

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LITE-ON TECHNOLOGY CORPORATION,
Petitioner,

v.

SENSOR ELECTRONIC TECHNOLOGY, INC.,
Patent Owner.

IPR2022-00780 (Patent 9,923,117 B2)
IPR2022-00781 (Patent 8,552,562 B2)¹

Before DONNA M. PRAISS, KRISTINA M. KALAN, and
ELIZABETH M. ROESEL, *Administrative Patent Judges*.

KALAN, *Administrative Patent Judge*.

TERMINATION

Due to Settlement After Institution of Trial and
Granting Joint Motion to Keep Settlement Agreement
Separate and Confidential
35 U.S.C. § 317; 37 C.F.R. § 42.74

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

I. INTRODUCTION

With the Board’s authorization, Petitioner and Patent Owner (collectively, “the Parties”) filed a Joint Motion to terminate in each of the above-captioned proceedings. Paper 32 (“Joint Motion”).² Along with the Joint Motion, the Parties filed a copy of a settlement agreement (Ex. 1025, “Settlement Agreement”), as well as a Joint Request that the Settlement Agreement be treated as business confidential information and kept separate from the files of the patents involved in the above-captioned proceedings (Paper 33, “Joint Request”).

II. DISCUSSION

In the Joint Motion, the Parties represent that the Settlement Agreement resolves their dispute involving the patents at issue in the above-captioned proceedings. Joint Motion 1. The Parties also represent that they have filed a true copy of the Settlement Agreement made in connection with, or in contemplation of, the termination of the above-captioned proceeding. *Id.* The Parties “certify that there are no other agreements or understandings, oral or written, between the parties, including any collateral agreements.” *Id.* The Settlement Agreement states that it “sets forth the entire understanding between the Parties and supersedes and replaces all prior understanding and agreements between the Parties as to the subject matter hereof.” Ex. 1025, 10.

We instituted trial in the above-captioned *inter partes* review proceedings, but we have not yet decided the merits of the proceedings, and

² The relevant papers and exhibits filed in the above-captioned proceedings are substantively the same. We cite to the record in IPR2022-00780, unless otherwise indicated.

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final written decisions have not been entered. Notwithstanding that the proceedings have moved beyond the preliminary stage, the Parties have shown adequately that the termination of the proceedings is appropriate. Under these circumstances, we determine that good cause exists to terminate the above-captioned *inter partes* review proceedings with respect to the Parties.

The Parties also request that the Settlement Agreement be treated as business confidential information and kept separate from the files of the patents involved in the above-captioned proceedings. Joint Request 2. After reviewing the Settlement Agreement, we find that it contains confidential business information regarding the terms of settlement. Thus, good cause exists to treat the Settlement Agreement 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).

III. ORDER

Accordingly, it is:

ORDERED that the Joint Motions to terminate (IPR2022-00780, Paper 32; IPR2022-00781, Paper 32) are *granted*, and IPR2022-00780 and IPR2022-00781 are *terminated* with respect to Petitioner and Patent Owner; and

FURTHER ORDERED that the Joint Requests to treat the Settlement Agreement as business confidential information (IPR2022-00780, Paper 33; IPR2022-00781, Paper 33) are *granted*; and

FURTHER ORDERED that the Settlement Agreement (IPR2022-00780, Ex. 1025; IPR2022-00781, Ex. 1016) shall be kept separate from the

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file of U.S. Patent Nos. 9,923,117 B2 and 8,552,562 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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