

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

MACRONIX INTERNATIONAL CO., LTD., MACRONIX ASIA  
LIMITED, MACRONIX (HONG KONG) CO., LTD., and  
MACRONIX AMERICA, INC.,  
Petitioner,

v.

SPANSION LLC,  
Patent Owner.

---

Case IPR2014-00103 (Patent 6,369,416 B1)  
Case IPR2014-00104 (Patent 6,459,625 B1)  
Case IPR2014-00105 (Patent 6,731,536 B1)  
Case IPR2014-01250 (Patent 6,731,536 B1)  
Case IPR2014-00108 (Patent 7,151,027 B1)  
Case IPR2014-00898 (Patent 7,151,027 B1)

Before HOWARD B. BLANKENSHIP, DEBRA K. STEPHENS,  
KRISTEN L. DROESCH, JUSTIN T. ARBES, and RICHARD E. RICE,  
*Administrative Patent Judges.*

ARBES, *Administrative Patent Judge.*

JUDGMENT  
Termination of the Proceedings  
*37 C.F.R. § 42.72*

IPR2014-00103, IPR2014-00104, IPR2014-00105, IPR2014-01250, IPR2014-00108, IPR2014-00898

On January 28, 2015, the parties filed, in each of the instant proceedings, a joint motion to terminate the proceeding on the basis of a settlement reached by the parties. *See* 35 U.S.C. § 317(a); 37 C.F.R. § 42.72. The parties also filed a copy of their written settlement agreement and a request that the settlement agreement be treated as business confidential information under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).<sup>1</sup>

The parties' joint motion to terminate was filed prior to the oral hearings in Cases IPR2014-00103, IPR2014-00104, IPR2014-00105, IPR2014-00108, and IPR2014-00898, and the Board has not made a final decision on the merits in any of the proceedings. *See* 35 U.S.C. § 317(a). Regarding Case IPR2014-01250, the Board has not yet determined whether to institute an *inter partes* review. The parties represent that their "settlement agreement has resolved all disputes involving the [four challenged patents] between all the parties" in the related district court case and International Trade Commission investigation, and that the parties will be filing a motion to dismiss and a motion to terminate, respectively, in those proceedings. Paper 35, 7–9. The parties further represent that there are "no other petitions for *inter partes* review" and "no other litigations" involving the challenged patents. *Id.* at 7. Given these facts, we determine that it is appropriate to terminate the proceedings without rendering a final

---

<sup>1</sup> *See* IPR2014-00103, Papers 33–35; IPR2014-00104, Papers 31–33; IPR2014-00105, Papers 39–41; IPR2014-01250, Papers 8–10; IPR2014-00108, Papers 42–44; IPR2014-00898, Papers 34–36. As the papers are the same in each proceeding, we will refer to those filed in Case IPR2014-00103 for convenience. We authorized the joint motion to terminate in a conference call on January 26, 2015.

IPR2014-00103, IPR2014-00104, IPR2014-00105, IPR2014-01250, IPR2014-00108, IPR2014-00898

written decision under 37 C.F.R. § 42.72. The oral hearings in all of the instant proceedings are cancelled.

Regarding Case IPR2014-00105, we previously granted Patent Owner's motion to seal and ordered that Paper 24, Exhibits 2010–2021, and the unredacted version of Exhibit 2005 be maintained under seal. *See* IPR2014-00105, Paper 29, 6–7. The sealed materials were filed after institution of trial and were not considered by the Board in instituting trial. Given that we are not rendering a final written decision in the proceeding, the sealed materials will be expunged from the record unless either party objects within five business days by emailing the Board at *Trials@uspto.gov*.

In consideration of the foregoing, it is hereby:

ORDERED that the parties' joint request that the settlement agreement be treated as business confidential information, kept separate from the files of U.S. Patent No. 6,369,416 B1, U.S. Patent No. 6,459,625 B1, U.S. Patent No. 6,731,536 B1, and U.S. Patent No. 7,151,027 B1, and made available only to Federal Government agencies on written request, or to any person on a showing of good cause, under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c), is *granted*;

FURTHER ORDERED that the joint motion to terminate the instant proceedings is *granted* and the proceedings are hereby *terminated*; and

FURTHER ORDERED that, unless either party objects within five business days of this Judgment, Paper 24, Exhibits 2010–2021, and the unredacted version of Exhibit 2005 in Case IPR2014-00105 will be expunged from the record of the proceeding.

IPR2014-00103, IPR2014-00104, IPR2014-00105, IPR2014-01250,  
IPR2014-00108, IPR2014-00898

PETITIONER:

Michael M. Murray  
Michael J. Scheer  
Andrew R. Sommer  
Steven M. Anzalone  
WINSTON & STRAWN  
[mmurray@winston.com](mailto:mmurray@winston.com)  
[mscheer@winston.com](mailto:mscheer@winston.com)  
[asommer@winston.com](mailto:asommer@winston.com)  
[sanzalone@winston.com](mailto:sanzalone@winston.com)

PATENT OWNER:

J. Steven Baughman  
Gabrielle E. Higgins  
ROPES & GRAY LLP  
[steven.baughman@ropesgray.com](mailto:steven.baughman@ropesgray.com)  
[gabrielle.higgins@ropesgray.com](mailto:gabrielle.higgins@ropesgray.com)