

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ARNOLD & RICHTER CINE TECHNIK GMBH & CO. BETRIEBS KG,
Petitioner,

v.

ROTOLIGHT LIMITED,
Patent Owner.

IPR2021-01496 (Patent 10,197,257 B2)
IPR2021-01497 (Patent 10,197,258 B2)
IPR2021-01498 (Patent 10,203,101 B2)
IPR2022-00099 (Patent 10,845,044 B2)¹

Before RAE LYNN P. GUEST, GRACE KARAFFA OBERMANN, and
JEFFREY W. ABRAHAM, *Administrative Patent Judges*.

OBERMANN, *Administrative Patent Judge*.

TERMINATION

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

Dismissing Joint Motion to Waive Oral Argument
37 C.F.R. § 42.5(a)

¹ This Order addresses issues common to all four proceedings, except that the Joint Motion to Waive Oral Argument was filed only in IPR2022-00099 (Paper 38). The proceedings themselves are not consolidated.

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I. INTRODUCTION

On January 13, 2023, in each proceeding, Petitioner and Patent Owner filed a joint motion to terminate the *inter partes* review as a result of a settlement agreement that resolves all pending disputes between Petitioner and Patent Owner, and a joint request to treat the settlement agreement as business confidential information and to keep separate from the files of the involved patents, pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c). Papers 38, 34, 38, 36 (joint motions); Papers 39, 35, 39, 37 (joint requests).² That same day, they also filed a copy of their settlement agreement in each proceeding. Exs. 2016, 2016, 2016, 2020 (settlement agreements). The joint requests and settlement agreements were filed under seal as Board and Parties Only.

One day later, on January 14, 2023, the Board received an email from a non-party, Videndum Production Solutions, Inc. (“VPS”), alleging “that termination of these proceedings is not appropriate and contrary to the public interest.” Ex. 3001, 3001, 3001, 3002.

² In this section, we refer sequentially to papers and exhibits filed in IPR2021-01496 (“IPR496”), IPR2021-01497 (“IPR497”), IPR2021-01498 (“IPR498”), and IPR2022-00099 (“IPR099”). In subsequent sections, we refer only to papers and exhibits filed in IPR496, unless otherwise noted. Similar papers and exhibits were filed in each proceeding, except that the Joint Motion to Waive Oral Argument was filed only in IPR099 (Paper 38). We exercise our discretion and enter the same order in each proceeding.

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II. DISCUSSION

An *inter partes* review “shall be terminated with respect to any petitioner upon the joint request of the petitioner and 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) (“Section 317(a)”) (Board’s emphasis). As explained in our Consolidated Trial Practice Guide (“CTPG”), issued in November 2019,³ “[t]he Board expects that a proceeding will terminate” as to settling parties “after the filing of a settlement agreement, unless the Board has already decided the merits of the proceeding.” CTPG 86.

On December 13, 2022, the Board conducted a consolidated final hearing in IPR496, IPR497, and IPR498. *See* Paper 37 (transcript of consolidated hearing). A final hearing in IPR099 is set to occur on February 13, 2023. *See* IPR099, Paper 35 (hearing order). The Board has not entered a final decision on the merits in any of the four proceedings. Final written decisions are due in IPR496, IPR497, and IPR498 on March 16, 2023. In IPR099, the final written decision is due nearly two months later, on May 12, 2023.

VPS speculates that “there is a high likelihood that the Board has already decided the merits of the proceedings.” Ex. 3001, 1. As VPS acknowledges, however, the final hearing in IPR099 has not yet occurred, and several weeks remain before the final written decisions are due in the

³ Available at <https://www.uspto.gov/TrialPracticeGuideConsolidated>.

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other three cases. *Id.* Contrary to VPS’s speculation, the Board has not “decided the merits” of the four proceedings pursuant to Section 317(a).

VPS directs us to three nonbinding prior decisions in which the Board denied a motion to terminate where the motion was filed after a final hearing and, in two cases, prior to entry of a final written decision, upon a showing that “termination is against public interest.” *Id.* (citing Board decisions in *Rubicon Communications, LP, v. Lego A/S*, IPR2016-01187, Paper 100 (PTAB Dec. 14, 2017) (“*Rubicon*” or “IPR187”), *Apple Inc. v. Open TV, Inc.*, IPR2015-00969, Paper 29 (PTAB Sept. 10, 2016) (“*Apple*” or “IPR969”), and *Kinetic Technologies, Inc. v. Skyworks Solutions, Inc.*, IPR2014-00690, Paper 43 (PTAB Oct. 19, 2015) (“*Kinetic Technologies*” or “IPR690”)). Those nonbinding Board decisions are not persuasive here in light of the particular facts and circumstances at hand.

For example, none of the decisions cited by VPS relates to a case family where, as here, one of the cases has yet to be argued in a final hearing. In *Rubicon*, the Board denied a motion to terminate that was filed “*very near* the conclusion of the proceeding,” namely, “*less than one week* prior to the statutory due date to enter a final written decision.” IPR187, Paper 100 at 2 (Board’s emphasis). By contrast, the parties filed the instant motions to terminate with considerably more time remaining before the statutory due dates in all four proceedings and, moreover, well before the final hearing date set in IPR099. The due date for a final written decision in IPR099 is months away.

In *Apple*, as in *Rubicon*, the motions to terminate were “filed at an extremely late date in each proceeding,” after “oral hearings were held in

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each proceeding,” and after “the panel deliberated and decided the merits of each proceeding.” IPR969, Paper 29 at 4. Unlike in the instant case family, the Board in *Apple* was confronted with material questions of fact casting doubt on the sufficiency of the settlement agreements, which involved “signatories that [had] not been identified as real parties-in-interest.” *Id.* Thus, the Board in *Apple* could not “know whether,” or “rely on [the parties’] assurances that, these agreements in fact settle their disputes.” *Id.* at 5. No similar questions of fact cast doubt on the sufficiency of the settlement agreements in these proceedings. Furthermore, the Board has not heard final arguments, deliberated, or even preliminarily decided the merits of the case in IPR099. The facts at play in the *Apple* decision are inapposite.

The decision in *Kinetics Technologies* does not tip the scales against terminating the proceedings based on settlement. That decision includes little analysis and involves a motion to terminate filed *after* the final hearing and *after* the Board “had substantially decided the merits of the proceeding.” IPR690, Paper 43 at 20–21. There can be no meaningful dispute that the panel decided the merits of that case, prior to denying the motion for termination, where the denial of the motion was embedded within the final written decision. *Id.* No comparable facts support a denial of the motions for termination in the instant cases.

In a nutshell, we find that *Rubicon*, *Apple*, and *Kinetics Technologies* are not persuasive to support a denial of the instant motions for termination. A more recent Board decision demonstrates that the grant of a motion for termination, filed much later than those at issue here, may nonetheless be appropriate. *See Ascend Performance Materials Operations LLC, v.*

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Samsung SDI Co., LTD, IPR2020-00349, Paper 64 (PTAB, March 3, 2022) (“*Ascend Performance*” or “IPR349”). There, even *after* entry of a final written decision, the Board granted the parties’ joint motion to terminate the case prior to “rendering a new final written decision” on remand from the Director. IPR349, Paper 64 at 2–3, 5. Although the panel had “made progress toward issuing a new Final Written Decision on remand,” termination was granted where the Board had “not ‘decided the merits of the proceeding.’” *Id.* at 4. Neither have we decided the merits of any proceeding in this case family, although, as in *Ascend Performance*, “progress” has been made. *Id.*

We have considered VPS’s other arguments, but none persuades us to deny the motions for termination. *See generally* Ex. 3001. For example, VPS acknowledges that only a subset of the four patents-at-issue “have been asserted against VPS in” a district court action. *Id.* at 1. VPS’s further assertion that “other industry participants” are facing allegations of “infringement of the same patents” is vague and speculative. *Id.* On this record, although VPS may have some interest in the Board proceeding to final written decisions in the instant proceedings, we are not persuaded that termination is “contrary to” any broader “public interest.” *Id.*

We were first made aware of VPS’s asserted interests by an email received after the filing of the motions for termination, with no prior attempt by that non-party to otherwise be involved in the proceedings. *Id.* VPS does not explain why it could not have filed copy-cat petitions along with motions for joinder in one or all of the instant proceedings, to serve as a back-up or understudy petitioner in the event of a settlement between the parties. *Id.*

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VPS also indicates that it is not time-barred and may file its own petitions in the future. *See id.* at 2 (VPS’s assertion that it “may have to refile similar IPR petitions” if the Board terminates the instant cases). Those circumstances, taken together with the fact that termination leaves open the ultimate patentability issues implicated in these cases, persuade us that a grant of the instant motions for termination is appropriate.

Stated somewhat differently, VPS’s asserted interests as a non-party do not, on this record, outweigh the substantial interests of the actual participants in these proceedings. The parties have reached settlements in a collection of four IPRs, together with a co-pending district court action, involving all four related patents. Paper 39, 2. We take notice that so comprehensive a settlement likely involves robust, time-consuming, and sensitive negotiations, which we hesitate to undermine. Against that backdrop, the late-asserted interests of VPS, a non-party, do not outweigh the “strong public policy reasons to favor settlement between the” actual parties who have participated in these proceedings from the onset. CTPG 86.

The content of the settlement agreements supports the parties’ requests to treat the settlement agreements as business confidential information. Ex. 2016. The Joint Motion to Waive Oral Argument in IPR099 (Paper 38) is *dismissed* as moot.

III. CONCLUSION

For the above reasons, we determine that termination of the proceedings as to both Petitioner and Patent Owner is appropriate. Pursuant to Rule 42.74(c), we also grant the parties’ requests to treat the settlement

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agreements as business confidential information, and to keep those agreements separate from the files of the patents-at-issue. The Joint Motion to Waive Oral Argument in IPR099 is *dismissed* as moot.

IV. ORDER

It is

ORDERED that the joint motion to terminate each proceeding is *granted*;

FURTHER ORDERED that the settlement agreement in each proceeding shall be maintained as confidential business information and kept separate from the files of the challenged patent; and

FURTHER ORDERED that the Joint Motion to Waive Oral Argument in IPR2022-00099 is *dismissed* as moot.

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