

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

VIZIO, INC.,
Petitioner,

v.

MAXELL, LTD.,
Patent Owner.

IPR2022-01459 (Patent 7,730,507 B2)
IPR2022-01463 (Patent 7,760,213 B2)¹

Before KEVIN C. TROCK, JOHN A. HUDALLA, and
JASON W. MELVIN, *Administrative Patent Judges*.

MELVIN, *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 each of these proceedings. We issue one Order to be entered in each proceeding. The parties are not authorized to use this style caption unless later permitted.

I. INTRODUCTION

On September 7, 2023, with the Board’s authorization, Petitioner and Patent Owner (collectively referred to as “the Parties”) filed a Joint Motion to Terminate *Inter Partes* Review (“Joint Motion”) (Paper 15²), as well as a Joint Motion to Keep Confidential and Separate (“Joint Request”) (Paper 16), in each of the above-identified proceedings due to settlement. In support of the Joint Requests, the Parties filed a copy of a Patent License Agreement (“Agreement”) (Ex. 1031) in each proceeding.

II. DISCUSSION

Under 35 U.S.C. § 317(a), “[a]n inter partes review instituted under this chapter shall be terminated with respect to any petitioner upon the joint request of the petitioner and the patent owner, unless the Office has decided the merits of the proceeding before the request for termination is filed.” Section 35 U.S.C. § 317(a) also provides that if no petitioner remains in the *inter partes* review, the Office may terminate the review.

In the Joint Motions, the Parties represent that they “have now settled their dispute and have reached agreement to terminate the Petition” in each proceeding, and that “neither Patent Owner nor Petitioner will be prejudiced by termination of” the proceedings. Paper 15, 2. The Parties further represent that the Agreement is “the entire agreement or understanding between the Parties made in connection with, or in contemplation of, the termination of” the proceedings, and that it “is a true and accurate copy of the agreement between the Parties that resolves” the proceedings. *Id.*

² For expediency, we cite to papers in IPR2022-01459. Similar papers were filed in IPR2022-01463.

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We instituted trials in the above-identified proceedings on April 11, 2023. Paper 7. Even though the proceedings have moved beyond the preliminary stage, we have not yet decided the merits, and the Parties have adequately shown that termination of the proceedings is appropriate. Under these circumstances, we determine that good cause exists to terminate the proceedings with respect to the Parties.

In the Joint Requests, the Parties request to file the Agreement “as business confidential, and to have it be kept separate from the file of the involved patent” in each proceeding. Paper 16, 1. After review, we find that the Agreement contains business confidential information regarding the terms of settlement. We determine that good cause exists to treat the 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, for the reasons discussed above, it is:

ORDERED that the Joint Motions are *granted*, and IPR2022-01459 and IPR2022-01463 are *terminated* with respect to Petitioner and Patent Owner pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. § 42.72; and

FURTHER ORDERED that the Joint Requests are *granted*, and the Agreement shall be kept separate from the files of Patents 7,730,507 B2 and 7,760,213 B2, and be 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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