

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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AVX CORPORATION,  
Petitioner,

v.

SAMSUNG ELECTRO-MECHANICS CO., LTD.,  
Patent Owner.

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Case PGR2017-00010  
Patent 9,326,381 B2

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Before SALLY C. MEDLEY, JONI Y. CHANG, and  
RAMA G. ELLURU, *Administrative Patent Judges*.

MEDLEY, Administrative Patent Judge.

ORDER  
Conduct of the proceeding  
*37 C.F.R. § 42.5*

AVX Corporation (“Petitioner”) filed a Petition for post-grant review of claims 1–19 of U.S. Patent No. 9,326,381 B2 (Ex. 1001, “the ’381 patent”). Paper 2 (“Pet.”). Samsung Electro-Mechanics Co., Ltd. (“Patent Owner”) filed a Preliminary Response. Paper 6 (“Prelim. Resp.”). On July 18, 2017, we instituted trial as to claims 1–4, 6–11, and 13–19 of

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the '381 patent. Paper 11. On January 29, 2018, Patent Owner informed the Board that the parties have reached a settlement agreement and seek authorization to file a joint motion to terminate the proceeding pursuant to 35 U.S.C. § 317.

Generally, the Board expects that a proceeding will terminate after the filing of a settlement agreement. *See, e.g.*, Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,768 (Aug. 14, 2012). The rule governing settlement indicates that any agreement between the parties made in connection with, or in contemplation of, the termination of a proceeding shall be in writing and filed with the Board. 37 C.F.R. § 42.74. Based on the facts of this proceeding, the parties are authorized to file a joint motion to terminate this proceeding.

The joint motion to terminate must include a brief explanation as to why termination of the proceeding is appropriate, and also should update the Board as to the status of any other matters involving the patent at issue. The parties also must file, as an exhibit, a true copy of their settlement agreement to terminate the proceeding. A redacted version of the settlement agreement will not be accepted as a true copy of the settlement agreement. Any request that the agreement be treated as business confidential information and be kept separate from the file of the involved patent must be filed with the settlement agreement. 37 C.F.R. § 42.74(c). The parties are directed to FAQ G2 on the Board's website page at <http://www.uspto.gov/patents-application-process/patent-trial-and-appeal-board/ptab-e2e-frequently-asked-questions> for instructions on how to file their settlement agreement as confidential (*e.g.*, uploading as "Parties and Board Only") in PTAB E2E.

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The joint motion to terminate and the settlement agreement shall be filed no later than February 9, 2018. Accordingly, it is

ORDERED that the parties are authorized to file a joint motion to terminate the proceeding;

FURTHER ORDERED that the joint motion is due no later than February 9, 2018;

FURTHER ORDERED that the joint motion shall be accompanied by a true copy of the settlement agreement as required by 37 C.F.R. § 42.74(b);

FURTHER ORDERED that the parties may request that the settlement agreement be treated as business confidential information as specified by 37 C.F.R. § 42.74(c); and

FURTHER ORDERED that any confidential settlement agreement must be filed electronically in accordance with the instructions provided on the Board's website (*e.g.*, uploading as "Parties and Board Only").

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