

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BLACKBERRY CORPORATION,
Petitioner,

v.

MAXELL, LTD.,
Patent Owner.

Case IPR2019-00097
Patent 9,100,604 B2

Before MINN CHUNG, TERRENCE W. McMILLIN, and
JOHN A. HUDALLA, *Administrative Patent Judges*.

HUDALLA, *Administrative Patent Judge*.

DECISION

Granting Joint Motion to Terminate Proceeding Due to
Settlement Before Institution and
Granting Joint Request to File Settlement Agreement as
Business Confidential Information
37 C.F.R. §§ 42.71(a) and 42.74(c)

I. DISCUSSION

On April 23, 2019, the parties filed a Joint Motion to Terminate this proceeding. Paper 10 (“Mot.”). We authorized the Joint Motion via email on April 22, 2019. Along with the Joint Motion, the parties filed a copy of a document they describe as “a true copy” (*id.* at 2) of their written settlement agreement (Ex. 1021) covering various matters, including those involving the patent at issue in this proceeding. The parties also filed a Joint Request to File Settlement Agreement as Business Confidential Information under 37 C.F.R. § 42.74(c). Paper 11.

This proceeding is still in its preliminary stages. Petitioner filed a Petition requesting an *inter partes* review of claims 1–5 of U.S. Patent No. 9,100,604 B2 (Ex. 1003, “the ’604 patent”). Paper 1, 1. Patent Owner filed a Preliminary Response. Paper 9. We have not entered a decision on whether to institute an *inter partes* review.

In their Joint Motion, the parties represent that the settlement agreement completely resolves the underlying disputes between the parties involving the ’604 patent at issue in this proceeding. Mot. 1, 3. The parties indicate that the settlement encompasses this proceeding, and the co-pending district court case in which Patent Owner asserted the ’604 patent against Petitioner and which was dismissed on April 22, 2019. *Id.* at 3–4. The parties also state that the settlement agreement filed as Exhibit 1021 represents all agreements made in connection with, or in contemplation of, the termination of this proceeding. Mot. 2.

Under these particular circumstances, we determine that it is appropriate to dismiss the Petition without rendering any further decisions, thereby terminating this proceeding. *See* 37 C.F.R. § 42.71(a). We also have reviewed the settlement

agreement, and we determine that good cause exists to treat the settlement agreement as business confidential information under 37 C.F.R. § 42.74(c).

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

II. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that the parties' Joint Request (Paper 11) to file the settlement agreement (Exhibit 1021) as business confidential information under 37 C.F.R. § 42.74(c) is *granted*;

FURTHER ORDERED that the settlement agreement (Exhibit 1021) shall be treated as business confidential information, kept separate from the file of the '604 patent, and made available only to Federal Government agencies on written request to the Board, or to any person on a showing of good cause, under the provisions of 37 C.F.R. § 42.74(c); and

FURTHER ORDERED that the parties' Joint Motion to Terminate (Paper 10) is *granted*, and the Petition is dismissed resulting in termination of this proceeding.

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