

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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HISENSE CO LTD.,  
Petitioner,

v.

MAXELL, LTD.,  
Patent Owner.

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IPR2020-01598  
Patent 9,578,369 B2

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Before MINN CHUNG, JOHN A. HUDALLA, and  
FREDERICK C. LANEY, *Administrative Patent Judges*.

HUDALLA, *Administrative Patent Judge*.

DECISION  
Settlement Prior to Institution of Trial  
Granting Request to Keep Agreement Confidential  
*37 C.F.R. § 42.74*

## I. INTRODUCTION

With the Board's authorization, Petitioner and Patent Owner (collectively "the Parties") filed a joint motion to dismiss the Petition. Paper 6 ("Joint Motion"). Along with the Joint Motion, the Parties filed a copy of a "Patent License Agreement" (Ex. 1100, "Agreement"), as well as a joint request (Paper 7, "Joint Request") to treat the Agreement as business confidential information and to keep the Agreement separate from the files of U.S. Patent No. 9,578,369 B2 ("the '369 patent").

In the Joint Motion, the Parties represent that they have resolved their disputes regarding the '369 patent, and they jointly seek termination of this proceeding. Joint Motion 2. According to the Parties, "[a]side from the written agreement concurrently filed with the Board[,] there are no other agreements, oral or written, between the parties and made in connection with, or in contemplation of, the termination of the proceeding[]." *Id.*

This proceeding is at an early stage. We have not considered the merits of the Petition, Patent Owner has not yet filed a Preliminary Response, and we have not yet decided whether to institute a trial in the proceeding. In view of the early stage of the proceeding and the settlement between the Parties, we determine that good cause exists to dismiss the petition and terminate the proceeding with respect to the Parties.

In the Joint Request, the Parties request that the Agreement be treated as business confidential information and be kept separate from the files of the '369 patent. Joint Request 2. After reviewing the Agreement between the Parties, we find that the Agreement contains confidential business information regarding the terms of settlement. We determine that good

cause exists to treat the Agreement between Petitioner and Patent Owner as business confidential information pursuant to 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

Accordingly, it is:

ORDERED that the Joint Motion (Paper 6) is *granted*, and the Petition in IPR2020-01598 is dismissed and the proceeding is *terminated* with respect to Petitioner and Patent Owner; and

FURTHER ORDERED that the Joint Request (Paper 7) is *granted*, and the Agreement (Ex. 1100) shall remain designated as “Parties and Board Only” in the Board’s filing system, shall made available only to Federal Government agencies on written request, or to any person on a showing of good cause, and shall be kept separate from the files of Patent 9,578,369 B2 and its associated proceeding, pursuant to 37 C.F.R. § 42.74(c).

IPR2020-01598  
Patent 9,578,369 B2

PETITIONER:

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