

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TOYOTA MOTOR CORP.,
Petitioner,

v.

INTELLECTUAL VENTURES II LLC,
Patent Owner.

IPR2022-00708 (Patent 9,291,475 B2)
IPR2022-00709 (Patent 9,602,608 B2)
IPR2022-00710 (Patent 9,232,158 B2)
IPR2022-00857 (Patent 7,484,008 B2)
IPR2022-00970 (Patent 6,832,283 B2)
IPR2022-00971 (Patent 7,382,771 B2)

Before SCOTT A. DANIELS, FREDERICK C. LANEY, and
MATTHEW S. MEYERS, *Administrative Patent Judges*.

LANEY, *Administrative Patent Judge*.

TERMINATION
Due to Settlement After Institution of Trial
35 U.S.C. § 317, 37 C.F.R. § 42.74

IPR2022-00708 (Patent 9,291,475 B2)
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We previously instituted *inter partes* review proceedings with respect to the challenged claims of U.S. Patent Nos. 9,291,475 B2, 9,602,608 B2, 9,232,158 B2, 7,484,008 B2, 6,832,283 B2, and 7,382,771 B2 (“the subject patents”). IPR2022-00708, Paper 12; IPR2022-00709, Paper 11; IPR2022-00710, Paper 13; IPR2022-00857, Paper 8; IPR2022-00970, Paper 10; IPR2022-00971, Paper 12. On March 27, 2023, with our authorization, Petitioner Toyota Motor Corporation and Patent Owner Intellectual Ventures II LLC (collectively, “the Parties”) filed joint motions to terminate the proceedings pursuant to 35 U.S.C. § 317 and 37 C.F.R. § 42.74. IPR2022-00708, Paper 23 (“708 Motion”); IPR2022-00709, Paper 21; IPR2022-00710, Paper 15; IPR2022-00857, Paper 15; IPR2022-00970, Paper 21; IPR2022-00971, Paper 18.

The Parties represent in the joint motions that litigation between them involving the subject patents, previously pending in the United States District Court for the Eastern District of Texas, was “dismissed pursuant to Court Order dated March 20, 2023 [Dkt. No. 159] on joint motion of the parties” after the Parties reached an agreement resolving their disputes. *See, e.g.*, 708 Mot. 1–2. The parties contend that termination is appropriate because the Board has not yet decided the merits of the proceedings and termination would preserve significant resources for the Parties and the Board, pointing out, among other considerations, that these proceedings remain “far from final disposition” because there still remains substantial briefing on a myriad of issues by the Parties, oral arguments for all of the proceeding are not scheduled to take place for several more months, and the

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statutory deadlines for the Final Written Decisions are even further away.
Id. at 5.

Pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b), the joint motions each were accompanied by a copy of a settlement agreement that the Parties represent to be a true and correct copy of the written settlement agreement that resolves the disputes between them in these proceedings. IPR2022-00708, Ex. 2027; IPR2022-00709, Ex. 2032; IPR2022-00710, Ex. 2006; IPR2022-00857, Ex. 2003; IPR2022-00970, Ex. 2006; IPR2022-00971, Ex. 2005. The Parties further represent that there are no other agreements, oral or written, between them made in connection with, or in contemplation of, the termination of the proceedings. *See, e.g.*, 708 Mot. 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.” Patent Trial and Appeal Board Consolidated Trial Practice Guide 86 (Nov. 2019), *available at* <https://www.uspto.gov/sites/default/files/documents/tpgnov.pdf>; *see also* 37 C.F.R. § 42.72 (“The Board may terminate a trial without rendering a final written decision, where appropriate, . . .”). As noted by the Parties, these proceedings are at an early stage, oral hearing has not yet been held, and the Board has not yet decided the merits of the proceedings. *See, e.g.*, 708 Mot. 5; IPR2022-00708, Paper 13 (Scheduling Order). Under the circumstances presented here, and in view of the Parties’ representations, we determine that it is appropriate to terminate these proceedings with respect to all parties, and we, accordingly, grant the Parties’ joint motions to terminate.

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In a separate paper, the Parties also jointly request that the Board treat as business confidential information and keep separate from the file of the involved patents, the true and complete copy of the settlement agreement, which is referenced in the Parties' Joint Motion to Terminate in each of the proceedings. IPR2022-00708, Paper 24 ("Settlement Agreement"); IPR2022-00709, Paper 22; IPR2022-00710, Paper 16; IPR2022-00857, Paper 16; IPR2022-00970, Paper 22; IPR2022-00971, Paper 19. After reviewing the Parties' Settlement Agreement, we find that the settlement agreement contains confidential business information regarding the terms of settlement, and we determine that good cause exists to treat the settlement agreement as business confidential information. *See* 37 C.F.R. § 42.74(c).

However, we deny the portion of the Settlement Agreement seeking that "the Board order that in the event a person or entity makes a written request, as stated in 37 C.F.R. § 42.74(c)(1)–(2), for access to the settlement agreement, that any such written request be served upon the parties on the day the written request is provided to the Board." Settlement Agreement 1–2. We have no such procedure to serve upon the Parties a request for access to the Settlement Agreement, and, further, our regulations do not require us to do so.

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Accordingly, it is

ORDERED that the joint motions to terminate are GRANTED; and
FURTHER ORDERED that Cases IPR2022-00708, IPR2022-00709,
IPR2022-00710, IPR2022-00857, IPR2022-00970, and IPR2022-00971 are
hereby *terminated*.

FURTHER ORDERED that the filed settlement agreement (IPR2022-
00708, Ex. 2027; IPR2022-00709, Ex. 2032; IPR2022-00710, Ex. 2006;
IPR2022-00857, Ex. 2003; IPR2022-00970, Ex. 2006; IPR2022-00971, Ex.
2005) be treated as business confidential information pursuant to 37 C.F.R.
§ 42.74(c) and also remain designated as available only to “Parties and
Board” in the Board’s E2E system.

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