

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ASCEND PERFORMANCE MATERIALS OPERATIONS LLC,
Petitioner,

v.

SAMSUNG SDI CO., LTD.,
Patent Owner.

IPR2020-00349
Patent 9,819,057 B2

Before CHRISTOPHER L. CRUMBLEY, JO-ANNE M. KOKOSKI, and
SHELDON M. MCGEE, *Administrative Patent Judges*.

CRUMBLEY, *Administrative Patent Judge*.

TERMINATION AND ORDER
Settlement After Remand; Lifting Stay of
Reissue Application No. 17/473,938
35 U.S.C. §§ 315(d), 317; 37 C.F.R. §§ 42.74, 42.122(a)

As set forth in our Order of December 21, 2021, the parties to this *inter partes* review requested that the Board temporarily stay further proceedings on remand from the Director while the parties engaged in settlement negotiations. Paper 59, 2. We agreed to delay consideration of the remand until January 7, 2022, but informed the parties that “if they are unable to reach a settlement by that date, the Board intends to proceed to consideration of the issues.” *Id.*

On January 7, counsel for Petitioner contacted the Board by email to inform us that the parties had not reached a settlement, and Patent Owner’s counsel subsequently contacted us to request an additional week for settlement negotiations, in light of “unforeseen challenges and delays.” Exs. 3001, 3002. We instructed the parties to update the Board by January 14, 2022, but did not commit to further delaying consideration on remand. Ex. 3003. Patent Owner’s counsel again contacted us on January 14, reporting “substantial progress,” and estimating a signed agreement within the “next two weeks.” Ex. 3004. Petitioner’s counsel contacted us on January 28, 2022, indicating that the parties had not reached a settlement and requesting that “the Board proceed with rendering a new final written decision.” Ex. 3005.

On February 4, 2022, prior to the Board issuing a new final written decision, the parties notified us that they had “reached an agreement in principle” and would “likely” file a joint motion to terminate “shortly.” Ex. 3006. We reminded counsel that prior authorization would be required before any such motion could be filed, and that the panel would not grant such authorization until the parties had reached a final agreement. Ex. 3007. The parties responded on February 9, 2022, acknowledging the Board’s instructions and informing us that the parties had executed a term sheet and

expected a formal settlement agreement to be executed “this week.”

Ex. 3008.

The Board received no further updates from the parties that week. In response to an inquiry from the panel, the parties indicated on February 17, 2022 that an “unexpected delay” had arisen and that a settlement was now anticipated “next week.” Ex. 3009. On February 24, 2022, the parties finally notified the Board that a final settlement and license agreement had been fully executed, and requested authorization to file a joint motion to terminate. Ex. 3010. We granted authorization, and the parties filed their Joint Motion to Terminate Proceeding on February 24. Paper 60. The Joint Motion was accompanied by a copy of the parties’ License Agreement (Ex. 1050) and a Joint Request to file the agreement as confidential (Paper 62).¹

In the Joint Motion, the parties contend that terminating this proceeding would promote the goal of “establishing a more efficient and streamlined patent system” by limiting unnecessary and counterproductive litigation costs. Paper 60, 2. The parties also argue that permitting settlement here would serve the goal of promoting future settlements in other cases. *Id.* The parties indicate that there is no copending litigation involving the ’057 patent, and no other pending *inter partes* or post-grant reviews. *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

¹ Petitioner also filed an apparently identical copy of the Joint Request as “Board Only,” (Paper 62) but that appears to have been in error, and we see no reason the Joint Request should not be public. We will expunge the “Board Only” version of the paper.

the proceeding.” 35 U.S.C. § 317(a). Here, although the Director’s Order (Paper 57) denied review of a number of issues that were decided in our prior Final Written Decision, the ultimate effect of the remand was to vacate our original decision. And while the panel has made progress toward issuing a new Final Written Decision on remand, we have not “decided the merits of the proceeding.” Thus, under 35 U.S.C. § 317(a), the Joint Motion of the parties requires termination with respect to Ascend Performance Materials Operations LLC as Petitioner. No petitioner remains in the *inter partes* review. In such situations, “the Office may terminate the review or proceed to a final written decision under section 318(a).” *Id.*

Upon consideration of the facts of this case, we believe termination of the *inter partes* review is warranted. As the parties observe, termination without rendering a final written decision on remand will eliminate the need for the parties to further litigate the validity of the ’057 patent on appeal, and we note in particular Patent Owner’s indication that there is no other pending infringement litigation involving the ’057 patent.

The License Agreement filed by the parties appears to be a true copy, and, after reviewing the agreement, we find that it contains confidential business information regarding the terms of settlement. We, therefore, believe it appropriate to grant the parties’ Joint Request to treat the agreement as business confidential information pursuant to 35 U.S.C. § 317(b).

Finally, in our Order of December 21, 2021, we found that Petitioner had articulated good cause to stay Patent Owner’s copending reissue application 17/473,938, which seeks reissue of the ’057 patent. Paper 59, 4. With the termination of this *inter partes* review proceeding, the

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circumstances establishing good cause are no longer operative. We, therefore, lift the stay of the '938 reissue application, effective immediately.

ORDER

In consideration of the foregoing, it is hereby:

ORDERED that the Joint Motion to Terminate (Paper 60) is *granted*, and IPR2020-00349 is *terminated* as to all parties;

FURTHER ORDERED that the Joint Request (Paper 63) is *granted*;

FURTHER ORDERED that the filed License Agreement (Ex. 1050) shall be treated as business confidential information, to be kept separate from the file of the '057 patent pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c), and shall remain designated as "Parties and Board Only" in the Board's filing system; and

FURTHER ORDERED that the stay of Reissue Application No. 17/473,938 is hereby lifted, and all time periods restarted.

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