agreement is a true and correct copy, and that “[t]here are no other agreements, oral or written, between the parties made in connection with, or in contemplation of, the termination of this proceeding.” Joint Motion 2–4.

We instituted trial in the above-identified proceeding on May 11, 2022. Paper 11. We have not yet decided the merits of the proceeding, and a final written decision has not been entered. Although this proceeding has

moved beyond the preliminary stage, the Parties have shown adequately that termination of the proceeding is appropriate. Under these circumstances, we determine that good cause exists to terminate the proceeding with respect to the Parties.

The Parties also requested that the Settlement Agreement be treated as business confidential information and be kept separate from the file of Patent RE44,818. Joint Request 1. After reviewing the Settlement Agreement, 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 as business confidential information pursuant to 35 U.S.C. § 317(b) and 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 is *granted* and IPR2022-00096 is *terminated* with respect to Petitioner and Patent Owner, pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. § 42.72; and

FURTHER ORDERED that the Joint Request is *granted*, and the Settlement Agreement shall be kept separate from the file of Patent RE44,818 and made available only to Federal Government agencies on written request, or to any person on a showing of good cause, pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

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