

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD. and
SAMSUNG ELECTRONICS AMERICA, INC.,
Petitioner,

v.

NEODRON LTD.,
Patent Owner.

IPR2020-00308
Patent 10,365,747 B2

Before MIRIAM L. QUINN, PATRICK M. BOUCHER, and
CHRISTOPHER L. OGDEN, *Administrative Patent Judges*.

QUINN, *Administrative Patent Judge*.

ORDER
Denying Joint Motion to Terminate
37 C.F.R. § 42.74

With our authorization, the parties filed a Joint Motion to Terminate this proceeding. Paper 29. With the Joint Motion, the parties filed copies of exhibits they describe as “a true copy of the settlement agreement that resolves the disputes in the above-captioned *inter partes* review related to the Patent-in-Suit.” *Id.* at 1; *see* Exs. 2016–2018. In their Joint Motion, the parties represent that “[t]here are no other collateral agreements between the parties made in connection with, or in contemplation of, the termination sought.” *Id.* The parties further represent, in a Joint Request to Keep Separate, that “[t]he settlement agreements resolve the disputes in the above-captioned *inter partes* review relating to U.S. Patent No. 10,365,747.” Paper 30, 1. “The parties jointly request that the Board treat the settlement agreements as business confidential information and keep them separate from the files of this proceeding and the files of the Patent-in-Suit.” *Id.*

“An *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.” 35 U.S.C. § 317(a). The filed settlement agreements between Petitioner and Neodron Ltd. include redactions. *See* Exs. 2016-2018. As such, those agreements are not “true copies of the settlement agreements” as asserted by the parties, and as required under both the relevant statute and regulation. *See* 35 U.S.C. § 317(b) (“Any agreement or understanding between the patent owner and a petitioner . . . made in connection with, or in contemplation of, the termination of an *inter partes* review under this section shall be in writing and a true copy of such agreement or understanding shall be filed in the Office before the termination of the *inter partes* review”); 37 C.F.R.

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§ 42.74(b) (“Any agreement or understanding between the parties made in connection with, or in contemplation of, the termination of a proceeding shall be in writing and a true copy shall be filed with the Board before the termination of the trial.”).

We accordingly deny the Joint Motion to Terminate. Also, because a request to keep separate “must be filed with the settlement,” 37 C.F.R.

§ 42.74(b), and true copies of the settlement have not yet been filed, we also deny the Joint Request to Keep Separate at this time. The parties may file a renewed Joint Motion to Terminate and a renewed Joint Request to Keep Separate with *true copies* of the settlement agreements.

It is

ORDERED that the joint Motion to Terminate is *denied*, without prejudice;

FURTHER ORDERED that the Joint Request to Keep Separate is also *denied*, without prejudice.

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