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Paper No. 35
Entered: April 20, 2021

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

MAXELL, LTD.,
Patent Owner.

IPR2020-00199 (Patent 6,329,794 B1)
IPR2020-00200 (Patent 10,084,991 B2)
IPR2020-00202 (Patent 10,212,586 B2)
IPR2020-00204 (Patent 6,928,306 B2)[1]

Before MICHAEL R. ZECHER, MINN CHUNG, KEVIN C. TROCK, and JOHN A. HUDALLA, *Administrative Patent Judges*.[2]

HUDALLA, *Administrative Patent Judge*.

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

[1] This Order addresses issues that are the same in the identified cases. We exercise our discretion to issue one Order to be filed in each case. The parties are not authorized to use this filing style in subsequent papers.

[2] This is not an expanded panel decision. Judges Chung, Trock, and Hudalla are the panel in IPR2020-00199. Judges Zecher, Trock, and Hudalla are the panel in IPR2020-00200, -00202, and -00204.

I. INTRODUCTION

With our authorization, Petitioner and Patent Owner (collectively, "the Parties") filed a Joint Motion to Terminate in each of the above-captioned proceedings due to settlement ("Joint Motions"). Paper 27.[3] In support of the Joint Motions, the Parties filed copies of a Confidential Settlement and License Agreement, Ex. 1052 ("Settlement Agreement"),[4] as well as corresponding Joint Requests to Keep the Settlement Agreement Confidential and Separate pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c), Paper 28 ("Joint Requests").

II. DISCUSSION

In the Joint Motions, the Parties represent that the Settlement Agreement fully resolves the above-captioned *inter partes* review proceedings. Joint Motions 2. The Parties also represent that they have filed true and accurate copies of the Settlement Agreement and that the Settlement Agreement represents the entire agreement between the Parties. *Id.* The Parties further represent that the related district court case (*Maxell, Ltd. v. Apple Inc.*, No. 5:19-cv-00036 (E.D. Tex. filed Mar. 15, 2019)) has been dismissed. *Id.* at 3. Accordingly, the Parties jointly request termination of these proceedings. *Id.* at 4.

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[3] For purposes of expediency, we cite to papers filed in IPR2020-00199, unless otherwise noted. The Parties filed similar papers in each of the above-identified proceedings.

[4] For purposes of expediency, we cite to the copy of the Settlement Agreement filed in IPR2020-00199. The Parties filed the same Settlement Agreement in each of the above-identified proceedings.

The Board generally expects that a case "will terminate after the filing of a settlement agreement, unless the Board has already decided the merits." *Consolidated Trial Practice Guide*, 86 (Nov. 2019) ("Consolidated TPG")[5]; *see* 35 U.S.C. § 317(a); 37 C.F.R. § 42.72. Although we have instituted *inter partes* review of the challenged patents in these proceedings, we have not yet decided the merits of these proceedings. Therefore, we determine that it is appropriate to terminate these proceedings without rendering any further decisions.

In the Joint Requests, the Parties request to have the Settlement Agreement treated as business confidential information and to keep it separate from the files of the respective patents involved in these *inter partes* proceedings. Joint Requests 1. After reviewing the Settlement Agreement between Petitioner and Patent Owner, we find that it contains confidential business information regarding the terms of settlement. We determine that good cause exists to treat the Settlement Agreement between Petitioner and Patent Owner 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).

[5] *Available at* https://www.uspto.gov/TrialPracticeGuideConsolidated.

III. ORDER

Accordingly, for the reasons discussed above, it is

ORDERED that the Joint Motions to Terminate are *granted*, and the above-identified proceedings are *terminated*; and

FURTHER ORDERED that the Joint Requests to Keep the Settlement Agreement Confidential and Separate are *granted*, and the Settlement Agreement shall be kept separate from the files of U.S. Patent Nos. 6,329,794 B1, 10,084,991 B2, 10,212,586 B2, and 6,928,306 B2, 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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