

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

WINTEK CORPORATION,
Petitioner,

v.

TPK TOUCH SOLUTIONS,
Patent Owner.

Case IPR2013-00567¹
Patent 8,217,902 B2

Before TONI R. SCHEINER, JOSIAH C. COCKS, and
RICHARD E. RICE, *Administrative Patent Judges*.

COCKS, *Administrative Patent Judge*.

DECISION
Termination of the Proceeding
35 U.S.C. § 317 and 37 C.F.R. § 42.72

¹ IPR2014-00541 has been joined with IPR2013-00567. *See* IPR2013-00567, Paper 23.

On November 25, 2014, Petitioner, Wintek Corporation, and Patent Owner, TPK Touch Solutions, Inc. (collectively referred to as “the Parties”) filed a joint motion to terminate this *inter partes* review involving U.S. Patent 8,217,902. Paper 52 (“Joint Motion to Terminate”); *see* 35 U.S.C. § 317; 37 C.F.R. § 42.72. Authorization to file the motion was given via e-mail correspondence from Board personnel on November 21, 2014. Along with the Joint Motion to Terminate, the Parties filed a true copy of their written settlement agreement (Ex. 2029), as well as a joint request (Paper 53) to have their settlement agreement treated as business confidential information under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

The Parties state in their Joint Motion to Terminate:

The parties respectfully submit that termination is appropriate because Patent Owner has agreed to license U.S. Patent No. 8,217,902 to Petitioner (*see* Settlement Agreement § 2.1), the parties have settled all disputes with respect to U.S. Patent No. 8,217,902 and the parties have agreed to terminate this *inter partes* review. No public interest or other factors militate against termination of this proceeding.

Paper 52, 2.

The parties also state that “Patent Owner represents that it does not contemplate initiating any proceedings involving U.S. Patent No. 8,217,902 in the foreseeable future, either against Petitioner or any third party.” *Id.* The Parties further state that they have agreed to dismiss with prejudice litigation relating to U.S. Patent 8,217,902 styled *TPK Touch Solutions Inc. v. Wintek Corp.*, Civ. A. No. 3:13-CV-02218-VC (N.D. Cal.). *Id.* at 1.

The Parties are reminded that the Board is not a party to the settlement, and may identify independently any question of patentability.

37 C.F.R. § 42.74(a). Generally, however, 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. 48,756, 48,768 (Aug. 14, 2012).

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.” The requirement for terminating review with respect to Wintek is met.

Furthermore, under 35 U.S.C. § 317(a), “[i]f no petitioner remains in the *inter partes* review, the Office may terminate the review or proceed to a final written decision under section 318(a).” Wintek is the sole petitioner in this review. The Board has discretion to terminate this review with respect to TPK.

Upon consideration of the circumstances of this case, the panel has determined to terminate this *inter partes* review as to both Wintek and TPK without rendering a final written decision. The oral argument scheduled for December 12, 2014 is cancelled.

TPK’s Motion to Seal (Paper 28) is pending. Because this proceeding is terminated without rendering a final written decision, the Motion to Seal is dismissed as moot. The subject paper (Ex. 2019) of the Motion to Seal is hereby expunged.

It is

ORDERED that, as was requested timely by the Parties (Paper 53), the settlement agreement (Paper 2029) will be treated as business confidential information under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c);

IPR2013-00567
Patent 8,217,902 B2

FURTHER ORDERED that TPK's Motion to Seal (Paper 28) is *dismissed* as moot;

FURTHER ORDERED that Exhibit 2019 is hereby expunged;

FURTHER ORDERED that the oral argument scheduled for December 12, 2014 is *cancelled*; and

FURTHER ORDERED that the joint motion to terminate IPR2013-00567 is *granted* and this proceeding is hereby *terminated*.

PETITIONER:

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