

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INNOLUX CORPORATION
Petitioner

v.

SEMICONDUCTOR ENERGY
LABORATORY CO., LTD.
Patent OWNER

Cases IPR2013-00028 (Patent 6,404,480)
IPR2013-00038 (Patent 7,956,978)
IPR2013-00060 (Patent 7,697,102)
IPR2013-00064 (Patent 7,923,311)
IPR2013-00065 (Patent 7,923,311)
IPR2013-00066 (Patent 7,876,413)
IPR2013-00068 (Patent 8,068,204)¹

Before SALLY C. MEDLEY, KARL D. EASTHOM, and KEVIN F.
TURNER *Administrative Patent Judges*.

MEDLEY, *Administrative Patent Judge*.

¹ This order addresses a similar issue in the seven cases. Therefore, we exercise discretion to issue one order to be filed in each case. The parties, however, are not authorized to use this style of heading in subsequent papers.

ORDER
Conduct of the Proceeding
37 C.F.R. § 42.5

On November 26, 2013, a conference call was held between counsel for the respective parties and Judges Medley, Easthom and Turner.

The purpose of the conference call was to discuss a settlement agreement entered into by the parties. Counsel explained that the parties have a written settlement and licensing agreement which contemplates the termination of the *inter partes* review proceedings, along with the termination of the related litigation.

An *inter partes* review has been instituted in each of the seven cases. The Board does not have before it full briefing on the issues raised during each of the seven trials. Moreover, the Board has not entered a final written decision. Generally, the Board expects that a proceeding will terminate after the filing of a settlement agreement. *See, e.g., Office Patent Trial Practice Guide, 77 Fed. Reg. 48756, 48768 (Aug. 14, 2012)*. The rule governing settlement indicates that any agreement between the parties made in connection with, or in contemplation of, the termination of a proceeding² shall be in writing and filed with the Board. 37 C.F.R. § 42.74.

Based on the facts of these proceedings, the parties are authorized to, and shall file, in addition to the settlement agreement, a joint motion to terminate the proceeding briefly explaining why termination is appropriate in these cases. As explained, the parties also must file, as an exhibit, a true copy of their settlement agreement to terminate the proceedings. Any request that the agreement be treated as business confidential information

² A “proceeding” includes a preliminary proceeding. 37 C.F.R. § 42.2.

and be kept separate from the files of the involved patent must be filed with the settlement agreement. 37 C.F.R. § 42.74(c). The parties are directed to FAQ G3 on the Board's website page at <http://www.uspto.gov/ip/boards/bpai/prps.jsp> for instructions on how to file their settlement agreement as confidential (*e.g.*, uploading as "Parties and Board Only").

Counsel agreed to file the joint motion to terminate each proceeding and the settlement agreement by close of business Wednesday, December 4, 2013.

Accordingly, it is

ORDERED that the parties are authorized to file a separate joint motion to terminate in each of the seven proceedings;

FURTHER ORDERED that the joint motions are due December 4, 2013; and

FURTHER ORDERED that the joint motions shall be accompanied by a true copy of the settlement agreement as required by 37 C.F.R. § 42.74(b);

FURTHER ORDERED that the parties may request that the settlement agreement be treated as business confidential information as specified by 37 C.F.R. § 42.74(c);

FURTHER ORDERED that any confidential settlement agreement must be filed electronically in each of the seven proceedings via the Patent Review Processing System (PRPS) in accordance with the instructions provided on the Board's website (*e.g.*, uploading as "Parties and Board Only"); and

FURTHER ORDERED that the remaining DUE DATES in each of the seven proceedings are *vacated*.

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