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Paper No. 9
Entered: April 25, 2019

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HUAWEI TECHNOLOGIES CO., LTD.,
Petitioner,

v.

MAXELL, LTD.,
Patent Owner.

Case IPR2019-00576
Patent 6,973,334 B2

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

HUDALLA, *Administrative Patent Judge*.

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

I. DISCUSSION

On April 10, 2019, with Board authorization (Paper 6), the parties filed a Joint Motion to Terminate this proceeding. Paper 7 ("Mot."). Along with the Joint Motion, the parties filed a copy of a document they describe as "a true and complete copy" (*id.* at 1) of their written settlement agreement (Ex. 1013) covering various matters, including those involving the patent at issue in this proceeding. The parties also filed a Joint Request to Treat the Settlement Agreement as Business Confidential Information under 37 C.F.R. § 42.74(c). Paper 8.

This proceeding is still in its preliminary stages. Petitioner filed a Petition requesting an *inter partes* review of claims 4 and 6 of U.S. Patent No. 6,973,334 B2 (Ex. 1001, "the '334 patent"). Paper 2, 5. 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 '334 patent at issue in this proceeding. Mot. 2–3. The parties indicate that the settlement encompasses this proceeding and the co-pending district court case where Patent Owner asserted the '334 patent against Petitioner. *Id*. The parties also state that the settlement agreement filed as Exhibit 1013 represents all agreements made in connection with, or in contemplation of, the termination of this proceeding. Mot. 1–2; Ex. 1013, 10. 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 8) to treat the settlement agreement (Exhibit 1013) as business confidential information under 37 C.F.R. § 42.74(c) is *granted*; and

FURTHER ORDERED that the parties' Joint Motion to Terminate (Paper 7) is *granted*, and the Petition is dismissed resulting in termination of this proceeding.

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