

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TAIWAN SEMICONDUCTOR MANUFACTURING COMPANY, LTD.,
TSMC NORTH AMERICA CORPORATION, FUJITSU
SEMICONDUCTOR LIMITED, FUJITSU SEMICONDUCTOR
AMERICA, INC.,
ADVANCED MICRO DEVICES, INC., RENESAS ELECTRONICS
CORPORATION, RENESAS ELECTRONICS AMERICA, INC.,
GLOBAL FOUNDRIES U.S., INC., GLOBALFOUNDRIES DRESDEN
MODULE ONE LLC & CO. KG, GLOBALFOUNDRIES DRESDEN
MODULE TWO LLC & CO. KG, TOSHIBA AMERICA ELECTRONIC
COMPONENTS, INC., TOSHIBA AMERICA INC., TOSHIBA
AMERICA INFORMATION SYSTEMS, INC., TOSHIBA
CORPORATION, and THE GILLETTE COMPANY

Petitioners,

v.

ZOND, LLC,
Patent Owner.

Case IPR2014-00781¹
Patent 7,147,759 B2

Before KEVIN F. TURNER, JONI Y. CHANG, SUSAN L.C. MITCHELL,
and JENNIFER M. MEYER, *Administrative Patent Judges*.

CHANG, *Administrative Patent Judge*.

ORDER

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

¹ This Order addresses similar issues in the *inter partes* reviews identified in the Appendix of this Order. For efficiency, we enter this Order in this case as representative. The parties may not use this style of filing in subsequent papers, without prior authorization.

We instituted an *inter partes* review in each of the proceedings identified in the Appendix of this Order, challenging U.S. Patent Nos. 6,805,779 B2, 6,806,652 B1, 6,853,142 B2, 6,896,773 B2, 6,896,775 B2, 7,147,759 B2, 7,604,716 B2, 7,808,184 B2, and 7,811,421 B2. Paper 13.² After institution, we also granted the revised Motions for Joinder filed by Taiwan Semiconductor Manufacturing Company, LTD., TSMC North America Corporation (collectively, “TSMC”), Fujitsu Semiconductor Limited and Fujitsu Semiconductor America, Inc. (collectively, “Fujitsu”), Advanced Micro Devices, Inc. (“AMD”), Renesas Electronics Corporation, Renesas Electronics America, Inc. (collectively, “Renesas”), GLOBALFOUNDRIES U.S., Inc., GLOBALFOUNDRIES Dresden Module One LLC & Co. KG, GLOBALFOUNDRIES Dresden Module Two LLC & Co. KG (collectively, “GlobalFoundries”), Toshiba America Electronic Components, Inc., Toshiba America Inc., Toshiba America Information Systems, Inc., and Toshiba Corporation (collectively, “Toshiba”), and The Gillette Company (“Gillette”). *See, e.g.*, Papers 16, 17, 18. A list of these Joinder Cases is provided in the Appendix of the instant Order.

On March 9, 2015, a telephone conference call was held between respective counsel for the parties and Judges Turner, Chang, Mitchell, and Meyer. During the conference call, TSMC and Zond sought authorization to file a joint motion to terminate each of the pending proceedings, only with respect to TSMC.

² All citations are to IPR2014-00781, as representative, unless otherwise noted.

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. 48,756, 48,768 (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 proceeding shall be in writing and filed with the Board. 37 C.F.R. § 42.74. Based on the facts before us, we authorize TSMC and Zond to file a joint motion to terminate these proceedings with respect to TSMC.

Each joint motion to terminate must include a brief explanation as to why termination of these proceedings with respect to TSMC is appropriate. Because TSMC has been the lead petitioner in some of the joined proceedings (*see* Paper 18), the Board requested the parties to designate a new lead petitioner in each joined proceeding and identify any impact on the new lead petitioner's ability to file subsequent briefing papers (e.g., replies and motions to exclude evidence) and take depositions of Zond's witnesses, as well as identify any impact on the trial schedule of each joined proceeding, including any combination of patents for which a single hearing may be held. The parties are authorized to file this information as a separate paper concurrently with the joint motion to terminate.

The joint motion to terminate also must be accompanied by *a true copy* of the settlement agreement as required by 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b). A redacted version of the settlement agreement will not be accepted as a true copy of the settlement agreement.

TSMC and Zond also are authorized to file a joint request that the settlement agreement be treated as business confidential information under

37 C.F.R. § 42.74(c), requesting that the settlement agreement be kept confidential from the public and other petitioners. TSMC and Zond must file the confidential settlement agreement electronically via the Patent Review Processing System (PRPS) in accordance with the instructions provided on the Board's website (uploading as "Filing Party and Board Only")³, and then contact the Board's administrative staff at 571-272-7822, requesting the Board to change the designation to "Board Only."

In consideration of the foregoing, it is hereby:

ORDERED that TSMC and Zond are authorized to file a joint motion to terminate each pending review identified in the Appendix, with respect to TSMC, within five business days from the date of this Order; the motion must include a brief explanation as to why termination of these proceedings with respect to TSMC is appropriate;

FURTHER ORDERED that the parties are authorized to file, as a separate paper concurrently with the joint motion to terminate, the information requested by the Board in each proceeding;

FURTHER ORDERED that the joint motion must be accompanied by a true copy of the settlement agreement between TSMC and Zond made in connection with the termination, as required by 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b); for efficiency, TSMC and Zond may file the settlement agreement for each patent, as an exhibit, in one of the

³See FAQ G2 on the Board's website page at <http://www.uspto.gov/ip/boards/bpai/prps.jsp> for more information on how to file their settlement agreement as confidential.

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proceedings involving that patent, but each joint motion to terminate must contain an appropriate reference to the settlement agreement;

FURTHER ORDERED that TSMC and Zond may file a separate paper requesting that the settlement agreement be treated as business confidential information as specified in 37 C.F.R. § 42.74(c); and

FURTHER ORDERED that any confidential settlement agreement must be filed electronically via PRPS in accordance with the instructions set forth above.

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