

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HTC CORPORATION,
HTC AMERICA, INC.,
LG ELECTRONICS, INC.,
SAMSUNG ELECTRONICS CO., LTD., and
SAMSUNG ELECTRONICS AMERICA, INC.,
Petitioner,

v.

PARTHENON UNIFIED MEMORY ARCHITECTURE LLC,
Patent Owner.

Case IPR2015-01500 (Patent 7,321,368 B2)
Case IPR2015-01501 (Patent 7,777,753 B2)
Case IPR2015-01502 (Patent 7,542,045 B2)¹

Before JAMES B. ARPIN, MATTHEW R. CLEMENTS, and
SUSAN L. C. MITCHELL, *Administrative Patent Judges*.

ARPIN, *Administrative Patent Judge*.

TERMINATION

Termination of Proceedings Only As To Samsung Electronics Co., Ltd., and
Samsung Electronics America, Inc.

37 C.F.R. § 42.72

¹ The parties are not authorized to use a multiple proceeding caption. They must file individual papers separately in each proceeding to which they pertain.

IPR2015-01500 (Patent 7,321,368 B2)

IPR2015-01501 (Patent 7,777,753 B2)

IPR2015-01502 (Patent 7,542,045 B2)

On May 24, 2016, Patent Owner and two Petitioners, Samsung Electronics Co., Ltd., and Samsung Electronics America, Inc. (the “Samsung Petitioners”),² filed Joint Motions (Papers 25)³ to terminate the above-captioned *inter partes* reviews with respect to the Samsung Petitioners only and Joint Requests to treat the settlement agreements (Exhibits 1031) filed in each proceeding, as business confidential information (Papers 26), to be kept separate from the patent files. *See* 35 U.S.C. § 317(a) and (b); 37 C.F.R. §§ 42.72, 42.74. Patent Owner and the Samsung Petitioners stated in the joint motion that:

The Parties have settled their disputes and executed a settlement agreement to terminate this proceeding, as well as the Parties’ related district court litigation regarding the [challenged] Patent: *Parthenon Unified Memory Architecture LLC v. Samsung Electronics Co., Ltd. et al.*, Case Number 2:14-cv-00902 (E.D. Tex.). The district court litigation was dismissed with prejudice on May 20, 2016.

Paper 25, 2. Further, Patent Owner and the Samsung Petitioners identified four district court litigations involving the patents challenged in the captioned reviews, in which Patent Owner asserts these patents against the remaining Petitioners, as well as ZTE (TX) Inc., ZTE Corporation, and ZTE USA, Inc.⁴ *Id.* at 2–3. The parties indicate that no other litigation or proceeding involving these patents is contemplated in the foreseeable future. *Id.* at 3.

² The remaining Petitioners are HTC Corporation; HTC America, Inc.; and LG Electronics, Inc.

³ Except where a particular proceeding is identified, the same paper and exhibit numbers are applicable to each of the captioned proceedings. The citations refer to the papers and exhibits filed in *each* proceeding.

⁴ Petitioners do not identify ZTE (TX) Inc., ZTE Corporation, or ZTE USA, Inc. as a privy or a real party-in-interest in any of the captioned proceedings. *See, e.g.*, IPR2015-01501, Paper 1, 2.

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In addition, Patent Owner and the Samsung Petitioners also identify two other *inter partes* reviews to which they are parties: IPR2015-01944 (terminated) and IPR2015-01946 (terminated). Moreover, ZTE USA, Inc. has filed petitions for *inter partes* review challenging the patents challenged in these proceedings: IPR2016-00666 (U.S. Patent No. 7,321,368 B2), IPR2016-00667 (U.S. Patent No. 7,542,045 B2), and IPR2016-00670 (U.S. Patent No. 7,777,753 B2). *Id.*

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 patent owner, unless the Office has decided the merits of the proceeding before the request for termination is filed.” The Board instituted a trial in each of these proceedings on January 6, 2016, (IPR2015-01500, Paper 14; IPR2015-01501, Paper 12; IPR2015-01502, Paper 14), but has not decided the merits of any of the proceedings.

Further, under 37 C.F.R. § 42.74(b), “[a]ny agreement or understanding between the parties made in connection with, or in contemplation of, the termination of a proceeding shall be in writing and a true copy shall be filed with the Board before termination of the trial.” *See also* 37 C.F.R. §§ 42.72; 42.73(a). In the Joint Motions, the parties represent that the district court litigation involving Patent Owner and the Samsung Petitioners has been dismissed with prejudice (Paper 25, 2), and that a true copy of the settlement agreement between Patent Owner and the Samsung Petitioners has been filed in each proceeding (*id.* at 3–4 (citing Ex. 1031)). Moreover, the parties represent that “[t]here are no collateral agreements or understandings made in connection with, or in contemplation of, the termination of the inter partes review.” *Id.* at 4. In view of the representations set forth in the Joint Motions, we determine that it is appropriate to terminate these

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proceedings with respect to the Samsung Petitioners prior to rendering final written decisions. *See* 37 C.F.R. §§ 42.72, 42.73(a).

ORDER

In consideration of the foregoing, it is hereby:

ORDERED that the Joint Motions of Patent Owner and the Samsung Petitioners to terminate these proceedings only with respect to the Samsung Petitioners are *granted*;

FURTHER ORDERED that the Joint Requests of Patent Owner and the Samsung Petitioners to treat the settlement agreements as business confidential information to be kept separate from the patent files are *granted*; and

FURTHER ORDERED that these proceedings hereby are terminated only with respect to the Samsung Petitioners.

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