

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BOMBARDIER INC.,
Petitioner,

v.

THE LITEBOOK COMPANY LTD.,
Patent Owner.

IPR2023-00192
Patent 7,678,140 B2

Before JAMES P. CALVE, BARRY L. GROSSMAN, and
GEORGE R. HOSKINS, *Administrative Patent Judges*.

CALVE, *Administrative Patent Judge*.

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

I. INTRODUCTION

On July 10, 2023, Petitioner and Patent Owner (collectively, “the Parties”) filed a Joint Motion to Terminate Proceeding (“Joint Motion”) in the above-identified *inter partes* review due to a settlement. Paper 10. The Parties previously sought authorization to file their Joint Motion, and we provided that authorization via email on July 6, 2023. *Id.* at 1. In support of their Joint Motion, the Parties filed a Settlement Agreement (Ex. 1035) and a Joint Request to File Settlement Agreement as Business Confidential Information Pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) (Paper 11, “Joint Request”).

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 317(a) also provides that the Office may terminate the review if no petitioner remains in the *inter partes* review.

In the Joint Motion, the Parties represent that they have settled their dispute regarding U.S. Patent No. 7,678,140 (“the ’140 patent”) and the filed copy of the Settlement Agreement is a true and correct copy that represents their entire agreement. Joint Motion 1–2 (“[T]he parties have no collateral agreements or understandings in connection with, or in contemplation of, the termination of the *inter partes* review.”). The Parties also represent that the Settlement Agreement resolves their dispute regarding the ’140 patent in this proceeding and the related district court litigation, and no further litigation is anticipated between them concerning the ’140 patent. *Id.* at 1.

The parties assert that “good cause exists to terminate the proceedings based on settlement as the Board has not yet conducted an oral hearing or otherwise resolved the merits of the Petition.” Joint Motion 2.

Although we have instituted trial in this proceeding, no briefing has been submitted during the trial, we have not yet decided the merits of the proceeding, and a final written decision has not been entered. Notwithstanding that the proceeding has moved beyond the preliminary stage, the parties have shown adequately that termination of the proceeding is appropriate. In these circumstances, we determine that good cause exists to terminate the proceeding.

The parties also filed a Joint Request that the Settlement Agreement be treated as business confidential information and be kept separate from the file of the ’140 patent in this proceeding. Joint Request 1. After reviewing the Settlement Agreement, we find that the Settlement Agreement contains confidential business information regarding the terms of settlement. We determine that 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, for the reasons discussed above, it is:

ORDERED that the Joint Motion by Petitioner and Patent Owner to Terminate Proceeding is *granted*, and IPR2023-00192 is *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 Request to Treat Settlement Agreement as Business Confidential Information is *granted*, and the Settlement Agreement shall be kept separate from the file of the above-referenced patent, 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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